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This Opinion is Not Citable as Precedent of the TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Sunrider Corporation, dba Sunrider International

Serial No. 74716136

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The Sunrider Corporation.

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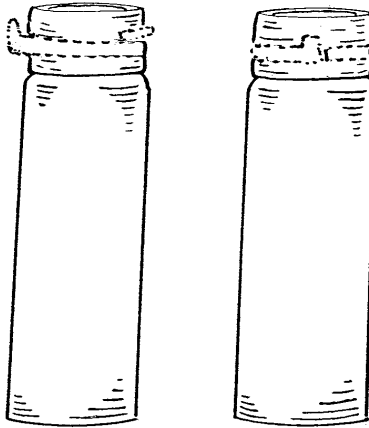
Before Hohein, Hairston and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

The Sunrider Corporation has applied to register, as a mark for goods ultimately identified as "nutritional supplements" in Class 5 and "herbal food beverages" in Class 30, certain elements of the trade dress embodied in the packaging for its goods. The drawing of the proposed mark, and the description thereof, has been amended on numerous occasions during the prosecution and examination of the application. These changes affect the issues to be

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addressed in deciding applicant's appeal. For now, so that we may provide some framework for our discussion and analysis, we set forth below the most recently submitted drawing, which appears in the USPTO's TARR, X-Search and PCTram databases.



We also set forth the most recently submitted description of the proposed mark:

The mark consists of a configuration of a three-stage bottle cap having a generally constant diameter. The top section is a cap with a small tab protruding from the side which enables the consumer the ability to lift the cap up to access the contents of the container. The middle section consists of a tamper-evident, safety-tab-seal ring with a pull-tab protrusion that allows the consumer to remove the ring to permit the opening of the top section of the cap. The bottom section consists of a solid ring that adheres to the neck of the container. Between the top and bottom section is a small connector which remains after the middle section or safety-tab-seal ring has been removed and appears to be

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inclusive of the middle section until such action is taken. The dotted lines shown in the drawing are not part of the mark but are merely intended to show the position of the mark on the goods packaging.

The Substantive Refusals

The above drawing and description were submitted after applicant had filed an appeal from the examining attorney's refusal to register the proposed mark, which presents various issues for our consideration. In the November 18, 1998 final refusal of registration that precipitated applicant's appeal (which hereinafter is referred to as the "substantive final"), the examining attorney essentially refused registration of the proposed mark under Sections 1, 2 and 45 of the Lanham Act, 15 U.S.C. §§ 1051, 1052 and 1127, on the ground that the proposed mark is functional, and on the ground that the proposed mark is merely trade dress having neither inherent distinctiveness nor acquired distinctiveness. This office action did not contain any requirements regarding the then extant drawing and description of the mark, or discuss the question whether the drawing showed the mark illustrated by applicant's specimens of use. However, the examining attorney later wrote, in his appeal brief, that his review of the record while preparing his brief led him to conclude that

applicant's description of its proposed mark did not match the drawing, and that the drawing did not match the specimens. Accordingly, the examining attorney submitted not only his brief but also a request for remand, which the Board granted.

Before we address what occurred following remand, we pause to note that the substantive final argued in the alternative that applicant's proposed mark was a de jure functional configuration or, if not, it was at least a de facto functional configuration which was neither inherently distinctive nor possessed of acquired distinctiveness. However, when the examining attorney filed his brief in response to applicant's appeal brief, he wrote as follows: "The applicant has argued that the proposed configuration mark is not de jure functional throughout the record. In doing so, the applicant has stated that the proposed mark is de facto functional. The examining attorney agrees." Also, in the brief's conclusion, the examining attorney asked that the refusal to register under Sections 1, 2 and 45 of the Lanham Act be affirmed, on the ground that the proposed mark is not inherently distinctive and has not been shown by applicant to have sufficient acquired distinctiveness to allow for registration under Section 2(f) of the Lanham Act, 15 U.S.C. §1052(f). In short, we

view the examining attorney as having withdrawn any refusal based on "functionality."¹

Requirements Made Following Remand

On remand, the examining attorney issued a non-final office action that asserted: (1) the drawing of applicant's proposed mark did not match the specimens of use because it depicted the protruding tab on the middle level of the cap of applicant's container "in a downward position," while the specimens showed it "in an outwardly upward position"; (2) that the description of the mark was incorrect because it referred to the entire container, rather than just the cap, notwithstanding that applicant had previously amended its drawing to depict the cylindrical bottle in dotted or

