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OF THE TTAB

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

BUTLER

Mailed: July 26, 2011

Cancellation No. 92051353

RAWLINGS SPORTING GOODS
COMPANY, INC.

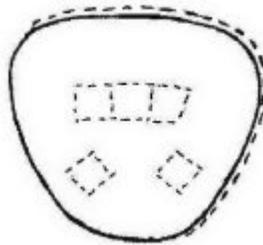
v.

PETER C. BIRMINGHAM

Before Grendel, Holtzman and Wellington, Administrative Trademark
Judges.

By the Board:

Petitioner seeks to cancel respondent's registration for the
following mark



for a "baseball and softball training apparatus, namely a glove
used for catching practice."¹ The following description of the
mark is of record:

¹ Registration No. 3019645, issued on November 29, 2005, claiming a
date of first use anywhere and a date of first use in commerce of
1983; and claiming acquired distinctiveness pursuant to Trademark Act
§ 2(f).

The mark consists of the design/configuration of the training apparatus/glove which is triangular in shape with curve edges. Broken lines are not a part of the mark. They are just shown to see a 3 dimensional view of the glove/apparatus.

Applicant, thus, had made it clear that his mark consists only of the triangular configuration of the glove.²

As grounds for cancellation, petitioner alleges that respondent's mark, consisting of a glove design that is triangular with curved edges, comprises matter that, as a whole, is functional within the meaning of Trademark Act § 2(e)(5). Petitioner alleges that the mark was the subject of U.S. Patent No. 4802669 (now expired) for a "Baseball Training Device."

In his answer, respondent admits that the registered mark was the subject of the expired patent but otherwise denies the essential allegations of the complaint.

Petitioner's main testimony period was set to open on June 24, 2011.³ This case now comes up on petitioner's motion for summary judgment, filed June 22, 2010. Respondent filed a response thereto.

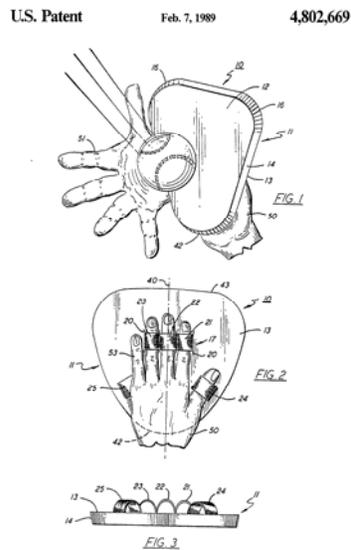
Background

As explained in the patent file record (introduced by petitioner) and the parties' statements of undisputed facts, the

² The lined portions within the triangular design are merely to show location of thumb and finger loops on the goods. To hold the mitt properly, the user inserts the thumb and fingers into the loops. These loops, and the lined shadow of the triangular shape showing dimension, are not features of the registered mark.

subject matter of the expired patent is a baseball (or softball) training device worn upon a fielder's glove hand to aid the wearer in developing proper fielding skills. The invention is intended to teach a fielder better skills, namely, to receive a ball in the heel of the glove hand and use two hands when fielding or catching the ball.

The following drawings are set out in the patent:



The abstract of the patent explains the invention as follows:

A baseball training device that is worn upon a fielder's glove hand for aiding the wearer in developing proper fielding skills. *The device has a thick triangular shaped pad that encompasses the entire hand.* Webbing on the back surface of the pad encircles the thumb and first three fingers of the glove hand to position the apex of the pad over the wearer's wrist and the base leg of the pad extended beyond the

³ Petitioner served pretrial disclosures on the due date of June 8, 2010.

wearer's fingertips. The pad is comprised of a resilient material that will deform upon being struck by a ball over the heel region of the hand to provide the ball sufficient residency time on the pad to enable the wearer to bring his or her other hand over the ball and thus complete the catch. Balls striking the pad in other areas are provided little or no residency time and are thus more difficult to field.

(Emphasis added.)

