

Oral Hearing:
November 3, 1998

Paper No. 26
CEW

1/31/01

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Briles Rivet Corporation

Serial No. 75/053,459

Edward M. Prince of Alston & Bird and William W. Haefliger,
Esq. for applicant.

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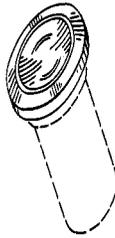
Before Walters, Chapman and Bucher, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Briles Rivet Corporation has filed a trademark application to register the subject matter shown below for "rivets."¹ Applicant submitted a description of this subject matter as "a configuration of a toroidal head of a rivet." In this regard, we take judicial notice of the

¹ Serial No. 75/053,459, in International Class 6, filed February 5, 1996, based on an allegation of use in commerce, alleging first use and first use in commerce as of January 1, 1997. The application includes a statement that the lining in the drawing is a feature of the mark and is not intended to indicate color.

definition, in *Webster's II New Riverside University Dictionary* (1984), of "toroid" as "a surface generated by a closed curve rotating about, but not intersecting or containing, an axis in its own plane."



The Trademark Examining Attorney has finally refused registration under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. 1051, 1052 and 1127, on the ground that the subject matter of the application is *de jure* functional.² Applicant concedes that the subject matter is not inherently distinctive, stating that, while the subject

² Applicant also argues that the refusal on the ground of functionality was prematurely made final in the second office action. Applicant contends that the first office action, while refusing registration on the ground of functionality, did not specify whether the basis was *de jure* or *de facto* functionality. This issue is a matter for petition to the Commissioner, although applicant did not timely file a petition in this regard. See, *Trademark Manual of Examining Procedure*, Sections 1105.04(e) and 1501.01. Moreover, the term "functionality" encompasses both *de jure* and *de facto* functionality; and applicant has had ample opportunity, both prior to appeal and in its request for reconsideration and supplemental materials filed prior to oral argument, as well as in its briefs, to present its position regarding the issue of *de jure* functionality.

matter is admittedly *de facto* functional, it has acquired distinctiveness as a mark under Section 2(f) of the Trademark Act, 15 U.S.C. 1052(f). The Examining Attorney has, alternatively, accepted applicant's claim of acquired distinctiveness.³

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, and an oral hearing was held.

Procedural Issue

This case was suspended pending the final outcome of *Allfast Fastening Systems, Inc. v. Briles Rivet Corporation et. al.*, CV 97-8190, in the U.S. District Court for the Central District of California. Applicant has submitted a copy of that court's stipulated order dismissing the action with prejudice, entered February 16, 2000. Therefore, the Board now proceeds with consideration of this appeal.

Drawing and Description of Mark

In its reply brief, applicant stated that its drawing of its mark had been amended and that the drawing shown in its main brief was incorrect. We do not find that such an amendment has been made and, thus, we consider the proposed

³ In view of the Examining Attorney's acceptance, in the alternative, of applicant's Section 2(f) claim, should the subject matter of the application ultimately be determined not to be *de jure* functional, the alternative question of whether this subject matter has acquired distinctiveness is not before us in this appeal.

mark that is the subject of this application to be as shown and described above.

The record reveals that, on November 22, 1996, applicant submitted, via fax, a drawing like the one shown in applicant's reply brief. The fax cover sheet was signed by applicant's attorney and included the statement:

"Proposed revised trademark drawing. Please comment." The drawing was proposed to be modified to represent the outer shape and depth of the head of the rivet in dotted lines rather than solid lines, so that only the design of the surface of the rivet head appeared in solid lines. We note that applicant did not, at any time, propose an amendment to its description of its mark. The Examining Attorney did not respond at all to the November 22, 1996 filing, nor is there any notation in the record regarding the proposed amendment. Similarly, until its reply brief, applicant did not refer again to its proposed amendment and, in fact, continued to refer to its proposed mark as the configuration of the head of a rivet, rather than as the configuration of the *surface* of the head of a rivet. Moreover, in its main brief, applicant depicted its proposed mark as shown in its originally-filed drawing.

