

Oral Hearing:
February 12, 1998

Paper No. 17
GDH/gdh

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB MARCH 5, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Nellcor Puritan Bennett Incorporated**

Serial No. 74/418,140

Raymond A. Kurz of **Rothwell, Figg, Ernst & Kurz, P.C.** for **Nellcor Puritan Bennett Incorporated**.

Ira J. Goodsaid, Trademark Examining Attorney, Law Office 105
(**Thomas G. Howell**, Managing Attorney).

Before **Simms**, **Hohein** and **Hairston**, Administrative Trademark Judges.

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

Nellcor Puritan Bennett Incorporated, by assignment from **Nellcor Incorporated**, is the owner of an application to register the design, reproduced below,

as a trademark for "medical instruments, namely[,] pulse oximeters".¹ Such design, which is referred to by applicant as the "knob configuration" and the "Nellcor knob," is described by applicant as follows:

The mark consists of a configuration of a light colored circular control knob mounted substantially flush to a control panel, with a circular indentation on the outer perimeter, the diameter of the indentation being one fourth to one third the diameter of the knob.

Although applicant asserts that the design is registrable on the Principal Register as inherently distinctive, in the alternative it seeks registration thereof on the basis of a claim of acquired distinctiveness pursuant to the provisions of Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f).

Registration has been finally refused under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127, on the ground that the knob design sought to be registered is *de jure* functional and thus is unregistrable, irrespective of any assertion of inherent distinctiveness or claim of acquired distinctiveness.² Alternatively, on the basis of the same statutory provisions, registration has been finally refused on the ground that, even if applicant's knob design is only *de facto*, rather than *de jure*, functional, it is not inherently

¹ Ser. No. 74/418,140, filed on July 29, 1993, which alleges dates of first use of August 15, 1983 and states that "the stippling in the drawing is for shading purposes only."

² It is well settled, of course, that "[e]vidence of distinctiveness is of no avail to counter a *de jure* functionality rejection". In re R.M. Smith, Inc., 734 F.2d 1482, 222 USPQ 1, 3 (Fed. Cir. 1984).

distinctive and has not acquired distinctiveness so as to serve as an indication of origin for the goods.³

Applicant has appealed. Briefs have been filed⁴ and an oral hearing was held. We reverse the *de jure* functionality refusal, but affirm the refusal that applicant's *de facto* functional knob design is not inherently distinctive and has not been shown to have acquired distinctiveness.

Turning first to the issue of *de jure* functionality, the Supreme Court, in its most recent pronouncement on such

³ Although, under the same sections of the Trademark Act, registration has also been finally refused on the basis that, because it is used as a control knob for applicant's pulse oximeters, the design "fails to function as a mark," such a refusal in this case is, in essence, simply another way of stating that the design is neither inherently distinctive nor has it acquired distinctiveness so as to function as a mark for the goods. We have accordingly considered the arguments pertaining to whether applicant's design functions as a mark as bearing on the issues of whether the design is either inherently distinctive or has acquired distinctiveness.

⁴ The Examining Attorney, in his brief, has objected to consideration of the seven exhibits attached to applicant's initial brief, arguing that six of the exhibits "appear to be reproductions of material previously submitted, but with less clarity than the originals," while the seventh exhibit, which is a declaration from applicant's "Director of Marketing--Monitoring Systems," Scott Christensen, should not be considered since it is "untimely filed, undated, and may not even be sworn to by a corporate officer" The exhibits other than the declaration, however, are merely copies (in the case of exhibits 1, 2, 3, 4 and 6) of materials which were previously made of record or an updated copy (in the case of exhibit 5) thereof. As such, those exhibits are simply duplicative and need not be stricken. However, as to the declaration, which applicant submitted in support of its alternative claim of acquired distinctiveness, the Examining Attorney is correct that such exhibit is untimely under Trademark Rule 2.142(d), which provides that evidence submitted after an appeal has been filed will ordinarily not be considered by the Board. Applicant, in its reply brief, has offered no reason why it failed to furnish the declaration prior to filing the appeal. Accordingly, while the declaration will not be considered further, we note in any event that even if such evidence had been timely submitted, it would make no difference in the outcome of this appeal inasmuch as it is basically duplicative of most of the other evidence which applicant properly made of record prior to commencement of this appeal.

