

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Visual Communications Company, Inc.

Serial Nos. 74/670,554, 74/670,555 and 74/673,994

William W. Haefliger for applicant.

Glenn G. Clark, Trademark Examining Attorney, Law Office
102 (Thomas V. Shaw, Managing Attorney).

Before Simms, Wendel and Bucher, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Visual Communications Company, Inc. has filed
applications to register the following configurations for
" housings for mounting LED's[sic]":

S.N. 74/670,554	S.N. 74/670,555	S.N. 74/673,994 ¹
("square")	("round")	("domed")

¹ S.N. 74/670,554, filed May 5, 1995, claiming first use dates of July 12, 1978. S.N. 74/670,555, filed May 5, 1995, claiming first use dates of July 8, 1976. S.N. 74/673,994, filed May 11, 1995, claiming first use dates of Jan. 15, 1980. LED is the initialism for light emitting diode.

Registration has been finally refused in each application under Sections 1, 2, and 45 of the Trademark Act, on the ground that the proposed mark is de jure functional and thus unregistrable, regardless of any evidence submitted by applicant with respect to acquired distinctiveness.²

Applicant and the Examining Attorney have filed briefs in each of the cases, but no oral hearing was requested. In view of the common questions of law and fact which are involved therein, we find it in the interests of judicial economy to consolidate the cases for purposes of final decision. Thus, we have issued this single opinion.

THE MARKS

As a starting point, we must define the exact parameters of the subject matter sought to be registered as trademarks by applicant. Applicant has inserted the statement in each application that the solid lining in the drawing of each mark is a feature of the mark, not a color indication. Thus, the circular markings as shown in the

² By amendments to the Trademark Act to implement the provisions of the Trademark Law Treaty which became effective October 30, 1998, Section 2(e) has been amended to specifically incorporate the functionality doctrine into the statute in new subsection 2(e)(5), which provides for refusal if the mark "comprises any matter that, as a whole, is functional." Section 2(f) has been amended to exclude subsection 2(e)(5) from the provisions thereof.

drawings on the top of each housing as well as the vertical side markings on two of the housings are part of the proposed marks. On the other hand, the dotted lines for the shank portion of each housing serve only to indicate the three-dimensional nature of the configuration or unclaimed matter, with the solid portion of the outline defining the features which applicant claims as its mark.³ See 37 CFR 2.51(d); TMEP § 807.03(a). We have adopted the designations "square," "round" and "domed" simply for ease in reference to the three configurations.

DE JURE FUNCTIONALITY

The configuration of a product or a portion of a product is de jure functional if it is so utilitarian as to constitute a superior design which others in the field need to be able to copy in order to compete effectively. In re Morton-Norwich Products, Inc., 671 F.2d 11332, 213 USPQ 9 (CCPA 1982). The four factors found to be useful in reviewing the evidence of record with respect to this

³ Applicant failed to submit a description of the mark as was required by the Examining Attorney in the first action, and as should have been pursued by the Examining Attorney. See TMEP § 808.03. Accordingly, the dotted line portion of the drawings cannot be construed as other than non-claimed matter and applicant's arguments with respect to features in the shank portions of the housings have been given no consideration.

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issue, as discussed in *In re Morton-Norwich, Inc.*, *supra*, and consistently looked to by the Board, are as follows:

- (1) the existence of a utility patent that discloses the utilitarian advantages of the design;
- (2) the touting by the originator of the design in advertising material of the utilitarian advantages of the design;
- (3) facts showing the unavailability to competitors of alternative designs; and
- (4) facts indicating that the design results from a relatively simple or cheap method of manufacturing the product.

See also *In re Caterpillar Inc.*, 43 USPQ2d 1335 (TTAB 1997); *In re American National Can Co.*, 41 USPQ2d 1841 (TTAB 1997); *In re Honeywell Inc.*, 8 USPQ2d 1600 (TTAB 1988); *In re Weber-Stephen Products Co.*, 3 USPQ2d 1659 (TTAB 1987).

Before turning to the utility patent which is relevant to our analysis of the product configurations involved here, we note that under the standards set forth in Morton Norwich, the disclosure in a utility patent of features of a product design sought to be registered as a trademark is but one factor to be considered in the determination of de jure functionality. Despite both the Examining Attorney's and applicant's references to the holdings of the Tenth Circuit in *Vornado Air Circulation Systems Inc. v. Duracraft Corp.*, 58 F.3d 1498, 35 USPQ2d 1332 (10th Cir.

