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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Bedford Industries, Inc.**

Serial No. 74/620,872

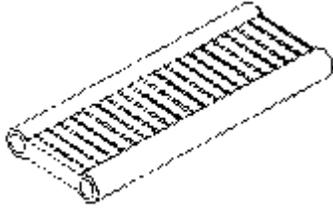
Robert C. Baker of **R. C. Baker & Associates, Ltd.** for
Bedford Industries, Inc.

Odette Bonnet, Trademark Examining Attorney, Law Office 109
(**Deborah S. Cohn**, Managing Attorney)

Before **Simms**, **Hanak** and **Walters**, Administrative Trademark
Judges.

Opinion by **Simms**, Administrative Trademark Judge:

Bedford Industries, Inc. (applicant), a South Dakota
corporation, has appealed from the final refusal to
register the asserted mark shown below



for plastic double wire tie ribbon with or without an adhesive coating on one side.¹ In an amendment to the application, applicant describes its mark as follows:

The mark consists of transverse parallel ridges and valleys on one side of the web of material extending between the thickened embedded-wire edges of the tie ribbon. The outline of the goods depicted in dotted lines in the drawing shows the placement of the mark on the goods and is not claimed as a feature of the mark.

In her brief, the Examining Attorney indicates that there are two issues on appeal:

- I. Whether applicant's proposed mark for a "railroad track" design is *de jure* functional insofar a[s] it assists positive machine feeding;
- II. Whether the mark is *de facto* functional and a nondistinctive configuration of the goods if it is proven not to be *de jure* functional, and whether applicant's proposed mark is inherently distinctive.

¹ Application Ser. No. 74/620,872, filed January 13, 1995, based upon applicant's claim of use in commerce since at least as early as September 1977.

We believe, however, that there is only one issue before us -- whether applicant's asserted mark is inherently distinctive of its tie ribbon. We turn first, therefore, to a discussion of this aspect of the appeal.

In the first Office action, the Examining Attorney refused registration on the grounds of *de jure* functionality. She stated that the asserted mark consists of a design feature which serves a utilitarian purpose. The Examining Attorney also refused registration because the proposed mark was not inherently distinctive. In the next Office action, the Examining Attorney requested that applicant provide information concerning whether its asserted mark is the subject of a patent and whether alternative designs are available. In the third (Final) Office action, the Examining Attorney stated:

The attorney agrees that the proposed mark does not appear to be *de jure* functional. However, it is clearly *de facto* functional, as pointed out by applicant. Since it is *de facto* functional, the issue of acquired distinctiveness arises, if the mark is not inherently distinctive.

See Final Office action mailed September 5, 1996. After applicant submitted a request for reconsideration, the Examining Attorney then stated, among other things:

...At any rate, the issue here is not one of descriptiveness but whether the

proposed mark is functional and whether it is a nondistinctive configuration of the goods. As previously shown, the answer must be that the mark is *de facto* functional and is a non-distinctive configuration of the goods.

Thereafter, applicant in its appeal brief stated that the "sole issue is inherent distinctiveness." (Emphasis in original) In her appeal brief, however, the Examining Attorney discussed both the issue of *de jure* functionality as well as the issue of inherent distinctiveness. In its reply brief, applicant objected to the Examining Attorney again raising the issue of *de jure* functionality. We agree with applicant that the issue of *de jure* functionality must be considered withdrawn.

It seems to us that some of the confusion surrounding this case has resulted from the Examining Attorney's apparently confusing the concepts of *de jure* functionality and *de facto* functionality, and, contrary to normal usage, using the term "functionality" alone to refer to *de facto* functionality rather than *de jure* functionality. The difference between these concepts is discussed in a number of cases including the seminal case of *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 USPQ 9 (CCPA 1982). Suffice it to say that any product or product container that has utility may be considered to have a *de facto*

function. The container in *Morton-Norwich*, for example, was *de facto* functional because it performed the function of holding applicant's liquid product. Possessing a *de facto* function or having *de facto* functionality, however, is not a ground of refusal. Almost any product or container can be said to be *de facto* functional because it possesses some utility. However, the question is always the degree of utility possessed by the asserted mark, not the mere possession of utility, and the statute and case law only bars registration of asserted marks which are *de jure* functional, that is, products, product containers and trade dress which are so superior in design that they are essential to effective competition.

