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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85700986
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application of:
Loggerhead Tools, LLC
Serial No.: 85/700,986
Filed: August 10, 2012
Mark: WRENCH MOTION

Trademark Examining Attorney:
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APPELLANT'S APPEAL BRIEF

Appellant, Loggerhead Tools, LLC (“Appellant” or “Loggerhead”), submits this Brief pursuant to a timely notice of appeal filed under 37 C.F.R. §§ 2.141 and 2.142. Appellant disputes the Examining Attorney’s assertions directed to the alleged functionality of Appellant’s applied-for mark in the above-identified application in view of the prior responses, each of which is fully incorporated herein by reference, including all exhibits thereto and evidence in support thereof. The functionality refusal is the only refusal outstanding in the pending application. All other matters having been resolved. Appellant requests that this Board reverse the refusal and pass this mark to publication.

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INTRODUCTION

Appellant filed a product configuration motion trademark application for its mark that depicts a portion of a hand tool as the jaw-like elements of the hand tool move radially in and out in a symmetrical iris-type motion. All refusals and objections were resolved with the examining attorney during prosecution of the application with the exception of the refusal based on the allegation that the applied-for mark is functional.

The errors made in the functionality determination include no consideration or weight given to the non-functional aspects of Appellant's product design and no consideration given to the third-party expert declarations provided by Appellant during prosecution. These errors resulted in the erroneous conclusion that Appellant's applied-for mark is functional. Careful consideration of all the evidence of record in the application, including the declarations of third parties, and consideration of the non-functional aspects of Appellant's design indicates that Appellant's applied-for mark includes aesthetic design choices such that Appellant's applied-for mark, overall, is non-functional and acceptable for registration. Appellant respectfully disagrees with the functionality refusal and requests that the Board reverse the refusal and pass the application to publication for the reasons set forth herein.

DESCRIPTION OF THE RECORD

On August 10, 2012, Appellant filed U.S. Application Serial No. 85/700,986 for the mark WRENCH MOTION (“Appellant’s Mark”) for “hand tools, namely, gripping tools in the nature of wrenches and wire crimpers for sale through mass merchandisers to retail consumers” in International Class 008. Appellant’s Mark is a product configuration motion mark in which a portion of Appellant’s hand tool moves. Appellant’s drawing a freeze-frame depiction of the motion showing five stages of such motion. The entire prosecution record for U.S. Serial No. 85/700,986 is *de facto* of record in this Appeal Brief as evidence.

On August 30, 2012, the examining attorney issued a first non-final office action. In the office action, the mark was refused registration based on functionality, failure to function, the identification of goods, and the description of the mark.

On January 23, 2013, Appellant submitted a response to the office action. In the response, Appellant addressed all the issues raised in the office action and submitted the requested information and supporting evidence.

On February 15, 2013, the examining attorney issued a second non-final office action. In the office action, Appellant’s amendment to the identification of goods was accepted. The mark was refused registration based on allegations of a distinctive product design, functionality, failure to function and inaccurate description of the mark.

On August 15, 2013, Appellant submitted a response to the office action. In the response, Appellant addressed all the issues raised in the second office action. In addition, Appellant submitted supporting information and evidence.

On September 10, 2013, the examining attorney issued a first final office action. In the final office action, the functionality and failure to function refusals were maintained.

On March 10, 2014, Appellant submitted a request for reconsideration that included further argument and supporting evidence regarding the outstanding issues raised in the final office action. Appellant also filed a notice of appeal.

On April 2, 2014, the examining attorney issued a non-final Office Action. In the non-final Office Action, the examining attorney requested information regarding Appellant's Mark. In addition, Appellant's Mark was refused registration for allegedly being directed to a nondistinctive product configuration, being function and for failure to function as a mark.

On October 2, 2014, Appellant filed its response to the Office Action. In the response, the outstanding issued were addressed as well as evidence in support thereof.

On October 26, 2014, the examining attorney issued a second final office action. In the second final office action, the nondistinctive product configuration and failure to function refusals were withdrawn. The only refusal that was maintained was the functionality refusal.

On April 27, 2015, Appellant filed a request for reconsideration. In the request for reconsideration, Appellant responded to the functionality refusal. In support thereof, Appellant introduced declarations of two experts (Dr. Kim and Dr. Colgate) as well as introduced a product sample. Appellant also re-attached evidence already of record.

On June 19, 2015, the examining attorney denied Appellant's request for reconsideration.

On June 23, 2015, Appellant's appeal was resumed by order of the Board.

THE ISSUES ON APPEAL

15 U.S.C. 1052(e)(5): Functionality

Issue: *Is Appellant's Mark essential to the use or purpose of the product such that it, as a whole, is functional and thus not suitable for registration?*

Can registration of Appellant's Mark be refused registration without consideration of all evidence made of record and without consideration and analysis of the non-functional aspects, in addition to the allegedly functional elements, of a product design?

ARGUMENT

I. Legal Framework

The Lanham Act states that no mark that distinguishes the goods of one party over the goods of another shall be refused registration on the principal register except in a few instances. 15 U.S.C. § 1052. One such instance is where the mark “comprises any matter that, as a whole, is functional. 15 U.S.C. § 1052(e)(5).

A feature is functional if it is ““essential to the use or purpose of the [product]”” or ““it affects the cost or quality of the [product].”” *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33, 58 U.S.P.Q.2d 1001, 1006 (2001) (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165, 34 U.S.P.Q.2d 1161, 1163-64 (1995)). However, in a case where an Appellant seeks to protect ornamental or incidental aspects of a product, protection under the Lanham Act is available. See *TraFFix*, 58 U.S.P.Q.2d at 1007.

To determine whether a mark is functional, a four factor test is considered. The four factors are: (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. *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332 , 213 U.S.P.Q. 9 (C.C.P.A. 1982). When considering the first factor (i.e. the existence of a utility patent), an Appellant may show that the aspects of an applied-for mark are directed to non-functional aspects by demonstrating that those aspects of the mark do not serve a functional purpose within the terms of the utility patent. *TraFFix*, 58 U.S.P.Q.2d at 1007. The functionality determination considers all the factors and depends on the totality of the evidence presented in a particular case. *Valu Eng'g Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 U.S.P.Q.2d 1422, 1426 (Fed. Cir. 2002).

In situations (as is present in this proceeding) where an applied-for mark includes both functional and non-functional features, “the critical question is the degree of utility present in the overall design of the mark.” *In re Becton, Dickinson and Co.*, 675 F.3d 1368, 102 U.S.P.Q.2d 1372, 1376 (Fed. Cir. 2012). A refusal cannot inappropriately focus on a single aspect of an applied-for mark and ignore the other elements of the mark that comprise the configuration as a whole. *In re Hershey Chocolate and Confectionary Corp.*, Proceeding No. 77809223, decided Dec. 8, 2011 (made of record in Appellant’s Response filed Aug. 15, 2013, Exhibit B). Any product configuration mark would be rendered unregistrable if the mark, as a whole, is not considered. *Id.* Even if certain features of a product are functional, it does not necessarily follow that the overall appearance of product is functional. *Id.*

II. Appellant’s Mark, as whole, is not functional because the mark as shown and described in Appellant’s application is directed to aesthetic design choices

The *Morton-Norwich* factors and the determination of functionality of a trademark application requires consideration of the totality of the circumstances and consideration of the non-functional aspects of the design when considering the applied-for mark as a whole. *See Becton, Dickinson and Co.*, 102 U.S.P.Q.2d at 1376. In this instance, all of the examining attorney’s determinations are rebutted by competent evidence such that the conclusory functionality determination fails. First, the declarations of experts in mechanical design support that significant elements of Appellant’s design are directed toward non-functional design choices rendering the overall design, and thus Appellant’s Mark, non-functional. In addition, consideration of the Morton-Norwich factors favors an overall determination of non-functionality.

a. Elements included in Appellant’s Mark are aesthetic design choices and do not render the overall mark functional

The refusal inappropriately declares Appellant's Mark functional without considering all the elements in the mark. As stated in *Morton-Norwich*, functionality determinations require consideration of all aspects of a mark because review of only the functional aspects would lead to an unacceptable interpretation of the law where "the design of a particular article would be protectable as a trademark only where the design was useless, that is, wholly unrelated to the function of the article." *Morton-Norwich*, 213 U.S.P.Q. at 13. This is the reason that determination of functionality requires consideration of the non-functional aspects of an applied-for mark. Appellant's Mark includes significant elements that are non-functional aesthetic design choices. These non-functional elements render the mark, as whole, non-functional.

Appellant's drawing and description is reproduced below.

Description	Drawing
The mark consists of a motion mark depicting the product configuration of a hand tool in which six rectangular-shaped jaw-like elements of the circular head of a hand tool radially move in and out. The elements symmetrically converge and diverge in a mechanical iris-type motion. The broken or dotted lines are not part of the mark and serve only to show the position or placement of the moving elements of the mark in the hand tool.	

As can be seen in the drawing, the relative size, shape and movement of the jaw-like elements of Appellant's Mark are elements of the mark. A photo of Appellant's product (the "Bionic Wrench") is shown below for reference. In addition, a product sample was made of record in this case. (See Request for Reconsideration filed Oct. 26, 2014, Appendix F).



The design choice to expose the jaws to the consumer when the product is being used along with the design choices regarding the size, shape and configuration of the jaws, opening and head of the tool creates a unique user experience. This unique consumer experience is distinctive in the marketplace and has gained secondary meaning to indicate to the consumer that the Bionic Wrench is a Loggerhead Tools product. These are premeditated design choices created to achieve the desired source identifying aspects of the design.

The refusal of Appellant's Mark does not consider all the elements of the Appellant's Mark and considers Appellant's Mark at an inappropriate level of abstraction. The size, shape, configuration and motion of Appellant's product as depicted in Appellant's Mark render the mark, overall, non-functional.