doctrine, pointed out in *Qualitex Co. v. Jacobsen Products Co. Inc.*, 514 U.S. 159, 34 USPQ2d 1161, 1163-64 (1995), that:

The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature. If a product's functional features could be used as trademarks, however, a monopoly over such features could be obtained and could be extended forever (because trademarks may be renewed in perpetuity). See *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 119-120[, 39 USPQ 296, 300] (1938) ...; *Inwood Laboratories, Inc. [v. Ives Laboratories, Inc.]*, [456 U.S. 844 (1982)] ... at 863[, 214 USPQ 1 at 9] This Court consequently has explained that, "[i]n general terms, a product feature is functional," and cannot serve as a trademark, "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. *Inwood Laboratories, Inc.*, 456 U.S., at 850, n. 10[, 214 USQP, at 4, n. 10].

In line therewith, it has long been settled law that, as stated, for example, in *In re Bose Corp.*, 215 USPQ 1124, 1126 (TTAB 1982), *aff'd*, 772 F.2d 186, 227 USPQ 1 (Fed. Cir. 1985):

A shape or configuration of an article which is in its concept essentially or primarily utilitarian or functional cannot function as a trademark under the Federal trademark statute, and cannot be registered either on the Principal or Supplemental Register. *In re Deister Concentrator Co.*, [Inc., 289 F.2d 496,] 129 USPQ 314 (CCPA 1961); *Best Lock Corp. v. Schlage Lock Co.*, [413 F.2d 1195,] 162 USPQ 552 (CCPA 1969); *In re Honeywell, Inc.*, 187 USPQ 576 (TTAB 1975), *aff'd*, [532 F.2d 180,] 189 USPQ 343 (CCPA 1976); *In re Water Gremlin Co.*, [635 F.2d 841,] 208 USPQ 89 (CCPA 1980); *In re Lighting Systems, Inc.*, 212 USPQ 313 (TTAB 1981); [and] *In re Teledyne Industries, Inc.*, 212 USPQ 299 (TTAB 1981). This rule applies

irrespective of whether [an] applicant may have established a de facto secondary meaning in the configuration of its goods due to ... extensive advertising and promotion of the configuration over a period of time. In re Water Gremlin Co., supra, at [9]0-91. Accordingly, the threshold issue ... is whether the configuration ... sought to be registered here is or is not dictated primarily by functional or utilitarian considerations.

In determining whether a design is *de jure* functional, the court in the leading case of In re Morton-Norwich Products, Inc., 671 F.2d 1332, 213 USPQ 9, 15-16 (CCPA 1982), outlined four general factors to be considered when evidence thereof is of record. Such factors are: (1) the existence of a utility patent which discloses the utilitarian advantages of the design sought to be registered; (2) advertising by the originator of the design which touts the utilitarian advantages thereof; (3) facts showing that alternative designs are available to competitors; and (4) facts indicating that the design results from a comparatively simple or cheap method of manufacturing the article.

Applicant, in its main brief, properly observes that the first of such factors is not applicable inasmuch as applicant "has no utility or design patents on its knob configuration which would disclose the utilitarian advantages of the design to be registered."⁵ Applicant also correctly insists in such brief

⁵ We note, in this regard, that it is well settled that the existence of one or more utility patents which disclose the superior utilitarian advantages of a design generally is adequate, and frequently is conclusive or incontrovertible, evidence of the de jure functionality of a configuration. See, e.g., Best Lock Corp. v. Schlage Lock Co., supra at 556; and In re Shenango Ceramics, Inc., 362 F.2d 287, 150 USPQ 115, 119 (CCPA 1966). By contrast, the existence of a design patent for the design in issue, "at least presumptively, indicates

that the second *Morton-Norwich* factor does not pertain to this case since it "has never touted any utilitarian advantage of its knob through its advertising."⁶ While, as to the fourth *Morton-Norwich* factor, applicant urges in its main brief that its knob design "does not result in a comparatively simpler or cheaper method of manufacture" since "the Nellcor knob's molded indentation makes the knob more costly to produce," there is simply no evidence properly of record which bears upon such factor.

