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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Optiva Corporation

Serial No. 76143014

Clark A. Puntigam of Jensen & Puntigam, P.S., for Optiva Corporation.

Susan Leslie DuBois, Trademark Examining Attorney, Law Office 111 (Craig Taylor, Managing Attorney).

Before Chapman, Bucher and Rogers, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Optiva Corporation, seeks registration on the Principal Register of the design shown below:



for goods identified in the application as "toothbrushes" in International Class 21.¹ The application includes the following statement: "[t]he mark consists of a circular whirlpool design, with a plurality of light and dark sections, indicating separate lines." Hereinafter, we shall refer to the proposed mark as the design or the whirlpool design.

The application is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this design based upon the ground that, as shown on the specimen of record, the design does not function as a trademark under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. Sections 1051, 1052 and 1127, and based upon applicant's failure to comply with the requirement for a substitute specimen showing use of the mark as it appears on the drawing. 37 C.F.R. §2.51.

Applicant and the Trademark Examining Attorney submitted briefs.² Applicant did not request an oral hearing.

We affirm the refusals to register.

¹ Optiva Corporation filed application Serial No. 76143014 on October 10, 2000 based upon applicant's allegation of first use in commerce at least as early as December 7, 1992.

² We accept the appeal brief of the Trademark Examining Attorney as timely filed because it appears that she did not receive timely notice of the deadline for her brief. 37 C.F.R. §2.142(b)(1); and TBMP §1203.02(b)(2d ed. Rev. 2004).

The original specimen of record is a packaging box for an electric toothbrush, of which we have reproduced the top and front portions:



The Refusal under Sections 1, 2 and 45

The Trademark Examining Attorney has taken the position that, as it appears on the packaging, applicant's whirlpool design does not function as a trademark:

[The whirlpool design] appears on the specimens as background to a picture of a large toothbrush head with droplets of water scattering around it, along with a picture of the whole toothbrush and stand. ... [T]he whirlpool design is simply an ornamental background. It does not function as a source-identifier for the applicant's goods because the design is not set apart or featured in a way so that it stands out from the package or is noticed separate and apart from its function as a background design for the toothbrush head and toothbrush with stand.

Trademark Examining Attorney's final refusal of October 6, 2003, pp. 1 - 2.

By contrast, applicant argues that its design - even if it is considered to be ornamental - is far more than mere background. Applicant takes the position that it is registrable because it is "uncommon," "arbitrary," "complex," "fanciful" and "distinctive."

On the other hand, the Trademark Examining Attorney has properly raised a question about whether this "complex" design, as it appears on the specimens of record (the original or the substitute filed during prosecution of the application), will strike the prospective consumer as a source indicator. In arguing that it will not, the

Trademark Examining Attorney has relied on reported decisions dealing with issues of decorative trade dress. See e.g., In re J. Kinderman & Sons Inc., 46 USPQ2d 1253 (TTAB 1998); In re F.C.F., Inc., 30 USPQ2d 1825 (TTAB 1994); and In re Petersen Mfg. Co., 2 USPQ2d 2032 (TTAB 1987).

In any use-based application seeking registration of a design utilized as part of trade dress in the nature of product packaging, the Trademark Examining Attorney must determine (based upon the specimens of record) whether the design is eligible for registration as a trademark. Specifically, the Trademark Examining Attorney must determine whether the design is inherently distinctive or, when necessary, whether it has acquired distinctiveness. In this case, applicant does not claim that its design has acquired distinctiveness and it is, therefore, necessarily relying on a claim that it is inherently distinctive. When considering this claim in the instant case, the Trademark Examining Attorney properly referred to the specimens of use to discover how applicant actually uses the whirlpool design within the context of its overall package design. See In re Bose Corp., 546 F.2d 893, 192 USPQ 213 (CCPA 1976); In re Manco Inc., 24 USPQ2d 1938 (TTAB 1992); In re Scientific Methods, Inc., 201 USPQ 917 (1979). The Trademark Examining Attorney also properly assessed the likely impact of the

design on the potential consumer. For trade dress in the nature of product packaging to be registered, there must be a logical basis for the consumer to draw an association between the design and the product - an association that causes consumers to recognize the design as a source indicator for the goods.

The Trademark Examining Attorney contends that applicant's overall trade dress relegates the whirlpool design to nothing more than a background design. Given the placement of the design on the packaging, she takes the position that it will not create strong and distinct visual impressions in the mind of a potential consumer so as to allow the consumer to distinguish applicant's goods from similar goods of others. The Trademark Examining Attorney also contends that the placement of the pictorial image(s) of the toothbrush(es) and the flecks of water in the foreground further minimize the ability of this design to create a distinct commercial impression.