In her brief, the Examining Attorney indicated that applicant has admitted that its mark is "functional." The "admission" by applicant, however, was that its asserted mark is *de facto* functional, that is, that it possesses some function. Further evidence of the Examining Attorney's confusing these terms is her reference to factors of *de jure* functionality in that part of her brief discussing the asserted mark's lack of inherent distinctiveness. For example, the Examining Attorney indicated, page 6 of her brief, that applicant's configuration is not inherently distinctive "because the

railroad track design is in great part dictated by the functionality aspect of the product...". She also discussed available alternative designs and other considerations that usually apply to determining whether an asserted mark is *de jure* functional. The Examining Attorney concluded:

Therefore, since the applicant has failed to introduce any evidence of acquired distinctiveness, registration should also be refused on the ground that the mark is *de facto* functional.

Suffice it to say that the Examining Attorney's assertion in the final refusal that applicant's asserted mark "does not appear to be *de jure* functional" is considered a withdrawal of this refusal, and that it would be unfair to applicant to now interject this issue in this case.²

With respect to the refusal based on the lack of inherent distinctiveness, the Examining Attorney argues that, unless the design is of such nature that its

² Although the issue of *de jure* functionality is not before us, there is some evidence tending to support a *de jure* functionality refusal. Applicant submitted two declarations by Lloyd Tinklenberg, its director of product development. In the first of his two declarations, Mr. Tinklenberg stated that it is "possible" that applicant's tie ribbon having the transverse parallel ridges and valleys "may provide some degree of anti-slip for the gripping of the tie ribbon as it is moved through application machinery in packaging operations at the industrial user level," although counsel maintains that the smooth tie ribbons work satisfactorily. (Applicant also argues that this feature is not important to the ultimate consumer of the products employing its tie ribbons.) Exhibit No. 4 of applicant's record also contains the following statement: "Exclusive Bedford railroad track design assists positive machine feed." Applicant

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distinctiveness is obvious, evidence must be submitted to prove that the relevant purchasers recognize the design as a trademark identifying the source of the goods (secondary meaning). The Examining Attorney relies, to a significant degree, upon *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 196 USPQ 289 (CCPA 1987). In determining whether a design is inherently distinctive, that Court stated, at 291, that in the past the Court:

...has looked to whether it was a "common" basic shape or design, whether it was unique or unusual in a particular field, [or] whether it was a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods...

The Federal Circuit more recently summarized the test for determining inherent distinctiveness:

Thus, the focus of the inquiry is whether or not the trade dress is of such a design that a buyer will immediately rely on it to differentiate the product from those of competing manufacturers; if so, it is inherently distinctive.

Tone Brothers Inc. v. Sysco Corp., 28 F.3d 1192, 31 USPQ2d 1321, 1331 (1994). It is the Examining Attorney's position in this case that the railroad track design of applicant's

has taken the position that there are alternative designs which perform this function just as well.

tie ribbon is not so unique, unusual or unexpected that it would immediately be perceived by customers as a trademark for tie ribbon emanating from applicant.

Applicant, on the other hand, argues that its asserted mark immediately functioned as a source identifier upon first use because all of its other double wire tie ribbons have a plain, smooth surface between the embedded edge wires, rather than the so-called railroad track design. Applicant argues that this railroad track design would immediately distinguish these from other tie ribbons. Applicant maintains that no one else has ever used a railroad track design on its tie ribbons and that it is not a mere refinement of the commonly adopted plain or smooth form of ornamentation of a double wire tie ribbon. Accordingly, applicant argues that the evidence points to the uniqueness of applicant's uncommon railroad track design on its double wire tie ribbon.

