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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Music City Marketing, Inc.

Serial No. 75/035,717

Charles A. Laff and Martin L. Stern of Laff, Whitesel & Saret, Ltd. for Music City Marketing, Inc.

Fred Mandir, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Simms, Hanak and Wendel, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Music City Marketing, Inc. has filed an application to register the configuration shown below for a "smoking pipe."¹

¹ Serial No. 75/035,717, filed December 22, 1995, based on an allegation of a bona fide intention to use the mark in commerce. A statement of use was filed January 9, 1998, setting forth a date of first use and first use in commerce of January 1988. The application was subsequently amended to one seeking registration under Section 2(f).

The description of the mark reads: The mark consists of a configuration which is the design of a cigarette. The lining statement reads: The drawing is lined for the color tan.²

The intent-to-use application was published for opposition on May 6, 1997. No oppositions were filed and a notice of allowance issued July 29, 1997. The statement of use was filed January 9, 1998. Thereafter the Examining Attorney refused registration under Sections 1, 2 and 45 of the Trademark Act on the ground that the proposed mark consists of a design which is de jure functional. Applicant subsequently amended the application to one seeking registration under the provisions of Section 2(f) and submitted evidence in support of its claim of distinctiveness. The Examining Attorney argued, however, that the proposed mark was not merely de facto functional,

² Contrary to the statement made in the dissent, applicant has never stated that "the color lining is not a feature of its mark." Applicant simply stated, in reference to the propriety of its drawing, that the "lining shown in the drawing is not intended as a feature of the mark, but is used only to indicate the color tan, pursuant to 37 C.F.R 2.52(e)." We find this a clear indication that applicant intends to claim the color tan as a feature of the mark and that the lining is not to be interpreted otherwise. Furthermore, since the Examining Attorney never raised the issue of the non-registrability of the end portion per se of the configuration, we find it an undue extension of prosecution to remand this application for consideration of this matter at this late date.

as would permit registration under Section 2(f), and made the refusal of de jure functionality final.

The refusal on the basis that the mark is de jure functional was appealed. Both applicant and the Examining Attorney filed briefs and both participated in an oral hearing on the case. The Examining Attorney stated in his brief that the evidence which applicant had submitted was sufficient to show acquired distinctiveness if the mark were only de facto functional.

The configuration or design of a product is de jure functional if it is so utilitarian as to constitute a superior design which others in the field need to be able to copy in order to compete effectively. In re Morton-Norwich Products, Inc., 671 F.2d 1332, 213 USPQ 9 (CCPA 1982). The four factors found to be useful in determining this issue, as discussed in In re Morton-Norwich, Inc., *supra*, and consistently looked to by the Board, are as follows:

- (1) the existence of a utility patent that discloses the utilitarian advantages of the design;
- (2) the touting by the originator of the design in advertising material of the utilitarian advantages of the design;
- (3) facts showing the unavailability to competitors of alternative designs; and
- (4) facts indicating that the design results from a

relatively simple or cheap method of manufacturing the product.

See also In re Zippo Manufacturing Co., 50 USPQ2d 1852 (TTAB 1999); In re Edward Ski Products, Inc., 49 USPQ2d 2001 (TTAB 1999); In re Caterpillar Inc., 43 USPQ2d 1335 (TTAB 1997).

The Examining Attorney has taken the position that applicant's proposed mark, a configuration in the design of a cigarette, is superior to other available designs for smoking pipes similar in function to applicant's pipes and thus would give a competitive advantage to applicant. He points to the specimens of record and promotional literature submitted by applicant as evidence that applicant's smoking pipes, which are marketed under the mark THE SMOKELESS CIGARETTE, are in fact used as a smoking cessation aid. As one example, he notes the statement in the brochure attached to the declaration of Richard K. Rowland, Vice President of Sales and Marketing for applicant, which was submitted in support of applicant's claim of distinctiveness, that: Today's health conscious smokers also can use the *Smokeless Cigarette*[™] to reduce tobacco consumption while satisfying the need for a smoke. (Exhibit A1). Further statements in the literature in Exhibit A2 are also pointed out as evidence of the use of

applicant's smoking pipes as a means of cutting down or quitting smoking.

