

1202.02(a) Functionality of Trade Dress

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 Prods. Co.*, 514 U.S. 159, 165, 34 USPQ2d 1161, 1163-64 (1995) (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850, n.10, 214 USPQ 1, 4, n.10 (1982)).

1202.02(a)(i) Statutory Basis for Functionality Refusal

Before October 30, 1998, there was no specific statutory reference to functionality as a ground for refusal, and functionality refusals were thus issued as failure-to-function refusals under §§1, 2, and 45 of the Trademark Act, [15 U.S.C. §§1051](#), [1052](#), and [1127](#).

Effective October 30, 1998, the Technical Corrections to Trademark Act of 1946, Pub. L. No. 105-330, §201, 112 Stat. 3064, 3069, amended the Trademark Act to expressly prohibit registration on either the Principal or Supplemental Register of functional matter:

- Section 2(e)(5) of the Trademark Act, [15 U.S.C. §1052\(e\)\(5\)](#), prohibits registration on the Principal Register of "matter that, as a whole, is functional."
- Section 2(f) of the Act, [15 U.S.C. §1052\(f\)](#), provides that matter that, as a whole, is functional may not be registered even on a showing that it has become distinctive.
- Section 23(c) of the Act, [15 U.S.C. §1091\(c\)](#), provides that a mark that, as a whole, is functional may not be registered on the Supplemental Register.
- Section 14(3) of the Act, [15 U.S.C. §1064\(3\)](#), lists functionality as a ground that can be raised in a cancellation proceeding more than five years after the date of registration.
- Section 33(b)(8) of the Act, [15 U.S.C. §1115\(b\)\(8\)](#), lists functionality as a statutory defense to infringement in a suit involving an incontestable registration.

These amendments codified case law and the longstanding USPTO practice of refusing registration of functional matter.

1202.02(a)(ii) Purpose of Functionality Doctrine

The functionality doctrine, which prohibits registration of functional product features, is intended to encourage legitimate competition by maintaining a proper balance between trademark law and patent law. As the Supreme Court explained, in *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164-165, 34 USPQ2d 1161, 1163 (1995):

The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature. It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time, 35 U.S.C. Sections 154, 173, after which competitors are free to use the innovation. If a product's functional features could be used as trademarks, however, a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever (because trademarks may be renewed in perpetuity).

In other words, the functionality doctrine ensures that protection for utilitarian product features be properly sought through a limited-duration utility patent, and not through the potentially unlimited protection of a

trademark registration. Upon expiration of a utility patent, the invention covered by the patent enters the public domain, and the functional features disclosed in the patent may then be copied by others – thus encouraging advances in product design and manufacture. In *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 34-35, 58 USPQ2d 1001, 1007 (2001), the Supreme Court reiterated this rationale, also noting that the functionality doctrine is not affected by evidence of acquired distinctiveness.

Thus, even when the evidence establishes that consumers have come to associate a functional product feature with a single source, trademark protection will not be granted in light of the public policy reasons stated. *Id.*

1202.02(a)(iii) Background and Definitions

1202.02(a)(iii)(A) Functionality

Functional matter cannot be protected as a trademark. [15 U.S.C. §§1052\(e\)\(5\)](#) and [\(f\)](#), [1064\(3\)](#), [1091\(c\)](#), and [1115\(b\)](#). A feature is functional as a matter of law if it is "essential to the use or purpose of the article or if it affects the cost or quality of the article." *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33, 58 USPQ2d 1001, 1006 (2001); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165, 34 USPQ2d 1161, 1163-64 (1995); *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850, n.10, 214 USPQ 1, 4, n.10 (1982).

While some courts had developed a definition of functionality that focused solely on "competitive need" – thus finding a particular product feature functional only if competitors needed to copy that design in order to compete effectively – the Supreme Court held that this "was incorrect as a comprehensive definition" of functionality. *TrafFix*, 532 U.S. at 33, 58 USPQ2d at 1006. The Court emphasized that where a product feature meets the traditional functionality definition – that is, it is essential to the use or purpose of the product or affects its cost or quality – then the feature is functional, regardless of the availability to competitors of other alternatives. *Id.*; see also *Valu Eng'g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1276, 61 USPQ2d 1422, 1427 (Fed. Cir. 2002) ("Rather, we conclude that the [*TrafFix*] Court merely noted that once a product feature is found functional based on other considerations there is no need to consider the availability of alternative designs, because the feature cannot be given **trade dress** protection merely because there are alternative designs available" (footnote omitted).)

However, since the preservation of competition is an important policy underlying the functionality doctrine, competitive need, although not determinative, remains a significant consideration in functionality determinations. *Id.* at 1278, 1428.

The determination that a proposed mark is functional constitutes, for public policy reasons, an absolute bar to registration on either the Principal or the Supplemental Register, regardless of evidence showing that the proposed mark has acquired distinctiveness. See *TrafFix*, 532 U.S. at 29-33, 58 USPQ2d at 1005-1007; see also *In re Controls Corp. of Am.*, 46 USPQ2d 1308, 1312 (TTAB 1998) (rejecting applicant's claim that "registration on the Supplemental Register of a de jure functional configuration is permissible if the design is 'capable' of distinguishing applicant's goods"). Thus, if an applicant responds to a functionality refusal under §2(e)(5), [15 U.S.C. §1052\(e\)\(5\)](#), by submitting an amendment seeking registration on the Supplemental Register that is not made in the alternative, such an amendment does not introduce a new issue warranting a nonfinal Office action. See [TMEP §714.05\(a\)\(i\)](#). Instead, the functionality refusal must be maintained and made final, if appropriate, under §§23(c) and 45, [15 U.S.C. §§1091\(c\)](#), [1127](#), as that is the statutory authority governing a functionality refusal on the Supplemental Register. Additionally, for functionality refusals, the associated nondistinctiveness refusal must be withdrawn. See *In re Heatcon, Inc.*, 116 USPQ2d 1366, 1370 (TTAB 2015) .

See [TMEP §§1202.02\(a\)\(v\)–1202.02\(a\)\(v\)\(D\)](#) regarding evidentiary considerations pertaining to functionality refusals.

