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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Lange Uhren GmbH

Serial No. 75/883,446

Eric P. Schellin for Lange Uhren GmbH.

Monique C. Miller, Trademark Examining Attorney, Law Office
108 (David Shallant, Managing Attorney).

Before Seeherman, Walters and Holtzman, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

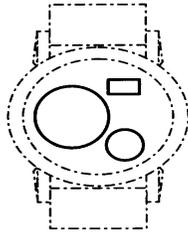
Lange Uhren GmbH has appealed from the final refusal
of the Trademark Examining Attorney to register the design
shown below on the Supplemental Register for "chronometers,

chronographs for use as watches."¹ The application includes the following description of the mark:

The mark consists of a configuration of a watch face consisting of two circles and a rectangle. The large circle serves as a border for the hour and minute hands, the smaller circle serves as a border for the second hand, and the rectangle serves as the border for two numerals indicating the date of the month. Broken lines are used in the drawing to show placement of the mark on the watch. The matter shown by the broken lines is not part of the mark.²

¹ Application Serial No. 75/883,446. The application was originally filed on the Principal Register on December 23, 1999, claiming use between the United States and Germany since 1994. After the Examining Attorney refused registration pursuant to Sections 1, 2 and 45 of the Trademark Act, on the grounds that the proposed mark is not inherently distinctive and that it does not function as a mark, applicant amended its application to the Supplemental Register on December 21, 2000.

² Applicant, in its appeal brief, has offered a new description of the mark, with the following statement: "If it will material [sic] help matters, the applicant would ask to have the application for [sic] remand to consider definite language for the said two circles and rectangle." The proper manner in which to submit a request for remand is to file a separate document captioned as such, rather than to bury such a request in an appeal brief (in this case, at the bottom of the third page). Aside from the procedural irregularity, applicant has not shown good cause for such remand, and the request is hereby denied. It should also be noted that the proposed description appears to change the mark to eliminate the reference to the geometric figures acting as borders for the hour and minute hands, the second hand, and the date; such change would constitute an unacceptable material alteration of the mark.



Registration has been finally refused pursuant to Section 23 of the Trademark Act, 15 U.S.C. §1091, on the grounds that the applied-for design is de jure functional, and that the proposed mark is incapable of identifying applicant's goods and distinguishing them from others. The Examining Attorney has also made final a requirement, pursuant to Trademark Rule 2.61(b), that applicant submit a patent which was referred to in applicant's advertising.

Applicant and the Examining Attorney have filed appeal briefs; an oral hearing was not requested.

We turn first to the Examining Attorney's request that applicant submit its patent. This requirement was made in the second Office action, and arose because of a statement in what the Examining Attorney has characterized as a substitute specimen. (In fact, applicant did not submit a substitute specimen, but argued that its original specimen was acceptable. The statement appears in the original specimen.) The statement advertises a "patented outside

date" as a feature of applicant's watch.³ The Examining Attorney required that applicant submit a copy of the patent to which this statement refers. Applicant responded by stating that the mention of the patented outside date "does not refer to any U.S. patents expired or not expired so the point is moot." Apparently the Examining Attorney interpreted this statement as indicating that the relevant patent had not been issued in the United States, because in the next, and final, Office action, the Examining Attorney stated that applicant's response was insufficient because the request for information was not limited to U. S. patents.

In its appeal brief applicant made the following statement:

The examining-attorney relies heavily on the statement made by applicant in one [of] its advertising materials wherein [it] is mentioned mentions [sic] a patent to cover an "outside date". There is no patent of applicant or applicant's having rights under a patent live or expired depicting the two large and small circles with a rectangle as depicted on the present application or discoursed thereon in the above. Essentially such a statement was made heretofore during the course of prosecution. To obviate

³ The advertising text also refers to "stop seconds" as well as "manually wound," "twin barrels," and "power-reserve indicator." The Examining Attorney has assumed that the patent refers to the stop seconds as well as the outside date. We do not read the advertising material in this manner.

any further such assertion applicant offers herewith a list (EXHIBIT A) of all the patents in which applicant possesses some interest. Also forwarded herewith is a translated copy of European patent No. 0 529 191 (EXHIBIT B) which has absolutely no bearing on the instant matter. It is submitted that the reference to a patent is by way of puffery to gain advantage competitively which has nothing to do with a large circle, a smaller circle and a rectangle and their relative positions.
p. 2-3.