¹ This application involves substantive refusals that were issued prior to the amendment of the Lanham Act to include a separate section providing for refusal of a proposed mark on the grounds that it is functional. See Lanham Act Section 2(e)(5), 15 U.S.C. § 1052(e)(5). Prior to that amendment, functionality refusals were often discussed in terms of whether a proposed mark, usually trade dress, was de jure functional or whether it was only de facto functional but neither inherently distinctive nor possessed of acquired distinctiveness. De facto functionality is not an alternative basis for a functionality refusal, it simply means that the configuration embodied by trade dress proposed for registration has a function. Under the parlance of prior practice, when an examining attorney did not press a de jure functionality refusal, the grounds for refusing de facto functional trade dress were rooted in Lanham Act Sections 1, 2, 45. See discussions in Sections 1202.02(a)(iii)(A)-(B) of the Trademark Manual of Examining Procedure (TMEP) (3rd ed., rev. 2). Thus, when the examining attorney in this case withdrew the de jure functionality refusal, he effectively restricted the substantive refusal to Sections 1, 2, 45.

broken lines, thereby indicating that the bottle was not a part of the proposed mark; and (3) that the drawing needed further amendment (apart from amending it to match the specimens) because the tab on the top of the three sections of applicant's cap, and the "outwardly upward" protrusion on the middle section are de jure functional and have no trademark significance. These requirements were eventually made final (the action making them final hereinafter is referred to as the "requirements final").

We do not view the examining attorney's statement that certain *features* of the three-level cap for applicant's container are de jure functional as being inconsistent with his withdrawal in his brief of his prior de jure functionality refusal as to the proposed mark in its *entirety*. Likewise, when the examining attorney also stated in the requirements final that the refusal of registration on the ground that the proposed mark is functional was being maintained, in our estimation, this was only an expression of the examining attorney's view that the proposed mark was, under then extant parlance, de facto functional.

Applicant eventually adopted the description of the mark that is set forth earlier in this decision as its

final word on that subject.² The examining attorney has accepted it. Accordingly, the assertion in the "requirements final" that the description of the proposed mark was unacceptable is no longer an issue on appeal. Having adopted a description of its proposed mark that focuses on the cap for its container, applicant's submission in response to the requirements final of a substitute drawing which shows the bottle in solid rather than broken lining is viewed as inadvertent error. We do not construe applicant's actions as a deliberate attempt to, on the one hand, adopt a description that limits its mark to the cap and, on the other hand, submit a drawing that claims the entire container. We conclude that applicant, in attempting to address that portion of the requirements final in which the examining attorney argued that certain elements of the three-level cap were de jure functional, focused so intently on the cap that it

² Applicant had often argued, during prosecution of the application, that its proposed mark was not merely the cap for its bottle, but the entire container. In fact, following remand, applicant's response to the examining attorney's non-final action focusing on the drawing, description and specimens, maintained that applicant was seeking registration of the entire container, notwithstanding that it had earlier submitted a substitute drawing showing the bottle portion of the container in dotted or broken lining. Applicant's ultimate acceptance of the description of the mark as proposed by the examining attorney effectively abandoned that position.

neglected to present the bottle in broken lining that would match its description.³

We now address that aspect of the requirements final that argued applicant's previous drawing did not match the specimens of use. In essence, this is no longer an issue in this case. First, we disagree with the examining attorney that none of the specimens shows the protruding tab on the middle ring of the cap extending in a downward direction. Some of the specimens show this tab extending in a downward direction, while others show it appearing in an upward direction. Whether this is an optical illusion we cannot say. However, as applicant has now submitted a drawing which presents the tab on the top level of the cap in broken lining, and the entire middle ring, including the debated protruding tab thereon, in broken lining, these aspects of the cap are not claimed as part of the mark. It is therefore insignificant whether the specimens uniformly show the protruding tab of the middle ring extending upward or downward.

³ Also, it was error for applicant to submit a drawing with two renditions of the proposed mark. See TMEP Section 807.12 (3rd ed., rev. 2). Accordingly, if applicant should ultimately obtain approval of its proposed mark for registration, it should submit an amended drawing limited to one rendition of the mark, and showing the bottle portion in broken lining, so that the drawing will match the description.

Decision on Substantive Refusals

Having addressed the issues raised by the requirements final, we now turn back to the issues raised by the substantive final. We also note that the Board provided both applicant and the examining attorney the opportunity to file supplemental briefs, after filing of applicant's response to the requirements final. Neither, however, chose to file an additional brief. Accordingly, the only briefs on the issues raised by the substantive final are applicant's main brief and the examining attorney's responsive brief, both filed prior to remand.

