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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Kong Company, LLC

Serial No. 78259826

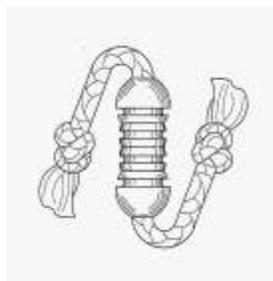
Brent P. Johnson and Christopher J. Hussin of Sheridan Ross, P.C., for The Kong Company, LLC.

Michael Webster, Trademark Examining Attorney, Law Office 102 (Thomas V. Shaw, Managing Attorney).

Before Kuhlke, Walsh and Cataldo, Administrative Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

On June 9, 2003, The Kong Company, LLC. (applicant) applied to register the mark shown below for "pet toys" in Class 28.



Applicant describes the mark as follows: "The mark consists of a three-dimensional configuration of a pet toy comprising

at least one rope operatively associated with a rubberized plasticized center." The application also includes the following statement: "The lining in the drawing is for shading purposes to illustrate the curved nature of the configuration." Applicant claims both first use of the mark anywhere and first use in commerce on July 31, 1991.

The examining attorney has finally refused registration under Trademark Act Section 2(e)(5), 15 U.S.C. § 1052(e)(5), on the ground that the mark is functional.¹ Applicant has appealed. Both applicant and the examining attorney have filed briefs. Applicant did not request an oral hearing. We affirm.

Functionality

Configurations of products, or product designs, may be protected and registered as trademarks subject to certain conditions. TraFFix Devices Inc. v. Marketing Displays Inc., 532 U.S. 23, 58 USPQ2d 1001, 1004 (2001). The Supreme Court has consistently proceeded with caution in according trademark protection to product designs. In TraFFix the Supreme Court states: "And in Wal-Mart, supra, we were

¹ The use of the term "functional" in this opinion means "de jure functional" as discussed in cases, such as, In re Morton-Norwich Prods., Inc., 671 F.2d 1332, 213 USPQ 9 (CCPA 1982). As the Board has stated, ". . . if the design of a product 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, it is de jure functional and is precluded from registration as a matter of public policy." In re Caterpillar Inc., 43 USPQ2d 1335, 1338 (TTAB 1997) (citations omitted).

careful to caution against misuse or over-extension of trade dress. We noted that product design almost invariably serves purposes other than source identification." Id., citing, Wal-Mart Stores Inc. v. Samara Bros. Inc., 529 U.S. 205, 54 USPQ2d 1065 (2000).

In this case we must consider whether applicant's mark satisfies the most basic condition related to the registration of a product design as a trademark, the "functionality" test. The functionality doctrine guards against the "misuse" or "over-extension" of trademark protection for product designs.

The Supreme Court has used a number of formulations to articulate the functionality doctrine. For example, in Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159, 34 USPQ2d 1161, 1163-64 (1995) the Court stated, "a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article, that is, if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage. (citation omitted)"

In Valu Engineering, the Court of Appeals for the Federal Circuit confirmed that its long-standing test for determining whether a particular product design is functional remained viable after TrafFix, noting, "We do not understand the Supreme Court's decision in TrafFix to have

altered the Morton-Norwich analysis." Valu Engineering Inc. v. Rexnord Corp., 278 F.3d 1268, 61 USPQ2d 1422, 1427 (Fed. Cir. 2002).

The Federal Circuit and its predecessor court, the Court of Customs and Patent Appeals, have employed the Morton-Norwich analysis or test for nearly twenty-five years. Morton-Norwich identifies the following factors to be considered in determining whether a particular design is functional: "(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." Morton-Norwich, 213 USPQ at 15-16.

In TrafFix, the Supreme Court addressed and clarified the proper weight to be accorded a utility patent in that analysis, as well as the role of alternative designs. TrafFix Devices Inc. v. Marketing Displays Inc., 58 USPQ2d at 1005. The Supreme Court notes, "A prior patent, we conclude, has vital significance in resolving the trade dress claim. A utility patent is strong evidence that the features claimed therein are functional. . . . 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. As to the role of alternative designs, the Federal Circuit observes in Valu Engineering:

Nothing in TraFFix suggests that consideration of alternative designs is not properly a part of the overall mix, and we do not read the Court's observations in TraFFix as rendering the availability of alternative designs irrelevant. Rather, we conclude that the Court merely noted that once a product feature is found functional based on other considerations, there is no need to consider the availability of alternative designs because the feature cannot be given trade dress protection merely because there are alternative designs available. But that does not mean that the availability of alternative designs cannot be a legitimate source of evidence to determine whether a feature is functional in the first place.