This determination is supported by experts in mechanical design. The declarations of Dr. James Edward Colgate, a professor of Mechanical Engineering at Northwestern University, and TJ Kim, a professor and experienced product designer are of record in this proceeding. (See Request for Reconsideration filed Oct. 26, 2014, Appendix B and Appendix C). These highly qualified and respected individuals both state that the design shown in Appellant's Mark does not

depict a functional product design. Dr. Colgate states “the Bionic Wrench design has achieved an aesthetic experience beyond the utilitarian function of a wrench that is unique in the marketplace.” (Decl. of Colgate, ¶7). Dr. Colgate further explains that he does not “believe that the Applied-for Mark depicts an overall functional product design because the Applied-for Mark depicts one alternative among many possible alternatives for a tool....” (*Id.* at ¶ 8). Dr. Colgate references Exhibit 1 of his declaration that shows numerous alternative designs “that even include circumferential jaws that are aesthetically different from the Bionic Wrench but also function as a wrench.” (*Id.*)

Professor Kim also supports the view that Appellant's Mark is non-functional. Professor Kim, an Associate Professor of Industrial Design at Purdue University with 18 years of industry experience in product design, states “the identity of the Bionic Wrench arises from a unique user experience including the movement of the jaws.” (Decl. of Kim, ¶ 7). Professor further explains, “the design of the Bionic Wrench embodies many of these designed elements such as shape, color, spacial relationships and motion designed to evoke emotional response when the product is experienced. The aesthetic design choices embodied in the Bionic Wrench’s form, include the size and shape of the jaws relative to the size and shape of the head of the tool coupled with their resulting movements of the jaws.” (*Id.* at ¶ 9).

The opinions and view of these two well-respected members of both the academic and the design community who together have almost 50 years of mechanical engineering and product design experience are not the only evidence of record supporting this determination. The declaration of Mr. Roy Berendsohn, a Senior Editor of Popular Mechanics magazine and a 25 year media veteran in the tool industry, is also compelling evidence of the aesthetic design choices used in Appellant's product and embodied in Appellant's mark. (See Request for

Reconsideration filed Oct. 26, 2014, Appendix D). Mr. Berendsohn states “[w]hen I think of the Bionic Wrench, I think of the “Weber Grill” and how the design of the Weber Grill redefined the home grilling category by its form, creating a new aesthetic experience in a very crowded product category.” (Decl. of Berendsohn, ¶ 8).

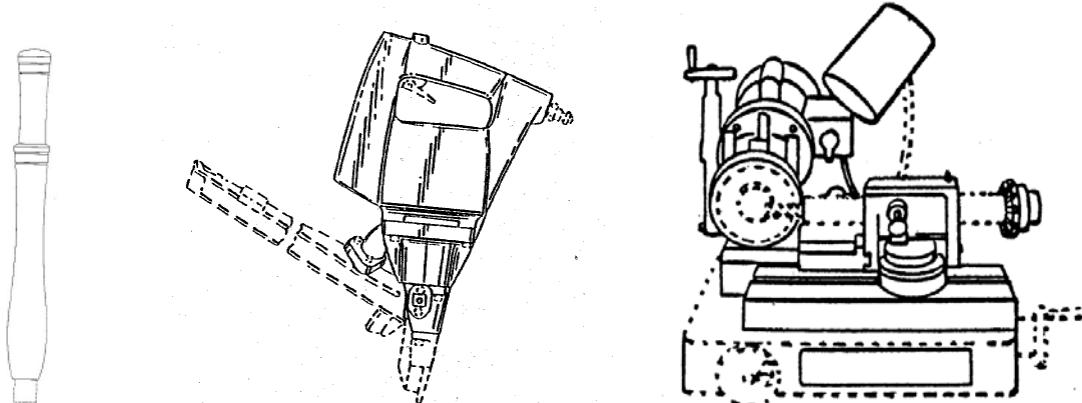
The inspired design of the Bionic Wrench combining distinctive form based product design aesthetics in a crowded product category is rare and certainly notable when it happens. The apple iPod achieved this distinction in the categories of portable media players. The iPod was also recognized with design awards for the unique source identifying nature of the iPod experience, winning both the Red Dot and the IF design awards at the highest levels. In further support of the similar design achievements of the Bionic Wrench, Appellant submitted the following quote from the print addition of the Wall Street Journal on March 21, 2006. “In two of this year’s noted international design competitions, only two U.S. companies took home highest honors for their products. One, predictably, was giant Apple Computer Inc. for its sleek, high-tech iPod Nano music player. The other was a tiny unknown Illinois upstart named LoggerHead Tools LLC.” (See Request for Reconsideration filed Oct. 26, 2014, Appendix G). When considering the Bionic Wrench design, and weighing the evidence, it is obvious that the Bionic Wrench has achieved an iconic form and motion design as a new to the world tool experience in the wrench marketplace. This designed distinction, beyond traditional form, into the non-traditional motion experience of the jaw movement anchors this design aesthetic.

The refusal to register Appellant’s Mark does not discuss the declarations of these experts and instead makes a cursory determination that the applied-for mark is functional. Indeed, in the examining attorney’s denial of Appellant’s Request for Reconsideration mailed June 19, 2015, the denial states that Appellant’s Request for Reconsideration does not “provide any new or

compelling evidence to the outstanding issues in the final Office Action" despite Appellant's introduction of the expert declarations of Professors Kim and Colgate discussed above.

The careful consideration of motion trademark applications, while rare, have resulted in the registration of several motion product configuration trademarks on the principal register. For example, U.S. Reg. No. 1,946,170 directed to the motion of Lamborghini's swing-up doors has functional purposes but nevertheless was permitted to register. (See Response to Office Action filed August 15, 2013). Lamborghini's doors have the functional purposes, *inter alia*, of providing closure to the passenger compartment of a vehicle and of reducing the clearance necessary to access the passenger compartment of the vehicle. These purposes, however, did not prevent registration of Lamborghini's trademark application. The consideration of both the non-functional aspects and the functional elements of Appellant's Mark is missing in the functionality determination in the present application.

Furthermore, product configuration trademark registrations are common-place in the tool industry. Many such applications have proceeded to registration. (See Response to Office Action filed Jan. 23, 2013, Exhibit G). A few examples of such product configuration trademark registrations are shown below.



Reg. No. 4,078,291

Reg. No. 2,050,197

Reg. No. 1,818,734

Proper consideration and analysis of all the evidence in this case and consideration of the individual elements of Appellant's Mark, particularly the non-functional elements of the mark, results in the determination that Appellant's Mark, as a whole, is non-functional and thus registerable on the Principal Register.

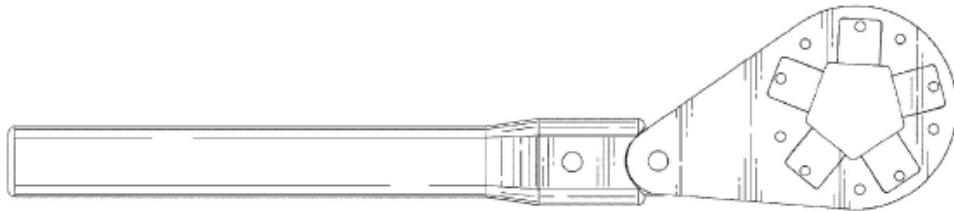
b. The existence of Appellant's utility patent does not render the applied-for mark functional because the mark is directed to a specific configuration that is merely one among many aesthetic design choices.

The refusal of Appellant's Mark includes an excerpt from Appellant's U.S. Patent No. 6,889,579. The refusal alleges that Appellant's utility patent explains that the applied-for motion mark "confers a utilitarian advantage in its ability, among other things, to automatically size and resize the gripping tool, to symmetrically translate gripping stress in a balanced and mechanically advantaged way, and to accomplish work with minimal distortion of the workpiece." (See Office Action mailed Oct. 26, 2014, p. 3). The excerpted portion quoted in the Office Action is in the "Background of the Invention" section of the patent. (See U.S. Pat. 6,889,579, Exhibit B to Office Action Response filed Jan. 23, 2013). This section describes information relevant for the reader to understand the context of the invention but this excerpted portion does nothing to describe Appellant's product nor does it describe the motion mark as applied for by Appellant.

The refusal fails to include any other portion or description of the patent. Appellant's patent, instead, shows many various embodiments of the invention that may provide the same purpose. This fact alone demonstrates that design choices can be made that are directed to non-functional aspects of the product. Indeed, the patent explains "[t]he gripping elements themselves may be varied in size, shape, or quantity...Also the size, shape and position of the openings may be altered...." (See U.S. Pat. No. 6,889,579, col. 8, ll. 37-42.) The particular size,

shape, configuration and movement of the jaws and the openings in the Bionic Wrench are the subject of Appellant's Mark and these specifics are directed to the aesthetic experience of the consumer. The patent does not describe a utilitarian advantage of exposing the jaws to view or of the exact relative position and movement of the jaws as shown in Appellant's mark.

The refusal also fails to make mention of the fact that Appellant owns a design patent for a similar product design. Appellant owns U.S. Pat. No. D618,974 for a hand tool. This design patent was made of record in Appellant's response filed Jan. 23, 2013. (Office Action Response filed Jan. 23, 2013, Exhibit B). The design patent is directed to the ornamental design of the tool shown below.



While this tool only has five jaws, evidence of the issuance of this design patent by the United States Patent and Trademark Office shows that the appearance of the tool includes non-functional, ornamental design elements.

Mere reference to the existence of utility patent without considering the full disclosure of the patent is not enough to render Appellant's Mark functional. In addition, the existence of Appellant's design patent supports registration of Appellant's Mark.

c. Appellant's advertising materials do not indicate that the specific aesthetic design choices in Appellant's Mark have utilitarian advantages

The refusal attempts to support the conclusion of functionality by pointing to Appellant's advertising. Of course, Appellant's advertising states that its Bionic Wrench performs in an

effective manner. Appellant submits that it is likely that all companies that sell tools tout the advantages of its design and/or the performance of its products. The mere existence of advertising does not make a mark functional.

