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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Zippo Manufacturing Company

Serial No. 74/570,070

M. Bud Nelson and Edwin T. Bean of Hodgson, Russ, Andrews, Woods & Goodyear for Zippo Manufacturing Company.

Jill Alt, Trademark Examining Attorney, Law Office 108 (David Shallant, Managing Attorney).

Before Quinn, Hohein and Hairston, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

On September 8, 1994 Zippo Manufacturing Company filed an application to register the configuration shown below for cigarette lighters.[1] Applicant provided the following description of the mark: "The drawing shows a lighter

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[1] Application Serial No. 74/570,070, alleging first use and first use in commerce on December 31, 1942.

having slightly rounded edges and corners, and a curvature in the shape of a slight arc in the top of the lighter."[2]

Registration was refused by the Trademark Examining Attorney on the ground that the cigarette lighter configuration for which applicant seeks registration is de jure functional and not inherently distinctive (Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. 1051, 1052 and 1145). Applicant subsequently amended its application to claim that the configuration has become distinctive of its goods due to its long use and public recognition.

The Examining Attorney has finally refused registration on the ground that the cigarette lighter

[2] There is no statement in the application with respect to the stippling shown in the drawing.

configuration is de jure functional. However, assuming that the lighter configuration is not de jure functional, the Examining Attorney has determined that the evidence submitted by applicant is sufficient to prove that the configuration has acquired distinctiveness as a trademark.[3]

Applicant has appealed from the final refusal to register. The case was extensively briefed, and an oral hearing was held.

It is the Examining Attorney's position that the configuration of applicant's cigarette lighter is dictated by the utilitarian function it performs. In particular, she contends that a rectangular design best accommodates the lighter's internal mechanism and allows it to hold more lighter fluid. In addition, the Examining Attorney maintains that while the rounded edges give the lighter a modern, streamlined design, they also make the lighter easier to hold and less likely to tear the inside of a pocket. Thus, the Examining Attorney asserts that these features provide utilitarian advantages which should remain available to others in the trade so that they may compete effectively.

[3] We note that the Examining Attorney has not contended that the lighter configuration does not function as a trademark.

After reviewing the record and giving consideration to the factors set forth in In re Morton-Norwich Products, Inc., 671 F.2d 1332, 213 USPQ 9 (CCPA 1982), we find that applicant's lighter configuration has not been shown to be de jure functional. We should point out that our decision rests solely on the evidence before us in this application; a different result might obtain if we were presented with a different record in the context of an inter partes proceeding.

The four factors set forth in Morton-Norwich which aid in a determination on the issue of functionality are (1) the existence of a utility patent which discloses the utilitarian advantages of the design sought to be registered; (2) advertising by the applicant which touts the utilitarian advantages of the design; (3) facts tending to show the existence of alternative designs; and (4) facts from which it could be determined that the design results from a comparatively simple or cheap method of manufacture.

With respect to the first factor, the Examining Attorney points out that applicant is the owner of an expired utility patent (No. 2,032,695) for a pocket lighter, and contends that such patent demonstrates the utility of the configuration which applicant seeks to register. However, it should be noted that the embodiment

of the invention illustrated in the patent, i.e., a lighter with square corners and edges and straight lines (commonly referred to as the “classic Zippo lighter”) and depicted below,

is different from the configuration applicant seeks to register, i.e., a lighter with slightly rounded edges and corners, and a curvature in the shape of a slight arc in the top of the lighter. Moreover, after careful consideration of the claims listed in the patent, we agree with applicant that the claims relate to the internal mechanism of the lighter. While the lighter configuration applicant seeks to register is designed to accommodate this internal mechanism, the patent discloses nothing of inherent utilitarian value about a lighter configuration with slightly rounded edges and corners, and a curvature in the shape of a slight arc in the top thereof. In this

regard, applicant submitted the declaration of its Director of Engineering, Myron Crumrine. Mr. Crumrine states that "it is size, and not shape which determines [the capacity for lighter fluid]," and "[t]here are many different shapes which will yield the same size reservoir." Further, he states that "the internal mechanism of the classic Zippo lighter need not be rectangular in cross section, but could be other shapes including oval and circular." Accompanying Mr. Crumrine's affidavit are two actual lighters from other manufacturers in which the internal mechanism is oval. Also, there are photographs of lighters previously made by applicant which are configured differently from the one in this case, but contain the same internal mechanism.