We can only conclude from the record that both applicant and the Examining Attorney overlooked this

proposed amendment to the drawing until applicant's reply brief, where applicant has mischaracterized what occurred as an *entered* amendment to the drawing, rather than a *proposed* amendment requesting comment from the Examining Attorney. We decline to remand the application *sua sponte* at this point for consideration of the proposed amendment because we view applicant's lack of follow-up action on the proposal during the period between the proposed amendment and the reply brief as indicating its lack of interest in pursuing the amendment. Thus, we conclude that the proposed amendment was effectively withdrawn.

Furthermore, as discussed *infra*, such an amendment to the proposed mark would not change our decision in this case.

De Jure Functionality

1. *Factual Record.*

Only applicant submitted evidence. With its initial filing, applicant submitted samples of its rivets; copies of four utility patents owned by applicant - No. 5,129,771 (granted July 14, 1992) for a "Precision Ring Dome-Headed Rivet," No. 4,086,839 (granted May 2, 1978) for a "Dome Headed Rivet and Workpiece Assembly," and No. 4,051,592 (granted October 4, 1977) and No. 4,000,680 (granted January 4, 1977), each for an "Expanding Head Riveting

Serial No. 75/053,459

Method"; and copies of two third-party utility patents - No. 3,748,948 (granted July 13, 1973) for "Fatigue Resistant Fasteners," and No. 3,526,032 (granted September 1, 1970) for a "Riveting Method Employing Metal Flow in Both the Manufactured Head and the Upset Head."

During the prosecution of the application and in its request for reconsideration, applicant submitted additional evidence, including, a page entitled "Typical Solid Rivet Configurations" containing pictures and names of thirteen different rivets; five form affidavits from "employees" of various third parties; promotional materials for rivets from two third parties; and additional third-party patents, namely, No. 2,991,858 (granted July 11, 1961) for a "Rivet," No. 3,747,467 (granted July 24, 1973) for a "Rivet Fastener System and Method," No. 3,936,205 (granted February 3, 1976) for a "Crowned Head Riveted Joint," Nos. 5,273,386 and 5,026,234 (granted December 28, 1993 and June 25, 1991, respectively) for an "Expandable Rivet Head," and No. 5,332,349 (granted July 26, 1994) for a "Flush Rivet with Compound Radius Domed Head."

Additional evidence submitted by applicant to "fulfill its duty of candor to the Office" has also been considered. This evidence includes the affidavit of Frank Briles, applicant's president, attesting to certain facts; excerpts

pertaining to specifications for a rivet, "BACR15FV," from a submission entitled "Boeing Part Standard"; an excerpt entitled "Military Standard" that describes standards for rivets "intended for use in riveted structures where flushness, fatigue life, static joint strength and corrosion resistance are of primary design importance"; and a copy of Trademark Registration No. 1,622,108 for a mark described as "the configuration of a thermostat cover that is circular and rounded in shape."

In his affidavit, Mr. Briles made several statements about applicant's rivets and the relevant industry that are paraphrased below:

Applicant competes with other rivet manufacturers to supply rivets to Boeing Aircraft, including for its military counterpart airplanes.

Boeing specifications for its rivet BACR15FV and MIL14218, its military counterpart, include the subject matter of this application.

Each airplane has a number of different rivets, some of which include the subject matter of this application; airplanes for which Boeing has chosen the BACR15FV rivet include rivets not supplied by applicant; each part used on an airplane is depicted in a detailed specification drawing; and rivets on the exterior of airliners and military jets must be flush, whereas that is not necessarily the case for rivets used on the interior of these planes.

A number of rivets used on a variety of different airplanes are designed to be flush after installation; airplane manufacturers have

specified flush rivets other than applicant's rivet, e.g., Airbus.