The advertising relied on in the refusal of Appellant's Mark reference the existence of jaw-like elements and that the jaw-like elements move. This material does not reference the specific size, shape and configuration of these elements as are shown in Appellant's Mark. The specific form, size and appearance of the Bionic Wrench is not touted as having a specific advantage nor is the fact that the jaw-like elements are exposed to view by a consumer touted as having a specific advantage. There are a multitude of tools in the marketplace with six moving jaws. There are even more with other quantities of jaws in different shapes, sizes or configurations. The vast array of design alternatives are detailed in the evidence introduced in this application (See Response to Office Action filed Jan. 23, 2013, Exhibit D; Request for Reconsideration filed Mar. 10, 2014, Exhibit A; Exhibits 1 & 2 to Decl. of Colgate, *et al.*). Appellant is not seeking to register the existence of six moving jaws. Such an interpretation is an inappropriate level of abstraction that the Board advised against in *Hershey*. *In re Hershey*, Proceeding No. 77809223, decided Dec. 8, 2011 at p. 8-9. Instead, Appellant is seeking to register the exact configuration and movement of the jaws as shown in the drawing Appellant's application.

d. The existence of many alternative designs favors registration of Appellant's Mark

The third *Morton-Norwich* factor considered in the functionality determination is that of alternative designs. The reason for this is that the existence of alternate designs preserves competition by ensuring that registration of the mark will not prevent competitors from competing effectively. *Valu Engineering Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1277 61

U.S.P.Q.2d 1422 (Fed. Cir. 2002). There are many alternative designs available in this instance that provides competitors the opportunity to compete effectively in the marketplace.

In fact there are many alternative designs already in existence in the marketplace competing in the adjustable wrench product category. This significant evidence has been presented in this case. (*See* Response to Office Action filed Jan. 23, 2013, Exhibit D; Request for Reconsideration filed Mar. 10, 2014, exhibit A; Exhibits 1 & 2 to Decl. of Colgate, et al.) One example of such evidence is provided in connection with the declarations of Dr. Colgate and Mr. Kim. (Request for Reconsideration filed Oct. 26, 2014, Appendix B and Appendix C). Exhibit 1 of the declarations shown several design alternatives that include circumferential jaws. A few examples from the Exhibit are reproduced below:



As can be seen from this limited sampling of the available alternative designs, the aesthetic appearance of six-jaw gripping mechanism can be very different from that depicted in Appellant's motion mark. As stated by Dr. Colgate, "a hand-tool could be designed such that

one or more jaw like elements move, as shown in the example alternative designs included in Exhibit 1. Such alternative designs could provide similar benefits of adjustability and distribution of forces but they exhibit very different aesthetic appearances.” (Request for Reconsideration filed Mar. 10, 2014, App. B, Decl. of Colgate, ¶ 9). Similarly, Mr. Kim holds a similar opinion, “although all of these designs share a common function of engaging a fastener and transmitting rotational force, as can be seen in Exhibit 1 the form of the tool has many design possibilities.” (Request for Reconsideration filed Mar. 10, 2014, App. C, Decl. of Kim, ¶ 8).

The evidence available in this proceeding circumstance, including the declarations of expert mechanical and industrial designers, compels the conclusion that Appellant’s mark is not directed a functional product design but instead depicts aesthetic design choices.

e. Appellant’s design is not directed to a simple or inexpensive method of manufacture

The fourth *Morton-Norwich* factor used in the consideration of whether a product design trademark is functional includes analysis of whether the design results from a comparatively simple or inexpensive method of manufacture. This factor received little to no consideration in the refusal despite the compelling evidence made of record. This factor weighs heavily in favor of registration.

The design depicted in Appellant’s Mark is not a result of a simple or low-cost method of manufacture. Instead, the design is a higher cost and more complex than other adjustable wrench designs.

The designer of the tool, Mr. Dan Brown, stated in his declaration and made of record in this proceeding that the Bionic Wrench “is not the most cost-effective combination among the various alternatives available.” (Response to Office Action filed Jan. 23, 2013, Exhibit D). This

is further supported by the declaration of Dr. Colgate. Dr. Colgate states the design of Appellant's tool "is likely more expensive and difficult to manufacture than other adjustable wrench designs. The fact that the Loggerhead Tools LLC Bionic Wrench has more parts than other designs makes the design more expensive and more difficult to manufacture than many other alternative designs." (Request for Reconsideration filed Mar. 10, 2014, App. B, Decl. of Colgate, ¶ 11).

This factor weighs heavily in favor of Appellant and strongly demonstrates that Appellant's mark is suitable for registration.

CONCLUSION

Appellant's Mark is non-functional, as a whole, when the entirety of the evidence in this proceeding and the non-functional aspects of Appellant's product design are carefully considered. The refusal failed to consider the non-functional aspects of Appellant's product design and to weigh these aspects against the utilitarian elements. In addition, the determination of functionality was rebutted with the significant compelling evidence of record in this case including several expert declarations as well as significant evidence demonstrating the availability of alternative designs. Appellant respectfully requests the Board to reverse the determination of the examining attorney with respect to the functionality of Appellant's Mark and pass the application to publication.

Respectfully submitted,

VEDDER PRICE P.C.

By: /s/ John E. Munro

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Subject: U.S. TRADEMARK APPLICATION NO. 85700986 - 35985000084 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85700986

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CORRESPONDENT ADDRESS:

JOHN E MUNRO

VEDDER PRICE PC

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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Loggerhead Tools, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

35985000084

CORRESPONDENT E-MAIL ADDRESS:

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the examining attorney's refusal to register a configuration motion mark described as: "a motion mark depicting the product configuration of a hand tool in which six rectangular-shaped jaw-like elements of the circular head of a hand tool radially move in and out.

The elements symmetrically converge and diverge in a mechanical iris-type motion. The broken or dotted lines are not part of the mark and serve only to show the position or placement of the moving elements of the mark in the hand tool.” The configuration motion mark is for “Hand tools, namely, gripping tools in the nature of wrenches and wire crimpers for sale through mass merchandisers to retail consumers,” as amended. Registration has been refused under Section 2(e)(5) of the Trademark Act, 15 U.S.C. §1052(e)(5), on the ground that the applied-for mark is a functional design of the goods. It is respectfully requested that this refusal be affirmed.

STATEMENT OF FACTS

Application was made on August 10, 2012, for registration on the Principal Register of the subject configuration motion mark. The examining attorney initially refused registration on the ground of functionality and because the proposed mark failed to function as a trademark. On January 23, 2013, applicant responded by arguing that the applied-for mark is non-functional and that it had acquired distinctiveness as a source indicator. On February 15, 2013, a second non-final Office action was issued in which the functionality and failure to function refusals were maintained, an additional refusal under Sections 1, 2, and 45 of the Trademark Act finding the applied-for mark to be a non-distinctive product design was added, and applicant’s amended description of the mark was not accepted. On August 15, 2013, applicant responded by arguing against the non-functional product design and functionality refusals, and submitted an amended description of the applied-for mark. A first final Office action was issued on September 10, 2013, refusing registration on the grounds of functionality and failure to function as a trademark, and accepting applicant’s amended description of the mark.

On March 10, 2014, applicant filed a notice of appeal along with a request for reconsideration of the final refusal to register. On April 2, 2014, a non-final Office action was issued maintaining the functionality, non-distinctive configuration and failure to function refusals, and requesting clarification of applicant's description of the mark. On October 2, 2014, applicant filed a response arguing against the non-distinctive product design, functionality and failure to function refusals, and by providing an amended mark description. On October 26, 2014, a second final Office action was issued maintaining the functionality refusal but withdrawing the refusals based on failure to function and non-distinctive configuration, and accepting applicant's amended description of the mark. Applicant's April 27, 2015, request for reconsideration of the second final refusal was denied in an Office action dated June 19, 2015. The current appeal was resumed on June 23, 2015, with applicant filing its brief on August 24, 2015.

The only issue remaining in applicant's appeal to the Trademark Trial and Appeal Board (hereinafter "TTAB" or "Board") is whether the applied-for configuration motion mark is functional under Section 2(e)(5) of the Trademark Act.

ARGUMENT

A mark that consists of a three-dimensional configuration of a product is functional, and thus unregistrable, when the evidence shows that the design provides identifiable utilitarian advantages to the user; i.e., the product or container "has a particular shape because it works better in [that] shape." *Valu Eng'g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1274, 61 USPQ2d 1422, 1425 (Fed. Cir. 2002) (internal punctuation and citation omitted).

A feature of the product configuration is functional if it is "essential to the use or purpose of the [product]" or "it affects the cost or quality of the [product]." *TraffFix Devices, Inc. v.*

Mktg. Displays, Inc., 532 U.S. 23, 33, 58 USPQ2d 1001, 1006 (2001) (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165, 34 USPQ2d 1161, 1163-64 (1995)); TMEP §1202.02(a)(iii)(A).

The evidence need not establish that the configuration at issue is the very best design for the particular product. A configuration can be held functional when the evidence shows that it provides a specific utilitarian advantage that makes it one of a few superior designs available. See *In re Am. Nat'l Can Co.*, 41 USPQ2d 1841 (TTAB 1997) (holding metal beverage containers with vertical fluting functional because vertical fluting is one of a limited number of ways to strengthen can sidewalls and it allows for an easier way to grip and hold the can); TMEP §1202.02(a)(v), (a)(v)(C).

In the present case, the applied-for mark consists of a design of a circular wrench head whose six jaw-like gripping elements move in an inward and outward, iris-type motion. The enclosed excerpt from applicant's website shows that the iris-like movement of the wrench head's six gripping elements provides a specific utilitarian advantage that makes it one of a few superior designs available. In particular, applicant's website *Loggerheadtools.com*, included with the Office action of August 30, 2012, indicates that the featured wrench provides a specific utilitarian advantage in that "the genius of attacking a bolt/nut on all 6 flat sides removes the stress and strain on the corners of the bolt. This coupled with the superior gripping action of the jaws, allows the user to complete their work without the wrench slipping off and damaging the bolt." See the excerpt from *Loggerheadtools.com* enclosed with the initial Office action dated August 30, 12, 2012, at p. 2 in TICRS.

