

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB      AUG. 16, 99

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Kason Industries, Inc.

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Serial No. 74/691,008

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**Robert B. Kennedy** of Kennedy, Davis & Kennedy, P.C. for  
Kason Industries, Inc.

**Chad M. Smith**, Trademark Examining Attorney, Law Office 104  
(Sidney Moskowitz, Managing Attorney)

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Before Seeherman, Chapman and Wendel, Administrative  
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Kason Industries, Inc. has applied to register the  
configuration shown below

for "metal door closers."<sup>1</sup> Applicant's description of its mark which was finally accepted by the Examining Attorney reads as follows: "The mark consists of the external appearance of a housing and a roller arm of a door closer which is attached to a door. The environment of the mark, including a strike for attachment to a door frame and a roller for cooperating with the strike, is shown in broken lines which are not part of the mark." Applicant also included a statement that "[t]he stippling in the drawing represents shading and is not intended to indicate color."

Applicant claims that the configuration is only de facto functional and has become distinctive of applicant's goods, and applicant therefore seeks registration pursuant to Section 2(f) of the [Trademark Act](#).

Registration was finally refused on the ground that the configuration is de jure functional under Sections 1, 2 and 45 of the [Trademark Act](#)<sup>2</sup>; and that if the configuration is held not de jure functional, the evidence submitted by

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<sup>1</sup> Application Serial No. 74/691,008, filed June 20, 1995. Applicant claimed dates of first use and first use in commerce of August 1987.

<sup>2</sup> As one of the amendments to the [Trademark Act](#) to implement the provisions of the Trademark Law Treaty which became effective October 30, 1998, Section 2(e) has been amended to specifically incorporate the functionality doctrine into the statute in new subsection 2(e)(5), which provides for refusal if the mark "comprises any matter that, as a whole, is functional." Section 2(f) has been amended to exclude subsection 2(e)(5) from the provisions thereof.

applicant in support of its Section 2(f) claim is insufficient for that purpose.

Applicant has appealed. Applicant and the Examining Attorney filed briefs, but no oral hearing was requested.

Preliminarily, we address an evidentiary matter. Applicant submitted several exhibits with its brief on appeal, some of which were submitted during the prosecution of the application, and thus, properly form part of the record. However, the Examining Attorney objected to the third-party materials which were not previously made of record. We agree that these submissions were untimely, and accordingly, applicant's exhibits C, D, and E (attached to its brief) have not been considered. See Trademark Rule 2.142(d).

*I. De Jure Functionality*

To be considered de jure functional, it must be shown that not only does the design of a product have a function, but performance of that function is enhanced by the particular configuration that it takes. See *In re R. M. Smith, Inc.* 734 F.2d 1482, 222 USPQ 1 (Fed. Cir. 1984); and *In re Virshup*, 42 USPQ2d 1403 (TTAB 1997). "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

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order to compete effectively, it is de jure functional and, as such, is precluded from registration for reasons of public policy." In re Caterpillar Inc., 43 USPQ2d 1335, 1338 (TTAB 1997).

The Examining Attorney bears the burden of making a prima facie showing of de jure functionality of the applied-for mark. Our primary reviewing court has recognized that "[t]he practicalities of the limited resources available to the PTO are routinely taken into account in reviewing its administrative action." In re Loew's Theatres, Inc., 769 F.2d 764, 226 USPQ 865, 868 (Fed. Cir. 1985).

Factors which may be considered in determining de jure functionality (i.e., whether or not a particular design is a superior one) include: (i) the existence of a utility patent showing the functional advantage of the design; (ii) advertising materials showing that the utilitarian advantages have been touted by applicant; (iii) facts tending to show an absence of alternative designs; and (iv) facts from which it could be determined that the design is the result of a comparatively simple or inexpensive method of manufacture. See In re Morton-Norwich Products Inc., 671 F.2d 1332, 213 USPQ 9 (CCPA 1982).

The Examining Attorney argues that applicant's product configuration is a simple rectangular-shaped housing for a locking cylinder, and a lever arm for positioning and holding of a locking roller; that this rectangular shape housing is necessary to cover the long narrow cylinder with a minimum of material and to provide a base from which to secure the tabs to the door itself; that use of the same or highly similar designs by competitors indicates the lack of available competitive designs; and that applicant's own brochure touts the utilitarian advantages of its product design.