Determinative, therefore, of the issue of *de jure* functionality in this case is the evidence pertaining to the third *Morton-Norwich* factor, namely, whether viable alternative designs exist. Applicant, in its main brief, argues that the record reveals that its competitors "utilize many [different] configurations of knobs for their pulse oximetry sensors," as shown by the competitive products depicted in its March 1995 brochure captioned "IF THE BEST PULSE OXIMETRY SENSORS WORK HERE . . .," and that "[s]uch illustrations provide clear evidence that alternative knob designs are available to competitors."⁷ In view

that the design is not *de jure* functional." In re *Morton-Norwich Products, Inc.*, supra at 17 n. 3.

⁶ While the record shows that applicant's knob design is utilized for making various adjustments to its pulse oximeters, such as setting the audible beep volume for each pulse detected and changing alarm limits and volume, nothing indicates that applicant's particular design is promoted as providing an easier or otherwise more advantageous way of making necessary adjustments to its goods.

⁷ Applicant, in fact, contends in its main brief that "the Nellcor knob is functionally inferior," asserting that:

It is counter-intuitive for a user to stick a finger into an indentation in order to turn a knob. Precise

thereof, applicant maintains that its design "neither prevents competitors from manufacturing alternative designs, nor hinders competition as shown by competitors' designs." Applicant consequently contends that because the same functions can be performed by a variety of other shapes or designs for control knobs, "the Nellcor knob is not *de jure* functional."

The Examining Attorney, on the other hand, is of the view that applicant's design is a superior one. In particular, and while we note that a contrasting color scheme is not part of the description of applicant's design and is not featured on at least one model of applicant's goods, the Examining Attorney points out that:

Having the light-colored knob mounted
substantially flush to a dark-colored control

adjustments using a single finger are difficult particularly when the user's finger tires.

Differing finger sizes may also affect the Nellcor knob's functionality. A user with a much larger or smaller than normal finger will either not be able to fit his finger into the indentation, or will find it more difficult to turn the knob as there is too much space within the indentation. Finally, users with long nails may have trouble sticking their fingers into the indentation. Moreover, their long fingernails may make it generally difficult for them to turn the knob.

A traditional "non-flush" design, which allows the user to turn the knob by holding the outside surface of the cylinder, is easier to use, allows for precise adjustments of the knob at all times, and is not affected by the user's finger size or fingernail length. As demonstrated by the brochure showing the competitive products ..., a non-flush design is the logical choice. It is functionally superior, and therefore preferred.

Applicant's assertions of functional inferiority for its design, however, are just not credible. Absolutely nothing in the record supports applicant's contentions and it defies belief that applicant would deliberately make a control for setting critical adjustments on its pulse oximeters more difficult or counter-intuitive to use than those featured on competitive medical devices.

panel provides several functional advantages: (1) the contrast of light knob against dark panel makes the knob easy to see; (2) the knob is less likely to be accidentally bumped because it is substantially flush with the control panel; (3) flush mounting the knob makes the unit more space efficient; and (4) flush mounting keeps the knob more free of dirt and dust. Because of the knob's substantially flush mounting, the finger hole is also highly functional: (1) it allows the knob to be adjusted without having to simultaneously push and twist it (a difficult maneuver requiring significant dexterity); and (2) the finger hole provides a visual cue of the knob's setting.

We are constrained to agree with applicant that, on this limited record, its knob design--while undoubtedly *de facto* functional in that it is used to make adjustments to various settings for its pulse oximeters--cannot be said to be *de jure* functional. Although, curiously, applicant offered nothing in its reply brief to counter or otherwise put to rest the Examining Attorney's observations, it appears from applicant's advertising and other literature of record that the control knob designs of competitors' pulse oximeters are just as easy to see, are not significantly more prone to accidental bumping,⁸ are just as space efficient and are not noticeably more prone to accumulations of dirt and dust. In short, there is nothing in the record which demonstrates that competitors will be unable to compete effectively in the marketplace for pulse oximeters if

⁸ Accidental touching of applicant's control knob design, we note, would affect only the beep volume of each detected pulse; it would not affect the settings of alarm volume and alarm limits since another button or buttons must be pushed while turning the knob in order to change such settings.

they are unable to utilize applicant's design as a control knob for their goods.

