

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Travis McCarthy
Serial Number: 85076553
Filing Date: July 01, 2010
Mark:

Esther Borsuk
Trademark Examining Attorney
Law Office 112
United States Patent and Trademark Office

RESPONSE TO OFFICE ACTION

Dear Madam:

Responsive to the Office Action issued October 14, 2010, please enter the following amendments and remarks:

Amendment to Identification of Goods and Classification and Amendment to Drawings for Configuration Mark and Description begin on page 2 of this paper.

Substantive Remarks/Arguments begin on page 3 of this paper.

I. Amendment to Identification of Goods and Classification

The Examining Attorney has required clarification in the identification and classification of Applicant's goods and services because the nature of the services is unclear. Applicant appreciates the Examining Attorney's suggestion and requests that the application be amended to include the following International Classification and description of goods and services.

IC 016: Containers for food products, namely ice cream, frozen yogurt and frozen confections.

II. Amendment to Drawings for Configuration Mark and Description

The Examining Attorney has suggested that Applicant's drawing consisting of a configuration of the goods or their packaging does not depict a single, three-dimensional view of the goods or packaging, showing only in solid lines those features Applicant claims as his mark. Submitted herewith, is a substitute drawing for the above-referenced application showing in solid lines those features Applicant claims as his mark. Furthermore, Applicant respectfully requests that the following amendment to the description of the mark be admitted as the amended description describes in more clear and concise details those features Applicant claims as his mark.

Description of the Mark

The mark consists of the three-dimensional shape of a disposable coffee cup as packaging for ice cream, frozen yogurt and frozen confections. The packaging consists of a removable lid in the shape of a disposable coffee cup lid without an opening; a thin, removable sleeve for receiving print in the form of labeling and nutritional information, the thin, removable sleeve being no more than two-thirds the total height of the container; and a container in the shape of a disposable coffee cup having a bottom and continuous, tapered cylindrical sidewalls extending upward from the container bottom.

REMARKS

III. Configuration Refusal

The Examining Attorney refused registration of the proposed mark pursuant to Trademark Act Section 2(e)(5), 15 U.S.C. § 1052(e)(5), on the grounds that the mark, which consists of three-dimensional packaging for the goods, appears to be a functional design for such goods. For the following reasons, the Applicant respectfully asserts that his mark is not functional and is inherently distinctive and therefore registrable on the Principal Register. Accordingly, Applicant respectfully request that the Examining Attorney reconsider the statutory refusal and allow Applicant's mark to proceed to publication.

When an applicant applies to register a product design, product packaging, color, or other trade dress for goods or services, the examining attorney must separately consider two substantive issues: (1) functionality; and (2) distinctiveness. *See TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 28-29, 58 USPQ2d 1001, 1004-1005 (2001); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 775, 23 USPQ2d 1081, 1086 (1992) (only nonfunctional distinctive trade dress is protected). In general terms, trade dress is functional, and cannot serve as a trademark, if a feature of that trade dress is essential to the use or purpose of the article or if it affects the cost or quality of the article. *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 165, 34 USPQ2d 1161, 1163-1164 (1995) (quoting *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 850, n.10, 214 USPQ 1, 4 n.10 (1982)). Unlike product design trade dress, trade dress constituting product packaging may be inherently distinctive for goods or services and registrable on the Principal Register without a showing of acquired distinctiveness. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 215 54 USPQ2d 1070 (2000). Here, Applicant's mark is a non-functional three-dimensional configuration for the packaging of ice cream, frozen yogurt and frozen confections. Applying the *Morton-Norwich* factors and the *Seabrook* factors, Applicants mark is both non-functional and inherently distinctive and therefore registrable on the Principal Register.

A. Functionality

The Examining Attorney requested that Applicant provide information and documentation regarding the applied-for three-dimensional configuration to further assess functionality according to the *Morton-Norwich* factors. A determination of functionality normally involves consideration of one or more of the following factors:

- (1) the existence of a utility patent that discloses the utilitarian advantages of the design sought to be registered;
- (2) advertising by the applicant that touts the utilitarian advantages of the design;
- (3) facts pertaining to the availability of alternative designs; and
- (4) facts pertaining to whether the design results from a comparatively simple or inexpensive method of manufacture.

