

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE
TTAB

9/18/98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re James V. Young

Serial No. 74/679,615

Lionel L. Lucchesi of Polster, Lieder, Woodruff & Lucchesi
for applicant.

Charles L. Jenkins, Jr., Trademark Examining Attorney, Law
Office 105 (Thomas G. Howell, Managing Attorney).

Before Hanak, Hohein and Walters, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

James V. Young has filed a trademark application to
register the mark shown below for a "hand-held massage
apparatus."¹

¹ Serial No. 74/679,615, in International Class 10, filed May 24, 1995,
based on an allegation of use of the mark in commerce, alleging first
use and first use in commerce as of May, 1994. The application
includes the statement that "the lining shown in the mark is used to
indicate the 3-dimensional character of the mark and is not a feature
of the mark."

Applicant submitted the following description of its mark:

The mark consists of a configuration of a hand-held massager with a generally circular head and a handle possessing a keyhole grip, the top and bottom of which grip duplicate the waveform of the handle shaft.

The Trademark Examining Attorney has finally refused registration under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. 1051, 1052 and 1127, on the alternative grounds that (1) applicant's applied-for mark is *de jure* functional, or (2) if it is not, that, in any event, it is not inherently distinctive. Additionally, the Examining Attorney has issued a final requirement that applicant amend its description of the mark to accurately describe the applied-for mark as shown in the drawing of record.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register on

the ground that the applied-for mark is *de jure* functional; and that the applied-for mark is not inherently distinctive. Further, we affirm the requirement that applicant amend its description of the applied-for mark to accurately describe the mark as shown in the drawing of record.

Description of the Applied-for Mark

Applicant submitted with its application, as originally filed, a drawing depicting the configuration of its hand-held massager wholly in solid lines and including the statement "the mark consists of the configuration of an applicator for hand-held massage." The Examining Attorney required a "clear and concise description of the mark." Additionally, the Examining Attorney sought clarification as to which features of the configuration shown in the drawing comprised the mark, noting that those features claimed as the mark should appear in the drawing in solid lines and the remainder of the configuration should appear in the drawing in broken or dotted lines to show the context/placement of the claimed features of the configuration.

Following the Examining Attorney's final refusal on the substantive grounds asserted herein, applicant submitted an amended drawing, which is the drawing of

record before us in this appeal, depicting the entire configuration in dotted lines except the "keyhole grip" and the "waveform" of the handle shaft. While applicant had amended its description of the mark in a previously-filed response, applicant also submitted a further amendment to the description of the mark, which is the description previously quoted herein.

The Examining Attorney reinstated the requirement for a clear description of the mark depicted in the drawing of record, objecting to the amended description of the mark on the ground that, as stated, applicant is describing the entire configuration of the goods. The Examining Attorney argues that the applied-for mark represented in the drawing of record is limited to the "keyhole grip" and the "waveform" of the handle shaft, as only these features are represented in the drawing in solid lines. Applicant argues that the description of record is accurate because "applicant's mark consists of the overall configuration of its massager."

Section 1 of the Trademark Act, 15 U.S.C. 1051, requires the submission with an application of a drawing of the mark. Trademark Rule 2.51, 37 CFR 2.51, sets forth the mandatory requirement for a drawing. Subsection (d) of that rule provides as follows:

Broken lines should be used in the drawing of a mark to show placement of the mark on the goods, or on the packaging, or to show matter not claimed as part of the mark, or both, as appropriate.

Trademark Rule 2.35, 37 CFR 2.35, permits applicant to submit a description of a mark *that must be acceptable to the Examining Attorney*. Rule 2.35 also permits the Examining Attorney to require a description of the mark. In this regard, Sections 808.02 and 808.03 of the *Trademark Manual of Examining Procedure* state the following:

If a description of a mark is placed in the record, its form must be satisfactory to the examining attorney. To be satisfactory, the description should state accurately what the mark comprises, and should not create a misleading impression by either positive statement or omission of facts.

. . .
The examining attorney should require a description of the mark where the mark is three-dimensional, where the mark is a configuration of the goods or packaging, where the drawing includes dotted lines to indicate a portion of the product or packaging which is not part of the mark, and in similar cases. ... If applicable, the description statement must clearly indicate the portion of the product or container that the mark comprises and what the dotted lines on the drawing represent.