With respect to the second Morton-Norwich factor, applicant's advertising materials, we note that in none of applicant's literature is the lighter configuration touted as a utilitarian advantage. While applicant has consistently emphasized the durability and overall quality of its cigarette lighters by such statements as "Zippo . . . The Lighter That Works"; and "If any Zippo lighter ever fails to work, we'll fix it free," such statements are irrelevant to applicant's particular lighter configuration. Further, the statements "timeless design" and "compact shape" are not evidence of touting the lighter

configuration, i.e., the slightly rounded edges and corners and a curvature in the shape of slight arc in the top of the lighter, as a utilitarian advantage. Also, we would add that pocket lighters, by their very nature, are compact in shape.

The third Morton-Norwich factor is the existence of alternative designs. In support of its position that there are numerous alternative designs, applicant submitted over thirty actual cigarette lighters from other manufacturers. Applicant and the Examining Attorney disagree as to what may properly be considered alternative designs. The Examining Attorney contends that only those lighters which are similar in type to applicant's lighter should be considered, i.e., lighters which are rectangular in shape; have a two-piece casing; contain a flint, thumbwheel, and windscreen; and use the same type lighter fluid. Applicant, on the other hand, argues that all types of pocket lighters should be considered as alternative designs, e.g., butane lighters and push-button lighters. On this point, we agree with the Examining Attorney that only those lighters which are similar in type to applicant's lighter may be considered alternative designs. However, this does not help the Examining Attorney's case because applicant has provided six such examples. We

recognize that most of these lighters are rectangular in shape, but none is identical or even substantially similar to applicant's particular configuration. That is, none of the other six lighters has slightly rounded edges and corners and a curvature in the shape of a slight arc in the top of the lighter.

Also, although the Examining Attorney argues that applicant's lighter configuration is easier to hold and less likely to tear the inside of a pocket, when we compare it to the alternative designs of record, this does not seem to be the case. All of the alternative designs are very easy to hold. Also, it does not appear that any of the alternative designs would be more likely to tear the inside of a pocket, not because of the absence of slightly rounded edges and corners, but because the material of which they are made is smooth and there are no sharp ends.

Finally, with respect to whether there is an economy of manufacture as a result of this configuration, there is no direct evidence on this point. However, the Examining Attorney notes that in Zippo Manufacturing Company v. Rogers Imports, Inc., 216 F.Supp 670, 137 USPQ 413 (SDNY 1963), the Court found that the principal reason applicant switched from the classic Zippo lighter design to the present lighter configuration was the latter is cheaper and

more efficient for applicant to manufacture. Applicant, on the other hand, contends that while it may be more economical for it to manufacture lighters in this configuration, this does not mean that it would be more economical for its competitors to do so. In particular, applicant argues that this record fails to show that applicant's lighter configuration is cheaper or simpler to manufacture than other designs available to competitors such as to cause a competitive disadvantage.