The Trademark Examining Attorney also takes the position that the design would not be perceived as a mark because the entire design is not shown intact on a single surface of the packaging. As seen on the first page of this opinion, the drawing depicts the mark as a rectangular portion of the whirlpool design, while the specimen on the

third page shows the design is broken up into two disjointed rectangular surfaces, with a small portion on the top of the package, and a larger portion on the front of the box. The top portion of the design is separated from the balance by a grey band having textual matter, including prominently thereon, the word "SONICARE."

We note that applicant submitted a substitute specimen that varies from the original specimen, but that, according to the Trademark Examining Attorney, suffers the same lack of inherent distinctiveness.



A merchant or manufacturer who merely uses a background graphic on packaging does not necessarily transform the graphic into a trademark for the packaged product. While applicant may have intended its design to function as a mark for its toothbrushes, it is also true that:

"... not everything that a party adopts and uses with the intent that it function as a trademark necessarily achieves this goal or

is legally capable of doing so and not everything that is recognized or associated with a party is necessarily a registrable trademark."

In re Port-A-Hut, Inc., 183 USPQ 680, 682 (TTAB 1974). To be an inherently distinctive aspect of trade dress, a design should "come out into the spotlight of real trademark significance" and 'hit the buyer in the eye'..." See 1 J.T. McCarthy, McCarthy on Trademarks and Unfair Competition §7:28 (4th ed. 2000). Stated differently, to be found inherently distinctive, the design feature should be " ... so unique, unusual or unexpected in this market that one can assume without proof that it will automatically be perceived by customers as an indicator of origin - a trademark." *Id.* §8:13. We find that applicant's design fails to emerge out of the background of the specimens and hit the prospective buyer in the eye.

This Board has had occasion in the past to review product packaging trade dress where each applicant claimed that its proposed mark was more than just a background design. The Trademark Examining Attorney argued at length in her brief about



one such case, wherein a package for cosmetics included a rose design as an ornamental or decorative background. In that case the Board held:

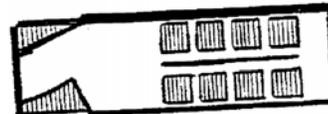
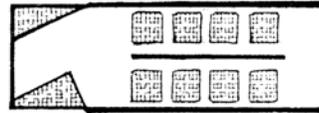
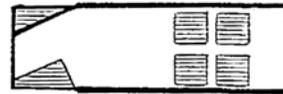
[A]pplicant's rose design is not utilized in an inherently distinct manner on the specimens of record. Instead, such design is employed on the packaging for its goods in a merely ornamental or decorative way, forming simply a background for the display of applicant's "CLARINS" within an oval mark. Applicant's rose design, we observe, covers the entire front and left side of the boxes for its goods, with a similar, but slightly different, rose pattern appearing on the remainder thereof. As so used, purchasers and prospective customers for applicant's goods would be unlikely to regard applicant's rose design as identifying and distinguishing its cosmetics and indicating their source.

In re F.C.F., Inc. supra, at 1827. The Trademark Examining Attorney argues that the *F.C.F.* case is most instructive for the instant case "where the whirlpool design functions as a background for the term SONICARE and the toothbrushes and flecks of water." Like the rose design in *F.C.F.*, she argues that applicant's proposed mark consists of nothing more than an ornamental background design that fails to function as a trademark. We agree.

In another case involving a number of related applications, the colored images on the rear panel of four different containers



for hand tools were held unregistrable as merely ornamental, and without acquired distinctiveness. In re Petersen Mfg. Co., 2 USPQ2d 2032 (TTAB 1987).



Related to the question discussed above of how the design is used in applicant's trade dress, is the question of how consumers are likely to perceive the design.

In response to applicant's argument that consumers will be able to recognize the whirlpool design notwithstanding that it is overlaid or bordered with other images and words, the Trademark Examining Attorney contends:

While the concept that the background is separable from the toothbrush is possible, the likelihood of it happening is not. A consumer cannot be expected to parse a package design to determine the trademark. A trademark that functions as a source-identifier is not one that needs to be scrutinized by the consumer.