What is claimed is:

1. A baseball training device that is worn over the glove hand of a player to aid the wearer in developing good fielding skills *that includes a triangular shaped uniformly resilient pad* having planar front and back surfaces, said pad having hand attachment means on the back surface thereof for encircling the thumb and first three fingers of the glove hand which will *align the middle finger along an axis of the triangle* with the apex of the pad being positioned over the wrist, the edge of the pad extending outwardly beyond the tips of the fingers and side edges of the user's hand, said pad having a resilience such that when worn on the hand of a player a ball striking said front surface backed by a wearer's hand heel portion will deform to a greater extent than the remaining portions of the pad and will have a longer surface contact time on said pad than balls striking the remaining portion of said pad whereby a wearer is afforded greater time in which to place his other hand over a ball when making a catch.
2. The training device of claim 1 wherein said attachment means further includes a pair of thumb loops diagonally disposed to each side of the finger loops whereby the device can be worn on either hand.
3. The training device of claim 2 wherein attachment members means is formed of an elastic material for biasing the thumb and fingers against the back of the pad.
4. The training device of claim 1 wherein the pad is formed of a high density foam material having closed cells whereby the pad is impervious to dirt and water.

(Column 4, lines 13-42. Emphasis added.)

The parties' arguments

In support of its motion, petitioner argues that applicant's mark is the functional shape of the goods and, pursuant to Trademark Act § 2(e)(5), is not entitled to trademark protection. Petitioner addresses the *Morton-Norwich* factors in advocacy of its position. *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 USPQ 9 (CCPA 1982). Those factors are:

- 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.

Id. at 15-16.

Specifically, petitioner points out that respondent obtained a utility patent (now expired) that disclosed and claimed the functional advantage of the triangular shape of the training glove; that respondent (as the patent applicant) distinguished the shape of his invention over the prior art referenced by the Patent Examiner; and that, before the patent expired, respondent filed a trademark application on the same product shape. Petitioner notes that, as reflected in the registration file record, the Trademark Examining Attorney refused to register the mark under Trademark Act § 2(e)(5) on the ground that the configuration was functional for the identified goods; that the

refusal was subsequently withdrawn; but that respondent never informed the Trademark Examining Attorney of the existence of the utility patent.⁴ Petitioner argues, as supported by the declaration of its category manager, Ryan Farrar, who states that he is involved in product development and marketing, that the shape of the training glove has utilitarian advantages because it covers the fingers, thumb, and heel of the hand in proper position (*i.e.*, alignment), mimics the outer profile of an actual glove, and protects all portions of the hand. Mr. Farrar states further that altering the shape could detract from the functionality of the product and be more expensive to make. More particularly, Mr. Farrar explains that the shape of the pad is important because the goal is to stop only those balls in the air that would be stopped by a player's glove; and that, if the shape were a rectangle or square, portions of the pad would extend beyond the normal circumference of a glove and could stop or block a ball in the air that would not normally be stopped by the player wearing a glove. Mr. Farrar states that the shape has cost advantages because it is less expensive to make and can be made without excess material or complicated construction; that the registered shape is needed for competition because it is a relatively low cost training aid; and that other products

⁴ In response to the Trademark Examining Attorney's refusal to register because the mark is the nondistinctive configuration of the goods, respondent (as applicant) amended the application to seek registration under Trademark Act § 2(f). Such amendment, with a declaration and accompanying evidence, was eventually accepted.

available in the industry are functionally different and more expensive to make because they are made of more expensive material (e.g., leather or simulated leather), have a full pocket for the hand, and require joining of several pieces. Mr. Farrar provides examples from the Internet indicating that petitioner's and respondent's products cost between \$10-20 while alternative training products cost between \$20-60.⁵

Petitioner introduces a copy of respondent's now-expired patent; the file record for the patent; the declaration of Mr. Farrar and accompanying exhibits of Internet printouts featuring the parties' products and third-party products; and a copy of the registration file.

In response, respondent argues that he specifically disclaimed any particular shape of his product, as reflected in the patent at column 4, lines 4-11, which state as follows:

While this invention has been described in detail with respect to a single preferred embodiment, it should be recognized that the invention is not limited to that embodiment, and that many modifications and variations ...