Thus, the Examining Attorney argues that, since applicant's smoking pipes are used as a "cigarette substitute smoking cessation aid," the use of a design in the form of a cigarette provides functional advantages. He contends that the "realistic cigarette design allows the smoker to be inconspicuous" whereas the alternative designs available do not offer the user the same inconspicuous design or serve as a substitute which looks and feels like a regular cigarette.

Turning to the factors considered in determining functionality, the Examining Attorney points to the touting by applicant in its promotional material that the "SMOKELESS CIGARETTE looks, lights and smokes just like a regular cigarette" (Exhibit A2) and that it is "an acceptable alternative to public cigarette smoking." (Exhibit A1).

Insofar as alternative designs are concerned, he argues that although applicant has provided evidence of other smoking pipe designs, these are not actually alternatives, in that they do not offer the same inconspicuous cigarette design. He has made of record evidence of the use of "realistic cigarette configurations"

for products marketed as artificial cigarettes under the marks NICOTROL and E-Z QUIT which are used by persons attempting to quit smoking. He contends that the use of similar cigarette configurations for these competitive smoking cessation aids demonstrates the lack of alternative designs when the consumer desires the "look and feel of a real cigarette" and that "to prevent applicant's competitors from using the common design of a cigarette would be costly...because they could not market to consumers that demand a cigarette substitute in the form of a realistic cigarette." (Brief, p. 9).

Applicant, on the other hand, describes its goods as a smoking pipe which burns only a single pinch of tobacco at a time, thus, as it advertises, "satisfying the smoker's need for a 'puff' while eliminating afterburn and reducing the quantity and odor of 'secondhand' smoke objectionable to so many non-smokers." (Exhibit A1). Applicant acknowledges that this ability to burn only a single pinch of tobacco also permits users with a means of rationing or controlling the amount of tobacco they consume. Applicant insists, however, that all of these functions are fulfilled by the size of the tobacco bowl at the end of the pipe and not the cigarette design or of any particular design of the pipe. Applicant's declarant, Richard Rowlands, has stated

that the resemblance of applicant's pipe to a cigarette is "purely whimsical and adds nothing to its function as a pipe."

Looking to the determinative factors, applicant states that applicant's cigarette design is not the subject of a utility patent;³ that its advertising does not tout any utilitarian advantages of the cigarette design; and that the configuration does not result from a relatively simple or inexpensive method of manufacture.⁴ As for alternative designs, applicant points to the Rowland declaration in which evidence was presented of several different designs, many similar to a baseball bat, which are used by competitors for similar products. (Exhibit E).

Accordingly, we find that only two of the four factors which potentially may take a part in the determination of functionality need be further considered here. There is no relevant utility patent and there is no evidence that a smoking pipe in a cigarette configuration is any cheaper or easier to manufacture.

³ The only patent of applicant's which is of record is for a smoking system for holding a pipe and smoking material in a single container and does not show use of a pipe having the configuration of a cigarette.

⁴ In the Rowlands declaration the statement is made that "[c]onfiguration as a cigarette does not affect the cost or quality of manufacture of smoking pipes... ." (Par. 11).

Turning to applicant's advertising and promotion of its smoking pipes, we find that at least in one instance applicant has touted the fact that its pipe "looks, lights and smokes just like a regular cigarette." Obviously, simply by using the mark SMOKELESS CIGARETTE in conjunction with the pipe, applicant draws attention to the resemblance of the pipe to a cigarette. But we agree with applicant that this advertising does not in any significant manner tout any utilitarian advantages which are linked to the cigarette design. The functioning of the smoking pipe as one which only burns a single pinch of tobacco at one time and the benefits obtained thereby, albeit reduction of second hand smoke or reduction of tobacco consumption, are not touted as resulting from the particular configuration of the pipe. Nor is there any reference to the inconspicuous appearance or any psychological benefit which might be obtained from the use of a pipe resembling a cigarette.

We further agree with applicant that advertising copy describing the pipes as "an acceptable alternative to public cigarette smoking" relates not to the cigarette design itself, but rather to the features inherent in the small bowl size of the pipe which makes smoking thereof

much more acceptable to persons frequently subjected to second hand smoke.

We also find no evidence of the unavailability to competitors of alternative designs which would serve the same purposes and function in the same manner as applicant's smoking pipe which is in the configuration of a cigarette. As shown by the examples of competitors' products in Exhibit E attached to the Rowland declaration, the pipes are often offered in a baseball bat configuration or a highly decorated straight configuration. The appearances of the pipes may vary widely; the utilitarian functions remain the same.