When one looks at the original and substitute specimens, it is possible to identify distinctly different levels of imagery. In the center of the pictorial portion of each package is a toothbrush head. In the substitute specimen (p. 7 *supra*), the toothbrush head is vertical and static, while in the original specimen (p. 3 *supra*), it is horizontal and noticeably vibrating (e.g., the tips of the

bristles appear somewhat blurry and flecks of water are being sprayed from the moving toothbrush head). Also in the original specimen is a second image of the entire automatic, rechargeable toothbrush, shown in relatively close proximity to its base recharging unit. Given the scale of this toothbrush (i.e., significantly smaller than the toothbrush head depicted directly above it), it might well appear to be located in a second plane of the composite imagery at an intermediate distance, but curiously, still in front of the background whirlpool design associated with the larger, horizontal and vibrating toothbrush head in the foreground.

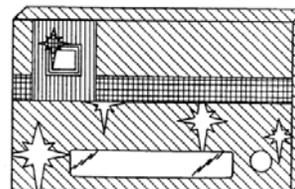
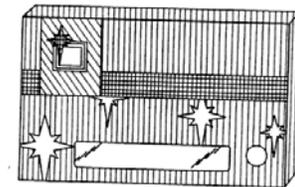
The interplay of the various visual elements, including the whirlpool design, as well as certain wording on applicant's package, influences the way in which consumers are likely to perceive the design. We note that applicant's packaging refers to its product as "the sonic toothbrush" and touts its sonic wave technology. In addition to the scrubbing action created by contact between the teeth/gums and the moving bristle tips of the toothbrush, applicant claims that the ultrahigh-speed motion of the bristles creates acoustic pressure that results in remote sonic cleansing of the teeth and massaging action for the

gums -- "31,000 gentle brush strokes per minute create sonic waves." Despite applicant's description of the applied-for-matter as being a whirlpool design, given the nature of the goods, the dynamic interplay of the visual elements on the packaging, and the wording which touts the sonic wave action of the product, we find that the whirlpool design shown on applicant's packaging, if consumers actually cogitate about it, will be viewed as a visual representation of sonic waves.



Imagery on original specimens

In one published decision that similarly involved a visual element of trade dress that constituted a suggestive evocation of the product, the designs of containers for holiday lights that resembled wrapped gifts were held not to be inherently distinctive. See In re J. Kinderman & Sons Inc., 46 USPQ2d 1253 (TTAB 1998).³



In discussing trade dress issues, the Supreme Court has observed that there will clearly be cases "where it is not

³ In the J. Kinderman case, the highly suggestive relationship between packaging in the form of wrapped gifts used for holiday lights diminished the likelihood that prospective consumers would immediately rely upon this gift box design to differentiate J. Kinderman's holiday lights from the lights of its competitors.

reasonable to assume consumer predisposition to take ... packaging as indication of source." Wal-Mart Stores, Inc. v. Samara Brothers, Inc., 120 S.Ct. 1339, 1344, 146 L.Ed.2d 182, 190, 54 USPQ2d 1065, 1068 (2000). This is especially true where, as in this case, the element of the trade dress is highly suggestive of the product or an attribute thereof. Applicant argues, in essence, that its design is not suggestive but is unusual relative to toothbrushes - "unlike anything used by applicant's competitors on similar products" - that it is "arbitrary," "fanciful" and "distinctive." However, as we have discussed, the interplay of the words and images on applicant's package make it most likely that its design - if consumers even cogitate over its significance instead of glossing over it as mere background ornamentation - will be perceived as a highly suggestive representation of the touted sonic waves.

The specimen refusal

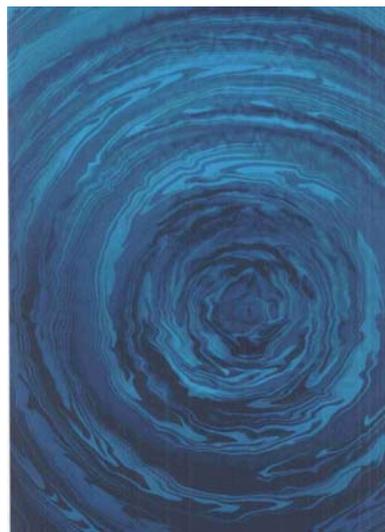
We turn then to the second basis for refusal to register in this case. The Trademark Examining Attorney has taken the position, in the alternative, that even if the matter shown in the drawing should be found to function as a mark, applicant failed to provide a specimen - either the original or the substitute - showing use of the design as it appears on the drawing. Accordingly, the Trademark

Examining Attorney has refused registration based upon applicant's failure to comply with the requirement to provide a proper specimen.