In addition, applicant's patent, U.S. Registration No. 6,889,579, for an "Adjustable gripping tool," indicates that the applied-for mark confers a utilitarian advantage on the user in that the tool at issue, unlike the prior art, "may be automatically sized and resized to engage a workpiece" and "symmetrically translates the force applied to the gripping tool onto the workpiece in a symmetrically

balanced and mechanically advantaged and efficient way." See the excerpt from U.S. Registration No. 6,889,579 enclosed with the initial Office action dated August 30, 12, 2012, at p. 12 in TICRS.

As these excerpts from applicant's website and utility patent make clear, the iris-like gripping motion of applicant's wrench head confers a utilitarian advantage in its ability, among other things, to automatically size and resize the gripping tool, to symmetrically translate gripping stress in a balanced and mechanically advantaged way, and to accomplish work with minimal distortion of the workpiece. The subject mark, therefore, must be refused registration under Section 2(e)(5) of the Trademark Act as being functional.

Determining functionality normally involves consideration of one or more of the following factors, commonly known as the "*Morton-Norwich factors*":

- (1) The existence of a utility patent that discloses the utilitarian advantages of the product or packaging 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.
- (4) Facts pertaining to whether the design results from a comparatively simple or inexpensive method of manufacture.

In re Morton-Norwich Prods., Inc., 671 F.2d 1332, 1340-41, 213 USPQ 9, 15-16 (C.C.P.A. 1982); TMEP §1202.02(a)(v).

I. **Applicant's Advertising Extols Utilitarian Advantages of Product Design/Motion**

An applicant's own advertising that extols specific utilitarian advantages of the applied-for product design is strong evidence that the matter sought to be registered is functional.

TMEP §1202.02(a)(v)(B); *see, e.g., In re Becton, Dickinson & Co.*, 675 F.3d 1368, 1375-76, 102 USPQ2d 1372, 1377-78 (Fed. Cir. 2012).

As previously indicated, applicant's website, as well as various third-party promotional materials, some of which are discussed in detail below, emphasize the utilitarian advantages of the iris-type motion of applicant's wrench head design. The following is a representative sample of additional excerpts from the record describing the functionality of the applied-for product, referred to by applicant as the Bionic Wrench.

- *Loggerhead Tools*, "The Bionic Wrench™ is different than traditional wrenches or pliers because it actively distributes force on all sides of a nut or bolt instead of the corners. The Bionic Wrench™ has six steel jaws that simultaneously converge on the sides of a nut or bolt when the cushioned, ergonomic handle is squeezed. This patented design provides several advantages": The Bionic Wrench™ will **not slip or round off** nuts or bolts. In fact, it can often remove fasteners damaged by other wrenches;" "It **eliminates the need to find the exact wrench size**;" and "It **can be used on softer materials** that traditional wrenches often damage, such as plastic, copper and aluminum." (Emphasis in original.)

Excerpt from www.lhtmediakit.com, enclosed with final Office action dated September 10, 2013, at pp. 11-12 in TICRS.

- *Trucker (The)*, article entitled Bionic Wrench Offers Mechanical Advantage, "Loggerhead Tools has announced the availability of the 8-inch Bionic Wrench, a new type of hand tool that teams the versatility of an adjustable wrench with the simplicity of pliers. The hybrid tool delivers a mechanical advantage unlike any other gripping tool because it equally distributes force around the workload, the company said in a news release. With a one-handed squeeze, the 8-inch Bionic Wrench automatically sizes and grips 16 U.S. and metric-sized nuts and bolts, distributing equal force on all sides of the work, the company said."

"The Bionic Wrench is the first wrench of its kind to actively distribute gripping force on all six sides of a nut or bolt, the company said."

Excerpts from *Trucker (The)*, August 31, 2005, enclosed with applicant's Office action response dated January 23, 2013, at p. 170 in TICRS.

- *Pittsburgh Tribune-Review*, "Brown designed a new wrench - with a twist. Instead of the standard two-sided grip, Brown's wrench closes like a camera shutter, grabbing a bolt or nut with its patented six-sided clench."

Excerpt from *Pittsburgh Tribune-Review*, April 13, 2006, enclosed with applicant's Office action response dated January 23, 2013, at p. 178 in TICRS.

- *McFeelys.com*, the Bionic Wrench "functions better than a box-end wrench because it automatically adjusts to fit all types of hex bolts and nuts, whether SAE or metric, and it applies pressure to the hex head bolt or nut on the flats (rather than the fragile corners) to virtually illuminate rounded corners."

Excerpt from *McFeelys.com*, enclosed with applicant's Office action response dated January 23, 2013, at p. 200 in TICRS.

- *Mobile Electronics*, "According to Loggerhead, the patented hybrid delivers a mechanical advantage because the tool equally distributes force around the workload and eliminates the rounding effect of traditional wrenches and pliers."

Excerpt from *Mobile Electronics*, July 2005, enclosed with applicant's Office action response dated January 23, 2013, at p. 205 in TICRS.

- *Loggerhead Tools*, "Combining the best features of an adjustable wrench with the simplicity of pliers, Bionic Wrench *automatically* grips the most common sizes of U.S. and metric nuts and bolts. No more searching for the exact-size wrench for each project! Better yet, you gain a mechanical advantage unlike any other hand tool. Ordinary sockets grip only at the points of a bolt head. But Bionic Wrench grips equally along all 6 flat sides, giving you 10-30x more surface-gripping power. In fact, Bionic Wrench easily removes nuts and bolts damaged by cruder tools. And it ratchets with ease, just by releasing and regripping." (Emphasis in original.)

Excerpt from *Loggerhead Tools*, enclosed with applicant's Office action response dated January 23, 2013, at p. 208 in TICRS.

- *SkyMall*, "Genius of attaching a bolt/nut on all (6) flat sides removes the stress and strain on the corners of the bolt."

"Superior gripping action of the jaws allows the user to complete their work without the wrench slipping off and damaging the bolt."

Excerpts from *SkyMall*, Summer 2006, enclosed with applicant's Office action response dated January 23, 2013, at p. 223 in TICRS.

- *The Wall Street Journal*, "Wrenches usually junk up toolboxes and are tough, on hands. This one solves both issues and eliminates a lot of guesswork with a single hole that adjusts as you squeeze the rubber-coated handles."

Excerpt from *loggerheadtools.com* quoting *The Wall Street Journal*, December 10, 2005, enclosed with initial Office action dated August 30, 2012, at p. 4 in TICRS.

- *Newsday*, "Because of its wrap-around grip, it won't strip corners like conventional wrenches and pliers."

Excerpt from *loggerheadtools.com* quoting *Newsday*, January 19, 2006, enclosed with initial Office action dated August 30, 2012, at p. 4 in TICRS.

- *Star Telegram (Dallas/Fort Worth) Detroit News*, "The Bionic Wrench is far superior to regular pliers or an adjustable wrench - and you don't have to worry whether the nut is metric or standard-sized."

Excerpt from *loggerheadtools.com* quoting *Star Telegram (Dallas/Fort Worth) Detroit News*, February 26, 2006, enclosed with initial Office action dated August 30, 2012, at p. 4 in TICRS.

- *The Charlotte Observer*, "The Bionic Wrench from Loggerhead Tools teams the versatility of an adjustable wrench with the simplicity of pliers. The wrench won't slip or round off nuts or bolts. In fact, it can often remove fasteners damaged by other wrenches."

Excerpt from *loggerheadtools.com* quoting *The Charlotte Observer*, March 11, 2006, enclosed with initial Office action dated August 30, 2012, at pp. 4-5 in TICRS.

- *Arkansas Democrat Gazette*, "As easy to use as a pair of pliers. Excellent gripping action of jaws means wrench won't slip off and damage bolt."

Excerpt from *loggerheadtools.com* quoting *Arkansas Democrat Gazette*, April 1, 2006, enclosed with initial Office action dated August 30, 2012, at p. 5 in TICRS.

- *Chicago Sun Times*, "Think about it as (Dan) Brown did: a wrench that would not just provide a couple of pincers but would totally envelop the little nut it's attacking...Simple? Maybe. But through the years, not even giant tool makers thought of the concept."

Excerpt from *loggerheadtools.com* quoting *Chicago Sun Times*, May 16, 2006, enclosed with initial Office action dated August 30, 2012, at p. 5 in TICRS.

- *BusinessWeek*, "Because it applies force only to the side surfaces, it won't strip the corners the way conventional wrenches or pliers do."

Excerpt from *loggerheadtools.com* quoting *BusinessWeek*, October 2005, enclosed with initial Office action dated August 30, 2012, at p. 5 in TICRS.

- *Better Homes and Gardens Wood*, "No more chasing down the right size open-ended or box wrench (or guessing between English or metric) with the Bionic Wrench from Loggerhead Tools."

Excerpt from *loggerheadtools.com* quoting *Better Homes and Gardens Wood*, January 2006, enclosed with initial Office action dated August 30, 2012, at p. 6 in TICRS.

- *Rainy Day (Internet Magazine)*, “The surface contact of the traditional tools are less compared to the Bionic Grip. The larger surface contact translates directly to more torque applied to the turning or force in the grip.”

Excerpt from *loggerheadtools.com* quoting *Rainy Day (Internet Magazine)*, July 2006, enclosed with initial Office action dated August 30, 2012, at p. 6 in TICRS.

- *The Wall Street Journal*, “Part of Mr. Brown's inspiration was the SLR camera shutter, which opens and closes in an even, concentric fashion. Because the jaws of his wrench grip the sides of a nut or bolt evenly on all six sides -and not just at the corners - it helps prevent the stripping that can happen over time.”