There is no question, and applicant does not contest, that the drawing of record in this application is the amended drawing of the configuration of applicant's product showing in solid lines only the keyhole grip and waveform of the handle shaft. Thus, the applied-for mark consists

only of the configuration of the keyhole grip and waveform of the handle shaft as these features appear on applicant's massager. However, it is equally clear that the description of record describes the mark as the entire configuration of the goods, which is not how the mark appears in the drawing of record. We find, on these facts, that the description submitted by applicant does not accurately describe the mark depicted in the drawing; and that the Examining Attorney properly required applicant to amend its description to accurately describe the mark as shown in the drawing of record.

De Jure Functionality

We turn to the issue of whether applicant's applied-for mark is *de jure* functional.² As the Board stated in *In re Peters*, 6 USPQ2d 1390, 1391 (TTAB 1988), "[a] design configuration is considered to be unregistrable when it has been determined to be *de jure*, as opposed to *de facto*, functional. An item which is *de facto* functional may be registrable, while one which is *de jure* functional may never be registered even if it has been shown to possess

² Both applicant's and the Examining Attorney's arguments pertaining to *de jure* functionality and inherent distinctiveness pertain to the entire configuration of the goods rather than to the features of the goods claimed as the mark in this application, as discussed herein. We have limited our consideration to only those elements of the configuration claimed as the mark in this application and have considered applicant's and the Examining attorney's arguments in this regard.

some recognition in the trade." For the design in question to be *de jure* functional, it must be shown not just that the claimed elements of the configuration of the goods are functional, but also that the performance of that function is enhanced by the particular configuration in which the design is executed. *In re R.M. Smith*, 734 F.2d 1482, 222 USPQ 1 (Fed. Cir. 1984). A configuration which is so utilitarian as to constitute a superior design for its purpose, so that competitors need to copy it in order to compete effectively, is *de jure* functional, and unregistrable. *In re Lincoln Diagnostics Inc.*, 30 USPQ2d 1817 (TTAB 1994). As set out in *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 USPQ 9 (CCPA 1982), there are a number of factors which are useful in determining whether particular product designs are superior, including:

- (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.

There is no evidence in this case with respect to the fourth factor. As regards the first factor, whether utility patents exist which disclose the utilitarian advantages of the design, applicant is the owner of a design patent,³ rather than a utility patent, for the entire configuration of the goods. The design patent claims "the ornamental design for a cordless, hand-held massager, as shown and described." The drawing includes several perspectives, including one perspective identical to the drawing of the configuration, although the design patent drawing depicts the configuration in solid lines.

While there is no specific reference in the description of the design to the "keyhole grip" or the "waveform of the handle shaft," these elements are encompassed in the description of the configuration in its entirety. We note that the existence of a design patent, while some evidence of non-functionality, is not alone sufficient evidence to overcome a finding of *de jure* functionality. See, *In re R.M. Smith, Inc.*, 219 USPQ 629 (TTAB 1983), *aff'd*, 734 F.2d 1482, 222 USPQ 1 (Fed. Cir. 1984). See also, *In re Vico Products Mfg. Co.*, 229 USPQ 364 (TTAB 1985) [the fact that a product shape is the subject of a design patent does not, without more, prove

³ Design Patent No. 367,712, issued March 5, 1996.

Serial No. 74/679,615

that the shape is non-utilitarian and serves as a trademark]. In this case, the evidence of applicant's design patent is clearly outweighed by the other evidence of record showing the great degree of utility embodied in the particular elements of the configuration asserted as the mark.

With respect to the second factor, whether applicant's advertising materials tout the utilitarian advantages of the relevant elements of the configuration, applicant's promotional brochure contains photographs, shown below, demonstrating the different ways to hold the massager and identifying as "hand grips" the particular elements of the massager that comprise the applied-for mark.

Applicant's brochure goes on to tout this aspect of its massager, stating "[l]ocate desired applicator section and apply to body ... [m]ultiple grip handle will facilitate convenient application."

It is clear from the foregoing that the "keyhole grip" and the "waveform of the handle shaft," the elements claimed as the mark herein, function as "hand grips"; and that applicant's promotional materials tout the utilitarian advantages of these features comprising the applied-for mark.

Regarding the third evidentiary factor, the availability to competitors of alternative designs, both applicant and the Examining Attorney have submitted copies of third-party registrations and advertisements for numerous hand-held massagers. Applicant argues that this evidence demonstrates that there are "multitudinous alternative designs for hand-held massagers [and that] each has a different overall configuration and a different handle with a different surface to allow a firm grasp"; and that, therefore, competitors can compete effectively without using applicant's design.