As noted earlier, because the examining attorney withdrew the functionality refusal, the substantive issues we must address are limited to whether applicant's three-level cap is inherently distinctive trade dress or, if not, whether it has acquired distinctiveness. Moreover, because applicant has acceded to the examining attorney's requirement that certain elements of its cap be presented in broken lining -- in essence a requirement that applicant disclaim exclusive rights in these elements -- we need only consider whether the connected top and bottom levels of applicant's cap, sans the tab that allows a consumer to open the top, are either inherently distinctive or have acquired distinctiveness.

In In re Creative Beauty Innovations Inc., 56 USPQ2d 1203 (TTAB 2000), the Board found the configuration of a container for "bath salts, bath powders, shower gels, body oils, bath oils, body lotions, and creams" to be inherently distinctive. The container -- concave on one side and convex on the other, with a cap elongated on one side so as to arc down over the front face of the bottle -- was found to be unique and unusual rather than a mere refinement of a common bath product bottle. Id. at 1207. In reaching its decision, the Board relied on, inter alia, a *Packaging World* article that termed the container an "attention-getting package" created when the applicant therein went to great lengths to differentiate its first branded line from other products on the market; and the article noted that the packaging was a gold award winner in a competition sponsored by the National Association of Container Distributors. Id.

The instant case is nothing like the *Creative Beauty* case. Applicant, now limited to claiming the top and bottom elements of its three-level cap, is essentially claiming that a plain geometric shape -- a circular disk -- that forms the top of its cap for a cylindrically shaped bottle, when coupled with the equally plain geometry of the bottom ring that is attached to the top disk by a band so

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that the top cannot be lost, creates an inherently distinctive trade dress. In *Creative Beauty*, the Board held "when the design at issue is only a common geometric shape, for example, a circle, oval, square or triangle, it is not necessary for the examining attorney to provide evidence that such a design is a common geometric shape" and the applicant in such a case would have to present evidence supporting its request for registration. Id. at 1205.

Applicant's coupling of the plain geometric shapes of a disk and a ring is precisely the type of circumstance contemplated by *Creative Beauty*. Accordingly, even if there were no evidence in the record, we would hold that these common geometric shapes, notwithstanding their linkage by a band to prevent the top level of the cap being lost, do not comprise an inherently distinctive mark. See In re Pacer Technology, 338 F.3d 1348, 67 USPQ2d 1629 (Fed. Cir. 2003), relying on Seabrook Foods, Inc. v. Bar-Well Foods Ltd., 568 F.2d 1342, 196 USPQ 289, 291 (CCPA 1977) (determining whether a design is inherently distinctive involves consideration of, inter alia, whether design is a common basic shape or unique and unusual in a field).

There is, in any event, evidence in the record that shows that applicant's cap design would not be perceived as

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unique or unusual in its field. Applicant has contended that its competitors typically package concentrated liquid nutritional or dietary supplements in bottles that have eye-dropper caps, rather than a cap like that of applicant. The examining attorney, however, has put in the record (see requirements final) photocopies of two examples of dietary supplements that utilize three-level caps very similar to that of applicant. Even though these products do not appear to be liquid concentrates, they appear to be the types of products that would be marketed in the same places and in the same manner as applicant's identified goods. Thus, consumers of dietary or nutritional supplements would not be likely to perceive applicant's cap as a design on which to rely to differentiate applicant's product from those of competitors. See *Pacer Technology*, 67 USPQ2d at 1632 (design patents for cap designs similar to that of the applicant held sufficient evidence that consumers would not find Pacer's cap unique or unusual, even in the absence of evidence of use of the patented designs). See also, *Tone Bros., Inc. v. Sysco Corp.*, 28 F.3d 1192, 31 USPQ2d 1321 (Fed. Cir. 1994) (trade dress is inherently distinctive only if it is such "that a buyer will immediately rely on it to differentiate the product from those of competing manufacturers"). Further, although the specimens show

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applicant uses the container and cap shown in its drawing for liquid concentrates, its identification of its Class 5 goods reads simply "nutritional supplements" and thus any registration applicant would obtain would cover use of the cap design for any nutritional supplements, be they liquid, powder, tablets or capsules. Use of the cap design for containers for non-liquid forms of nutritional supplements would place applicant's products and container cap even closer to those containers and caps put in the record by the examining attorney.