1202.02(a)(iii)(B) "De Jure" and "De Facto" Functionality

Prior to 2002, the USPTO used the terms " *de facto*" and " *de jure*" in assessing whether "subject matter" (usually a product feature or the configuration of the goods) presented for registration was functional. This distinction originated with the Court of Customs and Patent Appeals' decision in *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 213 USPQ 9 (C.C.P.A. 1982) , which was discussed by the Federal Circuit in *Valu Eng'g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1274, 61 USPQ2d 1422, 1425 (Fed. Cir. 2002):

Our decisions distinguish *de facto* functional features, which may be entitled to trademark protection, from *de jure* functional features, which are not. 'In essence, *de facto* functional means that the design of a product has a function, i.e., a bottle of any design holds fluid.' *In re R.M. Smith, Inc.*, 734 F.2d 1482, 1484, 222 USPQ 1, 3 (Fed. Cir. 1984). *De facto* functionality does not necessarily defeat registrability. *Morton-Norwich*, 671 F.2d at 1337, 213 USPQ at 13 (A design that is *de facto* functional, i.e., 'functional' in the lay sense . . . may be legally recognized as an indication of source.'). *De jure* functionality means that the product has a particular shape 'because it works better in this shape.' *Smith*, 734 F.2d at 1484, 222 USPQ at 3.

However, in three Supreme Court decisions involving functionality – *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001 (2001), *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 54 USPQ2d 1065 (2000), and *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161 (1995) – the Court did not use the "*de facto/de jure*" distinction. Nor were these terms used when the Trademark Act was amended to expressly prohibit registration of matter that is "functional." Technical Corrections to Trademark Act of 1946, Pub. L. No. 105-330, §201, 112 Stat. 3064, 3069 (1998). Accordingly, in general, examining attorneys no longer make this distinction in Office actions that refuse registration based on functionality.

De facto functionality is not a ground for refusal. *In re Ennco Display Sys. Inc.*, 56 USPQ2d 1279, 1282 (TTAB 2000) ; *In re Parkway Mach. Corp.*, 52 USPQ2d 1628, 1631 n.4 (TTAB 1999) .

1202.02(a)(iv) Burden of Proof in Functionality Determinations

The examining attorney must establish a prima facie case that the proposed **trade dress** mark sought to be registered is functional in order to make and maintain the §2(e)(5) functionality refusal. See *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 1374, 102 USPQ2d 1372, 1376 (Fed. Cir. 2012); *Textron, Inc. v. U.S. Int'l Trade Comm'n*, 753 F.2d 1019, 1025, 224 USPQ 625, 629 (Fed. Cir. 1985); *In re R.M. Smith, Inc.*, 734 F.2d 1482, 1484, 222 USPQ 1, 3 (Fed. Cir. 1984). To do so, the examining attorney must not only examine the application content (i.e., the drawing, the description of the mark, the identification of goods or services, and the specimen, if any), but also conduct independent research to obtain evidentiary support for the refusal. In applications where there is reason to believe that the proposed mark may be functional, but the evidence is lacking to issue the §2(e)(5) refusal in the first Office action, a request for information pursuant to [37 C.F.R. §2.61\(b\)](#) must be issued to obtain information from the applicant so that an informed decision about the validity of the functionality refusal can be made.

The burden then shifts to the applicant to present "competent evidence" to rebut the examining attorney's prima facie case of functionality. See *In re Becton, Dickinson & Co.*, 675 F.3d at 1374, 102 USPQ2d at 1374; *Textron, Inc. v. U.S. Int'l Trade Comm'n*, 753 F.2d at 1025, 224 USPQ at 629; *In re R.M. Smith, Inc.*, 734 F.2d at 1484, 222 USPQ at 3; *In re Bio-Medicus Inc.*, 31 USPQ2d 1254, 1257 n.5 (TTAB 1993). The "competent evidence" standard requires proof by preponderant evidence. *In re Becton, Dickinson & Co.*, 675 F.3d at 1374, 102 USPQ2d at 1377.

The functionality determination is a question of fact, and depends on the totality of the evidence presented in each particular case. *In re Becton, Dickinson & Co.*, 675 F.3d at 1372, 102 USPQ2d at 1375; *Valu Eng'g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1273, 61 USPQ2d 1422, 1424 (Fed. Cir. 2002); *In re Udor U.S.A., Inc.*, 89 USPQ2d 1978, 1979 (TTAB 2009) ; *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1338 (TTAB 1997) . While there is no set amount of evidence that an examining attorney must present to establish a prima facie case of functionality, it is clear that there must be evidentiary support for the refusal in the record. See, e.g., *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1342, 213 USPQ 9, 16-17 (C.C.P.A. 1982) (admonishing both the examining attorney and the Board for failing to support the functionality determination with even "one iota of evidence").

If the design sought to be registered as a mark is the subject of a utility patent that discloses the feature's utilitarian advantages, the applicant bears an especially "heavy burden of showing that the feature is not functional" and "overcoming the strong evidentiary inference of functionality." *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 30, 58 USPQ2d 1001, 1005 (2001); *Udor U.S.A., Inc.*, 89 USPQ2d at 1979-80; see [TMEP §1202.02\(a\)\(v\)\(A\)](#).

1202.02(a)(v) Evidence and Considerations Regarding Functionality Determinations

A determination of functionality normally involves consideration of one or more of the following factors, commonly known as 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 alternative 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) .

Since relevant technical information is often more readily available to an applicant, the applicant will often be the source of most of the evidence relied upon by the examining attorney in establishing a prima facie case of functionality in an ex parte case. *In re Teledyne Indus. Inc.*, 696 F.2d 968, 971, 217 USPQ 9, 11 (Fed. Cir. 1982); *In re Witco Corp.*, 14 USPQ2d 1557, 1560 (TTAB 1989) . Therefore, in an application for a **trade dress** mark, when there is reason to believe that the proposed mark may be functional, the examining attorney must perform a search for evidence to support the *Morton-Norwich* factors. In applications where there is reason to believe that the proposed mark may be functional, the first Office action must include a request for information under [37 C.F.R. §2.61\(b\)](#), requiring the applicant to provide information necessary to permit an informed determination concerning the functionality of the proposed mark. See *In re Babies Beat Inc.*, 13 USPQ2d 1729, 1731 (TTAB 1990) (finding that registration is properly refused where applicant failed to comply with examining attorney's request for copies of patent applications and other patent information). Such a request should be issued for most product design marks.

Accordingly, the examining attorney's request for information should pertain to the *Morton-Norwich* factors and: (1) ask the applicant to provide copies of any patent(s) or any pending or abandoned patent application(s); (2) ask the applicant to provide any available advertising, promotional, or explanatory material concerning the goods/services, particularly any material specifically related to the features embodied in the proposed mark; (3) inquire of the applicant whether alternative designs are available; and (4) inquire whether the features sought to be registered make the product easier or cheaper to manufacture. The examining attorney should examine the specimen(s) for information relevant to the *Morton-Norwich* factors, and conduct independent research of applicant's and competitors' websites, industry practice and standards, and legal databases such as LexisNexis®. The examining attorney may also consult USPTO patent records.