As a consequence, respondent contends that there is no basis to determine that the shape of the product is essential to its function.⁶ Respondent points out that he has sold his product in

⁵ At least one of these third-party products appears to be an item to be inserted into the palm area of a player's glove as opposed to a distinctly separate hand-held pad or training glove.

⁶ The Board notes in passing that a patent applicant is required to set forth the best mode (*i.e.*, the preferred embodiment) in the patent

the triangular configuration for 27 years but has never made any claims in advertising relating to the superiority of the shape. Respondent contends that the shape of the product does not mimic a baseball glove but, instead, resembles a ping pong paddle or hand-held fan. Respondent argues that the shape of the product does not impact the cost. Specifically, respondent explains that the product is manufactured by being cut from square blocks of high density foam by a machine resembling a drill press with a cookie-cutter attachment that cuts the foam in the desired shape; that any shape could be cut in the same manner from the foam for the same price; and there is no ability to use the excess foam scraps. Respondent argues that the shape of the product may take any form without compromising the ultimate purpose of securing a baseball in the critical heel area of the hand, or "sweet spot," which provides sufficient residency time for the player to successfully entrap the ball with the free hand. Respondent indicates that players historically trained with flat, wooden boards (which he surmises may have been rectangular or square in shape) placed inside the glove and covering the player's palm. Respondent explains that it is the foam material, not the triangular shape, which provides the necessary resilience for the success of the product in meeting its purpose.⁷ Respondent

application, if known at the time. 35 U.S.C. § 112. See also MPEP § 2165 (8th ed. rev. July 2010).

⁷ To be clear, respondent's arguments concerning the material from which the gloves are made are directed only to the fourth *Morton-*

contends that the triangular shape is purely ornamental and aesthetic; that his design mark has secondary meaning in the market place;⁸ and that petitioner could choose a different configuration, such as a fan shape, rather than making an exact duplicate of his product.⁹

Summary judgment

In a motion for summary judgment, the moving party has the burden of establishing that there is no genuine dispute as to any material fact and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(a). A genuine dispute with respect to a material fact exists if sufficient evidence is presented such that a reasonable fact finder could decide the question in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts as to whether any particular

Norwich factor, whether the **design** (emphasis added) results in relatively simple or inexpensive method of manufacture. The material itself from which the product is made is not considered in determining whether respondent's mark is a functional configuration of the goods. Thus, the material used for the product and for alternative products, whether foam or leather or something else, cannot create a genuine dispute of material fact with respect to the question of the functionality of the mark.

⁸ A mark which is determined to comprise any matter that, as a whole is functional, within the meaning of Trademark Act § 2(e)(5), is not registrable under a showing of acquired distinctiveness. See also Trademark Act § 2(f); and TMEP § 1202.02(a)(i) (7th ed. Oct. 2010). However, a mark which is determined to be the nondistinctive configuration of the goods may be registrable with a showing of acquired distinctiveness. See TMEP § 1202.02(b)(i) (7th ed. Oct. 2010).

⁹ The Board notes in passing that respondent referred to the shape of its product as "a hand-held fan."

factual issues are genuinely in dispute must be resolved in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

1. Standing

Petitioner, as a competitor now offering a baseball training product using the same configuration as the one that is the subject matter of respondent's registered trademark, has a real interest in the outcome of this proceeding. See *Ritchie v. Simpson*, 170 F.3d 1092, 1098, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999). Accordingly, there is no dispute of material fact as to petitioner's standing, and petitioner has standing in this case.