Turning, then, to the issues of distinctiveness, applicant argues that its knob design is inherently distinctive or, in the alternative, that it has acquired distinctiveness. As to the former, applicant maintains in each of its briefs that its design is unique in that it sells its goods in a niche market in which "[n]o other third party marks exist that are similar" In particular, referring to an illustration, reproduced below,

of certain of its competitors' products (together with two models of its own goods) in its previously noted "IF THE BEST PULSE OXIMETRY SENSORS WORK HERE ..." brochure, applicant contends in its main brief that:

First, the Diascope knob [which is shown third from the top on the right hand side] is set over the edge of the oximeter on which it is placed. The knob is not flush with the face of the monitor and is apparently operated by running one's finger along the edge of the knob that extends past the face of the monitor. Also, ... the Diascope knob is not light in color and does not contain any circular indentation much less an indentation which is one-fourth to one-third of the diameter of the knob.

Second, the monitor above the Diascope model features a protruding knob which the oximeter operator grasps and rotates (as opposed to an indentation into which the operator would insert a finger to achieve rotation). This oximeter utilizes a design that is directly antithetical to the Applicant's knob-design which is substantially flush to the control panel.

Third, the model directly below the Diascope oximeter employs a small knob that, unlike Applicant's design[,] is not prominent on the face of the monitor either with respect to its color, or to its size[,] in relation to the overall size of the oximeter on which it sits, thus failing to be recognizable as a distinguishing mark on the oximeter. Applicant's mark, in contrast, is proportionally much larger than the cited knob. Furthermore, unlike the cited knob, Applicant's knob is featured in its identifiable light cover.

As for the Schiller model [which is shown second from the left in the "fifth" row from the top and which is] purported by the Examining Attorney to carry a knob configuration identical to Applicant's, an even cursory examination reveals that the knob on the Schiller model ... is raised beyond the surface of the monitor's face and is not substantially flush to the control

panel. Although the knob appears to have a small indentation on its surface, the knob apparently can be manipulated by grasping the edges of the knob in one's fingers. Additionally, the knob displayed on the Schiller model is not featured in the "identifiable light color" of Applicant's knob. Moreover, the Schiller knob lacks the prominence of the overall design of the Applicant's knob.

We concur with the Examining Attorney, however, that applicant's control knob design is not inherently distinctive. Under the test for inherent distinctiveness set forth in the leading case of *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 196 USPQ 289, 291 (CCPA 1977), such design is nothing more than a mere refinement of a common or basic design for control knobs and therefore would not be immediately perceived as a source indicator. The Examining Attorney, as stated in his December 11, 1995 Office action, has made of record in this regard various photographs, which were "taken at a couple of local electronics stores," of a television set, a control device and stereo equipment featuring, in each instance, "a round knob with a small round indentation on the perimeter." This evidence is sufficient to show, as maintained by the Examining Attorney, that such a design "is a common knob design for electronic goods in general." Moreover, not only are pulse oximeters, generally speaking, electronic goods, but one of applicant's competitors, Schiller, utilizes in particular a control knob for its pulse oximetry units which, when viewed straight on, is essentially identical in appearance (including a lighter-colored tone or shade than the background against which it is placed) to applicant's control knob design.