In general, to make evidence of record subsequent to the filing of an appeal, the applicant must file a request for remand. See Trademark Rule 2.142(d). In this case, however, the Examining Attorney has discussed and, in fact, relied on, the exhibits submitted with applicant's appeal brief. Therefore, we deem this evidence to have been stipulated into the record.

The Examining Attorney has continued to assert that applicant has not complied with the requirement that it submit its patent. Although the Examining Attorney has pointed to statements made in the European patent to support her claim that the design mark is functional, at the same time she has asserted that, because applicant stated that Exhibit B "has no bearing on the instant matter," it is not responsive to the requirement that applicant submit a copy of the patent referenced in the

specimen. The Examining Attorney also criticizes this exhibit because "applicant has not specified whether the submitted translation is the patent referenced in the specimen of use." Brief, p. 13.

There is a certain Alice-in-Wonderland quality to the Examining Attorney's objections. Applicant has repeatedly stated that the reference to a patent in the specimen is mere puffery, and does not refer to an actual patent. Yet the Examining Attorney continues to insist that applicant must submit this non-existent patent. Further, although applicant, in an excess of caution, has submitted a list of all the patents it owns or in which it has an interest, including a copy of its European patent for a date-indicating device, the Examining Attorney has criticized the latter patent (while at the same time relying on it to show the mark is functional) because applicant has not stated that it is the patent to which the advertising refers, when applicant has stated that there is no such patent.

Trademark Rule 2.61(b) provides that "the examiner may require the applicant to furnish such information and exhibits as may be reasonably necessary to the proper examination of the application." Clearly, Examining Attorneys are authorized to require such information, and

the Board has affirmed refusals of registration when applicants have failed to comply with such requirements. See **In re SPX Corp.**, 63 USPQ2d 1592 (TTAB 2002); **In re Babies Beat, Inc.**, 13 USPQ2d 1729 (TTAB 1990). However, the requirement must be reasonable. It is patently unreasonable for the Examining Attorney to continue to insist that applicant submit a copy of a patent when applicant has already explained that it does not exist.⁴

The Examining Attorney's requirement that applicant submit the requested information is reversed.

This brings us to a consideration of the refusal based on the ground that applicant's proposed mark is de jure functional. Section 23(c) of the Trademark Act prohibits the registration of any matter that as a whole is functional.

The Examining Attorney asserts that applicant's mark is functional because each of the separate elements of the overall configuration is functional, and that applicant has simply combined the functional elements into a logical combination which is merely the sum of the functional parts and, therefore, the whole is functional, also. The

⁴ Of course, if an applicant were, in response to a request for information or exhibits, to deliberately misstate that such information or materials did not exist, the application or any resulting registration would be vulnerable in an inter partes proceeding to a claim of fraud.

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Examining Attorney also asserts that the positioning of the different elements on the face of the watch is merely the logical accommodation of the internal functional shapes.

A product feature is functional and cannot serve as a trademark if it is essential to the use or purpose of the article or it affects the cost or quality of the article. A functional feature is one the exclusive use of which would put competitors at a significant non-reputation-related disadvantage. **Qualitex Co. v. Jacobson Products Co.**, 514 U.S. 159, 34 USPQ2d 1161 (1995), quoted in **TraFFix Devices Inc. v. Marketing Displays Inc.**, 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001).

The Examining Attorney has reached the conclusion that applicant's mark is functional by examining the evidence in light of the four factors set forth in **In re Morton-Norwich Products, Inc.**, 671 F.2d 1332, 213 USPQ 9 (CCPA 1982):

(1) the existence of a utility patent that discloses the utilitarian advantages of the design; 2) advertising materials in which the originator of the design touts the design's utilitarian advantages; 3) the availability to competitors of alternative designs; and 4) facts indicating that the design results from a comparatively simple or cheap method of manufacturing the product.

With respect to the first factor, the Examining Attorney points to the European patent which applicant submitted as Exhibit B to its appeal brief. That patent relates to a date indicator for a wristwatch. The patented operating mechanism for the date indicator requires a smaller operating area, thus allowing more flexibility in the positioning of the date display, including in the edge region of the watch.

The patent does not show that the rectangle portion of applicant's proposed mark, which is used as the border for the date, is functional. Although the patent allows for the rectangular date indicator to be located in the part of the watch face as shown in applicant's mark, that placement is not dictated by the patent. On the contrary, the patent indicates that the rectangle area for the date would not be restricted to any particular position on the watch face.