The record reveals that the specifications of a rivet may change depending on the material that is being riveted and the use of the riveted structure; that an installed rivet must be flush with the surface of the structure, whether as installed, due to the rivet's design, or by shaving; and that the rivet head interference with the cavity into which the rivet is installed (the countersink) is critical to the performance of the rivet. A review of the utility patents in this record indicates that there are a number of problems being solved in the rivet designs or systems, e.g., ensuring that the head is flush with the surface; ensuring inspectibility to detect faulty rivet installations; withstanding shear forces and avoiding drag; preventing fatigue in either the rivet, the joint, or the structure; preventing distortion to the structure; and/or ensuring a good seal, so that matter does not leak around the head and shank of the rivet and result in corrosion.

It is clear from the patents in the record that the various rivet inventions of applicant and third parties aim at solving all or some of the above-described problems. In fact, the later-issued patents cite some or all of the earlier patents, including several of applicant's patents,

as prior art upon which the later patents are alleged to be improvements.

2. *Analysis.*

The only question before us is whether the subject matter of this application is *de jure* functional in connection with the identified goods. In considering the issue of *de jure* functionality, we have considered all of the evidence in the record, including the evidence submitted in connection with applicant's Section 2(f) claim of acquired distinctiveness.

The Board stated in *In re Peters*, 6 USPQ2d 1390, 1391 (TTAB 1988), that "[a] design configuration is considered to be unregistrable when it has been determined to be *de jure*, as opposed to *de facto*, functional. An item which is *de facto* functional may be registrable, while one which is *de jure* functional may never be registered even if it has been shown to possess some recognition in the trade." For the design in question to be *de jure* functional, it must be shown not just that the claimed elements of the configuration of the goods are functional, but also that the performance of that function is enhanced by the particular configuration in which the design is executed. *In re R.M. Smith*, 734 F.2d 1482, 222 USPQ 1 (Fed. Cir. 1984). A configuration which is so utilitarian as to

constitute a superior design for its purpose, so that competitors need to copy it in order to compete effectively, is *de jure* functional, and unregistrable. *In re Lincoln Diagnostics Inc.*, 30 USPQ2d 1817 (TTAB 1994). As set out in *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 USPQ 9 (CCPA 1982), there are a number of factors which are useful in determining whether particular product designs are superior, including:

- (1) the existence of a utility patent that discloses the utilitarian advantages of the design;
- (2) advertising materials in which the originator of the design touts the design's utilitarian advantages;
- (3) the availability to competitors of alternative designs; and
- (4) facts indicating that the design results from a comparatively simple or cheap method of manufacturing the product.

The subject matter of this application is applicant's configuration of the toroidal head of a rivet.⁴ With reference to applicant's utility patents of record, the Examining Attorney contends that the toroidal, or ring-shaped, surface of applicant's rivet head is an essential aspect of applicant's patented rivet. The Examining

⁴ Applicant notes that the design of the surface of its rivet head exists only until the rivet is installed. We add that this appears to be the case with all rivet head designs in the record, as the goal is an installed rivet that is flush with the structure surface.

Attorney contends, further, that no acceptable alternative designs are available to competitors. He argues that rivet designs in third-party patents submitted by applicant are not actually alternatives to applicant's rivet design because applicant's rivet design is superior to the third-party rivet designs.

Applicant concedes that "the frusto-conical or toroidal head of the rivet is described in applicant's patent and is one element, among many, in the claims of this patent." [Applicant's Brief, p. 1.] Applicant contends, however, that the evidence of record establishes that the head of its rivet is merely *de facto* functional.⁵ Referring to the evidence of third-party patents and alleging that, essentially, the Examining Attorney has misconstrued the claims in the patents, applicant contends that one patent, No. 5,273,386, describes its rivet as "superior" to applicant's rivet; that the Examining Attorney has not demonstrated that the other third-party rivet patents in the record are not satisfactory alternatives to applicant's rivet; and that applicant's

⁵ Applicant and the Examining Attorney disagree about whether the existence of applicant's utility patent that includes a claim describing the toroidal head of applicant's rivet is dispositive of the issue of *de jure* functionality in this case. Based on our decision, *infra*, it is unnecessary for us to conclude that the existence of such a utility patent is dispositive.

evidence of acceptable alternative designs is the most important evidentiary factor in determining *de jure* functionality [Applicant's Reply Brief, p. 4].

