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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re All Rite Products, Inc.¹

Serial No. 75/260,089

Peter M. de Jonge of Thorpe, North & Western for applicant.

Karla Perkins, Trademark Examining Attorney, Law Office 102
(Thomas Shaw, Managing Attorney).

Before Quinn, Rogers and Drost, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by All Rite Products,
Inc. to register the configuration shown below

¹ The original application identifies applicant as "All Right Products, Inc." In subsequent filings, however, applicant was identified, both by applicant and the Office, as "All Rite Products, Inc.". In the event that applicant ultimately prevails herein, it should file, if appropriate, a correction to the spelling of its name as shown in the original application.

for "a carrier fork, sold as an integral component of a utility carrier mounted on motorized vehicles used to hold elongated objects."² Applicant has claimed acquired distinctiveness under Section 2(f) of the Trademark Act.

The Trademark Examining Attorney has refused registration under Section 2(e)(5) of the Trademark Act on the ground that the configuration sought to be registered is *de jure* functional and, thus, is incapable of functioning as a source identifying mark.³ The Examining Attorney further stated that in the event the configuration is only *de facto* functional, the evidence of acquired distinctiveness is sufficient to support registration on the Principal Register. (Office action, March 2, 2000) The Examining Attorney also made final a requirement to submit an acceptable drawing.⁴

² Application Serial No. 75/260,089, filed March 19, 1997, alleging first use anywhere and first use in commerce at least as early as July 15, 1985. The application includes the following statements: "The mark consists of a configuration of a carrier fork, a component part of a utility carrier for vehicles. The lining in the mark is for shading purposes only and does not indicate color."

³ The final refusal was grounded on Sections 1, 2 and 45 of the Trademark Act. However, as noted by the Examining Attorney in her brief, the Act was recently amended to provide explicitly that functionality is a ground of refusal if the mark "comprises any matter that, as a whole, is functional." Further, Section 2(f) of the Act was amended to exclude Section 2(e)(5) from the provisions thereof.

⁴ The Examining Attorney has required that applicant submit a new drawing that shows the threaded stem, which even applicant concedes is functional, in dotted lines. Applicant has not traversed this requirement. Therefore, in the event that

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney filed briefs, and both appeared at an oral hearing before the Board.

The Examining Attorney maintains that the proposed mark is *de jure* functional as disclosed by a utility patent. The Examining Attorney also points to applicant's advertising materials that, according to the Examining Attorney, tout the utilitarian advantages of applicant's product design. The Examining Attorney further asserts that applicant's design is one of a few superior designs and that, accordingly, the design should be freely available to competitors. In connection with this assertion, the Examining Attorney relied upon an excerpt from a printed publication wherein applicant's product was referred to as "the only truly innovative" design among similar carriers.

Applicant responded to the Examining Attorney by asserting that in refusing registration on the basis of *de jure* functionality, she improperly dissected applicant's configuration into its component design features.

Applicant argues that the configuration it seeks to register is not *de jure* functional, but rather is, at worst, *de facto* functional and is registrable under the

applicant ultimately prevails on the functionality issue, it must

provisions of Section 2(f). Applicant contends that the design sought to be registered is not the subject of the involved patent; according to applicant, the subject of the patent is the entire rifle carrier system, particularly the locking mechanism, not the configuration of the carrier's "holding member." Applicant further asserts that none of its advertisements touts the configuration as having a utilitarian advantage. Applicant goes on to discuss, in some detail, the availability of alternative designs, and that the cost of manufacturing these alternative designs is the same or less than that of applicant's product.

In support of its position, applicant submitted the declarations of Dennis Hancock and George Gates, both officers of applicant. Also of record is a declaration (with related exhibits) of James Schoudel, the owner of an injection molding company that manufactures applicant's product. Applicant also introduced the form declarations of distributors, retailers and consumers attesting to their recognition of the distinctive shape of applicant's product. The other materials introduced by applicant are as follows: the utility patent covering applicant's carrier, as well as a second patent; seventeen third-party patents covering products that, according to applicant,

submit a new drawing before the mark can be published.

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show the availability of alternative designs that are equally efficient and no more costly; packaging for applicant's product; and advertising and promotional materials for applicant's product.

We should note, at the outset, that the prosecution of this case, including the filing of the appeal briefs, occurred prior to the issuance of the recent United States Supreme Court case, *TraFFix Devices Inc. v. Marketing Displays Inc.*, 532 U.S. 23, 58 USPQ2d 1001 (2001). Although applicant's and the Examining Attorney's arguments, of course, did not include reference to the Supreme Court case, the Board, during the oral hearing, questioned each about the ramifications of the case for the present appeal. Applicant then filed, on August 31, 2001, a supplemental appeal brief focusing on the applicability of the Supreme Court's decision to this appeal.