It is not necessary to consider all the *Morton-Norwich* factors in every case. The Supreme Court held that "[w]here the design is functional under the *Inwood* formulation there is no need to proceed further to consider if there is a competitive necessity for the feature." *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29, 58 USPQ2d 1001, 1006 (2001); see also *In re Becton, Dickinson & Co.*, 675 F.3d at 1376, 102 USPQ2d at 1378 (stating that "since the patent and advertising evidence established functionality, the Board did not need to analyze whether alternative designs exist"); *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1499-1500 (TTAB 2017) (finding the mark as a whole primarily functional because the overall appearance of

applicant's engine configuration was essential to the use or purpose of the engine and affects its quality and the totality of the record showed the functional features outweighed the decorative and non-functional aspects); *In re Loggerhead Tools, LLC*, 119 USPQ2d 1429, 1434 (TTAB 2016) (finding that the first two Morton-Norwich factors established that applicant's applied-for mark is functional, before considering the remaining factors). Moreover, there is no requirement that all four of the *Morton-Norwich* factors weigh in favor of functionality to support a refusal. See *Valu Eng'g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1276, 61 USPQ2d 1422, 1427 (Fed. Cir. 2002) ("once a product feature is found functional based on other considerations there is no need to consider the availability of alternative designs"); *In re Pohl-Boskamp GmbH & Co.*, 106 USPQ2d 1042 (TTAB 2013) (finding the flavor peppermint functional for nitroglycerin lingual spray based on evidence that peppermint oil, which imparts a flavor of peppermint, can improve the effectiveness of sublingual nitroglycerin spray); *In re Udor U.S.A., Inc.*, 89 USPQ2d 1978 (TTAB 2009) (affirming the functionality refusal of "a round disk head on a sprayer nozzle" where the third and fourth factors showed that applicant's competitors manufactured and marketed spray nozzles with similar features, the shape was preferred in the industry, and it appeared efficient, economical, and advantageous, even though applicant's utility patent and advertising did not weigh in favor of functionality); *In re N.V. Organon*, 79 USPQ2d 1639 (TTAB 2006) (holding orange flavor for pharmaceuticals to be functional based on applicant's touting of the utilitarian advantages of the flavor and the lack of evidence of acceptable alternatives, even though the mark was not the subject of a patent or patent application and there was no evidence that the flavor affected the cost of the product); *In re Gibson Guitar Corp.*, 61 USPQ2d 1948 (TTAB 2001) (finding that since there was no utility patent, and no evidence that applicant's guitar configuration resulted from a simpler or cheaper method of manufacture, these factors did not weigh in Board's decision).

Evidence that the proposed mark is the subject of a utility patent that discloses the utilitarian advantages of the configuration at issue can be sufficient in itself to support a functionality refusal. *TrafFix*, 532 U.S. at 33, 58 USPQ2d at 1005 ("A utility patent is strong evidence that the features therein claimed are functional."); *Poly-America, L.P. v. Illinois Tool Works Inc.*, 124 USPQ2d 1508, 1519 (TTAB 2017) ("The issue is whether anything in the patent, its specification, or statements made in prosecution disclose the functionality of the marks. Here, they clearly do."); *In re Change Wind Corp.*, 123 USPQ2d 1453, 1460 (TTAB 2017) ("[T]he utility patent demonstrates the utilitarian advantages of . . . the design at issue, and for this reason, we find the product configuration functional."); *In re Howard Leight Indus., LLC*, 80 USPQ2d 1507, 1515 (TTAB 2006) ("[W]e find that applicant's expired utility patent, which specifically discloses and claims the utilitarian advantages of applicant's earplug configuration and which clearly shows that the shape at issue 'affects the . . . quality of the device,' is a sufficient basis in itself for finding that the configuration is functional, given the strong weight to be accorded such patent evidence under *TrafFix*."). See [TMEP §1202.02\(a\)\(v\)\(A\)](#) for further discussion of utility patents.

It is important that the functionality inquiry focus on the utility of the feature or combination of features claimed as protectable **trade dress**. *Morton-Norwich*, 671 F.2d at 1338, 213 USPQ at 13. Generally, dissecting the design into its individual features and analyzing the utility of each separate feature does not establish that the overall design is functional. See [15 U.S.C. §1052\(e\)\(5\)](#); *Teledyne*, 696 F.2d at 971, 217 USPQ at 11. However, it is sometimes helpful to analyze the design from the standpoint of its various features. See *Elmer v. ICC Fabricating Inc.*, 67 F.3d 1571, 1579-80, 36 USPQ2d 1417, 1422-23 (Fed. Cir. 1995) (rejecting the argument that the combination of individually functional features in the configuration resulted in an overall nonfunctional product design); *In re R.M. Smith, Inc.*, 734 F.2d 1482, 1484, 222 USPQ 1, 2 (Fed. Cir. 1984) (affirming the functionality determination, where the Board had initially considered the six individual features of the design, and then had concluded that the design as a whole was functional); *In re Change Wind Corp.*, 123 USPQ2d at 1456-61 (finding product configuration functional based on the functional role of the components claimed in applicant's drawing of the mark); *In re Controls Corp. of Am.*, 46 USPQ2d 1308, 1312 (TTAB 1998) (finding the entire configuration at issue functional because it consisted of several individual features, each of which was functional in nature).

Where the evidence shows that the overall design is functional, the inclusion of a few arbitrary or otherwise nonfunctional features in the design will not change the result. See *In re Becton, Dickinson & Co.*, 675 F.3d at 1374, 102 USPQ2d at 1376; *Textron, Inc. v. U.S. Int'l Trade Comm'n*, 753 F.2d 1019, 1025, 224 USPQ 625, 628-29 (Fed. Cir. 1985); *In re Vico Prods. Mfg. Co.*, 229 USPQ 364, 368 (TTAB 1985) .

In the limited circumstances where a proposed **trade dress** mark is not functional overall, but contains insignificant elements that are functional, the examining attorney must issue a requirement for an amended

drawing and allow applicant to remove or delete the functional elements from the drawing or depict them in broken or dotted lines to indicate that they are not features of the mark. See [TMEP §1202.02\(c\)\(i\)](#) regarding drawings in **trade dress** applications.

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. See [TMEP §1202.02\(a\)\(iii\)\(B\)](#) regarding *de facto* functionality. Usually, most objects perform a function, for example, a bottle holds liquid and a lamp provides light. However, only certain configurations that allow an object to work better are functional under §2(e)(5). As the *Morton-Norwich* court noted, "it is the 'utilitarian' *design* of a 'utilitarian' *object* with which we are concerned." 671 F.2d at 1338, 213 USPQ at 14. Similarly, a product feature that is deemed not functional under §2(e)(5) may lack distinctiveness such that it fails to function as a trademark under §§1, 2, and 45 of the Trademark Act. See [TMEP §§1202.02\(b\)–1202.02\(b\)\(ii\)](#) for distinctiveness of **trade dress**.