The second factor is whether there are any advertising materials which tout the utilitarian advantages of the design. The Examining Attorney points to that portion of the advertising copy which lists as a feature of the watch the "patented outsize date."⁵ To the extent that the

⁵ Again, the Examining Attorney also refers to the mention of "stop seconds" as part of the patented "outsize date" feature; however, as pointed out in footnote 3, we do not read the copy as referring to the "stop seconds" as being part of the patented "outsize date" feature.

Examining Attorney considers the reference to a patent as touting the utilitarian feature of the design, the utility patent which is of record, as we have discussed above, does not demonstrate that the rectangular portion of applicant's mark is utilitarian, or that the rectangular section must appear in the placement shown in the mark. To the extent the highlighting in the copy of the outside date is asserted to be touting the utilitarian nature of the design, we find that this is insufficient to show that the mark is functional. The rectangular shape which is part of applicant's proposed mark, while not particularly large, might be viewed as being able to accommodate a date shown in larger type. However, the rectangular shape does not appear to us to be particularly outside, such that the rectangular border would be perceived as utilitarian. Further, the rectangular shape is only one element of applicant's mark. The two circle designs are at least as prominent as the rectangular shape. And there is no touting of any utilitarian aspect of these designs, or of the configuration as a whole.

The third factor is the availability of alternative designs. Applicant has submitted 34 exhibits showing alternative designs of watch faces which contain various circles, squares and rectangles bordering indicators of

seconds, hours and minutes, dates and days. The Examining Attorney does not appear to contest that there are alternative designs, because in terms of this factor she states "the mere fact that there are alternative designs does not automatically mean that the configuration that Applicant seeks to register is not functional." Brief, p. 9. We think that applicant has persuasively shown that there are many alternatives for depicting minutes and hours; seconds; and the date. In fact, applicant's design is different from the others which have been submitted in that the others all appear to indicate the minutes and hours in a large circle that forms the circumference of the watch as a whole. Applicant's design, on the other hand, is for a smaller circle in which minutes and hours are to be depicted, and this circular border appears within the larger circumference of the watch itself.

As for the final factor, applicant has stated that there are alternate designs that would not be more costly to produce. Certainly there is no evidence that the use of the two circles and a rectangle as depicted in applicant's mark results from a comparatively simple or cheap method of manufacturing the product. The Examining Attorney argues that "it would seem that competitors would need to be free to copy the design in order to compete, given that it is

common for the various components of a watch face to consist of a date function, a minute and hour function and a seconds functions [sic]. The configuration is functional because the design must be made available for others to use if they are going to compete effectively." Brief, pp. 9-10. This argument clearly does not establish that applicant's design would result in a cheaper method of manufacture.

This is not to say that applicant's mark does not consist of very common elements. On the contrary, the evidence shows that circles are commonly used as the shape bordering the depiction of both hours and minutes, and seconds, and rectangles or squares are used as the border for the date. However, applicant is not seeking to obtain exclusive rights to the use of a circle or a rectangle as a trademark for watches. Applicant is seeking to register two circles and a rectangle which have a particular size ratio and placement to each other. The Examining Attorney has neither shown how these particular sizes and placements of circles and rectangle are functional, nor how the registration of this particular design would hinder competition.

Accordingly, we reverse the refusal based on the ground of de jure functionality.

The final ground for refusal is that "the proposed mark does not function as a trademark." Examiner's brief, p. 11. The Examining Attorney has asserted that applicant's sales figures do not provide [sic, should be prove] that purchases [sic] recognize the design sought to be registered as Applicant's mark" and that "the purchasing public would not perceive the applied for mark as identifying or distinguishing Applicant's chronometers and chronographs for use as watches as to source." Brief, p. 12.

We agree with the Examining Attorney that, based on this record, the applied-for design does not function as a mark. However, applicant has applied for registration on the Supplemental Register, for which the requirement is only that the matter be capable of distinguishing applicant's goods or services. Thus, it is not necessary that at this time the design actually distinguishes the source of applicant's goods, or that it currently functions as a mark. There is no question, as we mentioned above, that circular borders are used in numerous watches, and that rectangular borders are used for the date indicator. In view of this, consumers are not likely to recognize such geometric shapes as source indicators. However, applicant has not applied for a circle or rectangle shape per se, but

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two circles and a rectangle of particular size ratios and placement. We cannot say that the applied-for matter is incapable of ever distinguishing applicant's goods.

Accordingly, we find that the mark is registrable on the Supplemental Register.

Decision: The refusals of registration on the grounds that the applied-for mark is de jure functional and incapable of functioning as a trademark and the requirement for submission of a particular patent are reversed.