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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **The Dial Corporation**

Serial No. 75/**376,066**

Rebecca S. Nittle, Esq. for **The Dial Corporation.**

Lourdes D. Ayala, Trademark Examining Attorney, Law Office
106 (**Mary Sparrow**, Managing Attorney).

Before **Cissel**, **Wendel** and **Rogers**, Administrative Trademark
Judges.

Opinion by **Rogers**, Administrative Trademark Judge:

Applicant has applied to register the design shown
below as a trademark for "instant hand sanitizing
preparation with antibacterial properties," in
International Class 5.¹



¹ Serial No. 75/376,066, filed October 20, 1997, alleging a date
of first use and of first use in commerce of October 6, 1997.

The Examining Attorney refused registration of the two droplets design², under Sections 1, 2, and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052, 1127, on the ground that the design is mere ornamentation or decoration for applicant's product packaging and would not be perceived as a mark indicating the source of the product.

Although there is no description of applicant's mark in the record, and although none of the specimens shows precisely how the mark is affixed to the packaging for applicant's goods, the Examining Attorney concluded that "it appears that the mark will cover the entire back portion of the bottle" and "will then be seen by a consumer through the liquid or product in the bottle."

The Examining Attorney posits that if the design "were small, neat and discrete" it might function as a mark, but because of the design's "large size, where it is placed, and the way and how [sic] it is used make the mark appear as ornamental."

During prosecution of the application, the Examining Attorney offered applicant the option of pursuing registration under Section 2(f) of the Trademark Act, 15

² Applicant refers to the design as "nested droplets," while the Examining Attorney refers to it as "nestling droplets." The nomenclature is unimportant.

U.S.C. § 1052(f), and the alternative of attempting to establish that the design is a "secondary source indicator." See Section 1202.04 of the Trademark Manual of Examining Procedure [TMEP], which offers these as the two options for an applicant to overcome an Examining Attorney's refusal to place on the Principal Register that which is held principally ornamental, rather than source indicating.

When the refusal of registration was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs, but an oral argument was not requested.

In support of the refusal, the Examining Attorney introduced into the record four photographs showing filled containers for two household cleaning products and two hair shampoos. These photographs, according to the Examining Attorney, establish "that it is a common practice in the industry to place a design on a label which is affixed to the back of product packaging so a consumer may see the design through the bottle."³

³ The applicant has criticized the poor quality of the photographs. We must agree, as we cannot actually see the designs on the backs of the bottles that are captured in the photographs. The Examining Attorney states that they are "flowers and herbs, radiating sunlight or tiles." (Examining Attorney brief p. 6) Applicant does not contest this statement in its reply brief. Since the photographs were not, however, introduced to show anything about the particular designs on the pictured products, or similar designs, we need not make any

Applicant has not contested the Examining Attorney's assertion that the photographs all show examples of trade dress featuring rear label designs that are visible when viewing the product container from the front. Applicant does, however, challenge "the premise that devices placed on the back panel of transparent bottles are not inherently distinctive." Further, applicant argues that for the photographs to have any probative value, the Examining Attorney would have to establish "that the various devices shown in the photos had indeed been held not to be inherently distinctive."

The latter contention by applicant clearly contemplates that the designs utilized on the photographed products may themselves be source indicating and the Examining Attorney cannot presume that they are not. In this regard, we note that, subsequent to the briefing of this case, the Supreme Court discussed trade dress in the nature of product packaging in its *Wal-Mart* decision. The discussion directly relates to applicant's criticism of the Examining Attorney's arguments in this case.

The Court said:

The attribution of inherent distinctiveness to certain categories of word marks and product

findings of fact about the nature or distinctiveness of the designs themselves.

packaging derives from the fact that the very purpose of attaching a particular word to a product, or encasing it in a distinctive packaging, is most often to identify the source of the product.

Wal-Mart Stores, Inc. v. Samara Brothers, Inc., 2000 U.S. Lexis 2197 at *15, 120 S.Ct. 1339, 1344, 146 L.Ed.2d 182, 190, 54 USPQ2d 1065, 1068 (2000).

The Court also noted that, although "packaging can serve subsidiary functions... for instance... a garish form of packaging... may attract an otherwise indifferent consumer's attention on a crowded store shelf," the "predominant function [of packaging] remains source identification. Consumers are therefore predisposed to regard those symbols as indication of the producer...." *Id.* The Court, however, recognized that there will be cases "where it is not reasonable to assume consumer predisposition to take... packaging as indication of source". *Id.*

The Examining Attorney clearly believes that, in this case, it is not reasonable to assume that consumers of applicant's goods will be predisposed to view the two droplets design as a trademark. The thrust of the argument is that the design is large, and the placement of the design on the rear of the bottle, albeit in a manner where it can be seen from the front, is a common practice, therefore it will serve only to attract the consumer's

attention, as in the Supreme Court's allusion to "garish packaging."