A product feature is functional and cannot serve as a trademark if it is essential to the use or purpose of the article or it affects the cost or quality of the article. *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 34 USPQ2d 1161 (1995) and *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 214 USPQ 1 (1982). As just mentioned above, we also have the benefit of the *TraFFix Devices Inc.* case. In that case, the Supreme Court

confronted the issue of functionality of a product's trade dress and the probative value of a utility patent in analyzing the issue. In determining the functionality of a particular product design or trade dress, the Court noted that a prior utility patent has "vital significance." The utility patent is "strong evidence" and adds "great weight" to the presumption that the features claimed are functional.

The principal question in this case is the effect of an expired patent on a claim of trade dress infringement. A prior patent, we conclude, has vital significance in resolving the trade dress claim. A utility patent is strong evidence that the features therein claimed are functional. If trade dress protection is sought for those features the strong evidence of functionality based on the previous patent adds great weight to the statutory presumption that features are deemed functional until proved otherwise by the party seeking trade dress protection. Where the expired patent claimed the features in question, one who seeks to establish trade dress protection must carry the heavy burden of showing that the feature is not functional, for instance by showing that it is merely an ornamental, incidental, or arbitrary aspect of the device.

Id. at 1005.

With respect to the availability of alternative designs, the Court also stated that if a design is

functional, competitors need not explore whether other designs could be used.

There is no need, furthermore, to engage, as did the Court of Appeals, in speculation about other design possibilities, such as using three or four springs which might serve the same purpose. Here, the functionality of the spring design means that competitors need not explore whether other spring juxtapositions might be used. The dual-spring design is not an arbitrary flourish in the configuration of MDI's product; it is the reason the device works. Other designs need not be attempted.

Id. at 1007.

We now turn to apply the law to the facts of this case. There is a utility patent here, No. 4,607,772,⁵ that covers a utility carrier for holding a rifle or other elongated objects in a stable position on the handlebars of a motorcycle, all terrain vehicle or similar vehicles. As indicated above, the portion of applicant's invention that is sought to be registered as a trademark is the shape of the "holding member coupled to the mounting stem and configured to support and lock an object." The summary of the patent indicates, in pertinent part, that "an object of the present invention [is] to provide a utility carrying device in which an elongated member such as a rifle can be

laid and securely retained in place." The utility carrier "is capable of locking an elongated carried item in place such that it does not jar free from vibrations or bumps encountered by the motorcycle." The abstract of the patent reads as follows:

A utility holding device for carrying elongated objects such as a rifle at the handlebars of a motorcycle. The device includes a clamp for attachment to the handlebars, a support base attached to the clamp, a mounting stem which is adjustably attached in a threaded opening in the support base and a holding member coupled to the mounting stem and configured to support and lock an object in fixed position at the handlebars.

The summary of the invention discloses that "[t]he holding member is formed from a bar which is bent to a partially closed configuration with the respective ends of the bar forming an opening through which an object can be inserted." The patent goes on to state that "[t]he upper half of the holding member may be adapted with an elbow or cocked end which operates as a catch for gripping the contained object and preventing it from sliding free from the holding member."

The "Detailed Description of the Invention" offers even more specific information that, most pertinent to this

⁵ The patent is owned by George Gates and Dennis Hancock who, as

case, bears on the holding member: "Generally, the lower half of the holding member starts at the horizontal line where the contained area approaches its widest distance, and converges as a tapered U shape down toward the point of attachment of the stem...The lower half of the holding member is generally configured as a tapered or converging U-shape having upright arms and an intermediate base so that a contained object nests in a secure position toward the base of the V." The details also include the following: "At least one side of the holding member extends above the horizontal line and is configured as an elbow which bends toward the contained area. This structure provides a cocked configuration which provides a downward force for retaining the carried object in its seated position as the holding member is rotated to lock the object in place." The description also notes that rubber caps are mounted on the ends of the holding member and that "various shapes and methods of attachment of such flexible end caps can be applied."

The patent makes the following pertinent claims regarding the "holding member" that is depicted in applicant's drawing:

a holding member having an upper half
and a lower half, said lower half being

indicated above, are officers of applicant.

formed with a U-shape comprising two upright arms and an intermediate base which define a containment area, said lower half being attached at its base to an upper portion of the stem with the stem and arms generally in common upright orientation such that the lower half can be rotated with the stem in the support base about the longitudinal axis to engage and lock the carried object between the upright arms of the lower half of the holding member;

the upper half including an extension of at least one arm of the lower U-shape which is configured as an elbow which bends toward the containment area and provides an upper cocked end to the holding member for engaging an upper part of the contained object and for applying a counter, downward force toward the base of the U-shape to grip and restrain the contained object in a locked position within the holding member;

said upper half further including an open section between opposing ends of the holding member to enable insertion of the elongated object there through to the containment area.