2. Functionality

Section 2(e)(5) of the Trademark Act precludes registration of "any matter that, as a whole, is functional." The Supreme Court has clarified that a product feature is functional "if it is essential to the use or purpose of the article or if it affects the cost or quality of the article." *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 214 USPQ 1, 4 n.10 (1982). This "Inwood formulation" has been referred to as the "traditional rule" of functionality. See *TraFFix Devices Inc. v. Marketing Displays Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001). Although the existence of alternative designs may be considered in the determination of whether a product design is functional in the first place, once it is

determined, based on all of the evidence of record (especially the existence of a utility patent covering the product design), that the product design is functional under the *Inwood* "traditional rule," then the asserted existence of alternative designs does not suffice to overcome that determination that the product design is functional. That is, once a product feature is found to be functional under this "traditional rule," "there is no need to proceed further to consider if there is competitive necessity for the feature," and consequently "[t]here is no need ... to engage ... in speculation about other design possibilities... Other designs need not be attempted." *Valu Engineering Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1427 (Fed. Cir. 2002). "The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature." *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164, 34 USPQ2d 1161, 1163 (1995). As both parties recognize, consideration of the factors set out in *Morton-Norwich*, 671 F.2d 1332, 213 USQP 9, is generally involved in determining functionality. See also *Valu Engineering Inc.*, 61 USPQ2d 1422, 1426.

The existence of a prior utility patent is of vital significance. *Traffix*, 58 USPQ2d 1001, 1005. A utility patent is strong evidence that the features therein claimed are functional. *Id.* In considering any patent, in addition to the

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claims, the Board may consider any statements made in the patent application record and in the course of procuring the patent, including disclosures. See *Kistner Concrete Products, Inc. v. Contech Arch Technologies, Inc.*, 97 USPQ2d 1912, 1920 (TTAB 2011) and cases cited therein; and *M-5 Steel Mfg., Inc. v. O'Hagin's, Inc.*, 61 USPQ2d 1086, 1096 (TTAB 2001) and cases cited therein. Each embodiment of the invention described in a utility patent is equally functional for purposes of trademark law. See *Kistner Concrete, supra*; and *In re Edward Ski Products, Inc.*, 49 USPQ2d 2001, 2003 (TTAB 1999).

There is no doubt that respondent owned a now-expired utility patent for an invention which described the triangular configuration of the product as the preferred embodiment, and included it as an element of its independent Claim 1. Thus, notwithstanding respondent's position that the shape was somehow "disclaimed" in the patent, the shape is not considered "disclaimed" in considering the features disclosed, claimed and described and claimed in the patent to determine whether the shape is functional for purposes of trademark registrability. The triangular configuration, described in the patent as the preferred embodiment, is now the subject of respondent's Registration No. 3019645.

The expired utility patent demonstrates the utilitarian advantages of the triangular design. The shape of the pad as disclosed and claimed in the patent is not arbitrary or

ornamental, or incidental to the design and function of the training glove. Instead, it performs an essential function for the invention/product.¹⁰ Thus, the patent establishes that no genuine dispute of material fact exists and that the design, as a whole, is the functional configuration of the goods.

There is no evidence of record that respondent touts the utilitarian advantages of his design. This factor is neutral and does not raise a genuine dispute of material fact that would defeat the conclusion of functionality raised by the patent.

As noted earlier, insofar as the disclosures and claims in the expired patent establish the functionality of respondent's design, there is no need to consider the availability (actual or speculative) of other designs or if there is a competitive necessity for the feature. *Valu Engineering*, 61 USPQ 1422, 1427. Specifically, neither the availability of other designs nor the comparatively simple or inexpensive method of manufacture raises a genuine dispute of material fact in this case.

3. Acquired distinctiveness

Respondent's design is functional. Thus, any evidence of distinctiveness is of no avail to respondent in support of the maintenance of his registration. *See TrafFix*, 58 USPQ2d 1001, 1007 ("Functionality having been established, whether MDI's dual-

¹⁰ The Board notes in passing that, even if the triangular shape were not identified in the patent as the preferred embodiment, the claims of the patent would still encompass the shape for the function of the training pad/glove.

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spring design has acquired secondary meaning need not be considered"). See also *M-5 Steel Mfg. Co.*, 61 USPQ2d 1086.

Accordingly, petitioner's motion for summary judgment is granted; judgment is entered against respondent; the petition to cancel is granted; and the registration will be cancelled in due course.