1202.02(a)(v)(A) Utility Patents and Design Patents

Utility Patents

Utility patents cover the invention or discovery of a new and useful process, machine, article of manufacture, or composition of matter, or any new and useful improvement thereof. 35 U.S.C. §101.

In *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29-30, 58 USPQ2d 1001, 1005 (2001), the Supreme Court resolved a circuit split regarding the proper weight to be afforded a utility patent in the functionality determination, stating:

A utility patent is strong evidence that the features therein claimed are functional. If **trade dress** protection is sought for those features the strong evidence of functionality based on the previous patent adds great weight to the statutory presumption that features are deemed functional until proved otherwise by the party seeking **trade dress** protection. Where the expired patent claimed the features in question, one who seeks to establish **trade dress** protection must carry the heavy burden of showing that the feature is not functional, for instance by showing that it is merely an ornamental, incidental, or arbitrary aspect of the device.

See *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 1375, 102 USPQ2d 1372, 1377 (Fed. Cir. 2012) (utility patent supported functionality of closure cap for blood-collection tubes); *In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985) (shape of loudspeaker system enclosure found functional, per patent disclosure containing evidence of functionality); *In re Change Wind Corp.*, 123 USPQ2d 1453, 1459-60 (TTAB 2017) (utility patent disclosed functional role of components claimed in configuration of wind turbines); *In re Dietrich*, 91 USPQ2d 1622 (TTAB 2009) (patent evidence supported bicycle wheel configuration was functional); *In re Udor U.S.A., Inc.*, 89 USPQ2d 1978 (TTAB 2009) (functionality of spray nozzle head not supported by patent claims); *In re Visual Commc'ns Co.*, 51 USPQ2d 1141 (TTAB 1999) (patent disclosed functionality of light-emitting diode housings); *In re Edward Ski Prods., Inc.*, 49 USPQ2d 2001 (TTAB 1999) (ski mask found functional based on patent evidence); *In re Caterpillar Inc.*, 43 USPQ2d 1335 (TTAB 1997) (patent disclosures supported functionality of elevated sprocket configuration).

The Court in *TrafFix* went on to hold that where the evidence includes a utility patent that claims the product features at issue, it is unnecessary to consider evidence relating to the availability of alternative designs:

There is no need, furthermore, to engage, as did the Court of Appeals, in speculation about other design possibilities, such as using three or four springs which might serve the same purpose. Here, the functionality of the spring design means that competitors need not explore whether other spring juxtapositions might be used. The dual-spring design is not an arbitrary flourish in the configuration of MDI's product; it is the reason the device works. Other designs need not be attempted.

TrafFix, 532 U.S. at 33-34, 58 USPQ2d at 1007 (citation omitted).

Therefore, when presented with facts similar to those in *TrafFix* (i.e., where there is a utility patent establishing the utilitarian nature of the product design at issue), the examining attorney may properly issue a final functionality refusal based primarily on the utility patent. *In re Howard Leight Indus., LLC*, 80 USPQ2d 1507, 1515 (TTAB 2006). Where functionality appears to be an issue, in the first Office action, the examining attorney should ask the applicant to provide copies of any active, pending, or expired patent(s), and any pending or abandoned patent application(s). [37 C.F.R. §2.61\(b\)](#); see *Valu Eng'g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1279, 61 USPQ2d 1422, 1429 (Fed. Cir. 2002) ("We agree with the Board that an abandoned patent application should be considered under the first *Morton-Norwich* factor, because an applied-for utility patent that never issued has evidentiary significance for the statements and claims made in the patent application concerning the utilitarian advantages, just as an issued patent has evidentiary significance.").

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. See *AS Holdings, Inc. v. H & C Milcor, Inc.*, 107 USPQ2d 1829, 1834-35 (TTAB 2013); *In re Mars, Inc.*, 105 USPQ2d 1859, 1861 (TTAB 2013); *In re Dietrich*, 91 USPQ2d at 1627; *In re Am. Nat'l Can Co.*, 41 USPQ2d 1841, 1843 (TTAB 1997); *In re Virshup*, 42 USPQ2d 1403, 1405 (TTAB 1997); *In re Cabot Corp.*, 15 USPQ2d 1224 (TTAB 1990). In addition, a third-party patent may include other evidence directly related to the functionality of a proposed mark. In *Pohl-Boskamp GmbH & Co.*, the applicant sought to register the flavor of peppermint for use in connection with pharmaceutical preparations of nitroglycerin in the form of a lingual spray. The examining attorney made of record a third-party patent that described the results of two studies demonstrating that peppermint oil had therapeutic properties in the applicant's field of goods. *In re Pohl-Boskamp GmbH & Co.*, 106 USPQ2d 1042, 1046-48 (TTAB 2013). Therefore, the examining attorney may also consult patent databases, including the USPTO's patent records, to see if utility patents owned by applicant's competitors disclose the functional advantages of the product design that the applicant seeks to register.

It is important to read the patent to determine whether the patent actually claims the features presented in the proposed mark. If it does, the utility patent is strong evidence that the particular product features claimed as **trade dress** are functional. But the specification and/or drawings in the patent may also provide strong evidence, even if the feature is not claimed as part of the invention. See, e.g., *In re Becton, Dickinson and Co.*, 675 F.3d at 1375, 102 USPQ2d at 1377 (there is no requirement "that a patent claim the exact configuration for which trademark protection is sought in order to undermine an applicant's assertion that an applied-for mark is not de jure functional. Indeed, . . . statements in a patent's specification illuminating the purpose served by a design may constitute equally strong evidence of functionality.") (citation omitted). In contrast, if the features are referenced in the patent, but only as arbitrary or incidental features, then the probative value of the patent as evidence of functionality is substantially diminished or negated entirely. *TrafFix*, 532 U.S. at 34, 58 USPQ2d at 1007 (noting that where a manufacturer seeks to protect arbitrary, incidental, or ornamental features of a product found in the patent claims, such as arbitrary curves in the legs or an ornamental pattern painted on the springs, functionality will not be established if the manufacturer can prove that those aspects do not serve a purpose within the terms of utility patent); *Grote Indus, Inc. v. Truck-Lite Co., LLC*, 126 USPQ2d 1197, 1206 (TTAB 2018) (finding that utility patent did not show that the six-diode design of vehicle lights was essential to their use or purpose); *In re Udor U.S.A., Inc.*, 89 USPQ2d 1978, 1980-82 (TTAB 2009) (finding that where the patent's language and a detailed comparison between the identified features of the patent drawing with the visible features of the trademark drawing established that the patent claims involved components neither shown nor described in the trademark design, the utility patent did not support a finding of functionality); see also *Black & Decker Inc. v. Hoover Serv. Ctr.*, 886 F.2d 1285, 12 USPQ2d 1250 (Fed. Cir. 1989) (lower court's reliance on and misinterpretation of a patent not in evidence as support for a finding of functionality was clear error); *In re Zippo Mfg. Co.*, 50 USPQ2d 1852 (TTAB 1999) (configuration of cigarette lighter not functional since patent covered slightly different exterior features and claimed internal mechanism); *In re Weber-Stephen Prods. Co.*, 3 USPQ2d 1659 (TTAB 1987) (patent evidence did not show utilitarian advantages of barbeque grill design sought to be registered). Where a utility patent claims more than what is sought to be registered, this fact does not establish the nonfunctionality of the product design, if the patent shows that the feature claimed as a trademark is an essential or integral part of the invention and has utilitarian advantages. Cf. *TrafFix*, 532 U.S. at 31, 58 USPQ2d at 1006-07 (nothing in the applied-for dual-spring traffic sign design pointed to arbitrary features).

