

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mark:	Trade Dress Application)	
Filed:	July 28, 2014)	
Applicant:	R B & T's Empires, LLC)	Serial No. 86/349,828
Examining Attorney:	Karen Dindayal)	
	Law Office 117)	

Commissioner for Trademarks
P.O. Box 1451
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RESPONSE TO OFFICE ACTION

On November 24, 2014, the examining attorney issued an Office action refusing registration of the mark based on Section 2(e)(5) because, according to the examining attorney, the mark is functional and on Sections 1, 2, & 45 because, according to the examining attorney, the mark fails to function as a trademark.

Discussion

I. No Conflicting Marks

Applicant hereby acknowledges the Examining Attorney's finding that no registered or pending marks in the USPTO's database present a bar to registration of the applied for mark.

II. Voluntary Amendment to the Mark

Applicant wishes to voluntarily amend the mark as shown below:



III. Voluntary Amendment to the Description of the Mark

Applicant wishes to voluntarily amend the description of the mark to:

The mark consists of a three-dimensional configuration of product packaging for the goods having a window on the front panel and front and back walls joining at the top to resemble a steeple, the matter shown in broken lines is not part of the mark and serves only to show the position or placement of the mark.

IV. Applicant's Amended Mark is Not Merely Functional

The Examining Attorney has refused registration of Applicant's mark based upon her finding that the mark is a functional design for bags. A feature is functional if it is "essential to the use or purpose of the [product]" or "it affects the cost or quality of the [product]." *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33, 58 U.S.P.Q.2d 1001, 1006 (2001). However, Applicant respectfully disagrees with the assertion that the applied-for mark, as amended, is merely functional. Applicant's bag closure design is an ornamental feature that is visually unique and immediately recognizable to purchasers in the relevant industry and thus serves as a source indicator for Applicant. Thus, Applicant's mark is distinctive, ornamental, and non-functional. Applicant's mark is therefore entitled to trademark protection.

The determination of registrability of the mark must focus on whether the visual design embodied in the mark is functional, not whether Applicant's goods themselves are functional. *See, e.g. Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 214 U.S.P.Q. 1 (1982). A configuration can be held functional only when the evidence shows that it provides a specific utilitarian advantage that makes it one of a few superior designs available. *In re Bose Corp.*, 772 F.2d 866, 227 U.S.P.Q. 1 (Fed. Cir. 1985). Applicant acknowledges that bags in general serve a functional purpose. The Examining Attorney notes that there are "several features of applicant's bag [that] appear to be functional including front panel window the handle portion, the triangular section at the bottom and the overall shape of the bag." However, Applicant's amended mark does not seek registration of these features. Applicant submits that its distinctive closure design is a non-functional, ornamental feature of the bag that is entitled to trademark protection. Thus, the ornamental feature of Applicant's closure design, which is the precise element claimed in the mark as amended, is not essential to the purpose of the bag and does not beneficially affect the cost or quality of the bag.

A determination of functionality generally involves consideration of one or more of the *Morton-Norwich* 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 other designs; and
4. Facts pertaining to whether the design results from a comparatively simple

or inexpensive method of manufacture.

In re Becton, Dickinson & Co., 675 F.3d 1368, 1374-75, 102 USPQ2d 1372, 1377 (Fed. Cir. 2012); *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1340-1341, 213 USPQ 9, 15-16 (C.C.P.A. 1982). These factors must focus on whether the exact features claimed as the mark serve a utilitarian function, not whether the article as a whole is useful. *In re Morton-Norwich Prods., Inc.*, 213 U.S.P.Q. at 13. When considering each of these factors in relation to the applied-for mark as amended, Applicant has clearly demonstrated that its mark is not functional.

As an initial matter, neither the applied for mark, nor any features thereof, is or has been the subject of a design or utility patent or patent application. *See* Roth Declaration, Paragraph 6.

Additionally, Applicant's advertising does not promote the utilitarian advantages of the claimed mark. Therefore, there is no advertising available that could be considered under this factor. Thus, there is no evidence to support a determination that the design is functional based on advertising. *See* Roth Declaration, Paragraph 7.

Regarding the third prong, Applicant could have chosen from a variety of different shapes and designs for the bag and specifically for the shape of the closure. These other designs would still be able to accommodate the goods held in the bag. *See* Roth Declaration, Paragraph 10. The availability of alternative designs is relevant to show that the design sought to be registered will not hinder competition. *In re Morton-Norwich Products, Inc.*, 213 U.S.P.Q. at 16. The Supreme Court has clearly indicated that "a product feature is functional, and cannot serve as a trademark, if it is essential to the use or purpose of the article or if it affects the cost or quality of the article." *TrafFix*, 532 U.S. at 33, 58 U.S.P.Q.2d at 1006. And furthermore, "a functional feature is one 'the exclusive use of [which] would put competitors at a significant non-reputation-related disadvantage.'" *Id.* Here, as has already been indicated, a number of different shapes and designs for the bag closure could be used. Indeed, many different designs for bags are used in the marketplace. *See* Roth Declaration, Paragraph 10. The existence of these alternative designs is strong evidence that Applicant's mark is registrable because competitors have numerous options for selecting a bag design.