This record is relatively limited, and includes examples of applicant's tie ribbons as well as two declarations submitted by applicant. It is clear from this record that applicant and others sell substantially identical double wire tie ribbons without any transverse parallel ridges and valleys or so-called railroad track designs. For example, the first Tinklenberg declaration

indicates that at least one U.S. maker of soda cracker "slugs" or "tubes" uses plastic double wire tie ribbons supplied by applicant without any parallel ridges and valleys. Mr. Tinklenberg also indicates that there are others who manufacture double wire tie ribbons having a smooth surface between the edge wires. He also indicates that applicant makes double wire tie ribbons with a smooth surface between the lateral wires with widths both narrower and wider than the width of the double wire tie ribbon having the railroad track configuration. Mr. Tinklenberg declares that the appearance of its double wire tie ribbon "appears to be quite distinctive and unique to Bedford." First declaration, 5. In his second declaration, he again indicates that competitors have put out "smooth panels between the wires embedded at the edges." He also states:

b) Bedford sells the No. 17 ribbon of Exhibit 1 (having the mark of this application), and the mark of No. 18 of Exhibit 1 (not having the mark of this application, but otherwise extremely similar to No. 17) for the same price per quantity and for the same purposes.

Elsewhere, in discussing possible alternative designs, he indicates that a diamond design on tie ribbons has been produced by applicant.

After careful consideration of this record, we agree with the Examining Attorney that the asserted mark before

us is very similar to other double wire tie ribbons produced by applicant and by others. As noted, applicant's own director of product development admits in his second declaration that applicant's tie ribbon without the "mark" is "otherwise extremely similar" to the tie ribbon with the "mark." For applicant's asserted mark to be registrable on the Principal Register without resort to Section 2(f), the asserted mark would have to be immediately recognizable as a distinctive way of identifying the source of applicant's goods. See *Seabrook Foods*, supra, *Tone Brothers*, supra, and *In re Hudson News*, 39 USPQ2d 1915 (TTAB 1996).

Here, we have no evidence from others in the trade, such as purchasers or buying agents of manufacturers, that, from the beginning, they perceived the railroad track design as a distinctive source indicator. In other words, there is no evidence, other than applicant's statement in the declaration that its design "appears to be quite distinctive," that this design on tie ribbon is immediately recognizable as denoting origin. There is also no evidence that the asserted mark has been promoted in advertisements as being distinctive.³ Given the fact that applicant and others sell tie ribbons with a plain or smooth surface

³ We do not regard the statement in relatively small print on page 2 of applicant's brochure (Exhibit 4) that its railroad

between the double encased wires, and that the relevant public has been exposed to at least one other design on tie ribbons of this nature (a diamond design), we believe that this railroad track design, if it is noticed at all,⁴ would be perceived as nothing more than slightly different ornamentation. This slight difference in appearance does not, in our view, automatically transform this design to an inherently distinctive trademark registrable on the Principal Register. Finally, the fact that applicant is apparently the only one that has used this railroad track design on tie ribbon is also not persuasive of a contrary result. See *Hudson News*, at 1924.

In sum, we fail to see how the so-called railroad track design of applicant's double wire tie ribbon would be immediately recognized by potential purchasers of applicant's goods (even relatively sophisticated purchasers) to differentiate the source of that product from the source of other very similar tie ribbons. It appears to us that the asserted mark is a relatively minor refinement or variation, somewhat ornamental in nature,

track design assists in positive machine feed, quoted in footnote 2 above, as promotion as a distinctive mark.

⁴ In this regard, we note that the railroad track design is more noticeable on some tie ribbons than it is on others. On some of the tie ribbons, the design is not readily visible unless held up to the light.

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which would not ordinarily be perceived as a trademark. See, for example, *Goodyear Tire & Rubber Co. v. Vogue Tyre & Rubber Co.*, 47 USPQ2d 1748 (TTAB 1998)(gold annular stripe on tires not inherently distinctive); *In re Chung, Jeanne & Kim Co., Inc.*, 226 USPQ 938 (TTAB 1985)(stripes on shoes not inherently distinctive); *In re Keyes Fibre Co.*, 217 USPQ 730 (TTAB 1983)(T-shaped openings in beverage carrier sockets of molded carrying trays not inherently distinctive); and *In re Kwik Lok Corp.*, 217 USPQ 1245 (TTAB 1983)(perimeter and slot-shaped opening of plastic bag closures not inherently distinctive).

Decision: The refusal of registration is affirmed.

R. L. Simms

E. W. Hanak

C. E. Walters
Administrative Trademark
Judges, Trademark Trial and
Appeal Board

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