We affirm the refusal of registration on the ground that the claimed elements of applicant's cap design do not comprise an inherently distinctive design, for the examining attorney has established a prima facie case for such refusal. See *Pacer Technology*, 67 USPQ2d at 1632 ("to meet its prima facie burden, the PTO must, at a minimum, set forth a 'reasonable predicate' for its position of no inherent distinctiveness"). Applicant has not rebutted that case by its mere assertion that its proposed mark is more distinctive than trade dress registered by the USPTO in three registrations granted to other parties. We have not been provided with copies of those registrations, but we have nonetheless checked USPTO records and found that each was registered under a claim of acquired

distinctiveness pursuant to Section 2(f) of the Lanham Act. Thus, they do not in any way support applicant's claim that its proposed mark is inherently distinctive.⁴ Finally, we are not persuaded that applicant's proposed mark is inherently distinctive by the three declarations applicant has made of record -- one each from a consumer of applicant's products, a distributor of applicant's products, and from applicant's president. In large part, each of these declarations discusses applicant's container in its entirety, including the bottle and all elements of the cap, for they were submitted when applicant was maintaining its claim that its entire container was registrable. The declarations are not particularly probative on the question whether only certain claimed elements of applicant's cap are registrable. Thus, we find applicant has not rebutted the prima facie case by the examining attorney establishing that the proposed mark is not inherently distinctive.

Applicant argues in the alternative that its trade dress has acquired distinctiveness and may be registered

⁴ Even if these registrations had been made of record and were registrations issued on the Principal Register without resort to Section 2(f), they would not constitute evidence that applicant's proposed mark is distinctive. Each case must be decided on its own record and decisions made to register other marks, on different records are of little guidance. In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001).

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under Section 2(f) of the Lanham Act. On this issue, it is applicant that bears the burden of proof. In re Hollywood Brands, Inc., 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954) ("There is no doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant."). Applicant need not conclusively establish acquired distinctiveness, but must present a prima facie case for registration. In re K-T Zoe Furniture Inc., 16 F.3d 390, 29 USPQ2d 1787, 1789 (Fed. Cir. 1994). Moreover, the evidence must relate to the specific goods or services set forth in the application and the specific mark for which registration is sought, and the amount of evidence that will be deemed adequate will vary depending on the nature of the mark. See Id. and Yamaha International Corp. v. Hoshino Gakki Co., 840 F.2d 1571, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988) ("the standard of proof in an opposition under section 2(f) has always been a preponderance of the evidence, although logically that standard becomes more difficult to meet as the mark's descriptiveness increases"). See also, In re Gammon Reel, Inc., 227 USPQ 729, 730 (TTAB 1985) ("In determining whether a designation has acquired secondary meaning, we must look at the character of the subject matter for registration and the specific evidentiary record presented. This is clearly a

subjective factual determination and the question and character of the evidence necessary to satisfactorily prove acquired distinctiveness will vary from case to case.").

In this case, as we have discussed, the elements of applicant's cap that it seeks to register comprise a circular disk (the top level of its three-level cap) and a ring (the bottom level of the cap) connected by band. These are not only common geometric shapes, but also particularly suited to covering a cylindrical bottle (via the circular disk) and ensuring that the covering is not detached or separated from the bottle (via connection to the retention ring). In addition, measurements taken of one of applicant's bottles submitted as a specimen reveal that, including its cap, the bottle is approximately three inches long and three-quarters of an inch in diameter; and the entire cap is only about one-half inch high and three-quarters of an inch in diameter. In short, the container and, more specifically, its cap, are rather diminutive. Under these circumstances, the evidence of acquired distinctiveness sufficient to present a prima facie case for registration under Section 2(f), we find, ought to be rather significant. See In re Sandberg & Sikorski Diamond Corp., 42 USPQ2d 1544, 1548 (TTAB 1997) ("In view of the ordinary nature of these designs and the common use of gems

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in descending order of size on rings, applicant has a heavy burden to establish that its configuration designs have acquired distinctiveness..."). We find, however, that there is not significant evidence of acquired distinctiveness in this case.

Applicant's president has submitted a declaration attesting to five years substantially exclusive and continuous use of the proposed mark in interstate commerce, and to growth in annual sales of products packaged in applicant's container from 130,000 units in 1993 to 1,350,000 units in 1996. There is a second declaration from applicant's president, as well as one each from a distributor and a consumer; and all of these discuss the perceived distinctiveness of applicant's container. On the other hand, applicant conceded in its response to the first office action of the examining attorney that it does not advertise its products and only has brochures showing its packaged products, which its distributors show to potential purchasers.