In *Zippo Manufacturing Company,* applicant, the plaintiff therein, brought an action for trademark infringement and unfair competition against defendant Rogers for selling copies of applicant's lighters. Among other things, applicant maintained that Rogers had copied the windscreen which applicant used in both its classic Zippo lighter and the lighter configuration which applicant seeks to register. In addition, applicant maintained that Rogers had copied the lighter configuration itself. The Court, after finding that the windscreen was functional because it affected the efficiency and economy of the manufacture and use of the lighter, turned its attention to the lighter configuration, at 433:

> The pleasing appearance of a pocket lighter plays a strong part in a consumer's decision to purchase, and the entire external shape and appearance of plaintiff's lighter is, if this standard is applied, probably functional. Moreover, only under the broadest standard of functionality would the complete outside shape and appearance of the lighter when closed probably be functional. Under the somewhat narrower test, which excludes consumer appeal, these features of the lighter probably would not be functional because the shape could probably be narrower or shorter or thinner (such as the slim-lighter) without making the manufacture or use appreciably more costly or less efficient.
>
> However, special circumstances make it unnecessary to choose between these two standards of functionality. Plaintiff has conceded that the external shape and appearance of its lighter, as originally manufactured and as it appeared in the Gimera [applicant's expired utility] patent can be copied by defendant. Indeed, defendant may not have needed an express concession from plaintiff in view of the language of the Supreme Court in Singer Mfg. Co. v. June Mfg. Co., 163 U.S. 169, 185 1896): "[O]n the termination of the patent there passes to the public the right to make the machine in the form in which it was constructed during the patent." Therefore, plaintiff is compelled to rest this phase of its case upon the difference between the external shape and appearance of its lighter as portrayed in the Gimera patent and its shape and appearance today. The main difference between these two lighters is the change from severely squared corners and lines to rounded corners and beveled edges and a curved top. An important reason for these changes was that it was cheaper and more efficient to manufacture the outside cases this way.

> Therefore, the principal feature in the external shape of the lighter which plaintiff is compelled to rely upon is clearly functional without applying the test of consumer appeal. Defendant would have the Court go further, and find that there is no material change at all in plaintiff's lighter from the original shape disclosed in the Gimera patent so that plaintiff's case, in effect, is conceded away. I do not find that there has been no material change at all; but the main change in the external shape of the standard lighter from the original shape as portrayed in the Gimera patent was, within the context of the issues in this case, a change properly characterized as functional. (footnotes omitted)

We recognize that in *Zippo Manufacturing Company,* the Court found that the lighter configuration which applicant seeks to register was functional. However, it appears that the circumstances have changed significantly since *Zippo Manufacturing Company*, that is, we now have evidence of several alternative designs which shows that other lighter manufacturers can apparently compete effectively without adopting applicant's design. See e.g., In re Honeywell Inc., 8 USPQ2d 1600 (TTAB 1988) [Registration of applicant's thermostat cover configuration was permitted since conditions had changed since its prior application was refused registration on the ground that the design was de jure functional]. Further, as noted by our principal

reviewing court in Brunswick Corp. v. British Seagull Ltd., 35 F.3d 1527, 32 USPQ2d 1120, 1122 (Fed. Cir. 1994):

> In sum, the "crux" of the distinction between de facto and de jure functionality--determining eligibility for trademark protection or not--is a design's effect on competition. *Morton-Norwich*, 671 F2d. at 1341. Thus, the policies underlying the functional limitation on trademark protection explicitly invoke an inquiry into competitive fairness.

Inasmuch as several alternative designs are currently competing in the marketplace for these products, it does not appear that applicant's design has in any way hindered competition.

In sum, the Examining Attorney has not established that applicant's lighter configuration, as shown in the drawing and described in the application, is de jure functional. We wish to stress that applicant's lighter configuration is not simply a common rectangular design; rather, its distinguishing features are slightly rounded edges and corners, and a curvature in the shape of a slight arc in the top. Again, we note that competing lighters, while also rectangular in shape, are not identical or even substantially similar to applicant's lighter configuration.

Inasmuch as the Examining Attorney has accepted applicant's claim of acquired distinctiveness, and in view

of our finding that the lighter configuration is not de jure functional, applicant is entitled to registration under the provisions of Section 2(f) of the Trademark Act.

Decision: The refusal to register is reversed.

T. J. Quinn

G. D. Hohein

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