“Mr. Brown developed his Bionic Branch to tackle two dilemmas that wrench users - in particular female ones - face with the tool: It often slips on nuts and bolts that are worn, or “stripped,” around the edges, and it can be hard on the hand after lots of twisting. Another selling point: a single eight-inch Bionic Wrench quickly fits around 16 different sizes of nuts and bolts. That eliminates the need to carry multiple fixed-head wrenches or spend lots of time getting an adjustable wrench properly sized.”

Excerpts from *online.wsj.com* enclosed with final Office action dated September 10, 2013, at pp. 2-4 in TICRS.

- *Family Motor Coaching*, “What makes the Bionic Wrench different is that it distributes force on all sides of the nut or bolt instead of just the corners. One the ergonomic handle is squeezed six steel jaws simultaneously converge on the sides of the nut or bolt for a tight fit that reportedly will not slip or round off the edges.”

Excerpt from *Family Motor Coaching*, August 2006, enclosed with applicant's Office action response dated January 23, 2013, at p. 129 in TICRS.

- *The Family Handyman*, "The Bionic Wrench has a unique and effective way to grab. The business end holds six piston-like, spring-loaded grippers. As you squeeze the handles, the grippers constrict on hexagonal nuts or bolts with each piston contacting a face."

Excerpt from *The Family Handyman*, November 2005, enclosed with applicant's Office action response dated January 23, 2013, at p. 147 in TICRS.

- *Coastal Tool*, "The Bionic Wrench is a remarkable patented hybrid of an adjustable wrench with the ease of use of a pair of pliers. In addition, the genius of attacking a bolt/nut on all 6 flat sides removes the stress and strain on the corners of the bolt."

Excerpt from *Coastal Tool*, enclosed with applicant's Office action response dated January 23, 2013, at p. 167 in TICRS.

As these and the other excerpts of record clearly establish, applicant's advertising as well as various third-party promotional materials tout the utilitarian advantage of the iris-type motion of applicant's wrench head design in terms of its ability, among other things, to automatically size and grip the workpiece, to equally distribute force around the workload, and to accomplish work with minimal distortion of the nut or bolt.

II. Applicant's Patent Is Strong Evidence of Functionality

A utility patent claiming the design features at issue is strong evidence that those features are functional. *In re Becton, Dickinson & Co.*, 675 F.3d at 1375, 102 USPQ2d at 1377; see TMEP §1202.02(a)(iv), (a)(v)(A).

In this case, the utility patent claims the design features at issue. Accordingly, the trademark examining attorney has established a *prima facie* case that the applied-for mark is functional and the burden of proof now shifts to applicant to show nonfunctionality. See *In re Howard Leight*

Indus., LLC, 80 USPQ2d 1507, 1515 (TTAB 2006); see TMEP §1202.02(a)(iv), (a)(v)(A). Applicant must meet this burden by providing “competent evidence” of the applied-for mark’s nonfunctionality. See *In re Becton, Dickinson & Co.*, 675 F.3d at 1374, 102 USPQ2d at 1376. The “competent evidence” standard requires proof by a preponderance of the evidence. *Id.*

Furthermore, a patent need not claim the exact configuration for which trademark protection is sought to prove functionality. See *Id.* at 1375, 102 USPQ2d at 1377 (citing *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. at 32-33, 34-35, 58 USPQ2d at 1005). “[S]tatements in a patent’s specification illuminating the purpose served by a design may constitute equally strong evidence of functionality.” *Id.* Moreover, utility patents that claim more features than the applied-for configuration mark are relevant to a functionality determination if the patent shows that the features claimed as a trademark are an essential or integral part of the invention and have utilitarian advantages. TMEP §1202.02(a)(v)(A); see *In re Cabot Corp.*, 15 USPQ2d 1224, 1227-28 (TTAB 1990).

In the present case, as previously discussed, applicant’s utility patent, U.S. Registration No. 6,889,579, for an “Adjustable gripping tool,” indicates that the applied-for mark confers a utilitarian advantage on the user. In this regard, the Background of the Invention section of the patent reads, in pertinent part:

Therefore, there exists a need in the prior art for an adjustable gripping tool which, as a result of manual operation, self-energizes the tool action, may be automatically sized and resized to engage a workpiece, de-energizes upon release of actuation force, that has a broad range of dimensional capability, engages workpieces axially and radially and provides offsetting forces for stability in operation. Beyond the ability to resize the gripping range, the gripping tool of the present invention symmetrically translates the force applied to the gripping tool onto the workpiece in a symmetrically balanced and mechanically advantaged and efficient way. Thus, an even distribution of gripping and rotational force about the workpiece is achieved; whereby allowing for the most efficient distribution of mechanical stress about the workpiece. For any given force required to manipulate the workpiece the present invention will accomplish the work with the minimal distortion of the workpiece by distributing the work force over the

largest area of the workpiece. Other advantages of the adjustable gripping tool of the present invention include decreased costs, increased productivity and multi-access engagement of the workpiece resulting in a mechanically advantaged, efficient, even and balanced distribution of working forces.

See the excerpt from U.S. Registration No. 6,889,579 enclosed with the initial Office action dated August 30, 12, 2012, at p. 12 in TICRS. In addition, applicant's patent, U.S. Registration No. 7,748,298, for an "Adjustable gripping tool," includes this same language. See the excerpt from U.S. Registration No. 7,748,298, enclosed with the Office action dated February 15, 2013, at p. 10 in TICRS.

As the above-referenced excerpt illustrates, applicant's own patent indicates that the applied-for mark confers a utilitarian advantage on the user in that the tool at issue, unlike the prior art, "may be automatically sized and resized to engage a workpiece" and "symmetrically translates the force applied to the gripping tool onto the workpiece in a symmetrically balanced and mechanically advantaged and efficient way." In addition, other advantages "include decreased costs, increased productivity and multi-access engagement of the workpiece resulting in a mechanically advantaged, efficient, even and balanced distribution of working forces." See the excerpt from U.S. Registration No. 6,889,579 enclosed with the initial Office action dated August 30, 12, 2012, at p. 12 in TICRS.

III. Applicant Has Failed To Meet Its Burden of Showing Nonfunctionality

As previously discussed, in light of the trademark examining attorney's *prima facie* case, applicant must meet its burden under Section 2(e)(5) by providing "competent evidence" of the applied-for mark's nonfunctionality. *See In re Becton, Dickinson & Co.*, 675 F.3d at 1374, 102 USPQ2d at 1376. The "competent evidence" standard requires proof by a preponderance of the evidence. *Id.*

In the present case, applicant argues that the applied-for mark is not functional under Section 2(e)(5) because it “includes significant elements that are non-functional, aesthetic design choices. These non-functional elements render the mark, as whole, non-functional.” Brief for Applicant at p. 7. In this regard, applicant asserts that “[t]he design choice to expose the jaws to the consumer when the product is being used along with the design choices regarding the size, shape and configuration of the jaws, opening and head of the tool creates a unique user experience.” *Id.* at p. 8.

In support of its position, applicant relies on the declarations of Professors James Edward and TJ Kim. Brief for Applicant at p. 8, referencing the Colgate and Kim declarations enclosed with applicant's request for reconsideration dated April 27, 2015, at pp. 15 and 49 in TICRS, respectively. In his declaration, Professor Colgate states “I do not believe that the Applied-for Mark depicts an overall functional product design because the Applied-for Mark depicts one alternative among many possible alternatives for a tool that provides an adjustment feature so that the tool can be used with more than one size of fastener. Referring to Exhibit 1, there are numerous design alternatives that even include circumferential jaws that are aesthetically different from the Bionic Wrench but also function as a wrench.” *Id.* at p. 16, referring to applicant's examples of alternative adjustable wrench designs at pp. 18-20.

Similarly, Professor Kim, in his declaration, states that “[t]he aesthetic design choices embodied in the Bionic Wrench’s form include the size and shape of the jaws relative to the size and shape of the head of the tool coupled with their resulting movements of the jaws. These aesthetic design choices affect the experience and appearance of the tool and the identity that the designer was seeking to achieve. Many examples of the various form factors chosen by designers can be seen in Exhibit 1.” *Id.* at p. 50, referring to applicant's examples of alternative adjustable wrench designs at pp. 18-20.

In seeking to establish that applicant's wrench head design is merely one of a number of comparable alternatives, however, the declarants fail to cite any other adjustable wrench in applicant's Exhibit 1 that utilizes the "iris-type motion" incorporated into applicant's design. Indeed, nowhere does applicant itself allege that there exists in the marketplace another adjustable wrench with the motion feature of its wrench, which applicant in its website describes as "different than traditional wrenches or pliers because it actively distributes force on all sides of a nut or bolt instead of the corners" and by which "you gain a mechanical advantage unlike any other hand tool." See, respectively, the excerpt from www.lhtmediakit.com, enclosed with final Office action dated September 10, 2013, at pp. 11-12 in TICRS, and the excerpt from *Loggerhead Tools*, enclosed with applicant's Office action response dated January 23, 2013, at p. 208 in TICRS.

In addition, applicant cites a *Wall Street Journal* article as evidence that "it is obvious that the Bionic Wrench has achieved an iconic form and motion design as a new to the world tool experience in the wrench marketplace." Brief for Applicant at p. 10, referring to a *Wall Street Journal* article enclosed with its request for reconsideration dated April 27, 2015, at p. 76 in TICRS. However, the same article also states that with the Bionic Wrench "[t]he user squeezes two ergonomic handles, and that motion pushes in the tiny jaws in the wrench's circle-shaped head. Part of Mr. Brown's inspiration was the SLR camera shutter, which opens and closes in an even, concentric fashion. Because the jaws of his wrench grip the sides of a nut or bolt evenly on all six sides - and not just at the corners - it helps prevent the stripping that can happen over time." See the excerpt from online.wsj.com enclosed with final Office action dated September 10, 2013, at p. 4 in TICRS, referring to applicant's founder and president Dan Brown. Thus, this article underscores that the iris-like movement produced by applicant's wrench head, which is the very essence of applicant's applied-for mark, constitutes a functionally advantageous innovation that was inspired by the SLR camera shutter. In this regard, the *Wall Street Journal* article further states that "Mr. Brown developed his Bionic Branch to tackle two dilemmas that

wrench users - in particular female ones - face with the tool: It often slips on nuts and bolts that are worn, or ‘stripped,’ around the edges, and it can be hard on the hand after lots of twisting. Another selling point: a single eight-inch Bionic Wrench quickly fits around 16 different sizes of nuts and bolts. That eliminates the need to carry multiple fixed-head wrenches or spend lots of time getting an adjustable wrench properly sized.” *Id* at p. 3.