The Examining Attorney contends, however, that these other designs are not true alternatives, in that they do not offer the inconspicuous nature of applicant's cigarette design. He argues that persons trying to cut down or quit smoking, but wanting to use a substitute which has the appearance of a cigarette, would not find the other designs suitable. His claim of superior design is based for the most part on the allegedly inconspicuous appearance of applicant's cigarette design pipe and/or the psychological effects thereof.

Thus, the issue comes down to whether the cigarette design is merely an aesthetic feature of applicant's

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smoking pipe which has contributed to its commercial success or whether the design is in fact a superior design in that it provides a competitive advantage to applicant which truly hinders competition. As stated by our principal reviewing court in *Brunswick Corp. v. British Seagull Ltd.*, 35 F.2d. 1527, 32 USPQ2d 1120, 1124 (Fed. Cir. 1994):

...traditional trademark principles govern the registrability of a proposed mark's aesthetic features. As with any mark, the test for de jure functionality hinges on whether registration of a feature hinders competition, and not whether the feature contributes to the product's commercial success.

In the *Brunswick* case, the use of the color black for outboard motors was found to be de jure functional, not because the color was related in any way to the working of the engine or the ease of manufacture, but rather because the color black made the motors more compatible with boat colors and visually decreased the apparent size of the motors. These features were held to serve more than purely aesthetic functions; instead, they supplied a competitive advantage to the manufacturer of the black motors.

This holding was later referred to by the Supreme Court in *Qualitex Co. v. Jacobsen Products Co.* 514 U.S. 159, 34 USPQ2d 1161 (1995), wherein the Court considered

the applicability of the functionality doctrine to the color mark at issue. The Court succinctly stated that functionality bars use of a product's feature as a mark "where doing so will put a competitor at a significant disadvantage." Citing the Restatement (Third) of Unfair Competition, the Court reiterated the statement therein that the "ultimate test of aesthetic functionality is whether the recognition of trademark rights would *significantly* hinder competition." [Emphasis added].

We do not find this test to have been met here. It is true that the cigarette configuration may be appealing to or perhaps provide a psychological boost to persons who want to appear to be smoking a cigarette or who are accustomed to smoking cigarettes. If looked at with any detail, however, it is obvious that this is not a cigarette. The materials are not the same; this is a hard pipe. The end is not a tobacco tip, as in a cigarette, it is a metal tip. But even more significantly, there is no evidence of record that the cigarette appearance is such a major selling point that preventing competing manufacturers and sellers of smoking pipes from using a similar design would significantly hinder competition in this field. Although the Examining Attorney has provided evidence that somewhat similar cigarette shaped products are sold as non-

smoking cigarette substitutes, this evidence fails to demonstrate the competitive need for applicant's particular cigarette configuration for actual smoking pipes.⁵ Although the configuration may in fact enhance commercial success, the configuration has not been shown to be such a superior design that competitors would be put to a significant disadvantage by applicant's registration thereof. Thus, the configuration has not been proven to be de jure functional.

⁵ The dissent fails to recognize the distinction which must be made between applicant's product, which has been identified as a "smoking pipe" and non-smoking cigarette substitutes. Although applicant has acknowledged that its pipe may be used as a means of rationing the amount of tobacco used, the fundamental purpose of applicant's pipe is not the same as the smokeless cigarette substitutes such as E-Z QUIT or Nicotrol devices. While a cigarette design may be highly instrumental to the competitiveness of a cigarette substitute which is used to take the place in one's hand or mouth of a cigarette, there is no evidence of record that the same is true for a smoking pipe whose primary feature is to cut down on secondhand smoke and, coincidentally, to cut down on, not replace, tobacco consumption. Although the dissent states that the record establishes the superiority of a cigarette design for a "cigarette smoke cessation aid," the only evidence advanced by the dissent of the touting of the psychological advantages of a device which looks like a cigarette is that made in connection with a cigarette substitute, not a smoking pipe. We do not consider the single instance of applicant's touting its pipe as one which both "looks, lights and smokes" (emphasis added) like a cigarette sufficient to establish that this configuration provides such a psychological advantage that competition in the field of smoking pipes would be significantly hindered by the registration of applicant's configuration. Whether or not applicant could claim infringement when such a configuration is used for a non-smoking cigarette substitute is a matter of conjecture and clearly not a basis for refusing registration.