As a preliminary matter, we note that the differences between the original colored artwork on the packaging and the black-and-white drawing create such different commercial impressions that this alone would support the requirement for a substitute specimen. In this regard, we agree with the assessment of the original Trademark Examining Attorney, who explained in the Office action of March 23, 2001, that "the drawing displays the mark as a circular, whirlpool-like design with numerous sections of white denoting separate lines. However, this differs from the display of the mark on the specimen, where it appears as almost a solid background design with no clear designation of the circular pattern evidenced in the drawing ..."



Black-and-white
drawing



Color artwork used
in design of specimens

Applicant argued in its response of September 24, 2001, that:

"[t]he same camera-ready artwork used for the display on the container was used to prepare the drawing. Enclosed is a copy of that artwork [right image, *supra*] for the examiner's convenience. It is logical that the specimen and the drawing would agree, since they were made from the same source. In fact, they do agree. The same swirling whirlpool lines are present in both the specimen and the drawing as indicated by the pattern of and dark lines and regions. Considerable care was taken to ensure correlation between the specimen and the drawing."

This application was filed prior to November 2, 2003, the date on which the Office began accepting color drawings. Prior to that date, grey-tones were not allowed, and if applicant had wanted to show color in a special form drawing, it was done by use of lining patterns. Previous Trademark Rule 2.52(b) and (e). This problem would be solved by the current ability of the Office to accept a color drawing. 37 C.F.R. §2.52(b)(1).

Yet, we note that the current Trademark Examining Attorney has not explicitly taken the position that the image depicted in the black-and-white drawing creates a different commercial impression than the black-and-blue imagery shown on the specimens of record. This difference in look-and-feel is not even mentioned among the critical

differences discussed by the current Trademark Examining Attorney in her appeal brief:

The drawing filed with the application shows the mark as a complete whirlpool design, contained within a rectangle. However, this differs from the specimens, where it appears on two sections of the box for the toothbrushes. Three-quarters of the background design appears on the front of the box, separated from the top one-quarter of the design by a gray band with textual matter, including the term 'SONICARE.' The whirlpool design appears to be a decorative background for the textual matter. Both portions of the background whirlpool design have toothbrushes and flecks of water superimposed over the image. The drawing of the whirlpool design does not contain any additional elements, such as the toothbrushes or flecks of water. Simply put, there are significant differences between the two renditions of the mark. First, the whirlpool design is bisected by the textual term 'SONICARE' and the gray banner. Second, the whirlpool design appears in two sections on two different parts of the product packaging. Third, the whirlpool design has additional elements superimposed on it that cannot be separated visually from the underlying design. These differences serve to render the specimen unacceptable. An amendment to the drawing to add the additional elements would be an impermissible alteration of the original drawing. 37 C.F.R. §2.72(b); TMEP §§807.14, 807.14(a) and 807.14(a)(i).

Again, applicant argues that the Trademark Examining Attorney is in error:

... In this case of a composite mark shown in the specimen, the toothbrush with the flecks of water and the whirlpool design create two separate and distinct visual impressions. The design, being distinctive and recognizable as a swirl or whirlpool, is a

separate mental and visual concept from the toothbrush with water specks and is readily identified as separate in the mind of the consumer. They embody two separate, basically unrelated concepts and are visually quite different. This difference in intellectual concept and visual content results in the design making its own separate visual impression. Accordingly, since the whirlpool design makes its own separate and distinct visual impression a part of the composite mark, the submitted specimen satisfies the requirements of the Trademark Act.

We are mindful of the fact that in an application under §1 of the Trademark Act, the applicant should have some latitude in selecting the mark it wants to register. *Cf.* TMEP §807.14(b). However, in this case, applicant and the Trademark Examining Attorney disagree about whether these visually overlapping elements are separable for registration purposes. The test for whether the applied-for-matter can be registered alone has to do with that oft-quoted but sometimes-nebulous standard of "commercial impression."

In reported decisions, the question is whether one portion of that composite can be registered apart from other matter with which the mark is used on the specimen. The determinative factor is whether or not the subject matter in question makes a separate and distinct commercial impression apart from the other element(s).