The examining attorney should consider both the numbered claims and the disclosures in the written description, drawings, and abstract of the patent. In *Leight*, the Board found functionality based on both the

claims and the disclosure. The Board rejected the applicant's argument that the examining attorney erred in looking to the claims made in applicant's patent, noting that the Supreme Court in *TrafFix* repeatedly referred to a patent's claims as evidence of functionality. *Leight*, 80 USPQ2d at 1510-11. The examining attorney should also consider other evidence described in a patent that is relevant to the functionality of the mark at issue. *In re Pohl-Boskamp GmbH & Co.*, 106 USPQ2d at 1046-47; see also *In re Becton, Dickinson & Co.*, 675 F. 3d 1368, 1375, 102 USPQ2d 1372, 1377 (Fed. Cir. 2012) ("[S]tatements in a patent's specification illuminating the purpose served by a design may constitute equally strong evidence of functionality."); *In re Loggerhead Tools, LLC*, 119 USPQ2d 1429, 1431-32 (TTAB 2016) (indicating that evidence of functionality in a patent is not limited to language in the claims themselves).

Statements regarding utilitarian advantages of the design made in the course of the prosecution of the patent application can also be very strong evidence of functionality. *TrafFix*, 532 U.S. at 32, 58 USPQ2d at 1006 ("These statements [regarding specific functional advantages of the product design] made in the patent applications and in the course of procuring the patents demonstrate the functionality of the design. MDI does not assert that any of these representations are mistaken or inaccurate, and this is further strong evidence of the functionality of the dual-spring design."); *M-5 Steel Mfg., Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086, 1096 (TTAB 2001) .

The fact that the proposed mark is *not* the subject of a utility patent does not establish that a feature of the proposed mark is nonfunctional. *TrafFix*, 532 U.S. at 32, 35, 58 USPQ2d at 1006-07; *In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1950 n.3, (TTAB 2001) .

Design Patents

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. However, ownership of a design patent does not in itself establish that a product feature is nonfunctional, and can be outweighed by other evidence supporting the functionality determination. See *In re Becton, Dickinson & Co.*, 675 F.3d at 1375, 102 USPQ2d at 1377; *In re R.M. Smith, Inc.*, 734 F.2d 1482, 1485, 222 USPQ 1, 3 (Fed. Cir. 1984); *Caterpillar*, 43 USPQ2d at 1339; *Am. Nat'l Can Co.*, 41 USPQ2d at 1843; *In re Witco Corp.*, 14 USPQ2d 1557, 1559 (TTAB 1989); see also *In re Loggerhead Tools, LLC*, 119 USPQ2d 1429, 1432-33 (TTAB 2016) ("absent identity between the design patent and proposed mark . . . , similar design patents lack sufficient evidentiary value" to overcome other evidence showing that the proposed mark was functional, especially in view of a utility patent that disclosed the utilitarian advantages of the claimed feature) (citing *Becton, Dickinson*, 675 F. 3d at 1375, 102 USPQ2d at 1377) .

1202.02(a)(v)(B) Advertising, Promotional, or Explanatory Material in Functionality Determinations

The applicant's own advertising touting the utilitarian aspects of its product design or product packaging is often strong evidence supporting a functionality refusal. See, e.g., *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 1375-76, 102 USPQ2d 1372, 1377-78 (Fed. Cir. 2012); *In re Loggerhead Tools, LLC*, 119 USPQ2d 1429, 1433 (TTAB 2016); *AS Holdings, Inc. v. H & C Milcor, Inc.*, 107 USPQ2d 1829 (TTAB 2013); *Kistner Concrete Prods., Inc. v. Contech Arch Techs., Inc.*, 97 USPQ2d 1912 (TTAB 2011) ; *Mag Instrument, Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701 (TTAB 2010); *In re N.V. Organon*, 79 USPQ2d 1639 (TTAB 2006); *In re Gibson Guitar Corp.*, 61 USPQ2d 1948 (TTAB 2001) ; *M-5 Steel Mfg., Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086 (TTAB 2001); *In re Visual Commc'ns Co.*, 51 USPQ2d 1141 (TTAB 1999) ; *In re Edward Ski Prods., Inc.*, 49 USPQ2d 2001 (TTAB 1999) ; *In re Caterpillar Inc.*, 43 USPQ2d 1335 (TTAB 1997) ; *In re Bio-Medicus Inc.*, 31 USPQ2d 1254 (TTAB 1993); *In re Witco Corp.*, 14 USPQ2d 1557 (TTAB 1989).

An applicant will often assert that statements in its promotional materials touting the utilitarian advantages of the product feature are mere "puffery" and, thus, entitled to little weight in the functionality analysis. However, where the advertising statements clearly emphasize specific utilitarian features of the design claimed as a mark, the Board will reject such assertions of "puffing." See, e.g., *Gibson Guitar*, 61 USPQ2d at

1951; *Goodyear Tire and Rubber Co. v. Interco Tire Corp.*, 49 USPQ2d 1705, 1716-17 (TTAB 1998) ; *Bio-Medicus*, 31 USPQ2d at 1260 (TTAB 1993); *Witco*, 14 USPQ2d at 1559-61 (TTAB 1989).

In *Gibson Guitar*, the Board found the design of a guitar body to be functional, noting that applicant's literature clearly indicated that the shape of applicant's guitar produced a better musical sound. Applicant's advertisements stated that "[t]his unique body shape creates a sound which is much more balanced and less 'muddy' than other ordinary dreadnought acoustics." 61 USPQ2d at 1951.