Valu Engineering, 61 USPQ2d at 1428 (footnote omitted).

Accordingly, in this case we must analyze applicant's mark according to the Morton-Norwich factors to determine whether applicant's product-design mark is functional.

Utility Patents

Utility Patent No. 4,802,444² ("the '444 Patent") is the key piece of evidence in this case. The patent is for a "THERAPEUTIC PET TOY." The patent "ABSTRACT" states the following:

² The application was filed on July 15, 1987, and the patent issued on February 7, 1989. The patent was reissued on August 24, 1993 (Re. 34,352). The patent will expire on July 15, 2007.

Disclosed is a dental hygienic pet toy for dental prophylaxis on the teeth of a dog or other animal as the toy is chewed by the carnivore. The toy includes an elastomeric body having an outer surface and at least one groove which opens out onto the open surface. The groove is sized and configured so that a functional prophylaxis lip will scrape plaque and other debris from a tooth and gingiva of a carnivore which is repeatedly inserted into and at least partially withdrawn from the groove as the toy is chewed by the animal. An oral hygiene substance may be provided along the lip to enhance the benefit to the teeth and gingiva.

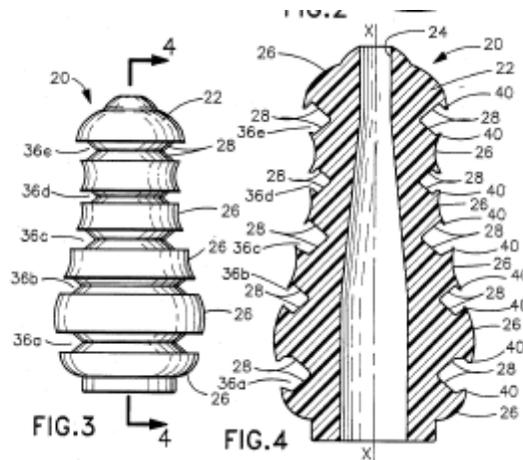
The discussion of "BACKGROUND ART" in the patent indicates that "very few pet toys have been designed with features that are directed to improving a dog's dental health."

The "DISCLOSURE OF THE INVENTION" refers, among other things, to the "grooves" discussed in the abstract and also refers to the "inner hollow core" of the body of the toy. The patent states, "The hollow core enhances the tooth and gingival scraping when a dog chews the toy by providing the body with the capability of resiliently bowing into the hollow core." The bowing action results in "champing or engagement of the tooth located in the groove which thereby results in scraping of the tooth's side and neck and the dog's gingiva surrounding the neck of the tooth."

The "BEST MODE FOR CARRYING OUT THE INVENTION" specifies, among other things, that "Appropriately designed toys are sized to accommodate the different lengths and width of mandible and maxilla seen in the various breeds of

dogs" and specifies preferred shapes and angles for the grooves.

The patent includes the following drawings related to the invention illustrating the key features, the grooves, lips and the body:



The patent claims specify various details related to the body and grooves of the "therapeutic pet toy" concluding with Claim 23 which states:

23. A dental hygiene play toy for performing dental prophylaxis on the teeth of a carnivore as said toy is chewed by the carnivore, said toy comprising:

An elastomeric deformable body defining an outer surface;

A plurality of parallel grooves formed in said outer surface and having spaced sides; and

A functional prophylaxis lip formed between at least one of said sides of each groove and its intersection with said toy's associated adjacent outer surface, said lip partially projecting over the opening of each groove and will further project inwardly over each groove when the carnivore bites down on said body, said lip being sized and configured to scrape a tooth as it is inserted into and partially withdrawn from each groove as the carnivore chews said toy.

Applicant argues that, "The '444 Patent does not, however, claim or disclose Applicant's pet toy product configuration. Instead it discloses and claims an individual feature of Applicant's overall product configuration." Applicant then argues that the overall combination of features in its product design is not functional even though the individual feature covered by the patent is functional. Applicant states further, ". . . Applicant seeks to register in the subject application 'a three-dimensional configuration of a pet toy comprising at least one rope operatively associated with a rubberized/plasticized center.' Such a product configuration is not the central advance of the '444 Patent."