Finally, Applicant's design does not make the product simpler or less costly to manufacture. In fact, to the best of Applicant's knowledge, the claimed design is both more costly to manufacture and more costly to utilize than competitors' alternative designs. *See* Roth Declaration, Paragraph 11.

In conclusion, Applicant's claimed trade dress, as amended, is not functional; the claimed design is not essential to the use of the bag and does not affect the cost or quality of the product. *See* Roth Declaration, Paragraph 5. Moreover, the Applicant does not own any granted patents or pending patent applications and does not tout any possible utilitarian advantages of the bag. *See* Roth Declaration, Paragraphs 6-7. Therefore, Applicant's mark is registrable.

V. Applicant's Mark is Distinctive

The Examining Attorney rejected Applicant's claim of acquired distinctiveness based on over five years' use and refused registration of Applicant's application because, according to the Examining Attorney, the mark is non-distinctive. As the Examining Attorney pointed out, there are several factors that are considered when determining the inherent distinctiveness of configuration marks:

1. Whether the applied-for mark is a "common" basic shape or design;
2. Whether the applied-for mark is unique or unusual in the field in which it is used;
3. Whether the applied-for mark is 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; and
4. Whether the applied-for mark is incapable of creating a commercial impression distinct from the accompanying words.

In re Pacer Tech., 338 F.3d 1348, 1350, 67 USPQ2d 1629, 1631 (Fed. Cir. 2003) (citing *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 1344 (C.C.P.A. 1977)); TMEP §1202.02(b)(ii). Any one of these factors, by itself, may be determinative as to whether the mark is inherently distinctive. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 1355, 96 USPQ2d 1681, 1687 (Fed. Cir. 2010); *In re Chevron Intellectual Prop. Grp. LLC*, 96 USPQ2d 2026, 2028 (TTAB 2010). However, the following factors are considered when determining whether an applied-for mark has acquired distinctiveness:

1. The length and exclusivity of use of the mark in the United States by Applicant;
2. The type, expense, and amount of advertising of the mark in the United States; and
3. Applicant's efforts in the United States to associate the mark with the sources of the goods.

Here, the applied for mark, as amended, is not a common shape or design in the relevant industry. None of the evidence that the Examining Attorney provided in the Office Action shows a closure design like Applicant's claimed steeple design. The evidence does not suggest that the claimed steeple design is commonly used in the industry. Indeed, none of the evidence relied upon in the Office Action pertained to potato chips. Moreover, the claimed design is unusual in the field in which it is used. Indeed, the evidence provided by the examiner shows that the common design used by competitors in the industry comprises a convex meeting of the walls of the bag. Other designs include not having a closure at all. Conversely, Applicant's design is unique because the walls come together in a convex design that clearly sets the bag apart from its competitors. This is easily recognizable by consumers due to its distinctive look on the shelves when compared to competitor designs.

Moreover, Applicant has been using the claimed design since 2009. *See* Roth Declaration, Paragraph 4. The fact that Applicant has been using the bag for six years combined with the unique nature of the steeple design suggests that the claimed design is in fact distinctive.

And still further, evidence suggests that consumers recognize Applicant's bag design as part of its brand. A review of Applicant's products, attached hereto as Exhibit A, recognizes the "packaging and design" of Applicant's product as "scream[ing] high quality artisan." It is therefore clear that consumers also associate the design of the packaging with Applicant, which further suggests the distinctiveness of the claimed design. As the Applicant's mark is recognized as a source identifier for the goods, trademark protection should be afforded.

VI. Request for Information

In the Office Action the Examining Attorney requests additional information and statements regarding Applicant's mark. Applicant addressed the requests for information above in section IV.

Conclusion

Whether a proposed trade dress mark sought to be registered is functional is a question of fact, depending on the totality of the evidence presented in the case. *In re Becton, Dickinson, & Co.*, 675 F.3d 1368, 1374, 102 U.S.P.Q.2d 1372, 1374 (Fed. Cir. 2012). The balance of factors and evidence in this case indicates that the proposed mark is not functional. There is no utility patent covering the design; Applicant does not advertise or promote the design's utilitarian advantages; there are many other designs that are still available, the design has no effect on the use of the bag; and finally, the design does not result from the simple or inexpensive design. *See* Roth Declaration, generally.

Applicant's mark is comprised of ornamental features that are visually unique and immediately recognizable to purchasers in Applicant's industry, thereby serving as a source indicator for Applicant. Its mark is distinctive, ornamental and non-functional, thereby entitling Applicant's mark to trade dress protection. In light of the foregoing remarks, Applicant respectfully requests that the examiner withdraw the functional refusal, and allow the mark to register on the Principal Register.

Applicant believes that all outstanding issues in the November 24, 2014 Office action are addressed in this response and respectfully requests withdrawal of the rejection. Should any outstanding issues remain, please contact the attorney of record.