Where functionality appears to be an issue, in the first Office action, the examining attorney must ask the applicant to provide any available advertising, promotional, or explanatory material concerning the goods/services, particularly any material specifically related to the features embodied in the proposed mark. [37 C.F.R. §2.61\(b\)](#). The examining attorney should also examine the specimen(s), and check to see if the applicant has a website on which the product is advertised or described.

In addition, examining attorney may check the websites of applicant's competitors for evidence of functionality. See *In re Van Valkenburgh*, 97 USPQ2d 1757, 1762-63, (TTAB 2011) ; *Gibson Guitar*, 61 USPQ2d at 1951. Industry and trade publications and computer databases may also be consulted to determine whether others offer similar designs and features or have written about the applicant's design and its functional features or characteristics. In *Gibson Guitar*, the record included an advertisement obtained from the website of a competitor whose guitar appeared to be identical in shape to applicant's configuration, touting the acoustical advantages of the shape of the guitar. 61 USPQ2d at 1951.

1202.02(a)(v)(C) Availability of Alternative Designs in Functionality Determinations

An applicant attempting to rebut a prima facie case of functionality will often submit evidence of alternative designs to demonstrate that there is no "competitive need" in the industry for the applicant's particular product design. See [TMEP §1202.02\(a\)\(iii\)\(A\)](#). In order to be probative, the alternative design evidence must pertain to the same category of goods as the applicant's goods. See, e.g., *In re Zippo Mfg. Co.*, 50 USPQ2d 1852, 1854 (TTAB 1999) ; *In re EBSCO Indus. Inc.*, 41 USPQ2d 1917, 1920 (TTAB 1997) .

However, in *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001 (2001), the Supreme Court clearly indicated that if the record shows that a design is essential to the use or purpose of a product, or if it affects the cost or quality of the product, it is unnecessary to consider whether there is a competitive need for the product feature. The Court explained:

[W]e have said "in general terms, 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." Expanding upon the meaning of this phrase, we have observed that a functional feature is one the "exclusive use of [which] would put competitors at a significant non-reputation-related disadvantage." The Court of Appeals in the instant case seemed to interpret this language to mean that a necessary test for functionality is "whether the particular product configuration is a competitive necessity." . . . This was incorrect as a comprehensive definition. As explained in *Qualitex, supra*, and *Inwood, supra*, a feature is also functional when it is essential to the use or purpose of the device or when it affects the cost or quality of the device . . . *Where the design is functional under the Inwood formulation there is no need to proceed further to consider if there is a competitive necessity for the feature.*

* * *

There is no need, furthermore, to engage, as did the Court of Appeals, in speculation about other design possibilities, such as using three or four springs which might serve the same purpose. Here, the functionality of the spring design means that competitors need not explore whether other spring juxtapositions might be used. The dual-spring design is not an arbitrary flourish in the configuration of MDI's product; it is the reason the device works. Other designs need not be attempted (emphasis added).

Traffix, 532 U.S. at 32-34, 58 USPQ2d at 1006-1007 (citations and additional internal quotations omitted); see also *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 1376, 102 USPQ2d 1372, 1378 (Fed. Cir. 2012) (quoting *Valu Eng'g Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1276, 61 USPQ2d 1422, 1427 (Fed. Cir. 2002)) ("If functionality is found based on other considerations, there is 'no need to consider the availability of alternative designs, because the feature cannot be given **trade dress** protection merely because there are alternative designs available.").

Nonetheless, since the preservation of competition is an important policy underlying the functionality doctrine, competitive need generally remains an important factor in a functionality determination. See *Valu Eng'g, Inc.*, 278 F.3d at 1277, 61 USPQ2d at 1428 ("In determining 'functionality,' the Board must assess the effect registration of a mark would have on competition.").

Accordingly, the examining attorney should request information about alternative designs in the initial Office action, pursuant to [37 C.F.R. §2.61\(b\)](#), i.e., inquire whether alternative designs are available for the feature embodied in the proposed mark and whether the alternatives are more costly to produce.

Where the evidence indicates that the applicant's configuration is the best or one of a few superior designs available, this evidence will strongly support a finding of functionality. See, e.g., *In re Dietrich*, 91 USPQ2d 1622, 1636 (TTAB 2009) ("The question is not whether there are alternative designs that perform the same basic function, but whether the available designs work 'equally well.'") (citation omitted); *In re N.V. Organon*, 79 USPQ2d 1639, 1645-46 (TTAB 2006) (concluding that, since the record showed that orange flavor is one of the most popular flavors for medicine, it cannot be said that there are true or significant number of alternatives); *In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1951 (TTAB 2001) (finding that applicant had not shown there were alternative guitar shapes that could produce the same sound as applicant's configuration, and noting that the record contained an advertisement obtained from the website of a competitor, whose guitar appeared to be identical in shape to applicant's configuration, which stated that the shape of the guitar produces a better sound).

A configuration of a product or its packaging that embodies a superior design feature and provides a competitive advantage to the user is functional. In *N.V. Organon*, 79 USPQ2d at 1648-49, the Board found that by masking the unpleasant taste of the medicinal ingredients in pharmaceuticals, "flavor performs a utilitarian function that cannot be monopolized without hindering competition in the pharmaceutical trade. To allow registration of 'an orange flavor' as a trademark would give applicant potentially perpetual protection for this flavor, resulting in hindrance of competition."

Functionality may be established by a single competitively significant application in the recited identification of goods, even if there is no anticompetitive effect in other areas of use, since competitors in that single area could be adversely affected. *Valu Eng'g*, 278 F.3d at 1278, 61 USPQ2d at 1428 ("If the Board identifies *any* competitively significant single use in the recited identification of goods for which the mark as a whole is functional, the Board should deny registration.").

If evidence shows the existence of a number of functionally equivalent alternative designs that work "equally well," such that competitors do not need applicant's design to compete effectively, this factor may not support functionality. *Dietrich*, 91 USPQ2d at 1636, citing *Valu Eng'g*, 278 F.3d at 1276, 61 USPQ2d at 1427. However, once deemed functional under other *Morton-Norwich* factors, the claimed **trade dress** cannot be registered merely because there are functionally equivalent alternative designs. *Valu Eng'g*, 278 F.3d at 1276, 61 USPQ2d at 1427. Existence of comparable alternative designs does not transform a functional design into a nonfunctional design. *Id.*

1202.02(a)(v)(D) Ease or Economy of Manufacture in Functionality Determinations

A product feature is functional if it is essential to the use or purpose of the product *or if it affects the cost or quality of the product*. *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 850 n.10, 214 USPQ 1, 4 n.10 (1982) (emphasis added). Therefore, a showing that a product design or product packaging results

from a comparatively simple or inexpensive method of manufacture will support a finding that the claimed **trade dress** is functional.