Applicant emphasizes that the patent does not refer to any rope element. Applicant also relies heavily on the fact that applicant did not refer to the functional features claimed in the patent in describing its trademark, "Any discussion of the actual shape and appearance of the rubberized/plasticized element embodied in the present trademark, however, is conspicuously absent." Applicant emphasizes that, "Nearly all of the claims and disclosures are directed to the grooves of a pet toy." And later applicant argues, "The particular configuration of the

grooves claimed in the utility patent can be used with truly an infinite number of differently shaped pet toys."

The examining attorney disputes applicant's characterization of its mark which minimizes the importance of the features claimed in the patent. The essence of the examining attorney's argument is captured in the following:

In this case the only portion of Applicant's chew toy that may be non-functional are the 'floss ropes' attached to the ends of the rubberized chew toy. On Applicant's website, the goods are listed under KONG DENTAL toys. The Applicant's advertising states that 'the grooves effectively squeegee clean dog's teeth and gum as they chew.' . . . Clearly, Applicants (sic) chew clean grooves are essential to the use or purpose of the pet dental toy and affect the cost and quality of the goods. The teeth cleaning function of the goods is the central advance of the overall product configuration.

Based on our review of the entire record, we concur with the examining attorney. The "rubberized plasticized center" is the dominant element in applicant's mark. The "grooves," including the lip, are, in turn, the dominant feature of the "rubberized plasticized center." The body and the particular shape and position of the grooves, as depicted in applicant's trademark drawing, are also the key elements of the '444 Patent.

The fact that applicant omits mention of the grooves and the shape of the center or body of the toy in its description of the mark in no way detracts from their

importance in the mark as shown in the trademark drawing.³ In this case the grooved "rubberized plasticized center" is the proverbial elephant in the middle of the living room. The grooved body itself is conspicuous, though applicant does not mention it. If applicant had truly intended to exclude the grooves or any other element from the mark it claims here, it could have done so by showing the grooves or other elements in broken lines in its drawing. See 37 C.F.R. § 2.52(b)(4). See also In re Controls Corp. of America, 46 USPQ2d 1308, 1312 (TTAB 1998); In re Famous Foods, Inc., 217 USPQ 177, 177 (TTAB 1983). Applicant elected not to do so.

A comparison of the mark, as shown in the trademark drawing above, and the invention, as identified and shown in the patent drawings above, illustrates that both include the grooved body. There is no ambiguity in the trademark drawing.

On the other hand, applicant's description of its mark lacks precision. Applicant's description inflates the importance of the ropes attached to the ends of the grooved body of the therapeutic pet toy. Applicant begins its description of the actual mark as follows, ". . . at least

³ The acceptability of applicant's description of the mark is not before us in this appeal as a ground for refusal. The examining attorney has accepted it. However, we must address the description because applicant has relied on that description, in part, in its arguments regarding functionality.

one rope operatively associated with . . ." The "rubberized plasticized center," the elephant, is at the end of the rope and at the end of the description. There is no mention of the grooved feature of the center. However, it is evident that the grooved center or body is the dominant element in the mark as shown in the drawing.

In a previous case this Board has noted the serious problems with the issuance of a registration for a product-design mark with ambiguities in either the description of the mark or the features claimed. The Board stated, "A registration of the instant configuration without any formal description of applicant's mark or explanation of the elements which applicant claims function as its mark would, we believe, hinder competitors who would not know if the features which they are using in their products, whose overall configurations are not dissimilar from that of the applicant, subject them to a suit for trademark infringement." In re R. M. Smith, Inc., 219 USPQ 629, 633-34 (TTAB 1983), aff'd, 734 F.2d 1482, 222 USPQ 1 (Fed. Cir. 1984). Here we have at least the benefit of a clear drawing, but the ambiguous description could indeed cause confusion as to what is being claimed.

Applicant also argues that its mark, when viewed overall, is nonfunctional. In its reply brief applicant delineates the "non-functional" features, "Applicant's product configuration

comprises a number of arbitrary and/or incidental non-functional features including, without limitation, the shape of the rubberized element, the position of that element in relation to the rope, and the number and configuration of grooves formed on the toy." Applicant then argues that its mark is not functional overall in view of these "nonfunctional" features.