While applicant has argued that its cigarette configuration is also not de facto functional, this question is irrelevant. Under the recent holdings by the Supreme Court in *Wal-Mart Stores, Inc. v. Samara Brothers Inc.*, 529 U.S. 205, 54 USPQ2d 1065 (2000), product design is not inherently distinctive for purposes of trademark recognition. Accordingly, the present configuration can only serve as an indication of source and be registrable on the Principal Register upon a showing of acquired distinctiveness. As previously noted, however, the Examining Attorney has stated in his brief that the evidence submitted under Section 2(f) is sufficient to establish acquired distinctiveness for the present configuration. Thus, we find applicant's product design registrable under the provisions of Section 2(f).⁶

⁶ We see no need to remand the application to the Examining Attorney for further consideration of the evidence submitted under Section 2(f). In *Wal-Mart* the Supreme Court simply held that a product design could never be inherently distinctive. No new or stricter standard was set forth for determining acquired distinctiveness. Since the Examining Attorney has already treated the present product configuration as one which was not inherently distinctive, we see no reason to re-evaluate the evidence which was found adequate to establish acquired distinctiveness.

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Decision: The refusal to register under Sections 1, 2 and 45 on the basis that the configuration sought to be registered is de jure functional is reversed. The mark will be forwarded for registration under the provisions of Section 2(f).

E. W. Hanak

H. R. Wendel

Administrative Trademark Judges,
Trademark Trial and Appeal Board

Simms, Administrative Trademark Judge, dissenting:

Because I believe that the majority has minimized the significance of applicant's touting of the appearance of its own goods, has otherwise given inadequate weight to the use of similar designs for smoke cessation devices and has failed to use common sense, I dissent.

Applicant's product is designed to help cigarette smokers cut down on or quit smoking. While applicant's goods are defined in its application as "smoking pipes," it is clear from the promotional literature of record that its goods are aimed at cigarette smokers and not pipe smokers.⁷ Applicant has apparently identified its goods as "smoking pipes" because its goods are not ordinary paper cigarettes but are constructed of aluminum or brass.⁸ Applicant's literature indicates that its cigarette-like device is sold in cases "about the size of a standard 100mm cigarette pack and can be carried easily in shirt pocket or purse." To

⁷ Despite the fact that applicant had been using its asserted mark for seven years, applicant's 1995 application was filed under Section 1(b) of the Act, 15 USC §1051(b), on the basis of applicant's "bona fide intention to use the mark in commerce."

⁸ Webster's Third New International Dictionary (Unabridged) (1993) defines "pipe" as, among other things, "a device usu. consisting of a tube having a bowl at one end and a mouthpiece at the other and used for smoking <tobacco~>." There is nothing in either the description of goods or the description of applicant's mark, both of which will be printed on applicant's registration, which indicates the composition of applicant's goods. However, from the identification "smoking pipes," one can surmise that the goods will be of somewhat rigid structure.

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use, one "fill[s] the Smokeless Cigarette and light[s] up as usual." Each fill offers up to six puffs and self-extinguishes after each puff.

The Examining Attorney has argued that applicant's cigarette design is superior to other available designs and provides applicant with a competitive advantage. The Examining Attorney maintains that a smoker using applicant's device can be "inconspicuous" because the device looks like a real cigarette. See the reproductions below, from applicant's packaging and promotional literature.

The Examining Attorney also notes the following statement from applicant's literature.

SMOKELESS CIGARETTE looks, lights and smokes just like a regular cigarette.

Because of the resemblance of applicant's product to a regular cigarette, there are obvious psychological benefits to the use of applicant's device in the difficult process of quitting smoking. Indeed, the majority concedes that the use of applicant's "cigarette configuration may be appealing to or perhaps provide a psychological boost to persons who want to appear to be smoking a cigarette or who are accustomed to smoking cigarettes."

The Examining Attorney maintains that the other designs which applicant has pointed to are less desirable alternatives because they do not resemble real cigarettes.

Consumers that are trying to cut down or quit smoking, and want a cigarette substitute to look, and feel just like a regular cigarette, would not purchase the colorful, metallic, odd shaped pipes for their purposes.