The Examining Attorney relies on cases that the applicant says are distinguishable. On this point, we agree with the applicant.

The applicant correctly distinguishes the type of trade dress involved in this case from the "T-shirt cases [relied on by the Examining Attorney] which hold that the small design which appears over the breast pocket of a T-shirt is probably regarded as a trademark" while larger designs emblazoned across the front are not. The T-shirt ornamentation cases make clear that the *raison d'être* for a prominent display of a design or slogan on a T-shirt, tote bag, mug or bumper of a vehicle or the like is not source identification, but the display of the design or slogan itself.⁴ These cases are of little utility, however, in assessing the commercial impression of a design on the packaging for a hand cleaner.

While the T-shirt cases hold that, for certain types of products, smaller, more discrete uses of designs are more likely to be perceived as trademarks than are big and

⁴ See, e.g., In re Dimitri's Inc., 9 USPQ2d 1666 (TTAB 1988), In re Astro-Gods, Inc., 223 USPQ 621 (TTAB 1984), and In re Tilcon Warren, Inc., 221 USPQ 86 (TTAB 1984).

bold designs, we do not, by distinguishing those cases from the case at hand, hold that "bigger is better" in all cases involving trade dress in the nature of product packaging or elements thereof. Each case must be decided on its own merits and the size of the design is but one factor to be considered in assessing the distinctiveness of a design used on product packaging.

The applicant also is correct in distinguishing the *F.C.F.* case. In that case, there was evidence of record showing use of floral designs is common for the involved goods. In re F.C.F. Inc., 30 USPQ2d 1825, 1827-28 (TTAB 1994). In the case at hand, we have no evidence whatsoever regarding whether drops or droplets are commonly used for applicant's goods or any similar goods.

In view of the Court's recognition of the predisposition of consumers to perceive product packaging as source indicating, even if it is also a means for attracting attention, to determine whether applicant's design is an exception we must consider such issues as placement of the design, its clarity or perceptibility, whether it is descriptive, suggestive or arbitrary when considered in connection with the goods, and whether the design is merely a variation on a common theme, or something unique and different.

In this case, the Examining Attorney clearly considered the issue of the placement of the design and whether placement on the rear of a container, in a way that the design can still be perceived from the front, is common. The Examining Attorney did not, however, require applicant to provide evidence showing the mark as it is actually used on a container, so we have no evidence on how clearly it would be seen by a consumer. Such a request could have been made pursuant to Trademark Rule 2.61(b), 37 C.F.R. §2.61(b). See also, TMEP Sections 1103.04 and 1105.02. Similarly, the Examining Attorney does not appear to have attempted to assess the distinctiveness of applicant's design when used in connection with applicant's goods.⁵

The tests for distinctiveness articulated in the *Abercrombie* and *Seabrook* decisions were both available.

⁵ While the Examining Attorney finds that the *placement* of applicant's design is common, we discern no analysis of the design itself. We do not consider the Examining Attorney's suggestion to the applicant that it consider seeking registration under Section 2(f) as an indication that distinctiveness of the design itself was considered. Rather, the suggestion appears to have been made solely to inform the applicant that resort to Section 2(f), like reliance on "secondary source," is an option for an applicant whose design is refused registration as ornamental matter. Nor do we consider the Examining Attorney's observation (emphasis added) that "[w]hen the applicant's mark is viewed *by itself*, it *could* function as a mark. ...it *could* even be a unique or unusual design in this particular field," as indicative of any analysis of distinctiveness. The observation is entirely equivocal and suggests no serious consideration of the distinctiveness of the design *vis a vis* the identified goods.

See, respectively, Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 9, 189 USPQ 759, 764 (2d Cir. 1976), and Seabrook Foods, Inc. v. Bar-Well Foods Ltd., 568 F.2d 1342, 1344, 196 USPQ 289, 291 (CCPA 1977). See also, In re Creative Beauty Innovations, Inc., ____ USPQ2d ____ (TTAB 2000) (Ser. No. 75/307,417), which found the tests complementary, rather than mutually exclusive, for assessing distinctiveness of product packaging. Indeed, the Trademark Manual of Examining Procedure appears to contemplate analysis of the distinctiveness of applicant's design under these tests. See, e.g., TMEP Section 1202.04(a) ("An arbitrary or fanciful word or design which may be construed as indicating source or origin creates the commercial impression of a trademark."), and TMEP Section 1202.04(b) ("In determining whether a proposed mark is inherently distinctive, factors to be considered include the issue of whether the subject matter is unique or unusual in a particular field.").

The Examining Attorney bears a burden of making out a prima facie case for refusal, of establishing why "it is not reasonable to assume consumer predisposition" to view applicant's design as an indication of source. In this case, the burden has not been met.

Decision: The refusal of registration under Sections
1, 2 and 45 is reversed.

R. F. Cissel

H. R. Wendel

G. F. Rogers

Administrative Trademark
Judges, Trademark Trial
and Appeal Board