While, admittedly, the Schiller knob configuration, unlike applicant's design, does not appear to be mounted substantially flush to the control panel and, thus, applicant's design would seem to be unique or novel to a limited extent, the fact that applicant's design in such respect is the one and only of its kind does not mean that it necessarily is inherently distinctive. See, e.g., *In re In re E S Robbins Corp.*, 30 USPQ2d 1540, 1542-43 (TTAB 1992) and cases cited therein. Instead, the record demonstrates that a light-colored and flush-mounted design for a circular control knob with a round recess on the outer perimeter is basically a refinement of a common means for adjustment of the settings of electronic equipment, including those for pulse oximeters. In fact, as previously mentioned, applicant's competitor Schiller utilizes a control knob design which, for practical purposes, is essentially identical in appearance to applicant's design. In view thereof, applicant's design would likely be perceived by prospective purchasers or users of its goods as just a means for changing certain settings on its pulse oximeters and would not be immediately regarded as identifying and distinguishing the source of such goods. See, e.g., *In re Hudson News Co.*, 39 USPQ2d 1915, 1925 (TTAB 1996), *aff'd in decision without published opinion*, 1997 U.S. App. LEXIS 15556 (Fed. Cir. June 12, 1997) [various blue trade dress motifs for newsstand services not inherently distinctive since such are "simply a mere refinement of a basic blue interior decorating scheme"]; *In re F.C.F. Inc.*, 30 USPQ2d 1825, 1828 (TTAB 1994) [rose design packaging for cosmetics not inherently distinctive

inasmuch as it "appears to be no more than a mere refinement of a basic, relatively common and well-known form of decoration or ornamentation for cosmetic packaging and would be so regarded by the public"]; and *Wiley v. American Greetings Corp.*, 226 USPQ 101, 103-104 (1st Cir. 1985) [red heart, permanently affixed to the left breast of a teddy bear, not inherently distinctive (even if unique) because it "is simply a mere refinement of a red heart motif which is a commonly adopted and well-known means of ornamentation for teddy bears, other stuffed animals and toys in general].

To be registrable, therefore, applicant's design must be shown to have acquired distinctiveness. As support for its alternative claim thereof, applicant notes that its "knob configuration" is currently used on nine of its products⁹ and has furnished a copy of an internal report showing the following sales in the United States (as of its October 3, 1995 response) since 1985:

<u>Fiscal Year</u>	<u>No. of Products</u>	<u>Units</u>
1985	1	2,038
1986	1	7,045
1987	2	13,992
1988	3	14,129
1989	3	15,395
1990	4	18,666
1991	5	17,088
1992	6	18,956
1993	7	18,053
1994	8	14,773
1995	9	15,446
1996	7	985

⁹ It would appear that the partial sales figures for fiscal year 1996 involve either a typographical error in the number of products bearing applicant's design or that only seven different models of products have been sold as of the date the information was furnished.

In all, applicant asserts that over 156,000 units have been sold. Applicant has also submitted copies of two internal documents showing that, in the 13 years from 1983 to 1996, it expended approximately \$21 million in promoting products which feature its knob design. In addition, samples of applicant's advertising, as well as copies of brochures illustrating its competitors' goods, were submitted. Applicant maintains that its advertising highlights its knob design through the use of special lighting and photography techniques or by utilizing words and arrows to point out such feature. Many of its products, applicant additionally observes, use a dark or contrasting background to display its knob design more prominently.

Representative excerpts from applicant's advertising, respectively bearing copyright dates of 1990, 1992 and 1995, are reproduced below:

The Examining Attorney, on the other hand, argues that applicant's evidence fails to establish acquired distinctiveness inasmuch as "[t]here is no evidence to suggest any promotion or perception of the subject knob design as a mark." While we disagree in part with such contention since applicant, when it first asserted its alternative claim of acquired distinctiveness during the prosecution of this application in 1995, at least arguably began to promote its knob design as a mark in its advertising by referring, as shown in the last of the excerpts illustrated above, to "The Nellcor knob for adjustment setting" and by including the statement that "NELLCOR ... and the Nellcor knob configuration are trademarks" of applicant, we nevertheless agree with the Examining Attorney that applicant's evidence is not sufficient to demonstrate acquired distinctiveness for its knob design.