Some of the alternative designs are shown below.

The Examining Attorney also points to other smoke cessation aids which use realistic cigarette appearances in arguing that applicant, by federal registration, should not be able to appropriate exclusive rights to a common cigarette design for a product that functions as its substitute. The fact that others use similar cigarette-like appearances for their smoke cessation aids demonstrates the lack of realistic alternatives, according to the Examining Attorney. If applicant were granted a registration, the Examining Attorney argues that others could be hampered in their ability to compete by selling realistic cigarette substitutes as smoke cessation aids. I agree. The Examining Attorney has pointed to the E-Z QUIT product ("a smokeless cigarette substitute that fills your need to do something with your hands and mouth, and to inhale deeply") and the Nicotrol inhaler. Those devices are reproduced below.

The maker of the E-Z QUIT product states that the user will "feel like smoking a real cigarette." The promotional information, obtained by the Examining Attorney from the Internet, further indicates that this product "Simulates The Sensation Of Smoking," that "E-Z QUIT is uniquely designed to substitute for the habits of handling and drawing on a cigarette... When you inhale through an E-Z QUIT, you replicate the actions of smoking, calming your oral desire to smoke... Holding and handling an E-Z QUIT keeps your hands occupied as if with a cigarette. This helps reduce your feeling of deprivation." The

testimonials that accompany this product information are also telling:

I have found the recently introduced (brand name) nicotine patches to be helpful in ridding myself of nicotine addiction; however, few proponents of the anti-smoking campaigns have considered effective aids for the more long-lasting psychological addiction or habit of holding that cigarette, puffing on it and actually drawing something into the lungs. Nothing on the market (I've tried them all) compares to the emotional comfort offered by E-Z QUIT cigarettes.—Carole Kilgore, Westland, MI

A smoker is used to having a cigarette in his hand and a pill or gum won't satisfy that habit...Evelyn Bergstedt, Bend, OR

Applicant, on the other hand, argues that the appearance of its smoking pipe does not make the product work better or easier to use or affect its costs. Applicant maintains that there is no *functional* reason for the appearance of its product because it does not matter whether its smoking pipe has a cigarette design, a cigar design or any other design for it to accomplish its stated purpose. That purpose is to contribute to eliminating afterburn, to reduce second-hand smoke and to curtail tobacco consumption. While applicant seems to admit in its reply brief, 3, that its design is "not entirely arbitrary," elsewhere applicant maintains that the look of its pipe is "whimsical" and "is different, unique and clearly capable of functioning as a trademark." Response,

filed, January 21, 1997, 1, 3; Response, filed September 10, 1998, 3; appeal brief, 8; and reply brief, 7.⁹

Concerning the touting of its product, applicant maintains that this statement appears only once in an eight-page brochure and is not in other advertisements or displays of applicant's goods. It is applicant's position that a single instance of touting is not sufficient to meet the burden of showing *de jure* functionality. Applicant argues that the Examining Attorney has provided no evidence that the cigarette design is intended to make applicant's pipe less conspicuous, and that the Examining Attorney's argument concerning this matter does not establish a *prima facie* case. Applicant maintains that the Examining Attorney's contention about the "inconspicuous" appearance of its cigarette-like device is at best indirect and tangential to the product's purpose of reducing tobacco consumption and second-hand smoke. Applicant argues that it does not promote its design as possessing any utilitarian advantage or increasing the "public acceptability" of its product.

⁹ If applicant's product design is entirely "whimsical," it is curious that the tan "filter," resembling the filter on many cigarettes, also appears in applicant's mark.

Concerning the existence of other cigarette-like devices which the Examining Attorney has made of record, applicant states that they have "an explicit function in providing the user with the sensation that he/she is smoking a real cigarette, despite the absence of tobacco." Request for Reconsideration, 6. Further, applicant maintains that these devices show different cigarette-like designs; for example, one is white with a flared end and a gold stripe around the middle while the Nicotrol inhaler is somewhat bulbous with a flattened end. According to applicant, these are not smoking pipes but substitutes for tobacco smoking.¹⁰

It is clear that trademarks and registrations of trademarks are designed to protect features which are not functional. *Textron, Inc. v. United States International Trade Commission*, 753 F.2d 1019, 224 USPQ 625, 628 (Fed. Cir. 1985). As the majority has noted, the effect on competition is really the crux of the matter of *de jure*