In re Morton-Norwich Products, Inc., 671 F.2d 1332, 1340-1341, 213 USPQ 9, 15-16 (C.C.P.A. 1982). The question of whether a product feature is “functional” should not be confused with whether that product feature performs a “function” (i.e., it is *de facto* functional) or “fails to function” as a trademark. TMEP § 1202.02(a)(v). Almost all objects perform a function, for example, a bottle holds liquid and a packaging configuration contains a product.

In response to the Examining Attorney’s request for information and documentation, Applicant submits the following statements:

(1) The applied-for-mark is not or has not been the subject of a design or utility patent or patent application, including expired patents and abandoned patent applications. It is not necessary that the utility patent be owned by the applicant; a third-party utility patent is also relevant to the functionality determination, if the patent claims the features in the product design sought to be registered. *In re Virshup*, 42 USPQ2d 1403 (TTAB 1997). Applicant, therefore, performed a search of the USPTO database for issued patents and pending patent applications. As a result of this search, Applicant uncovered several design patents covering disposable cups and lids and utility patents not necessarily relevant in the instant case, but instructive. See *Exhibit A*. Design patents cover the invention of a new, original, and ornamental design for an

article of manufacture. 35 U.S.C. § 171. A design patent is a factor that weighs against a finding of functionality, because design patents by definition protect only ornamental and nonfunctional features. TMEP § 1202.02(a)(v)(A). The utility patents are included to demonstrate the typical functional features associated with disposable cups and lids. These patents demonstrate the unique insulating properties associated with the patented product.

Applicant's applied-for-mark, however, does not possess insulating properties. The three-dimensional product packaging is of the same material used by like companies packaging ice cream, frozen yogurts and frozen confections. Applicant's lid is like any other lid used by like companies to enclose any of these frozen products. Applicant, however, is in the business of producing coffee flavored ice cream. Thus, to identify the source of Applicant's products, the packaging includes extraneous features added for no other purpose other than as a source designator. The removable sleeve and shape of the container lid are therefore included for no other purpose than to identify the source of Applicant's goods, namely an ice cream with a bolder coffee flavor. The removable sleeve has no insulating properties or other utility other than as a printing surface for a label and nutritional information. The lid, as stated above, although in the shape of a coffee lid has no openings and performs no function other than sealing the goods within the container.

(2) Applicant, in the advertising, promotional and/or explanatory materials concerning the applied-for-mark, does not tout any utilitarian aspects of the product packaging. What Applicant does tout is a super premium ice cream with a "blacker" and bolder coffee flavor. *See Exhibit B*. Applicant was displeased with the current depth of coffee flavor in coffee ice creams. To remedy the deficiency in current coffee ice creams, Applicant created three bolder and stronger coffee ice creams that actually pack a caffeine kick. In order to distinguish and identify the source of Applicant's blacker and bolder coffee ice creams, the distinctive packaging configuration of the instant application was created.

(3) There are many available alternative designs for packaging the goods of the applied-for-mark. These designs encompass varying dimensions, shapes and configurations including substantially rectangular containers, cup-like containers, cylindrical containers and the like.

Each alternative design includes a lid of like dimensions and shape. Many include labels that are affixed to the container itself or may be printed directly on the container. *See Exhibit C.*

(4) The product packaging at issue does not result from a comparatively simple or inexpensive method of manufacture in relation to alternative designs for the product packaging. The method of manufacture for the applied-for-mark follows the same process and cost structure of the many available alternative designs for packaging the goods. Applicant's product packaging is of the same material used in the many alternative designs and acceptable for packaging ice cream, frozen yogurt and frozen confections.