While a statement of five years of continuous and substantially exclusive use of a proposed mark may be accepted as prima facie evidence of distinctiveness, more evidence may be required, depending on the nature of the design sought to be registered. In re R.M. Smith, Inc.,

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734 F.2d 1482, 222 USPQ 1, 3 (Fed. Cir. 1984) (Court affirmed Board's finding of lack of acquired distinctiveness notwithstanding eight years of continuous and exclusive use). See also, In re Cabot Corp., 15 USPQ2d 1224 (TTAB 1990), wherein applicant claimed in each of two applications seeking registration for the packaging for its ear plugs, five years substantially exclusive and continuous use. In that case, the examining attorney found acquired distinctiveness for the package utilizing a blue and white color scheme, as applicant utilized "look for" advertising which highlighted the colors, but distinctiveness was not found in the application seeking registration of the package per se, without a claim as to use of particular colors. In contrast, see In re EBSCO Industries Inc., 41 USPQ2d 1917 (TTAB 1997), wherein the Board found applicant's fishing lure design to have acquired distinctiveness based on, inter alia, 40 years of use.

As for applicant's sales figures and the increase in sales over a period of years, healthy sales alone do not prove purchaser recognition of a design proposed for registration. See In re Bongrain International (American) Corp., 894 F.2d 1316, 13 USPQ2d 1727, 1729 (Fed. Cir. 1990) (growth in sales may be indicative of popularity of product

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itself rather than recognition of a term or design as denoting origin) and WLWC Centers, Inc. v. Winners Corp., 563 F.Supp. 717, 221 USPQ 701, 707 (M.D. Tenn. 1983) (popularity in sales alone cannot establish secondary meaning). See also, *Sandberg & Sikorski*, 42 USPQ2d at 1548.

Applicant, inasmuch as it does not advertise its products, cannot rely on "look for" advertising, as could the applicant in *Cabot*. See also, In re Parkway Machine Corp., 51 USPQ2d 1201, 1205 (TTAB 1999) ("Applicant has not promoted the asserted mark herein as a trademark and does not mention the asserted mark in its product catalogs."). Nor do applicant's specimen brochures used by its distributors promote recognition of the design. See *Sandberg & Sikorski*, 42 USPQ2d at 1548 ("None of applicant's advertising demonstrates promotion of this particular feature of applicant's wrap rings as its marks.").

Applicant could have argued that this case is similar to *Gammon Reel*, wherein acquired distinctiveness was found in the design of a surveyor's reel, insofar as both that case and this case involve limited declarations attesting to acquired distinctiveness (two in *Gammon Reel*, three here). However, we find the comparison unavailing. In

Gammon Reel, the Board relied on the five years use statement, the declarations of two individuals, and a finding made by the International Trade Commission in a separate proceeding that the *Gammon Reel* applicant's design had become distinctive. In the instant case, there is no separate proceeding that found applicant's proposed mark distinctive. Moreover, focusing solely on the differences between the declarations in *Gammon Reel* and in this case, though there was one less declaration in *Gammon Reel* than there is in this case, the *Gammon Reel* declarants testified to long periods of use of the design involved therein, whereas the declarations made of record by applicant in this case cover a more limited period of use. The declaration of Don Caster, a distributor of applicant's products, and the declaration of applicant's president attest to six years use of applicant's container. More significantly, these two declarations and that of a consumer, Lisa Hamilton, discuss the purported distinctiveness of applicant's entire container and, in particular, the protruding tear strip on the middle level of the cap. As we have already noted, these are no longer elements of the trade dress which applicant seeks to register. In short, the declarations proffered in this case are not as probative as those in *Gammon Reel*.

The totality of the evidence of acquired distinctiveness is not sufficient to allow applicant to meet its burden of proving acquired distinctiveness. Accordingly, we find that applicant has not overcome the refusal under Sections 1, 2 and 45 by demonstrating a right to registration under Section 2(f).

The final substantive issue to be addressed is applicant's assertion in its brief that its proposed mark is at least entitled to be registered on the Supplemental Register. The examining attorney argued in his responsive brief that applicant had unequivocally withdrawn its earlier request for registration on the Supplemental Register and had chosen to pursue registration on the Principal Register, claiming, in the alternative, that the proposed mark is either inherently distinctive or has acquired distinctiveness. The examining attorney argues that telephone discussions between applicant and the examining attorney, regarding the Supplemental Register but conducted after the applicant made the choice noted above, did not provide applicant the right to argue on appeal, as a third alternative, for registration on the Supplemental Register. We agree with the examining attorney. At a minimum, had applicant believed this issue was properly a subject for appeal, it ought to have filed a supplemental

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brief, when it was afforded by the Board an opportunity to file such, and presented further argument on the issue. We find the question of registrability on the Supplemental Register is not an issue properly preserved for appeal and have not considered the question.

Decision: The refusal of registration on the ground that the mark in the drawing does not match the mark in the specimens is reversed; the refusal of registration on the ground that applicant's trade dress does not function as a mark because it is neither inherently distinctive nor possessed of acquired distinctiveness is affirmed.