¹⁰ It is curious that applicant even argues that its product design is not *de facto* functional. See Response, filed September 10, 1998, 3, and appeal brief, 5, 10. Obviously, applicant's device is *de facto* functional because it performs the function of delivering tobacco to the user when it is lit. Almost every device which performs some function is *de facto* functional. See *In re R.M. Smith, Inc.*, 734 F.2d 1482, 222 USPQ 1, 3 (Fed. Cir. 1984) and the discussion of this matter in *In re Parkway Machine Corp.*, 52 USPQ2d 1628, 1631 n. 4 (TTAB 1999).

functionality. In re Morton-Norwich Products, Inc., 671 F. 2d 1332, 213 USPQ 9 (CCPA 1982).¹¹ I believe that this record establishes that applicant's cigarette-like device is the best or one of a few superior designs available for a cigarette smoke cessation aid. While there are alternative designs, it is obvious to me that, while they may perform the same function of delivering tobacco to the user in as efficient a manner as applicant's device, they do not offer the psychological advantage that applicant's device does. Applicant's promotional literature clearly indicates that its Smokeless Cigarette "looks, lights and smokes just like a regular cigarette." It is simply not understood why applicant would bring the appearance of its product to the attention of potential purchasers unless applicant was intending to make explicit the obvious--that a cigarette smoker who is trying to quit smoking could use applicant's realistic cigarette-like device to aid in the effort to quit smoking. Also, as noted above, another maker of a "Smokeless Artificial Cigarette System" clearly expresses the obvious psychological benefits of using applicant's device--that it looks and feels like a

¹¹ The statutory ground of refusal is now Section 2(e)(5), 15 USC § 1052(e)(5)(eff. Oct. 30, 1998), which bars registration of a mark which "comprises any matter that, as a whole, is functional."

cigarette, and that one trying to quit smoking may make the transition easier if the cigarette substitute looks like an ordinary cigarette to which the user is accustomed.

Aside from the evidence of record, including applicant's own touting and the touting of a similar design's advantages by another, I believe that the look-alike advantages of applicant's cigarette substitute product designed to help cigarette smokers stop smoking are patently obvious. It should not take much evidence to realize that a cigarette smoker who is trying to stop smoking would obviously feel more comfortable in using a device which closely resembled the cigarettes he is used to smoking, rather than an unfamiliar product, such as a miniature baseball-bat like device. The evidence of record only serves to substantiate what is obvious and intuitive. In the past, we have not been faulted for using our common sense. See *In re Teledyne Industries, Inc.*, 212 USPQ 299 (TTAB 1981)(stating that the functionality of certain features of applicant's showerhead were obvious, such as the spaced orifices, the cylindrical shape ("easily conformable to the human hand") and the knurls of the dial ("to facilitate manipulation of the dial when the user's hands are wet"), *aff'd* 696 F.2d 968, 217 USPQ 9 (Fed. Cir. 1982). I fully agree with the Examining Attorney that

registration of applicant's device as a trademark, which is designed as an aid to help people stop smoking cigarettes, would significantly hinder competition. Others should be free to copy this design and be able to compete by making and selling their competing smoke cessation aids in the form of a regular cigarette.¹² Applicant should not have the right to force competitors to resort to different designs which do not have the same advantages as applicant's. See also *Norwich Pharmacal Co. v. Sterling Drug, Inc.*, 271 F.2d 569, 123 USPQ 372 (2d Cir. 1959), cert. denied, 362 U.S. 919 (1960) (although stating the now discredited law that color may not become one's exclusive property for a particular product, court held that the color pink, used by numerous others for upset stomach remedies, is functional since pleasing appearance has a psychosomatic effect on users).

Also, with the advent of the 1995 Federal Trademark Dilution Act, codified as Section 43(c), 15 USC 1025(c), the pernicious effect of registration of this device as a trademark could even extend into other areas than

¹² It seems to me that applicant's cigarette-like smoking pipe should be no more registrable than a cigar cessation aid in the shape of a cigar. Aside from the fact that such a device would not likely be seen as a trademark for a cigar replacement device, the shape of a cigar for a device intended to help cigar smokers stop smoking should be free for others to copy.

competitive stop-smoking devices, potentially forever interfering with those markets.