In many cases, there is little or no evidence pertaining to this factor. However, the examining attorney should still ask the applicant for information, under [37 C.F.R. §2.61\(b\)](#), as to whether the subject design makes the product simpler or less costly to manufacture, since evidence on this issue weighs strongly in favor of a finding of functionality. See, e.g., *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 32, 58 USPQ2d 1001, 1006 (2001); *In re Virshup*, 42 USPQ2d 1403, 1407 (TTAB 1997). Statements pertaining to the cost or ease of manufacture may sometimes also be found in informational or advertising materials. See *M-5 Steel Mfg., Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086, 1097 (TTAB 2001) (statements in promotional material that applicant's design results in reduced installation costs found to be evidence of the functionality of applicant's configurations of metal ventilating ducts and vents for tile or concrete roofs).

While evidence showing that a product feature results from a comparatively simple or inexpensive method of manufacture supports a finding that the design is functional, the opposite is not necessarily the case. That is, assertions by the applicant that its design is more expensive or more difficult to make, or that the design does not affect the cost, will not establish that the configuration is not functional. *In re Dietrich*, 91 USPQ2d 1622, 1637 (TTAB 2009) ("Even at a higher manufacturing cost, applicant would have a competitive advantage for what is essentially, as claimed in the patents, a superior quality wheel."); *In re N.V. Organon*, 79 USPQ2d 1639, 1646 (TTAB 2006). Designs that work better or serve a more useful purpose may, indeed, be more expensive and difficult to produce.

1202.02(a)(vi) Aesthetic Functionality

"Aesthetic functionality" refers to situations where the feature may not provide a truly utilitarian advantage in terms of product performance, but provides other competitive advantages. For example, in *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 1531, 1533, 32 USPQ2d 1120, 1122, 1124 (Fed. Cir. 1994), *cert. denied*, 514 U.S. 1050 (1995), the Federal Circuit affirmed the Board's determination that the color black for outboard motors was functional because, while it had no utilitarian effect on the mechanical working of the engines, it nevertheless provided other identifiable competitive advantages, i.e., ease of coordination with a variety of boat colors and reduction in the apparent size of the engines.

The concept of "aesthetic functionality" (as opposed to "utilitarian functionality") has for many years been the subject of much confusion. While the Court of Customs and Patent Appeals (the predecessor to the Court of Appeals for the Federal Circuit) appeared to reject the doctrine of aesthetic functionality in *In re DC Comics, Inc.*, 689 F.2d 1042, 1047-1050, 215 USPQ 394, 399-401 (C.C.P.A. 1982), the Supreme Court later referred to aesthetic functionality as a valid legal concept in *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33, 58 USPQ2d 1001, 1006 (2001). The confusion regarding aesthetic functionality stems in part from widespread misuse of the term "aesthetic functionality" in cases involving ornamentation issues, with some courts having mistakenly expanded the category of "functional" marks to include matter that is solely ornamental, essentially on the theory that such matter serves an "aesthetic function" or "ornamentation function." It is this incorrect use of the term "aesthetic functionality" in connection with ornamentation cases that was rejected by the Court of Customs and Patent Appeals. See *In re DC Comics, Inc.*, 689 F.2d 1042, 1047-1050, 215 USPQ 394, 397, 399-401 (C.C.P.A. 1982) (majority opinion and Rich, J., concurring) (holding, in a case involving features of toy dolls, that the Board had improperly "intermingled the concepts of utilitarian functionality and what has been termed 'aesthetic functionality,'" and rejecting the concept of aesthetic functionality where it is used as a substitute for "the more traditional source identification principles of trademark law," such as the ornamentation and functionality doctrines).

Where the issue presented is whether the proposed mark is ornamental in nature, it is improper to refer to "aesthetic functionality," because the doctrine of "functionality" is inapplicable to such cases. The proper refusal is that the matter is ornamental and, thus, does not function as a mark under §§1, 2, and 45 of the Trademark Act, [15 U.S.C. §§1051, 1052](#), and [1127](#). See [TMEP §§1202.03-1202.03\(g\)](#) regarding ornamentation.

The Supreme Court's use of the term "aesthetic functionality" in the *TrafFix* case appears limited to cases where the issue is one of actual functionality, but where the nature of the proposed mark makes it difficult to

evaluate the functionality issue from a purely utilitarian standpoint. This is the case with color marks and product features that enhance the attractiveness of the product. The color or feature does not normally give the product a truly utilitarian advantage (in terms of making the product actually perform better), but may still be found to be functional because it provides other real and significant competitive advantages and, thus, should remain in the public domain. See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165, 34 USPQ2d 1161, 1163-1164 (1995) (stating that a product color might be considered functional if its exclusive use "would put competitors at a significant non-reputation-related disadvantage," even where the color was not functional in the utilitarian sense).

In *M-5 Steel Mfg., Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086, 1096 (TTAB 2001), the Board considered the proper use of the aesthetic functionality doctrine in connection with product designs for metal ventilating ducts and vents for tile or concrete roofs:

This case seems to involve elements of both utilitarian and aesthetic functionality. Here, for example, there is evidence of utility in applicant's patent application, as well as statements touting the superiority of applicant's design in applicant's promotional literature, and statements that applicant's design results in reduced costs of installation. On the other hand, there is no question that applicant's roof designs which match the appearance of surrounding roof tiles are more pleasing in appearance because the venting tiles in each case are unobtrusive.

Citing extensively from the *Traffix*, *Qualitex*, and *Brunswick* cases, the Board concluded that the product designs were functional for a combination of utilitarian and aesthetic reasons. *Id.* at 1097.

Note that this type of functionality determination – while employed in connection with a normally "aesthetic" feature such as color – is a proper use of the functionality doctrine, necessitating a §2(e)(5) refusal where the evidence establishes that a color or other matter at issue provides identifiable competitive advantages and, thus, should remain in the public domain. In *In re Florists' Transworld Delivery Inc.*, 106 USPQ2d 1784 (TTAB 2013), for example, the record included evidence reflecting that, in the floral industry, color has significance and communicates particular messages (e.g., elegance, bereavement, Halloween), which extend to floral packaging. The Board found, therefore, that the examining attorney had demonstrated a competitive need for others in the industry to use black in connection with floral arrangements and packaging therefor and concluded that the proposed mark was functional under §2(e)(5). This is the opposite of an ornamentation refusal, where the matter at issue serves no identifiable purpose other than that of pure decoration.