B. Inherent Distinctiveness

A mark is inherently distinctive if its intrinsic nature serves to identify a particular source. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210 54 USPQ2d at 1068 (citing *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768, 23 USPQ2d 1081 (1992)). The test for determining inherent distinctiveness set forth in *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 1344, 196 USPQ 289, 291 (C.C.P.A. 1977), although not applicable to product design trade dress, is still viable in the examination of product packaging trade dress. The examining attorney should consider the following "Seabrook" factors - whether the proposed mark is:

- (1) a "common" basic shape or design;
- (2) unique or unusual in the field in which it is used;
- (3) a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods;
- (4) capable of creating a commercial impression distinct from the accompanying words.

Applicant's applied-for-mark is not a common basic shape or design in the field of packaging for frozen confections. Although the lid, container and removable sleeve are commonplace for hot coffee and coffee related beverages, the applied-for-mark is nevertheless unique and arbitrary as a container for ice cream and frozen confections. *See In re Fre-Mar*

Industries, Inc., 158 USPQ 364, 367 (TTAB 1968) ("[A]lthough the particular shape is a commonplace one for flashlights, it is nevertheless so unique and arbitrary as a container in the tire repair field that it may be inherently distinctive and, therefore, by reason of its shape alone, serve to identify applicant's goods and distinguish them from like goods of others."); *In re International Playtex Corp.*, 153 USPQ 377 (TTAB 1967) (container configuration having the appearance of an ice cream cone found inherently distinctive as a trademark for baby pants). Applicant's unique packaging configuration for ice cream is inherently distinctive and the combination of the lid, container and removable sleeve serve as a source identifier for Applicant's goods.

Applicant's applied-for-mark is both unique and unusual as packaging for frozen confections. As discussed above there are several alternative designs for packaging ice cream and many of these manufacturers feature coffee ice cream. *See Exhibit D*. The current preferred packaging for ice cream is simply a container of varying dimensions and shapes and a lid configured to enclose the containers of varying dimensions and shapes. Applicant's applied-for-mark goes one step further to include additional unique design elements to distinguish Applicant's goods from others and identify the source of Applicant's products. Because Applicant's product is bolder and stronger coffee flavored ice cream, a lid in the shape of a typical coffee cup and a removable sleeve are included as a source designator.

Applicant's applied-for-mark is not a mere refinement of a commonly-adopted and well-known form of ornamentation for packaging frozen confections viewed by the public as a dress or ornamentation for the goods. As discussed above, the typical packaging for frozen confections consists of a container of varying dimensions and shapes and a lid configured to enclose the containers of varying dimensions and shapes. Applicant's applied-for-mark consists of the additional element of a removable sleeve and a lid in the shape of a typical disposable coffee cup. Thus, it cannot be said that Applicant's applied-for-mark is a mere refinement of a

commonly-adopted and well-known form of ornamentation for packaging ice cream, frozen yogurt or frozen confections.

Accordingly, for the reasons discussed above, Applicant's applied-for-mark, standing alone, creates a distinct commercial impression. The average purchasing consumer would immediately identify Applicant's frozen confection products based solely on the packaging for the same. Other companies selling coffee ice creams use commonly-adopted and well-known packaging configurations for their ice cream products and rely heavily on the accompanying words and logos to identify the source of the products. *See Exhibit E.* Applicant's product packaging configuration, however, creates a unique and distinct commercial impression with the combination of a lid shaped as a disposable coffee cup lid, a removable sleeve commonplace on disposable coffee cups and a container in similar dimensions to that of a disposable coffee cup.

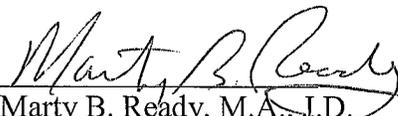
CONCLUSION

Based on the factors discussed above, Applicant's applied-for-mark is both non-functional and inherently distinctive and therefore registrable on the Principal Register. Applicant respectfully requests that the Examining Attorney reconsider the statutory refusal and allow Applicant's mark to proceed to publication.

The Applicant has responded to all relevant issues raised in the Office Action. The Examining Attorney is invited to contact Applicant's undersigned representative if there are any questions relating to this response.

Respectfully submitted,

Date: April 13, 2011


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