With respect to the alternative designs on the market, applicant states that there are 28 styles of smoking pipes. However, it appears that applicant is including pipes of identical appearance (the baseball bat-like devices, for example) but of different colors. In other words, applicant is counting a red bat-like device and an identical blue device as two different alternative designs, and the different garish variations of the cylindrical device reproduced above as separate styles. It appears from this record, however, that, in reality, only three or four different designs, including applicant's cigarette-like device, are currently available.

Applicant has made much of the fact that its device in the shape and appearance of a cigarette does not make it function any better or make it any easier or less expensive to make. However, neither did the black color of an applicant's outboard motors make those engines perform better or make them easier or less expensive to make. See *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994). Nevertheless, that color was more desirable and was held *de jure* functional because of the competitive need to copy a color which was compatible

with other colors and had the ability to make the engine appear smaller.

Further, I believe that there are several matters which suggest remand of this case, or at least clarification by applicant. First, in the application, applicant has indicated that its goods are lined for the color tan. Elsewhere, applicant states that the color lining is not a feature of its mark but is only used to indicate color. Response, filed September 10, 1998, 2. Where an applicant does not consider color to be a feature of its mark, the applicant should so indicate. TMEP §§807.06(b) and (c). Without such a statement, color is presumed to be a feature of the mark. If this application matures into a registration without further clarification, the public, including competitors, will likely presume that applicant is claiming the color tan as a feature of its mark.

Also, the beveled end of applicant's smoking device appears to be functional in appearance because it lets the user load it with tobacco with a simple twist of the fingers. See applicant's promotional literature. Functional aspects of trademarks should be disclaimed, and an application which includes a claim to rights in unregistrable subject matter must be refused. See In re

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Water Gremlin Co., 635 F.2d 841, 208 USPQ 89 (CCPA 1980);
and In re Famous Foods, Inc., 217 USPQ 177 (TTAB 1983).
See also Trademark Rule 2.51 (d) and TMEP § 807.03(a). It
is my opinion that the Examining Attorney should have
required a disclaimer of this matter, or at least inquired
into the functionality of this feature.

As a final matter, I believe that this case should
also be remanded to the Examining Attorney to reconsider
applicant's showing of acquired distinctiveness, in light
of a recent Supreme Court decision. The Examining
Attorney, while refusing this application on the ground of
de jure functionality, stated in his appeal brief,
submitted in December 1999, that applicant had filed a
sufficient showing of acquired distinctiveness, if
applicant's asserted mark were not *de jure* functional.
Applicant stated that it had sold over 3 million units and
spent \$250,000 in advertising and promotion of its asserted
mark in magazines, at trade shows and in product packaging
over approximately ten years. Also, form letters have been
submitted from several retailers asserting that applicant's
design has come to be recognized as an indication of
source.

In Wal-Mart Stores Inc. v. Samara Brothers Inc., 120
S.Ct. 1339, 54 USPQ2d 1065 (2000), handed down three months

after the Examining Attorney's appeal brief was submitted, the U.S. Supreme Court held that, in a trademark infringement suit brought on the basis of unregistered trade dress, product design, such as that involved here, is protectible only upon a showing of secondary meaning.

While it is true that the Examining Attorney has stated that applicant has submitted a sufficient showing of acquired distinctiveness, that determination was made in a pre-*Wal-Mart* legal environment in which a product configuration or product design mark was registered if the Examining Attorney believed that that the design was inherently distinctive (not permitted after *Wal-Mart*), and where an Examining Attorney may have required minimal evidence of acquired distinctiveness if he or she thought that the asserted mark, while not inherently distinctive, presented a close or borderline case of distinctiveness.¹³

However, in *Wal-Mart*, 54 USPQ2d at 1069-70, the Supreme

¹³ The courts and the Board have long recognized that the nature and amount of acquired distinctiveness vary from case to case, depending on the degree of descriptiveness (or distinctiveness of a product design). See, for example, TMEP § 1212.01 and cases cited therein. Now that the Supreme Court has ruled that product design can never be inherently distinctive, one might argue, I think reasonably, that a more persuasive showing of acquired distinctiveness than was previously required should be of record before a product design mark is allowed, in view of the public policy behind the Court's reasoning.