Considering the *Morton-Norwich* factors, there is no evidence in the record pertaining to the second factor, portrayal of rivet design features in applicant's advertising materials, or to the fourth factor, cost or ease of manufacture vis-à-vis other rivet designs. Thus, these factors are neutral and contribute nothing to our determination of the issue of *de jure* functionality.

With respect to the first *Morton-Norwich* factor, the record includes several utility patents owned by applicant for rivets and rivet systems, which each include as an essential claim the toroidal shape of the head of a rivet, which is precisely the subject matter of this trademark application. Applicant states that "[t]he claims of the Briles patents are not directed to the tapered frusto-conical section located on the face of the head of the rivet but rather to the combination of the rivet, counterbore and volumetric or spatial relationship between the two." [Request for Reconsideration, June 10, 1997, pp. 9-10.] While we agree that applicant's patents claim more than just the shape of the rivet head, it is equally clear from the patents of record, including applicant's patents,

that the shape of the rivet head is an essential and integral part of the invention; and that it is the shape of the head surface, in relation to the rivet seat and shank and to the shape and size of the countersink into which the rivet is installed, that enables the specified rivet or rivet "system" to avoid the above-described problems. The fact that there are other aspects to applicant's patented rivet or rivet system that may also be important to the utilitarian function of the rivet or rivet system does not negate the importance of the particular claim with which we are concerned herein. Clearly, this factor weighs strongly in favor of a finding of *de jure* functionality.

We consider, next, the third evidentiary factor, the availability to competitors of alternative rivet designs. The evidence shows that there are many different rivet designs. However, rivets are used in a myriad of different applications and applicant's president testified that, for airplanes alone, there are many different rivet designs for different applications. Applicant has not disclosed whether the various different rivet designs submitted for the record are competitive designs or whether they are simply for different applications. Nor has applicant disclosed the extent to which any of the different rivet designs in the record may be superior to one another or to

applicant's rivet. We do note that applicant has submitted third-party product sheets showing numerous different shapes of rivet heads. This could indicate either that a single manufacturer offers various different rivets for a single application depending upon preference, price and/or quality or that a single manufacturer offers different rivets for different applications. Because of the ambiguity of this evidence, it is of little persuasive value in our consideration of the availability to competitors of alternatives to applicant's rivet head design for the same application.

On the other hand, applicant stated that it competes with other manufacturers to provide rivets to airplane manufacturers; and that the specifications for one particular Boeing aircraft require a specific toroidal rivet that, at least during the pendency of applicant's patent, can only be provided by applicant. With no additional evidence regarding industry practice, we can only conclude from this fact that at least one manufacturer considers applicant's toroidal head rivet design to be superior; and that competitors are effectively barred from competing with applicant to supply to Boeing rivets for the same use.

Without additional evidence about practices in the industry, the single example above wherein rivet manufacturers are precluded from competing with applicant is not dispositive of the question of competitive advantage across the entire aircraft manufacturing industry. However, for this particular application, it does demonstrate the superiority of applicant's rivet design and the inability of other rivet manufacturers to compete.

In view of the evidence establishing the utilitarian advantages of the elements of applicant's configuration (as shown in applicant's utility patents), and the fact that in the manufacture of at least one type of Boeing aircraft, applicant's toroidal headed rivet is required, we conclude that the design herein is one of a very few superior designs for its functional purpose. Thus, a registration granted to applicant would seriously interfere with the right to compete. *In re Morton-Norwich, supra.*

In summary, we find that the claimed configuration of the toroidal head of applicant's rivet is one of the best designs to perform the desired function. Analysis of the *Morton-Norwich* factors shows that the configuration is *de jure* functional. Although there are points in applicant's favor, they are not persuasive of a contrary finding.

Serial No. 75/053,459

Accordingly, we find that the configuration sought to be registered is *de jure* functional.

Decision: The refusal to register on the ground that the subject matter of the application is *de jure* functional is affirmed.