First, we note that applicant does not own a utility patent for this configuration. While applicant does own a design patent, this is not, without more, decisive of the question of de jure functionality. We note that the drawing in the design patent is virtually identical to the drawing in the present application, the only difference being the design patent does not include the strike or hook for attachment to the door. However, the hook appears in the drawing of this application in broken lines, and applicant stated it makes no claim thereto. See *In re American National Can Co.*, 41 USPQ2d 1841 (TTAB 1997). Moreover, applicant's design patent is simply evidence of

recognition of the ornamental features of the door closer. The design patent is silent as to utilitarian features.

The next factor is applicant's touting of the utilitarian features in its advertisements or brochures. Applicant's brochure includes references that its "one-piece solid steel housing completely encloses hydraulic mechanism" and "You save the extra expense and assembly time needed for separate housing cover." Applicant contends this is mere "puffing" or promoting the unitary nature of its product, and, more importantly, that applicant is not claiming the unitary nature of the product as a feature of the mark. However, applicant's statements clearly refer to the rectangular housing cover, and this is, in fact, the feature that applicant is claiming as part of its mark. Thus, we find there is touting of this utilitarian feature of applicant's design. See *In re Edward Ski Products Inc.*, 49 USPQ2d 2001 (TTAB 1999).

The third factor, the unavailability of other designs, also weighs against applicant. Applicant's vice president of engineering, Burl M. Finkelstein (in two declarations) attested to the number of alternative designs available in the marketplace. The alternative designs provided by applicant essentially show the exact same shape, a rectangle. (Some of the asserted alternative designs are

manufactured by applicant.) There are of record two other designs produced by competitors (Standard-Keil Industries, Inc. and Dent Manufacturing Inc.). All of these products show essentially a rectangular-shaped cover or housing for the door closer, with essentially the same roller arm.

We agree with the Examining Attorney that the alternative designs made of record all constitute a single basic rectangular shape. See *Greenhouse Systems Inc. v. Carson*, 37 USPQ2d 1748 (TTAB 1995); and *In re Lincoln Diagnostics Inc.*, 30 USPQ2d 1817 (TTAB 1994). That is, all of these alternatives are comprised of a rectangular-shaped housing or casing covering a hydraulic closer with a hooking roller arm attached thereto. In the absence of any specifically different or alternative designs, it follows that the rectangular shape is the best or one of a very few superior designs for its functional purpose. Therefore, competition would be hindered and a registration to applicant would seriously interfere with the right to compete. It is not necessary that competition be eliminated totally to find de jure functionality. Rather, it is sufficient if the product design applicant seeks to register is one of only a few superior designs. See *In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985). Cf.

In re Weber-Stephen Products Co., 3 USPQ2d 1659 (TTAB 1987).

The fourth factor, whether applicant's product configuration design is the result of a simpler or cheaper method of manufacturing, we also find weighs against applicant. Applicant asserts that its door closers cost more to manufacture, and therefore the configuration is not the result of a cheaper method of manufacturing. However, in reviewing the supplemental declaration of applicant's vice president of engineering, Mr. Finkelstein, we note that the increased cost of making these door closers is due to the fact that they are made of steel instead of other materials such as plastic, which involves greater material as well as labor costs (for handling and finishing steel). This evidence all goes solely to the materials used, not to the actual design of the product involved. Applicant submitted no evidence regarding the cost of manufacturing the involved design. The housing and roller arm in applicant's product configuration simply follow the natural line of the functional portion of the door closer.

In sum, we find that the product configuration design sought to be registered by applicant is de jure functional.

*II. Acquired Distinctiveness*

Although we have found the applied-for matter to be de jure functional, in order to render an opinion on each of the issues before us, we now consider applicant's Section 2(f) evidence, assuming for this discussion that the configuration is only de facto, rather than de jure, functional. Applicant bears the burden of establishing acquired distinctiveness. See *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988). Applicant submitted a declaration and a supplemental declaration from its vice president of engineering, Burl M. Finkelstein; one affidavit from a customer, Judy Wansley; one affidavit from an officer of a competitor, Douglas D. Dodge; and certain documents from a law suit involving applicant and a third-party regarding alleged intentional copying of applicant's design.