Specifically, the sales figures submitted by applicant lack context in that we have no idea how large the market for

pulse oximeters is and, hence, what share thereof applicant commands. While we realize that applicant's goods form part of a limited or niche market, there appear to be a fair number of competitors in such marketplace, yet we have no idea as to the size of applicant's sales relative to those of other sellers of pulse oximeters. Moreover, as discussed below, there is very little evidence that applicant has continuously promoted its design as a trademark for its goods. At most, therefore, applicant's sales figures can be said to demonstrate a growing degree of popularity or commercial success for its products, but such evidence alone does not demonstrate that applicant's knob design has become distinctive of its goods and thus functions as a source indicator. See, e.g., *In re Pingel Enterprise Inc.*, 46 USPQ2d 1811, 1822 (TTAB 1998) [general sales growth during 16-year period does not suffice to establish that purchasing public for motorcycle fuel valves has come to view petcock configuration as a trademark]; *In re Bongrain International (American) Corp.*, 894 F.2d 1316, 13 USPQ2d 1727, 1729 (Fed. Cir. 1990) [growth in sales may be indicative of popularity of product itself rather than recognition of a term or design as denoting origin]; and *WLWC Centers, Inc. v. Winners Corp.*, 221 USPQ 701, 707 (M.D. Tenn. 1983) [popularity in sales alone cannot establish secondary meaning].

Similarly, while applicant's advertising expenditures might otherwise be an indication of its efforts to develop distinctiveness for its knob design, the amount of such outlays alone is not determinative of the success of those attempts.

See, e.g., In re Pingel Enterprise Inc., supra [effectiveness of promotional expenditures is significant rather than mere level thereof]; In re Semel, 189 USPQ 285, 287 (TTAB 1975) ["in evaluating the significance of advertising figures . . . , it is necessary to consider not only the extent of advertising but also whether the use of the designation [or design] therein has been of such nature as to create in the minds of the purchasing public an association of the designation [or design] with the user and/or his goods"] and Ralston Purina Co. v. Thomas J. Lipton, Inc., 173 USPQ 820, 824 (S.D.N.Y. 1972) [promotional expenditures indicate efforts to establish secondary meaning, but do not determine the success thereof]. In this case, it appears that not until sometime during the prosecution of this application in 1995 did applicant even arguably commence efforts to promote its knob design as a mark. Prior thereto, there is an absence of any advertising or other promotional material that even refers to applicant's knob design. The mere fact that applicant claims to have utilized special lighting and photography techniques in its advertising to illustrate the control knob on its pulse oximeters in a prominent or noticeable manner does not mean that the design of such knob would be regarded by purchasers or users of the goods as a mark. Instead, applicant's design appears in most of its advertising of record merely as part of the illustration of applicant's products.

The sole indication that we have been able to find in which applicant has arguably attempted to educate consumers to view its design of a control knob as a mark is a relatively

recent advertisement from 1995 in which, as mentioned previously, applicant makes reference to "The Nellcor knob for adjustment setting" and states, in exceedingly small print, that "NELLCOR ... and the Nellcor knob configuration are trademarks" of applicant. Although we recognize that applicant appears to have repeatedly designed various models of its pulse oximeters to incorporate the particular control knob design which it seeks to register, it does not appear from the record that applicant has continuously promoted the design as a source indicator nor, until a few years ago has it even made any minor effort to do so. The purchasing public for applicant's goods, seeing illustrations of the products in applicant's advertising, would regard the design as simply part of the pictures of the goods and would not be likely to notice applicant's recent statements that the control knob is a trademark for its pulse oximeters. See, e.g., In re Pingel Enterprise Inc., supra at 1823 [depiction in advertising of peacock configuration would be regarded by purchasers and prospective consumers "as nothing more than a graphical representation of applicant's product"; it being unlikely that such persons "would even take notice of or appreciate the statements [in fine print] on applicant's packaging and installation instructions which claim that the appearance of its product is a trademark for a motorcycle fuel valve and filter"]. Applicant, in summary, has not met its burden of establishing a prima facie case of acquired distinctiveness.

Accordingly, in order to overcome the refusal, more evidence than that which has been offered, including, in

Ser. No. 74/418,140

particular, representative advertising showing substantial promotion of applicant's control knob as a trademark for its goods and customer recognition thereof, would be necessary in order to demonstrate that the design which applicant seeks to register has in fact acquired distinctiveness in the pulse oximeter marketplace.

Decision: The refusal on the ground of *de jure* functionality is reversed, but the refusal on the ground of lack of distinctiveness is affirmed.

R. L. Simms

G. D. Hohein

P. T. Hairston
Administrative Trademark Judges,
Trademark Trial and Appeal Board