Court ruled that, as a matter of law, product design can never be inherently distinctive:

In the case of product design, as in the case of color [which the Court stated can never be inherently distinctive], we think consumer predisposition to equate the feature with the source does not exist. Consumers are aware of the reality that, almost invariably, even the most unusual of product designs - such as a cocktail shaker shaped like a penguin - is intended not to identify source, but to render the product itself more useful or more appealing.

The fact that product design almost invariably serves purposes other than source identification not only renders inherent distinctiveness problematical; it also renders application of an inherent-distinctiveness principle more harmful to other consumer interests. Consumers should not be deprived of the benefits of competition with regard to the utilitarian and esthetic purposes that product design ordinarily serves by a rule of law that facilitates plausible threats of suit against new entrants based upon alleged inherent distinctiveness...

...To the extent there are close cases, we believe that courts should err on the side of caution and classify ambiguous trade dress as product design, thereby requiring secondary meaning. The very closeness will suggest the existence of relatively small utility in adopting an inherent-distinctiveness principle, and relatively great consumer benefit in requiring a demonstration of secondary meaning.

Because this application was examined under prior law where registration was permitted, in some circumstances, of product designs without any showing of acquired distinctiveness and where the Examining Attorney may have accepted a lesser showing of acquired distinctiveness than

is now arguably required where product design is, as a matter of law, not registrable as inherently distinctive, I would remand this application to the Examining Attorney for reconsideration of the issue of acquired distinctiveness, in light of *Wal-Mart*. In view of the nature of this asserted mark (the appearance of a cigarette for a cigarette replacement product), I would also suggest that the Examining Attorney inquire into the nature of the third-party use of similar designs mentioned in the declaration of applicant's vice president ("a few isolated infringing designs") to determine if that use may have been of such a nature as to detract from applicant's showing of acquired distinctiveness. See *Levi Strauss & Co. v Genesco, Inc.*, 222 USPQ 939, 940-41 (Fed. Cir. 1984) ("When the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term or device, an application for registration under Section 2(f) cannot be successful, for distinctiveness on which purchasers may rely is lacking under such circumstances.") Cf. *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417, 422, 424 (Fed. Cir. 1985) ("We agree that color is usually perceived as ornamentation. While ornamentation is not incompatible with trademark function, 'unless the design is of such nature that its distinctiveness is

obvious, convincing evidence must be forthcoming to prove that in fact the purchasing public does recognize the design as a trademark which identifies the source of the goods.' ...By their nature color marks carry a difficult burden in demonstrating distinctiveness and trademark character." [Case citation omitted.]

What the Court of Appeals for the Federal Circuit said in the *Water Gremlin* case, 208 USPQ at 91, is especially noteworthy here:

Trademarks are useful tools of a competitive society, providing consumers with the means for choosing from among different producers. The tenet which precludes recognition of functional designs as trademarks is one of the balance points. Our society is better served if functional containers (as well as functional product designs and highly descriptive or generic terms--) remain available for use among competitors. To the extent this causes a modicum of confusion of the public, it will be tolerated. There is, indeed, no overriding requirement in the law that comparable goods be distinguishable in the marketplace. On the other hand, a merchant who *wishes* to set himself apart has no dearth of means to do so. One who chooses a commonplace design for his package, or one different from competitors only in essentiality functional features, even if he is the first to do so, must expect to have to identify himself as the source of goods by his labelling or some other device. [Footnotes omitted.]

In a similar vein, the Third Circuit has stated this cautionary concern, in *Versa Products Co., Inc. v. Bifold*

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Co. (Manufacturing) Ltd., 50 F.3d 189, 33 USPQ2d 1801, 1814
(1995), cert. denied, 516 U.S. 808 (1995):

Where product configurations are concerned, we must be especially wary of undermining competition. Competitors have broad rights to copy successful product designs when those designs are not protected by (utility or design) patents. It is not unfair competition for someone to trade off the goodwill of a *product*... it is only unfair to deceive consumers as to the origin of one's goods and thereby trade off the good will of a prior *producer*... [Citations omitted.]

Because I believe that registration to applicant of this product design would confer a serious competitive benefit on one producer to the detriment of competitors, and is therefore functional as a whole, I would affirm the refusal.

R. L. Simms
Administrative Trademark
Judge, Trademark Trial and
Appeal Board