We find this argument unpersuasive. "The shape of the rubberized element" is claimed in the '444 Patent, as is the "configuration of the grooves." That is to say, the grooves, including their configuration and position, are what the body is all about, according to the patent. The grooved body is also the dominant element in the trademark. Likewise, the ropes, as shown in applicant's drawing and in its product, are clearly subordinate to the grooved body. More generally, to the extent the trademark includes features not covered by the patent, such as the ropes, those features are incidental and of little importance in determining whether the mark is functional overall.

As the Federal Circuit has stated, "The case law of this court and its predecessor also establishes that before an overall product configuration can be recognized as a trademark, the *entire* design must be arbitrary or non de jure functional. Petersen Mfg. Co. v. Central Purchasing Inc., 740 F.2d 1541, 1550, 222 USPQ 562, 569 (Fed. Cir. 1984); In re Minnesota Mining and Mfg. Co., 335 F.2d 836, 142 USPQ 336 (CCPA 1964). The reason for this rule is self evident - the right to copy better working designs would, in due course, be stripped of all meaning if overall functional designs were accorded trademark protection because they included a few arbitrary and nonfunctional features.

See Petersen Mfg. Co., 740 F.2d at 1550, 222 USPQ at 569; In re R. M. Smith, 734 at 1484, 222 USPQ at 2-3." Textron, Inc. v. U.S. International Trade Commission, 753 F.2d 1019, 224 USPQ 625, 628-29 (Fed. Cir. 1985). See also In re Vico Prods. Mfg. Co., Inc., 229 USPQ 364 (TTAB 1985). In this case the ropes and other elements applicant points to are but "a few arbitrary and nonfunctional features" and insufficient to render the overall design nonfunctional.

Accordingly, we conclude that the '444 Patent is clear evidence that applicant's mark is functional. Furthermore, though applicant argues otherwise, we conclude that this is a case like TraFFix where the patent provides "strong evidence" that the product design is functional. TraFFix Devices Inc. v. Marketing Displays Inc., 58 USPQ2d at 1005. Although the patent evidence by itself could suffice to establish that applicant's mark is functional, we will examine the other Morton-Norwich factors. The evidence of record on those factors, in fact, is fully consistent with the utility-patent evidence.

Advertising

Under this factor, we will consider evidence regarding "advertising materials in which the originator of the design touts the design's utilitarian advantages." The examining attorney has pointed to evidence of applicant touting the functional advantages of its design on applicant's website. Specifically, as the examining attorney noted, applicant's

website categorizes the product as "DENTAL KONG" and extols the dental-hygiene utilitarian advantages of its product. The advertising boasts that "the patented 'chew-clean' grooves effectively squeegee clean dog's teeth and gums as they chew." This evidence is unambiguous. It touts the utilitarian advantages of the product design. See In re Caterpillar, Inc., 43 USPQ2d at 1340. Here too applicant minimizes the importance of the grooves relative to the overall mark and product design arguing that it touts the advantages of the grooves only, not the overall product. We find these arguments unpersuasive. Applicant argues, contrary to logic, as if the grooves could somehow exist without the body. In fact, applicant's reference to the grooves in its advertising indicates the paramount importance of this feature. As we have indicated, the body of the product is central to the overall product and the grooves are what the center or body of the product is all about. There is no evidence that the grooves could be implemented effectively without a body generally conforming to what is shown in the '444 Patent, the trademark drawing and applicant's product.

Accordingly, we conclude that the advertising evidence indicates that applicant's mark is functional.

Alternative Designs

Next we must consider evidence related to "the availability to competitors of functionally equivalent designs." In this regard applicant argues that "the utility patent can be used with truly an infinite number of differently shaped pet toys." To support this position, applicant has provided copies of four design patents for its therapeutic pet toys, which apparently also incorporate the subject matter claimed in the '444 Patent. Each of the design patents includes the same language in the CLAIM section, "The ornamental design for the pet toy, as shown and described." This is the only claim. The descriptions in turn merely refer to the drawings. The record also includes numerous examples of available pet toys from web-based catalogues.