As stated by the Supreme Court, a utility patent is strong evidence on the issue of functionality. The utility patent makes it clear that the configuration of the holding member sought to be registered as a trademark is, as a whole, *de jure* functional and, thus, unregistrable. The patent sets forth, in detail, the functional aspects of the holding member. There is nothing ornamental, incidental or arbitrary about the specific design at issue. To the

contrary, as explained in the patent, the shape of the holding member allows the carrier to function, that is, "[t]his structure provides a cocked configuration which provides a downward force for retaining the carried object in its seated position as the holding member is rotated to lock the object in place." Clearly, the holding member, and most especially the elbow-configured extension feature, is a utilitarian part of the patented invention.

The rubber caps likewise are functional "to offer protection against impact." The patent discloses that "various shapes and methods of attachment of such flexible end caps can be applied" and that "the opening between the ends can be closed off by flexible ends which extend across the object opening between the ends of the bar and form a gate through which the object can be pushed." The "load lock knobs" are described on applicant's packaging as "put[ting] a firm grip on your equipment" and "when properly adjusted, load lock knobs allow for equipment to be quickly snapped out with a firm pull."

As clearly recognized by applicant, the threaded mounting stem is functional, and is not intended to be part of the mark as registered.

In sum, the configuration sought to be registered, in its entirety, is *de jure* functional. The fact that the

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configuration does not cover applicant's entire invention but, rather, is only a portion thereof, is of no moment; the simple fact remains that, as demonstrated by the strong evidence of the utility patent, the "holding member" configuration is functional. *Disc Golf Association Inc. v. Champion Discs, Inc.*, 158 F.2d 1002, 48 USPQ2d 1132 (9th Cir. 1998).

Accordingly, as instructed by the Supreme Court, we need not examine whether or not there are alternative designs available for such utility carriers. The functionality of the holding member of applicant's product means that competitors need not explore whether other holding member designs might be used. *TraFFix Devices Inc.*, supra at 1007.

Be that as it may, both applicant and the Examining Attorney addressed the functionality issue in terms of the factors set forth by our primary reviewing court in the case of *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 USPQ 9 (CCPA 1982). As set out in that case, there were factors which the court deemed useful in determining whether a particular product design is utilitarian: (1) the existence of a utility patent that discloses the utilitarian advantages of the design; (2) advertising materials in which the originator of the design touts the

design's utilitarian advantages; (3) the availability to competitors of alternative designs; and (4) facts indicating that the design results from a comparatively simple or cheap method of manufacturing the product. In discussing the factors, applicant and the Examining Attorney expended much effort with respect to the availability of alternative designs.⁶

Even if we were to analyze applicant's proposed mark under the guidelines of Morton-Norwich, we would still find it to be *de jure* functional and, thus, unregistrable. Courts have often recognized the significant probative value to be given utility patents that disclose the primary functionality of a configuration. See, e.g., *Best Lock Corp. v. Schlage Lock Co.*, 413 F.2d 1195, 162 USPQ 552 (CCPA 1969). See also: J.T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, §7:89 (4th ed. 2001). This factor, before and even more so now, weighs in favor of a finding of *de jure* functionality.

With respect to alternative designs, applicant submitted seventeen patents covering various carriers and racks, as well as examples of competing products. Although

⁶ Clearly, in the wake of the TraFFix Devices case, applicant's contention that this factor "is probably the most important" (reply brief, p. 6) is not well taken.

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other shapes exist, applicant's design is one of only a small number of superior designs. The fact that carriers may be produced in other forms or shapes does not detract from the functional character of the involved configuration. In re Bose Corp., 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985); In re Edwards Ski Products Inc., 49 USPQ2d 2001 (TTAB 1999); and Greenhouse Systems Inc. v. Carson, 37 USPQ2d 1748 (TTAB 1995).

With respect to applicant's advertising, we do not share the Examining Attorney's view that it shows touting of the utilitarian advantages of applicant's design. Descriptions such as "universal," "versatile," "state of the art modular design" and "innovative" vaguely suggest the superiority of applicant's product design. However, these descriptions are somewhat amorphous and do not tout, with any specificity, the utilitarian advantages of the holding member of applicant's product.

As to the fourth factor, cost of design, the only evidence on this factor is the declaration of Mr. Schoudel who, as indicated above, is the owner of an injection molding company that manufactures applicant's rack. Mr. Schoudel states, in pertinent part, that the "alternative designs either cost approximately the same or are less to manufacture than applicant's configuration." Although this

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factor tends to weigh in applicant's favor, it is outweighed by the clear utilitarian function of the product configuration.

To summarize, the product design sought to be registered is *de jure* functional under the guidelines of the recent TraFFix Devices case decided by the Supreme Court. In conformance with the teachings of that case, we view applicant's utility patent as strong evidence that the design is functional. Accordingly, applicant's burden to establish that the design is not functional is heavy and, here, applicant has not shown that the design is merely an ornamental, incidental or arbitrary aspect of the design. Further, under this case, in view of the utilitarian functionality of the design, there is no need to explore the availability of alternative designs. We go on to find, however, that even if the functionality issue were analyzed under the traditional Morton-Norwich factors, the same result would pertain in this appeal.

Decision: The refusal to register is affirmed.