Applicant further argues that its utility patent, U.S. Registration No. 6,889,579, for an “Adjustable gripping tool,” fails to establish that the applied-for mark is functional. In particular, applicant asserts that the patent's aforementioned Background of the Invention Section -- which states, among other things, that applicant's “invention pertains to a hand tool and more particularly, to an adjustable gripping tool which, as a result of manual operation, self energizes, automatically configures to engage differently dimensioned and shaped workpieces and de-energizes upon release of actuating force” – merely describes “information relevant for the reader to understand the context of the invention” but “does nothing to describe Appellant's product nor does it describe the motion mark as applied for by Appellant.” Brief for Applicant at p. 12, referring to the excerpt of applicant's patent enclosed with the initial Office action dated August 30, 2012, at p. 12 in TICRS.

Furthermore, applicant asserts that its “patent, instead, shows many various embodiments of the invention that may provide the same purpose. This fact alone demonstrates that design choices can be made that are directed to non-functional aspects of the product. Indeed, the patent explains '[t]he gripping elements themselves may be varied in size, shape, or quantity . . . Also the size, shape and position of the openings may be altered.’ ” *Id*. Additionally, applicant contends that “[t]he particular size, shape, configuration and movement of the jaws and the openings in the Bionic Wrench are the subject of Appellant's Mark and these specifics are directed to the aesthetic experience

of the consumer. The patent does not describe a utilitarian advantage of exposing the jaws to view or of the exact relative position and movement of the jaws as shown in Appellant's mark." *Id.* at 12-13.

As previously discussed, a utility patent claiming the design features at issue is strong evidence that those features are functional. *In re Becton, Dickinson & Co.*, 675 F.3d at 1375, 102 USPQ2d at 1377; see TMEP §1202.02(a)(iv), (a)(v)(A). However, a patent need not claim the exact configuration for which trademark protection is sought to prove functionality. See *In re Becton, Dickinson & Co.*, 675 F.3d at 1375, 102 USPQ2d at 1377 (citing *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. at 32-33, 34-35, 58 USPQ2d at 1005). “[S]tatements in a patent’s specification illuminating the purpose served by a design may constitute equally strong evidence of functionality.” *Id.*

Moreover, a utility patent need not be in the exact configuration for which trademark protection is sought to be considered probative. See *Id.* at 1375, 102 USPQ2d at 1377 (citing *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 32-33, 34-35, 58 USPQ2d 1001, 1005 (2001)). A few arbitrary or otherwise nonfunctional features included within a product configuration mark does not affect a functionality determination where the evidence shows the overall design to be functional. See *Textron, Inc. v. U.S. Int’l Trade Comm’n*, 753 F.2d 1019, 1024-27, 224 USPQ 625, 628-30 (Fed. Cir. 1985); TMEP §1202.02(a)(v). Specifically, an applied-for mark possessed of significant functional features should not qualify for registration where insignificant elements of the design are non-functional. *In re Becton, Dickinson & Co.*, 675 F.3d at 1374, 102 USPQ2d at 1376.

As previously indicated, the Background of the Invention section of applicant’s patent describes applicant’s product as fulfilling “a need in the prior art for an adjustable gripping tool which, as a result of manual operation, self-energizes the tool action, may be automatically sized and resized to engage a workpiece, de-energizes upon release of actuation force, that has a broad range of dimensional capability, engages workpieces axially and radially and provides offsetting forces for

stability in operation.” See the excerpt of applicant's patent enclosed with the initial Office action dated August 30, 2012, at p. 12 in TICRS. This section states further that “[e]ach of the prior art devices have disadvantages” and that “all of the previously available gripping tools either loosely hold the workpiece or hold the workpiece in a manner that concentrates and focuses the gripping forces in a point pressure-loading configuration. This concentration of gripping forces is on certain points concentrates [sic] the force and serves to oftentimes deform the workpiece. Also the previously available tools for wrench applications could not be easily sized to the workpiece.” *Id.*

In addition, the patent's closing paragraph reads as follows:

The inventions is [sic] not limited to the details of the apparatus depicted and other modifications and applications may be contemplated. For example, the force transfer elements and aligning elements may be changed as desired for other bearing elements. The gripping elements themselves may ha [sic] be in size, shape, or quantity. And the gripping elements may have a cutter, roller or blade attached to perform cutting or scoring operations. Also, the size, shape and position of the openings may be altered as desired to suit particular applications. Certain other changes may be made in the above-described apparatus without departing from true spirit [sic] and scope of the invention here involved. It is intended, therefore that the subject matter of the above depiction shall be interpreted as illustrated and not in a limiting sense.”

Id. at p. 16.

This excerpt shows that while applicant's patent contemplates that the size, shape or quantity of the gripping elements may differ, or that the gripping elements may have a cutter, roller or blade attached to them, there is nothing in the patent to indicate, as applicant argues, that the iris-like motion of the gripping elements is itself subject to variation. Moreover, it is precisely this motion of applicant's wrench head that constitutes the essential or integral part of the invention. *See In re Cabot Corp.*, 15 USPQ2d at 1227-28. Indeed, were this not the case, applicant could reasonably have opted to seek registration of a product configuration mark by itself rather than a product configuration mark with

a motion component. Significantly, the utilitarian advantages associated with the motion of applicant's wrench head as outlined in its patent -- including, among other things, its ability to automatically size and resize the gripping tool, to symmetrically translate gripping stress in a balanced and mechanically advantaged way, and to accomplish work with minimal distortion of the workpiece -- are the very same features that applicant has consistently touted in its promotional materials.

Furthermore, the fact that applicant's product configuration comprises six jaw-like elements arranged in a particular pattern is in itself functional since applicant's wrench head is intended for use with hexagonal nuts or bolts. See the excerpt from *Loggerhead Tools* enclosed with applicant's Office action response dated January 23, 2013, at p. 208 in TICRS, stating that the "Bionic Wrench grips equally along all 6 flat sides, giving you 10-30x more surface-gripping power." Furthermore, there is nothing in the drawing of the mark or in the mark description that indicates, as applicant argues, that the jaws of the wrench head are "exposed" to view and thus represent a variable component of its product design.

Additionally, applicant argues against the Section 2(e)(5) refusal on the ground that while its "advertising states that its Bionic Wrench performs in an effective manner" applicant "submits that it is likely that all companies that sell tools tout the advantages of its design and/or the performance of its products. The mere existence of advertising does not make a mark functional." Brief for applicant at pp.13-14.

An applicant's assertion, however, that statements in its promotional materials are mere "puffery" is not persuasive when such statements clearly emphasize specific utilitarian features of the product or product packaging configuration claimed as a mark. TMEP §1202.02(a)(v)(B); see, e.g., *In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1950-51 (TTAB 2001). In the present case, as previously discussed, applicant's advertising and promotional materials contain numerous references to specific

utilitarian features of its configuration motion mark, including its ability to automatically size and resize the gripping tool, to symmetrically translate gripping stress in a balanced and mechanically advantaged way, and to accomplish work with minimal distortion of the workpiece.

Finally, applicant argues against the functionality refusal on the ground that “[t]he design depicted in Appellant's Mark is not a result of a simple or low-cost method of manufacture. Instead, the design is a higher cost and more complex [sic] than other adjustable wrench designs.” Brief for Applicant at p.16. An applicant's assertion that its design is more expensive or more difficult to make, however, does not establish that the configuration is not functional. *AS Holdings, Inc. v. H & C Milcor, Inc.*, 107 USPQ2d 1829, 1836 (TTAB 2013) (citing *In re Dietrich*, 91 USPQ2d 1622, 1637 (TTAB 2009) (“[E]ven at a higher manufacturing cost, applicant would have a competitive advantage for what is essentially . . . a superior quality wheel.”)); TMEP §1202.02(a)(v)(D). In addition, applicant's patent, U.S. Registration No. 6,889,579, indicates that included among the advantages of applicant's design are “decreased costs, increased productivity and multi-access engagement of the workpiece resulting in a mechanically advantaged, efficient, even and balanced distribution of working forces.” See the excerpt from U.S. Registration No. 6,889,579 enclosed with the initial Office action dated August 30, 12, 2012, at p. 12 in TICRS.

CONCLUSION

The functionality doctrine ensures that protection for utilitarian product features be properly sought through a limited-duration utility patent, and not through the potentially unlimited protection of a trademark registration. Upon expiration of a utility patent, the invention covered by the patent enters the public domain, and the functional features disclosed in the patent may then be copied by others – thus encouraging advances in product design and manufacture. In *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 34-35, 58 USPQ2d 1001, 1007 (2001), the Supreme Court reiterated

this rationale, also noting that the functionality doctrine is not affected by evidence of acquired distinctiveness. Thus, even when the evidence establishes that consumers have come to associate a functional product feature with a single source, trademark protection will not be granted in light of the public policy reasons stated. *Id.*

In the present case, the configuration of applicant's wrench head with its iris-like gripping motion confers a utilitarian advantage under the *Morton-Norwich* factors in its ability to self-size and resize the gripping tool, to evenly grip the workpiece so as to prevent stripping, and to eliminate the need to use multiple fixed-head wrenches.