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1995), cert. denied, 516 U.S. 1067 (1996) and the Seventh Circuit in its recent decision in *Thomas & Betts v. Panduit Corp.*, 138 F.3d 277, 46 USPQ2d 1026 (7th Cir. 1998), we find no reason to review those decisions, since we are not controlled thereby. Instead we adhere to the multi-faceted analysis laid out by our principal reviewing court in Morton Norwich.

We turn then to the disclosures of the expired patent, Reg. No. 4,035,681, which was submitted by applicant and which was issued to John M. Savage, Jr., the same person who signed the present trademark applications as the president of applicant.⁴ In doing so, however, we are not adopting the test applied by both the Examining Attorney and applicant. We do not find it necessary that the configuration designs for which trademark protection is sought be "virtually identical to the invention described and claimed" in the patent or that the patent must "cover" all facets of the proposed marks. Instead we look to the features disclosed in the patent which have been

⁴ The frequent references by applicant to the patent as one issuing to a "different entity" are immaterial. Under 35 USC §§ 101 and 102, the "person" who is the inventor is the one entitled to the patent, and thus the patent application must be filed by a person, not a company, as is permitted by the trademark laws.

incorporated into the present product designs and the teachings of the patent with respect to these features.

As background to the invention disclosed in the patent, it is stated that in the past, lens caps used for mounting light emitting diodes (LEDs) have been shaped to conform to the cross-sections of the LEDs. While at times lens caps of polygonal cross-section would have been desirable, it was not known how to provide luminosity which did not deteriorate near the cap corners, if such a shape were used.

Thus it is the focus of the invention to produce a polygonal LED lens cap with increased luminosity, and particularly without diminution of illumination near the cap corners. In order to do so, serrations are extended along the interior of the side walls toward the end wall of the cap, and the end wall has an interior surface with radially spaced serrations having circular arcs which diminish in length proximate the corners. These serrations can best be seen in Figs. 3 (end wall view) and 4 (section view of side wall) of the patent:

It is obvious that only one of applicant's lens caps configurations is polygonal, the other two being circular or cylindrical, as pointed out by applicant.⁵ Nor are certain other features of the patent incorporated in the product designs before us. But we find that features fundamental to the invention disclosed in the patent have been carried forward into each of the product designs sought to be registered as trademarks.

Applicant argues that because the patent fails to show any exterior view of the lens cap, and does not suggest that the interior serrations would be visible from the exterior, the patent is silent with respect to the solid lining of the present marks. We do not agree. The lens caps necessarily must be translucent in order to allow transmission of the light from the LED. Thus, the serrations shown in the patent, even though on the interior of the end and side walls, will be visible from the exterior. Examination of the photographs of the goods in the specimens of record shows that the visible exterior lines could well be the result of interior markings or serrations. Since there is no description of the marks in

⁵ We note that the Examining Attorney in his briefs has mistakenly referred to all three configurations as being polygonal.

the applications of the specific "feature" which the solid linings represent, there is no indication that these lines are other than markings visible through the cap and created by serrations on the interior of the cap. In fact, we are convinced that the markings represent just that.

Accordingly, applicant has incorporated the teachings of the patent with respect to the use of serrations in the side and end walls so as to obtain the advantages which result therefrom, i.e., to increase the luminosity of a lens cap which does not conform to the shape of the LED. Although the markings are much less detailed in the drawings of the trademark applications than in the patent, the adoption of a significant component of the invention disclosed in the patent is clear. We cannot accept applicant's analogy of the present markings on its lens caps to stripes or the like on the exterior portion of a shoe, which may well be registrable, despite the functionality of the shoe as a whole. Here the markings are not merely decorative exterior lines, but rather are the result of the incorporation of the features disclosed by the patent in order to obtain the utilitarian advantages thereof.

Under the second Morton-Norwich factor, we look to available advertising material of applicant and to whether

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any utilitarian advantages have been touted for the product design sought to be registered. Here we are limited to the specimens of record, which consist of promotional material covering all three lens/mount configurations.

In the first instance, the "square lens/mounts" being sold under the mark CUBELITE are described as offering "20% more viewing area over a round indicator light" and as having "unique patented features [that] include striated lines and fresnel rings permitting up to 180 degrees viewing angle with any stock 3mm or 5mm LED." The "round" configuration, marketed under the mark CLIPLITE, is described as using "striated lines and fresnel rings to increase apparent brightness up to 125% and viewing angle up to 180 degrees with either diffused or nondiffused LEDs." Finally, the low profile CLIPLITE (the "dome" configuration) "utilizes fresnel rings to increase apparent brightness and viewing angle up to 180 degrees." In each case, we find that applicant's literature clearly points out the utilitarian advantages of the striated lines (side wall serrations) and the fresnel rings (end wall serrations), and even specifically links these features to a patent. Furthermore, in viewing the pictures of the goods found in this material, we once again are convinced that it is the striated lines and the fresnel rings, which

appear to be on the interior, which result in the linings depicted in the application drawings.