As we noted, the utility patent indicates that "very few pet toys have been designed with features that are directed to improving a dog's dental health." The utility patent provides only one example of prior art, a ring-shaped device which bears no similarity to applicant's products. As we also noted, the utility patent indicates that the invention would vary in size according to the breed of dog. In fact, applicant's advertising indicates that the product is available in different sizes.

In its reply brief applicant sums up its argument with regard to alternative designs, as follows, “. . . the record is replete with evidence of the availability of alternative designs. . . Indeed, while the evidence of record shows that competitors’ products employ the same basic features of Applicant’s products, all of the products look different from each other, and importantly, different from Applicant’s product configuration. In other words, Applicant’s product configuration is not required for effective competition in the pet toy industry and the protection of that configuration does not hinder competition.”

For purposes of applicant’s argument on this factor we must focus on “functionally equivalent” designs. The many examples of pet toys on the market in the record reflect the statement in the ‘444 Patent that “very few pet toys have been designed with features that are directed to improving a dog’s dental health.” We do not see a single example of a product which is functionally equivalent to applicant’s product from the standpoint of dental hygiene. Accordingly, we find no support for applicant’s position in this evidence.

In fact, the only functionally equivalent designs of record are those reflected in applicant’s own design patents. We also find this evidence unpersuasive. In fact, to the extent that the designs of those products differ from

one another, the differences may provide advantages with respect to use with dogs of a particular breed or size, or indeed the suitability of the particular design for use with dogs of different breeds or sizes. For example, the specific design shown in Fig. 3 of the '444 Patent above and in one of applicant's design patents (Exh. D) employs a tapered grooved body which widens toward the middle and narrows at each end. This design may render the product suitable for use with dogs of different breeds and sizes. In any event, we find applicant's own design patents unpersuasive to establish the availability of functionally equivalent designs.

In fact, none of the many examples from the web catalogues either claim the dental-health advantages associated with applicant's product, nor do any of the many products have a grooved body which is in any way similar to applicant's mark. Of course, the '444 Patent is still in force; this may explain the absence of similar products.

The examples of existing products in the record does indicate that rope elements are extremely common in pet toys. This evidence is not helpful to applicant on the alternative-design factor or otherwise. It is the grooved body or center of applicant's product which is functional. The common use of ropes only reinforces our conclusion that the grooved body or center is the dominant element in

applicant's mark and product design. We reject applicant's argument that such an assessment of this element is out of bounds for purposes of the functionality determination because the examining attorney had accepted applicant's claim of acquired distinctiveness.⁴ It is appropriate and necessary to consider the significance of the rope element for purposes of the functionality determination.

Accordingly, based on all relevant evidence of record we conclude that there are no significant alternative functionally equivalent designs to the product design shown in applicant's mark.

Simpler or Cheaper Method of Manufacture

Applicant has provided an affidavit from its manager and founder stating that alternative pet-toy products with ropes are equally or less costly than applicant's product at issue here. This evidence is offered to establish that applicant's design does not result in a "comparatively simple or cheap method of manufacturing the product." Even if applicant's design is more expensive to manufacture than the ordinary pet toy, the functional advantages of Applicant's product in the area of dental health may very

⁴ While the acceptance of applicant's claim of acquired distinctiveness is not before us in this appeal, we note that the evidence submitted was very limited. Also, caution is in order in concluding that a mark is either nonfunctional or distinctive while the utility patent remains in force. Cf. Eco Mfg. LLC v. Honeywell Intl. Inc., 357 F.3d 649, 69 USPQ2d 1296 (7th Cir. 2003).

well outweigh any increase in cost. See In re American National Can Co., 41 USPQ2d 1841, 1844-45 (TTAB 1997). Therefore, we conclude that this factor is neutral.

Conclusion

Accordingly, based on the totality of the evidence bearing on the Morton-Norwich factors, we conclude that applicant's mark is functional. We conclude so based principally on the '444 Patent, applicant's touting of the functional advantages of the design and the limited availability of functionally equivalent alternatives.⁵

Decision: The refusal to register the mark under Trademark Act Section 2(e)(5) is affirmed.

⁵ In its reply brief applicant argued at length that the examining attorney had failed to make a prima facie showing that applicant's mark is functional. Obviously, we have concluded that the examining attorney not only made a prima facie showing but that applicant has failed to meet its burden in rebutting that showing.