The current record, moreover, provides ample evidence that applicant's advertising extols the specific utilitarian advantages of its applied-for product design and is strong evidence that the matter sought to be registered is functional. In addition, applicant's own utility patent indicates that the applied-for mark confers a utilitarian advantage on the user in that the tool at issue, unlike the prior art, "may be automatically sized and resized to engage a workpiece" and "symmetrically translates the force applied to the gripping tool onto the workpiece in a symmetrically balanced and mechanically advantaged and efficient way."

Furthermore, while applicant's patent may contemplate variations in the size, shape, quantity and nature of the wrench's gripping elements, it notably fails to include the motion of the gripping elements as among those elements of the wrench head that are subject to variation. Indeed, it is precisely the "iris-type motion" of applicant's wrench head that constitutes the essential and integral part of the invention and which doubtless prompted applicant to seek registration of a configuration motion mark.

Applicant has previously been granted protection for its product design through a limited-duration utility patent. It should not be permitted to secure further rights in the subject configuration motion mark through the potentially unlimited protection of a trademark registration.

For the foregoing reasons, the refusal under Section 2(e)(5) of the Trademark Act should be affirmed.

Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application of:
Loggerhead Tools, LLC
Serial No.: 85/700,986
Filed: August 10, 2012
Mark: WRENCH MOTION

Trademark Examining Attorney:
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APPELLANT'S REPLY BRIEF

Appellant, Loggerhead Tools, LLC (“Appellant” or “Loggerhead”), submits this Reply Brief pursuant to 37 C.F.R. § 2.142. Appellant disputes the Examining Attorney’s assertions directed to the alleged functionality of Appellant’s applied-for mark in the above-identified application in view of the prior responses, each of which is fully incorporated herein by reference, including all exhibits thereto and evidence in support thereof. The functionality refusal is the only refusal outstanding in the pending application. All other matters having been resolved. Appellant requests that this Board reverse the refusal and pass this mark to publication.

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INTRODUCTION

Appellant filed a product configuration motion trademark application for its mark that depicts a portion of a hand tool as the rectangular, exposed jaw-like elements of the hand tool move radially in and out in a smooth, uninterrupted symmetrical iris-type motion. All refusals and objections were resolved with the examining attorney during prosecution of the application with the exception of the refusal based on the allegation that the applied-for mark is functional.

The errors made in the functionality determination include no consideration or weight given to the non-functional aspects of Appellant's product design and no consideration given to the third-party expert declarations provided by Appellant during prosecution. These errors resulted in the erroneous conclusion that Appellant's applied-for mark is functional. Careful consideration of all the evidence of record in the application, including the declarations of third parties, consideration of alternate designs, and consideration of the non-functional aspects of Appellant's design indicates that Appellant's applied-for mark includes aesthetic design choices such that Appellant's applied-for mark, overall, is non-functional and acceptable for registration. Appellant respectfully disagrees with the functionality refusal and requests that the Board reverse the refusal and pass the application to publication for the reasons set forth herein.

SUMMARY OF THE ARGUMENT

The Examining Attorney's refusal to register Appellant's applied-for motion mark ("Appellant's Mark") should be reversed because the refusal fails to consider the non-functional aspects of Appellant's Mark. The refusal as articulated in the Examining Attorney's Appeal Brief unduly focuses on the description of Appellant's Mark. While the described motion in the description of Appellant's Mark is one aspect of the mark, Appellant's Mark also includes other elements that must be considered in the functionality determination. Some of these elements include the size of the jaw-like elements, the shape of the jaw-like elements, the relative size and orientation of the jaw-like elements, the shape of the opening, the relative size of the opening, the exposure of the jaw-like elements so that a consumer can see the movement of the jaw-like elements, among others. The refusal in this case does not attempt to consider the aesthetic elements of Appellant's Mark and instead only focuses on the description of Appellant's Mark. For at least this reason, the refusal should be reversed.

Consideration of the aesthetic, non-functional aspect of Appellant's Mark demonstrates that, overall, Appellant's Mark is non-functional and suitable for registration. The limited consideration of Appellant's Mark in the Examining Attorney's refusal not only erroneously focuses on the words in Appellant's description of Appellant's Mark but it also appears that the Examining Attorney may not fully understand Appellant's Mark and/or Appellant's product given the justifications in the refusal. Lastly, the refusal fails to fully consider all the relevant evidence including the existence of multiple third-party declarations, the existence of a design patent owned by Appellant for a similar design and ample evidence of competitive alternate

designs. Overall, the drawing and ample evidence supplied in this case support a finding of non-functionality and registration of Appellant's Mark.

ARGUMENT

I. The Examining Attorney erroneously focuses on Appellant's description of the mark rather than on the mark as a whole as shown in the drawing.

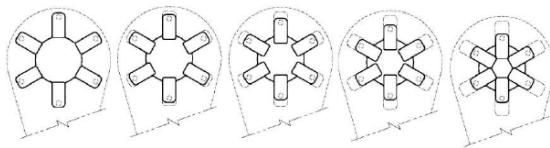
The Examiner Attorney's refusal to register Appellant's applied-for motion mark ("Appellant's Mark") should be reversed because the refusal fails to consider the non-functional aspects of Appellant's Mark. Similarly, the Examining Attorney additionally fails to consider the overall commercial impression of Appellant's Mark and instead focuses on Appellant's description of its motion mark. With this limited consideration, the functionality conclusion is flawed and should be reversed.

The drawing shows the mark that is sought to be registered. T.M.E.P. § 807; 37 C.F.R. § 2.52. An application for registration of a mark with the U.S.P.T.O. must also include a description of the mark if the mark is not a standard character mark. T.M.E.P. § 808.01; 37 C.F.R. § 2.37. The description of the mark, however, "cannot be used to restrict the likely public perception of the mark." T.M.E.P. § 808.02. For this reason, the description and the drawing must be carefully reviewed and all the elements of an applied-for mark should be used in analyzing a mark for functionality. *See In re Hershey Chocolate and Confectionary Corp.*, Ser. No. 77809223, T.T.A.B. decision dated June 28, 2012, p. 3 ("we must consider all elements, including those described in the description of the mark as well as those shown on the drawing page.") This type of detailed analysis of the applied-for mark is required because "when a proposed mark includes both functional and non-functional features...the critical question is the degree of utility present in the overall design of the mark." *In re Becton Dickinson and Co.*, 102 U.S.P.Q.2d 1372, 1376 (Fed. Cir. 2012).

The Examining Attorney in this case does not consider the full commercial impression of Appellant's Mark, including consideration of both the drawing and the description. The

Examining Attorney's review does not carefully analyze all of the features of Appellant's Mark. The minimal consideration of Appellant's Mark can be seen in the description of Appellant's Mark included in the Examining Attorney's Appeal Brief.

The Examining Attorney's description of the applied-for motion mark is limited to a single sentence. The Examining Attorney's Appeal Brief only states "the applied-for mark consists of a design of a circular wrench head whose six jaw-like gripping elements move in an inward and outward, iris-type motion." Ex. Atty. Appeal Brief, p. 3. Appellant's drawing includes more than the elements described by this statement. The drawing of Appellant's Mark is reproduced below. In addition, a photo of Appellant's product is also reproduced below.



Drawing of Appellant's Mark



Appellant's Product

As can be seen, Appellant's Mark includes many elements that are not sufficiently given consideration in the Examining Attorney's refusal if only the description of Appellant's Mark is considered. For example, Appellant's Mark includes:

- six rectangular jaw-like elements
- the jaw-like elements are approximately twice as long as they are wide
- the circular opening's radius is approximately the same as the length of one of the jaw-like elements

- the six rectangular elements are positioned such that the inner-most edge of the jaw resides even with a circular opening in the head of a wrench tool
- as the jaw-like elements move toward the center of the circular opening, the jaw like elements move into the circular opening
- the motion of the jaw-like elements operate in a smooth uninterrupted motion
- the movement of the jaw-like elements is visible to a consumer

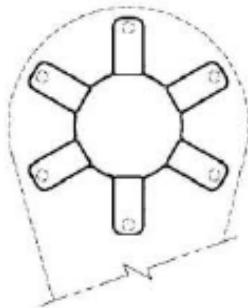
These elements of the tool are non-functional aesthetic design choices made by Appellant during the creation of its product.

It also appears that the Examining Attorney does not understand Appellant's Mark. The Examining Attorney's Appeal Brief states:

Furthermore, there is nothing in the drawing of the mark or in the mark description that indicates, as applicant argues, that the jaws of the wrench head are "exposed" to view and thus represent a variable component of its product design.

Ex. Atty's Brief, p. 20.

Appellant does not understand this statement given that the drawing of the mark shows the exposed rectangular jaw-like elements and that Appellant supplied numerous videos and even a product sample during prosecution of Appellant's mark. *See, inter alia,* Appellant's Response filed Sept. 10, 2013 and Appellant's Response filed April 27, 2105. Appellant believes that the drawing and evidence provided by Appellant makes very clear that the jaws are exposed to a consumer. A close-up image of the head of Appellant's product is shown below.



Portion of Drawing of Appellant's Mark



Appellant's Product

Given the above-quoted portion of the Examining Attorney's Appeal Brief, it appears that Appellant's Mark is not understood. This misunderstanding contributes to the error committed in refusing Appellant's Mark. When the full scope of Appellant's drawing is considered along with the overall commercial impression of Appellant's Mark in the marketplace, it is readily apparent that the aesthetic design choices, some of which are described above, are non-functional such that Appellant's Mark is suitable for registration on the Principal Register.

In the alternative, should the Trademark Trial and Appeal Board deem necessary, Appellant is willing to consider an amendment to the current description of the mark to clarify the nature of Appellant's Mark. Appellant believes, however, that the current description meets the requirements for registration.