The overall configurations of the third-party hand held massagers pictured in the record are various in shape, although certain common characteristics exist. However,

Serial No. 74/679,615

only the hand grips of these massagers are of relevance to us in this case. Like applicant's massager, several of the pictured third-party hand-held massagers have handles, either straight, like applicant's handle, or curved. Several of these handles, shown below, contain lines or "waves" which appear to function to assist the user's fingers to firmly grasp the device.

Thus, it would appear that hand grips, especially hand grips with indentations enabling fingers to firmly grasp the handle, are an important feature of some hand-held massagers. While none of the third-party massager's finger grips is identical to those of applicant, none is sufficiently different so as to constitute an alternative design. Thus, we find that this evidence supports the conclusion that the alternative designs of hand grips on the hand-held massagers made of record are all merely variations of a single basic design, that is, indentations for fingers to firmly grasp the massager's handle. Given the utilitarian advantages of the hand grip elements of applicant's configuration (as touted by applicant in its promotional materials), this design for hand grips is one of a very few superior designs for its functional purpose. Thus, a registration granted to applicant would seriously interfere with the right to compete. *In re Morton-Norwich, supra.*

In summary, we find that the hand grips of applicant's hand-held massager are in the configuration sought to be registered herein because such configuration is one of the best designs to perform the desired function. Analysis of the *Morton-Norwich* factors shows that the configuration is de jure functional. Although there are points in

applicant's favor (the design patent and the fact that not all third-party hand-held massagers utilize hand grips with finger indentations), they are not persuasive of a contrary finding. Accordingly, we find that the configuration sought to be registered is *de jure* functional.

Inherent Distinctiveness

Although we have found that the matter sought to be registered by applicant is *de jure* functional, we nonetheless now consider the issue of whether applicant's configuration is inherently distinctive in the event that applicant's applied-for mark is ultimately found not to be *de jure* functional.⁴ It is well-established that designs that are inherently distinctive are registrable without proof of secondary meaning, whereas those that do not possess inherent distinctiveness, and are not *de jure* functional, can acquire distinctiveness as registrable trademarks. *Wiley v. American Greetings Corp.*, 26 USPQ2d 101 (1st Cir. 1985). An inherently distinctive mark is one which is "by its very nature distinctive or unique enough to create a commercial impression as an indication of origin . . ." *In re Raytheon Co.*, 202 USPQ 317 (TTAB 1979). While a design may, in fact, be unique, i.e., it

⁴ A finding that the applied-for mark is distinctive, either inherently or otherwise, will not obviate a finding of *de jure* functionality.

may be the only such design being used by anyone, to be registrable as a trademark, it also must possess an "original, distinctive and peculiar appearance." *In re McIlhenny Co.*, 278 F.2d 953, 126 USPQ 138, 140 (CCPA 1960), quoting with approval from *Ex parte Haig & Haig, Ltd.*, 18 USPQ 229, 230 (Asst. Commr. 1958). The fact that other similar products use or incorporate designs that differ in only insignificant respects leads to the conclusion that such designs lack inherent distinctiveness. *See, In re E. S. Robbins Corp.*, 30 USPQ2d 1540 (TTAB 1992).

In view of the functional characteristics of applicant's configuration of its hand grips on its hand-held massager, and in consideration of the configurations of other hand grips for hand-held massagers of record, as discussed herein, there does not appear to be anything inherently distinctive or "unique enough" about applicant's configuration to warrant the conclusion that the applied-for mark would create a commercial impression as a source indicator. As discussed in connection with the question of *de jure* functionality, applicant's promotional materials establish that the "keyhole grip" and "waveform of the handle shaft," which are the elements of its hand-held massager asserted as the mark herein, function as the "hand grips" by which the user holds and applies the massager.

Serial No. 74/679,615

It would appear from the evidence herein that these elements of the configuration serve no other purpose other than as hand grips; and that the "waveform" of these elements function to provide a firm "grip" for the fingers while the apparatus is operating. As such, these features do not contribute any unique quality to the applied-for mark so that it can be considered inherently distinctive.

Decision: The refusal is affirmed on the grounds that the applied-for mark is *de jure* functional and, alternatively, that it is not inherently distinctive; and the final requirement for a clear and accurate description of the mark as shown in the drawing of record is affirmed.

E. W. Hanak

G. D. Hohein

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