Applicant has explained that its primary market is limited to 12 major original equipment manufacturers (OEM) of walk-in refrigerators and freezers, with a secondary market of hundreds of minor OEM's and refrigeration equipment supply houses which sell retrofit and replacement products. Applicant's identification reads "metal door closers," without any limitation thereto. Even considering such limitation, i.e., metal door closers sold to

manufacturers for use on walk-in commercial refrigerators and freezers, in assessing the evidence of acquired distinctiveness, we still find that applicant's evidence falls far short of proof that the relevant consumers have come to view applicant's rectangular door closer configuration as a trademark which identifies applicant as the source of the goods.

Applicant's brochures do not include any promotion of the rectangular housing shape as an indication of the source of the product. Mr. Finkelstein averred that applicant spent \$170,000 to create the involved door closer design, and since 1988 has spent \$10,000 for brochures, catalog inserts, displays at trade shows, and promotional photographs. The money spent in creating the design does not in any way indicate consumer recognition of the design as a trademark. The advertising expenditures have been very limited, with only \$10,000 spent in eight to nine years. Moreover, there is no clear indication what portion, if any, of these numbers relate solely to the door closer design, rather than applicant's trademark, KASON. That is, there is no information in the Finkelstein declarations specifically relating to the door closer design as opposed to applicant's trademark KASON, under which applicant's goods are sold.

Applicant's sales figures of 178,000 units, representing sales of approximately \$3,000,000, since 1988 certainly suggest applicant has enjoyed some success with this door closer. However, this does not establish there is secondary meaning associated with applicant's configuration (i.e., that consumers recognize applicant's design as a trademark). In sum, this evidence does not demonstrate that the container configuration is recognized as a source indicator. Rather, it shows only that applicant has, in fact, advertised, promoted and sold its goods. See *In re American National Can Co.*, 41 USPQ2d 1841 (TTAB 1997); and *In re Semel*, 189 USPQ 285 (TTAB 1975).

Despite sales of 178,000 units, as well as a primary market of twelve major original equipment manufacturers and a secondary market which includes hundreds of minor OEM's and supply houses, nonetheless applicant submitted a single affidavit from a customer, Judy Wansley. She averred that she recognizes applicant's door closers by their "overall general appearance, and particularly by their three extended ears and simple rectangular shape." Even this consumer referred to the shape as a "simple rectangular shape." We have little information regarding this consumer, and there is no further evidence of consumer recognition.

Applicant specifically argues that "it should be appreciated that customers and persons in the relatively small commercial refrigeration hardware industry are reluctant to step forward and give sworn legal statements" (Response filed March 17, 1997, p. 5). Although there is no further evidence as to why this may be particularly true in this industry, even assuming it is true, the affidavit of one customer simply does not prove that the applied-for matter has acquired distinctiveness.

An officer of one of applicant's competitors (Mr. Dodge, president of Dent Manufacturing, Inc.) also provided an affidavit. Mr. Dodge avers that he is familiar with many types of commercial refrigeration hardware; that he recognizes the design in question as coming from applicant; that he believes the design is well known in said industry and is "readily recognized by its long rectangular shaped appearance and its uni-body steel construction." While Mr. Dodge is aware of applicant as a competitor, again this does not establish consumer recognition of the design as indicating source.

Applicant also contends that evidence of intentional copying supports a determination of acquired distinctiveness, and that applicant filed a lawsuit against a competitor for trademark infringement. The record shows

that applicant's lawsuit ended in a consent judgment. Thus, there was no finding by the court on the merits of applicant's claim against its competitor. Moreover, we cannot tell from the materials submitted from the court case whether the third party admitted they were copying the specific configuration at issue here.

Applicant has submitted information regarding one purchaser and one competitor, along with some sales and advertising figures. However, given the ordinary nature of the involved rectangular shape, upon review of all the evidence of acquired distinctiveness, we find it is insufficient.

Decision: The refusal to register on the ground that applicant's door closer configuration is de jure functional is affirmed, and on the additional ground that even if this configuration of the goods were not de jure functional, applicant's evidence of acquired distinctiveness is insufficient to establish that the configuration has become distinctive through use in commerce.

E. J. Seeherman

B. A. Chapman

H. R. Wendel  
Administrative Trademark  
Judges, Trademark Trial and  
Board