We turn first to a case from our primary reviewing Court, *In re Chemical Dynamics Inc.*, 839 F.2d 1569, 5 USPQ2d

1828 (Fed. Cir. 1988). In this case, the Court affirmed the Board's decision that the mark as applied for (the medicine dropper and droplet alone) could not be registered based upon the larger composite image appearing on the specimens:



Drawing

Specimen

In the specimen ("7 DROPS") image, the dropper is in the foreground where it intersects the handle of the watering can, and the droplet is logically coming out of the dropper and falling into the watering can below. Hence, in Chemical Dynamics, it was determined that in the context of this composite design, the applied-for-image was inextricably bound up in the interrelated elements comprising the entire composite, and that applicant's attempt to separate out the dropper and droplet portions resulted in an impermissible mutilation of a single, unified design.

Similarly, in a Board decision, the relationship among various elements of a composite design on the specimens was held to create imagery appearing to be active, dynamic and

almost three-dimensional. In re Boyd Coffee Co., 25 USPQ2d 2052 (TTAB 1993). In this case, the Trademark Examining Attorney refused registration on the ground that the applied-for silhouette of a cup and saucer sitting on a tabletop was a mutilation of the composite mark in actual use, as illustrated by the specimens:



In the Boyd Coffee case, the Trademark Examining Attorney contended that the specimens showed a composite mark featuring the cup and saucer design as well as the sunburst design.⁴ In affirming the refusal of registration in that case, the Board agreed with the Trademark Examining Attorney that the cup and saucer design did not present a separate commercial impression, noting, *inter alia*, that the sunburst design seemed to be emanating from the cup. Boyd Coffee, *supra* at 2053. Similar to the image of a coffee cup and saucer in the Boyd Coffee case, here applicant's whirlpool design is centrally located within the larger imagery on the specimens. Moreover, as in Boyd Coffee, wherein the literal element TECHNI-BREW was deleted from the

⁴ In fact, the Trademark Examining Attorney in the Boyd Coffee case named the overall impression imparted by the specimens as "sunshine-in-a-cup."

mark drawing, applicant in this case has deleted the term SONICARE.⁵

In another Board case, the visual impact of the matter shown in the original drawing creates such a different impression from the usage on the specimens that the drawing was found to represent a mutilation of the graphics as shown on the specimens of record:



While multiple elements comprise the combined imagery in the instant case, consumers who encounter these graphics will be left with an impression of activity, motion, or sonic waves. The toothbrush head in the center of the wave design (especially in view of the logical connection explicitly created several times on these specimens between

⁵ As noted by this Board in the *Boyd Coffee* case, many "mutilation" cases have involved attempts by applicants to register designs or background devices apart from words with which they were used. Often the elements that the respective applicants wanted to extract were inextricably bound together with other design features within the composite, as shown on the respective specimens of record. See *In re Speroulias*, 227 USPQ 166 (TTAB 1985), *In re Volante International Holdings*, 196 USPQ 188 (TTAB 1977), *In re The Library Restaurant, Inc.*, 194 USPQ 446 (TTAB 1977), and *Permatex Company, Inc. v. California Tube Products, Inc.*, 175 USPQ 764 (TTAB 1972). Arguably, that is similar to one of the complaints of the Trademark Examining Attorney in her appeal brief herein, e.g., in the original specimens, the Sonicare® mark appears in the middle of the sonic wave design but is not part of the drawing.

⁶ *In re Miller Sports Inc.*, 51 USPQ2d 1059 (TTAB 1999).

the toothbrush head and the whirlpool or sonic wave design) is proximate, touching and interacting with the design.

Insofar as the involved design will be perceived as representing sonic waves, we find that the foreground image of the automatic toothbrush head is an integral feature of the total imagery. Seen in this light, the toothbrush head combined with the representation of a sonic wave, suggest a dynamic, three-dimensional activity. For example, the design suggests concentric waves that would be emanating outward if the bristles of the vibrating toothbrush head were placed down into the surface of a tub of water.

On the other hand, taking the toothbrush head out of this combined graphic creates a very different image. Moreover, the enlarged toothbrush head with the moving bristles on the specimens totally obscures the epicenter of the design as seen prominently at the center of the drawing. In other words, the center of the design in the drawing is, in practice, not seen by consumers.

In consequence thereof, a properly verified substitute specimen, in which the whirlpool or sonic wave design projects a separate and distinctive commercial impression, would have been necessary in order for applicant to register such design alone as a mark for its goods. Given applicant's failure to comply with this requirement, we

affirm the refusal of the Trademark Examining Attorney to register this matter.

Decision: The refusal to register this design based upon the ground that it does not function as a trademark under Sections 1, 2 and 45 of the Trademark Act is hereby affirmed. Moreover, we affirm the refusal to register based upon applicant's failure to comply with the requirement for a substitute specimen showing use of the mark as it appears on the drawing.