II. As a whole, Applicant's mark is non-functional.

The refusal to register Appellant's Mark unduly considers Appellant's Mark broadly to characterize the specific aesthetic design characteristics as being functional. The refusal characterizes Appellant's application as trying to register a trademark for an adjustable wrench with iris-type motion. As stated above, Appellant's Mark includes many aesthetic design elements in addition or in combination with the iris-type motion. The refusal ignores these characteristics. For this reason, the refusal is in error and should be reversed.

The *Morton-Norwich* factors and the determination of functionality of a trademark application requires consideration of the totality of the circumstances and consideration of the non-functional aspects of the design when considering the applied-for mark as a whole. *See Becton, Dickinson and Co.*, 102 U.S.P.Q.2d at 1376. The refusal in this case does not even make an attempt to review Appellant's Mark for non-functional aspects but merely paints the entire motion mark as seeking to register an adjustable wrench with an iris-type motion.

Such a characterization does not properly consider the overall commercial impression of a mark as is required. *Id.* The refusal does not consider the size of the jaw-like elements, the arrangement of the jaw-like elements, the relative size of the jaw-like elements, the smooth motion of the jaw-like elements, the exposed jaw-like elements or any other aspect of Appellant's Mark other than considering that Appellant's product is an adjustable wrench and that the jaw-like elements move.

The refusal supports its conclusion by referencing articles, advertising and other materials describing Appellant's product. This support, however, is fundamentally flawed because none of it discusses the details of Appellant's design as described above, including the non-functional aesthetic aspects of Appellant's product. For this reason the refusal should be reversed.

III. Applicant's utility patent does not claim the non-functional features of Applicant's Mark as a whole.

The *Morton-Norwich* factors and the determination of functionality of a trademark application requires consideration of the totality of the circumstances and consideration of the non-functional aspects of the design when considering the applied-for mark as a whole. *Becton, Dickinson and Co.*, 102 U.S.P.Q.2d at 1376. One of the *Morton-Norwich* factors is the existence of a utility patent claiming the features of the applied-for design. *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332 , 213 U.S.P.Q. 9 (C.C.P.A. 1982). This is but one of the factors

and the totality of the evidence presented should be considered in a functionality determination.

Valu Eng'g Inc. v. Rexnord Corp., 278 F.3d 1268, 61 U.S.P.Q.2d 1422, 1426 (Fed. Cir. 2002).

Notably absent from the Examining Attorney's Appeal Brief is any discussion of the Appellant's design patent directed to a similar design to that of Appellant's Mark. The existence of Appellant's Design Patent No. D618,974 is compelling evidence that Appellant's Mark includes non-functional elements that are not recognized or discussed in the Examining Attorney's Appeal Brief. Instead, the refusal speaks in broad functional language without considering the shape, size, exposure, smooth motion or any other non-functional aspect of Appellant's Mark. The Examining Attorney admits that Appellant's utility patent states that "size, shape or quantity of the gripping elements may differ or that the gripping elements may have a cutter, roller or blade attached to them." Ex. Atty's Appeal Brief, p. 19. Despite this admission, the Brief then states that Appellant's Mark is functional because the patent does not state that "the iris-like motion of the gripping elements is itself subject to variation." *Id.* This again erroneously views Appellant as attempting to broadly register the iris-like motion of an adjustable wrench apart from Appellant's design as a whole.

In addition, Appellant supplied other significant and competent evidence to support that Appellant's Mark is directed to non-functional aesthetic aspects of Appellant's product design. The Examining Attorney's Appeal Brief quickly mentions the declarations of Professors Colgate and Kim. However, no weight is given to this third-party evidence in the case despite that these Professors have over 50 years of mechanical engineering and product design experience. This adds to the erroneous conclusion of the Examining Attorney in this instance.

Still further, the Examining Attorney's Appeal Brief include no mention of the declaration of Mr. Roy Berendsohn, a Senior Editor of Popular Mechanics magazine and a 25-

year media veteran in the tool industry. Mr. Berendsohn, Professor Colgate and Professor Kim, all third-parties more than qualified to add their expert opinions in this matter, opined that Appellant's product design includes aesthetic elements as part of the overall design. *See* Request for Reconsideration filed April 27, 2015, Appendices B, C & D. Still further, Professor Colgate and Professor Kim believe that Appellant's Mark is directed to non-functional elements of Appellant's product design. This evidence receives no attention in the refusal of Appellant's Mark. *Id.*

The failure of the refusal to consider the non-functional aspects of Appellant's Mark and to give no consideration to the third-party declarations submitted in support of registration of Appellant's Mark and to ignore the existence of Appellant's design patent all amount to the clear error in the conclusion that Appellant's Mark is functional. Instead, consideration of all the evidence in the application, as is required under the law (*see Valu Eng'g Inc.*, 61 U.S.P.Q.2d at 1426), results in the conclusion that Appellant's Mark is directed to aesthetic design features and is suitable for registration. For this reason, the refusal of Appellant's Mark should be reversed.

IV. Many design alternatives are available for competitor's to effectively compete in the marketplace.

The Examining Attorney suggests that the policy underlying the functionality doctrine, namely the preservation of competition in the marketplace, supports the refusal of Appellant's Mark. Competition will not be hindered if Appellant's Mark is permitted to register because, despite the Examining Attorney's allegations to the contrary, numerous alternate designs are available for competitive products. The fact that the Examining Attorney alleges that Appellant does not cite any other adjustable wrench that utilizes an "iris-type motion" highlights, once again, that the Examining Attorney does not understand the evidence or the product submitted in this case. *See* Ex. Attys Appeal Brief, p. 16. The exact exhibit that the Examining Attorney

erroneously alleges is devoid of alternate designs, namely Exhibit 1 of the Declarations of Professor Colgate and Professor Kim, includes multiple examples of adjustable members of tools that have moving jaw-like elements. The examples differ from the aesthetic form and experience of Appellant's product. *See* Request for Reconsideration filed April 27, 2015, Appendices B & C. Some images from this Exhibit are reproduced below.



As stated by Professor Colgate in his Declaration, "a hand-tool could be designed such that one or more jaw like elements move, as shown in the example alternative designs included in Exhibit 1. Such alternative designs could provide similar benefits of adjustability and distribution of forces but they exhibit very different aesthetic appearances." *See* Request for Reconsideration filed Mar. 10, 2014, App. B, Decl. of Colgate, ¶ 9. Appellant additionally provided significant and competent evidence of other alternative hand tool designs. *See* Response to Office Action filed Jan. 23, 2013, Exhibit D; Request for Reconsideration filed Mar. 10, 2014, Exhibit A, et al. The overwhelming evidence provided by Appellant in this case shows

that various other tool designs with moving jaw-like elements and other adjustable wrenches are available in the marketplace. This factor favors registration of Appellant's Mark.

V. The additional evidence submitted by Appellant is not considered in the refusal yet clearly supports registration of Appellant's Mark.

The evidence submitted by Appellant to support registration of Appellant's Mark was not given its proper weight in the refusal. The totality of the evidence presented should be considered in a functionality determination. *Valu Eng'g Inc.*, 61 U.S.P.Q.2d at 1426. Here, Appellant's evidence of record in this case, including the international design awards, the statement of Dan Brown, among the other evidence discussed above, was not considered in the refusal.

The evidence of record demonstrates that Appellant's product as depicted in Appellant's Mark has won the Popular Mechanics, Editor's Choice Award, the iF International Forum Design Award, a Good Design Award, and International Industrial and Graphic Design Award from Chicago Athenaeum and the Red Dot Award. *See Response to Office Action*, filed Jan. 23, 2013, Exhibit F. These design awards considered the overall design of Appellant's product including the non-functional aesthetic elements of the design. The overwhelming recognition of the outstanding combination of function and form in Appellant's design is demonstrated by these multiple awards. The recognition of Appellant's product is summarized by the Wall Street Journal that stated "In two of this year's noted international design competitions, only two U.S. companies took home highest honors for their products. One, predictably, was giant Apple Computer Inc. for its sleek, high-tech iPod Nano music player. The other was a tiny unknown Illinois upstart named LoggerHead Tools LLC." *See Wall Street Journal*, March 21, 2006, Request for Reconsideration filed April 27, Appendix G.

This evidence is not discussed in the refusal of Appellant's Mark. These design awards demonstrate that there are significant aesthetic elements included in Appellant's product design. These significant aesthetic elements support registration of Appellant's Mark.

Another piece of evidence ignored in the refusal of Appellant's Mark is the declaration of Dan Brown. Among other things, the declaration states that Appellant's product design "is not the most cost-effective combination among the various alternatives available." *See Response to Office Action* filed Jan. 23, 2013, Exhibit D. In addition, the declaration also states "the appearance of the tool including the appearance and movement of the jaw-like element in the wrench head was an important design consideration..." and "the choice of the shape and configuration of the jaw-like element was made for its appearance among various alternatives." *Id.* This evidence is supported by the declarations of third parties, Professor Colgate and Professor Kim. *See Request for Reconsideration* filed April 27, 2015, Appendices B & C. This evidence was discounted and was not given its proper weight among the totality of the evidence presented in support of registration of Appellant's Mark.

This additional evidence should have been accorded significant weight in the functionality determination. Instead, the refusal narrowly focuses on self-serving evidence and ignored the evidence described above. If all the evidence in this application is weighed appropriately, Appellant's Mark can be seen as being directed to non-functional aesthetic aspects of Appellant's design and is thus suitable for registration. For this reason the refusal of the Examining Attorney should be reversed.

CONCLUSION

Appellant's Mark is non-functional, as a whole, when the entirety of the evidence in this proceeding and the non-functional aspects of Appellant's product design are carefully considered. The refusal failed to consider the non-functional aspects of Appellant's product design and to weigh these aspects against the utilitarian elements. In addition, the determination of functionality was rebutted with the significant compelling evidence of record in this case including several expert declarations as well as significant evidence demonstrating the availability of alternative designs. Appellant respectfully requests the Board to reverse the determination of the examining attorney with respect to the functionality of Appellant's Mark and pass the application to publication.

Respectfully submitted,

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