Generally speaking, examining attorneys should exercise caution in the use of the term "aesthetic functionality," in light of the confusion that historically has surrounded this issue. In most situations, reference to aesthetic functionality will be unnecessary, since a determination that the matter sought to be registered is purely ornamental in nature will result in an ornamentation refusal under §§1, 2, and 45 of the Trademark Act, and a determination that the matter sought to be registered is functional will result in a functionality refusal under §2(e)(5). Use of the term "aesthetic functionality" may be appropriate in limited circumstances where the proposed mark presents issues similar to those involved in the *Florists' Transworld Delivery*, *M-5 Steel*, and *Brunswick* cases discussed above – i.e., where the issue is one of true functionality under §2(e)(5), but where the nature of the mark makes the functionality determination turn on evidence of particular competitive advantages that are not necessarily categorized as "utilitarian" in nature. Any such use of the term "aesthetic functionality" should be closely tied to a discussion of specific competitive advantages resulting from use of the proposed mark at issue, so that it is clear that the refusal is properly based on the functionality doctrine and not on an incorrect use of "aesthetic functionality" to mean ornamentation.

See [TMEP §§1202.05](#) and [1202.05\(b\)](#) for additional discussion and case references regarding the functionality issue in connection with color marks.

1202.02(a)(vii) Functionality and Service Marks

Although rare in the context of service mark applications, examining attorneys are not foreclosed from refusing registration based on functionality. In *Duramax Marine, LLC v. R.W. Fernstrum & Co.*, 80 USPQ2d 1780, 1793 (TTAB 2006), the Board held that a two-dimensional design of a marine heat exchanger (commonly known as

a "keel cooler"), was not functional for "manufacture of marine heat exchangers to the order and specification of others." It found "a significant difference between an application to register **trade dress** in the nature of product design as a mark for the product itself . . . and an application to register a two-dimensional drawing that may look very much like such a product, but is used on labels, catalogs, brochures, and in various other ways as a mark for services;" and stated that "[t]he inquiry regarding functionality may need to be decidedly different" in cases involving a service mark.

The record showed that the keel cooler depicted in the proposed mark was "identical, or nearly so" to the depiction of a keel cooler in applicant's expired patent; that opposer and at least one other party had been marketing keel coolers very similar to the proposed mark; and that the design sought to be registered appeared in applicant's catalog of pre-manufactured keel coolers. *Id.* at 1786. The Board framed the question at issue as "whether any manufacturer of the formerly patented item should be free to utilize, in advertising its goods for sale, a realistic depiction of the item," and stated that:

[W]e must balance against opposer's argument for the extension of existing case law on functionality [to] what is shown by the record to be long use of the keel cooler depiction by applicant in the manner of a logo. Further, opposer has not discussed whether, when custom manufacturing services are involved, we should still apply the *TrafFix* test for functionality (a three-dimensional product design is functional if it is "essential to the use or purpose of the product or if it affects the cost or quality of the product") to the product that results from purchasing the services, or whether the test should be adapted and focus on whether use of the two-dimensional design to be registered is essential to anyone who would provide the same service, or would, if unavailable, affect the cost or quality of the service.

Id. at 1794, citing *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001 (2001).

The Board held that opposer had failed to justify an extension of existing law to cover the circumstances of this case, but stated that its decision "does not foreclose the extension of *TrafFix* to service marks if circumstances in a future case warrant such an extension." *Duramax*, 80 USPQ2d at 1794.

1202.02(a)(viii) Functionality and Non-Traditional Marks

In addition to product design and product packaging, the functionality doctrine has been applied to other non-traditional proposed marks, such as sound, color, and flavor, and the same *Morton-Norwich* analysis, discussed above, applies to these marks. *See, e.g., Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 1532, 32 USPQ2d 1120, 1123 (Fed. Cir. 1994), *cert. denied*, 514 U.S. 1050 (1995) (finding the color black for outboard motors functional because it provided competitive advantages such as ease of coordination with a variety of boat colors and reduction in the apparent size of the engines); *In re Florists' Transworld Delivery Inc.*, 106 USPQ2d 1784, 1791 (TTAB 2013) (finding the color black for floral packaging functional because there was a competitive need for others in the industry to use black in connection with floral arrangements and flowers in order to communicate a desired sentiment or occasion such as elegance, bereavement, or Halloween); *In re Pohl-Boskamp GmbH & Co.*, 106 USPQ2d 1042 (TTAB 2013) (finding the flavor peppermint functional for nitroglycerin lingual spray based on evidence that peppermint oil, which imparts a flavor of peppermint, can improve the effectiveness of sublingual nitroglycerin spray); *In re Vertex Grp. LLC*, 89 USPQ2d 1694, 1700 (TTAB 2009) (affirming the refusal to register an alarm sound emitted by personal security alarms in the normal course of operation without showing of acquired distinctiveness); *Saint-Gobain Corp. v. 3M Co.*, 90 USPQ2d 1425, 1447 (TTAB 2007) (deep purple shade for coated abrasives held functional, the Board finding that coated abrasive manufacturers have a competitive need to use various shades of purple, including applicant's shade, and that "[i]n the field of coated abrasives, color serves a myriad of functions, including color coding, and the need to color code lends support for the basic finding that color, including purple, is functional in the field of coated abrasives having paper or cloth backing."); *In re N.V. Organon*, 79 USPQ2d 1639, 1645-46 (TTAB 2006) (finding the flavor orange functional for pharmaceuticals where the evidence showed the flavor served to mask the otherwise unpleasant taste of the medicine flavor); *see also Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165, 34 USPQ2d 1161, 1163-1164 (1995) (stating that a product color might be considered functional if its exclusive use "would put competitors at a significant non-reputation-related disadvantage," even where the color was not functional in the utilitarian sense); [TMEP §§1202.02\(a\)\(vi\)](#) and [1202.05\(b\)](#) (regarding aesthetic functionality and color marks).

Examining attorneys should also consider the functionality doctrine in relation to other types of non-traditional marks, such as scent. For example, an application to register scent for an air freshener or an application to register the sound of a ring tone for downloadable ring tones must be refused as functional, as the proposed marks are essential to the use or purpose of the goods. *Cf. Vertex*, 89 USPQ2d at 1703 (finding that the "ability of applicant's [security alarms] to emit a loud, pulsing sound is essential to their use or purpose" because the evidence showed that use of a loud sound as an alarm is important and that alternating sound pulses and silence is a "more effective way to use sound as an alarm than is a steady sound").

The *Trademark Manual of Examining Procedure* (TMEP) may be downloaded free of charge from the United States Patent and Trademark Office (USPTO) website at <http://www.uspto.gov/trademark/guides-and-manuals/tmep-archives>.