Insofar as the third factor is concerned, applicant has failed to submit any information with respect to alternative designs available to competitors for lens caps which do not conform to the shape of the LED, but yet possess the increased overall luminosity inherent in applicant's product designs. Moreover, if registrations were issued for the three different overall shapes involved herein, all of which incorporate the features essential to the increased luminosity, the potential for fully competitive designs would appear to be greatly reduced.

Finally, there has been no evidence introduced by either the Examining Attorney or applicant as to the costs of production of lens caps with the features of applicant's product designs. While one might surmise that applicant's lens caps would be more costly to manufacture, applicant has introduced no evidence to this effect.

Regardless, we find that the evidence with respect to the first three factors points overwhelmingly to the conclusion that applicant's product designs are de jure functional. The patent discloses the utilitarian advantages of the serrations or striated lines in the side walls and the circular serrations or fresnel rings in the

end wall and claims these features as a significant component of the invention. Applicant touts the patenting of these features in its advertising and the advantages obtained thereby. There is no evidence that truly competitive alternative designs are available. Thus, we find these features lead to a superior product design, whether incorporated in an overall configuration which is square, round or domed, which is precluded from registration as a trademark under the doctrine of de jure functionality.

ACQUIRED DISTINCTIVENESS

The Examining Attorney has correctly stated that if applicant's product designs are de jure functional, the proposed marks cannot be registered on either the Principal or the Supplemental Register. The recent amendment to Section 2(f) has incorporated this prohibition, which is inherent in the functionality doctrine, into the Trademark Act.⁶

Nonetheless, if upon further review the present configurations are found not to be de jure functional, the issue would arise as to whether the product designs have acquired distinctiveness as an indication of source.

⁶ See footnote 2.

Although the Examining Attorney did not address the sufficiency of the evidence submitted by applicant until his appeal brief, applicant did respond to the Examining Attorney's arguments in its reply brief. Thus, we find it in the interests of judicial economy to take the matter of acquired distinctiveness under consideration at the present time.⁷

Applicant has submitted nine uniformly worded declarations in each application from the same nine customers and dealers stating that each of the configurations is "distinctive as indicating [applicant] as the source of the goods...". Applicant has also pointed to its use of the marks for well over five years as a basis for registration under Section 2(f).

The Examining Attorney takes the position that there is little evidence that the relevant purchasers would perceive the product configurations as an indication of

⁷ As best we can determine, applicant raised the question of registration under Section 2(f) based on years of use after the first action by the Examining Attorney. The declarations were later submitted in a request for reconsideration of the final refusal. The Examining Attorney simply refused to consider the evidence on the basis that de jure functionality bars registration. Although it is true that de jure functionality bars registration, it would have been the better practice for the Examining Attorney to fully consider this evidence in the alternative, in the event the refusal on the basis of de jure functionality was not upheld.

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source and that the declarations submitted by applicant are not persuasive. Applicant, in response, maintains that there is no evidence that purchasers would not view the configurations as source indicators.

Applicant has claimed acquired distinctiveness under Section 2(f) on the basis both of years of use and of the declarations submitted. There are no declarations by applicant, however, formally setting forth a claim of acquired distinctiveness based on years of use. Moreover, the form declarations submitted by applicant from customers and dealers do not show, as a reference point for the declarants, the marks sought to be registered, but rather the entire configurations of the housings.

The more significant deficiency, however, is the lack of any evidence of promotion by applicant of the product configurations as trademarks. Even though the promotional literature may show these configurations, there is nothing to lead us to believe that potential purchasers would view these as other than what they are, namely, pictures of the goods. See *In re Pingel Enterprise Inc.*, 46 USPQ2d 1811 (TTAB 1998)[consumers would not regard depiction of petcock configuration as anything more than graphic representation of the product.] There is no reference in the material to the product designs as a means of recognizing applicant as

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the source thereof; instead only the words CUBELITE and CLIPLITE are used in the manner of trademarks.

Accordingly, we find that, even if the product configurations were found not to be de jure functional, the evidence is insufficient to demonstrate acquired distinctiveness under Section 2(f).

Decision: The refusal to register on the ground that each of applicant's product configurations is de jure functional is affirmed.

R. L. Simms

H. R. Wendel

D. E. Bucher
Trademark Administrative Judges,
Trademark Trial and Appeal Board

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