

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Oral hearing:  
June 20, 2006

Mailed:  
February 21, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Elevator Safety Company

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Serial Nos. 76507505; 76507507; 76507675; 76507677;  
76507734; 76507735; 76507737; 76507741<sup>1</sup>

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James J. Merek of Merek, Blackmon & Voorhees, LLC for  
Elevator Safety Company.

Linda A. Powell, Trademark Examining Attorney, Law Office  
104 (Chris Doninger, Managing Attorney).

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Before Rogers, Kuhlke and Walsh, Administrative Trademark  
Judges.

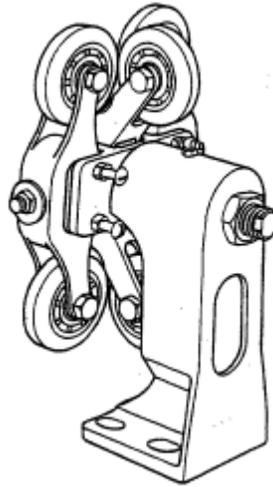
Opinion by Kuhlke, Administrative Trademark Judge:

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<sup>1</sup> On January 24, 2006, upon request by the examining attorney, the Board consolidated these eight appeals and the Board is addressing them in a single opinion. Citations to the briefs refer to the briefs filed in application Serial No. 76507505, unless otherwise noted; however, we have, of course considered all arguments and evidence filed in each case. Applicant also appealed the refusal issued in a related application, Serial No. 76507676. While the Board heard oral argument on that appeal as well as these consolidated appeals at the same oral hearing, the issues in application Serial No. 76507676 are different and a decision in that case is being issued under a separate opinion.

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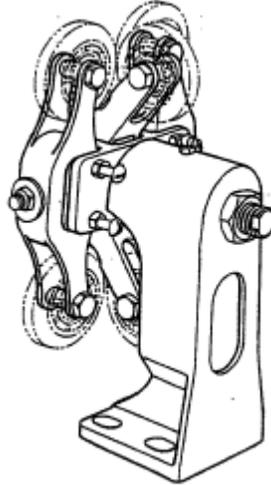
The Elevator Safety Company has filed applications to register as trademarks on the Principal Register the following:



for "elevator roller guides" in International Class 7, describing the mark as follows: "The mark consists of a three-dimensional configuration of an elevator roller guide. The roller guide includes three main components: the base mounting bracket, the central hub and the pivot arms. Each pivot arm holds two wheels, mounted at the extreme and opposite ends of the arm. The two 'side' pivot arms are identical, and consist of two parallel, generally diamond-shaped faces, connected in the middle by an elongated cylinder. Substantially oval holes at the center of each face of the pivot arm reveal the springs and some inner workings of the guide. The third pivot arm is disposed between the other two pivoting arms and is rotated approximately 90 degrees relative to the other arms. This 'face' pivot arm consists of two parallel faces, each shaped in an angular, three-section, wide-spread U configuration. These two planes are attached to each other in two places near the angles of the U shape. All three pivot arms are attached at their middles to a central hub, which consists of a cylindrical section attached to four flat rectangular surfaces. The base includes a substantially planar platform and a generally

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oval main support section, reinforced with an angled rib extending from the bottom of the main support section. The top of the oval main support receives the hub's cylinder. A large generally oval hole is formed in the lower portion of the main support";<sup>2</sup>

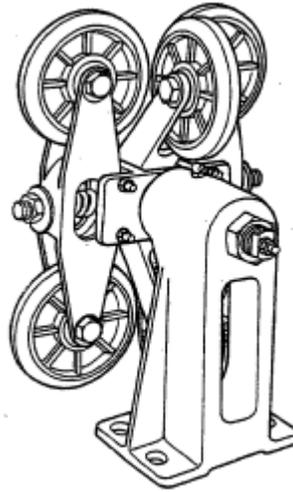


for "elevator roller guides" in International Class 7, the description of the mark is identical to the description in Serial No. 76507505 with the addition of the following: "The wheels depicted by dotted lines do not form any part of the mark in this application.";<sup>3</sup>

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<sup>2</sup> Application Serial No. 76507505, filed April 18, 2003, alleging January 1, 1980 as the date of first use and the date of first use in commerce.

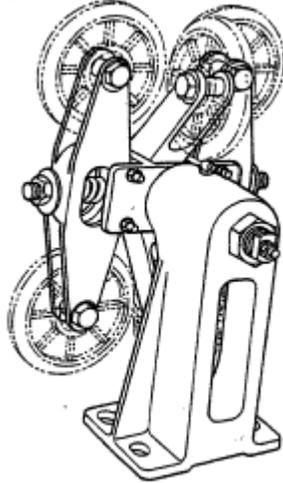
<sup>3</sup> Application Serial No. 76507507, filed April 18, 2003, alleging December 31, 1961 as the date of first use and first use in commerce.



for "elevator roller guides" in International Class 7, describing the mark as follows: "The mark consists of a three-dimensional configuration of an elevator roller guide consisting of three main components: the base mounting bracket, the central hub and the pivot arms. Each pivot arm holds two wheels, mounted at the extreme and opposite ends of the arm. The two 'side' pivot arms are identical, and consist of two parallel, generally diamond-shaped faces, connected in the middle by an elongated cylinder. Oval holes at the center of each face of the pivot arm reveal the springs and some inner workings of the guide. The third pivot arm is disposed between the other two pivoting arms and is rotated approximately 90 degrees relative to the other arms. This 'face' pivot arm consists of two parallel faces, each shaped in an angular, three-section, wide-spread U configuration. These two planes are attached to each other in two places near the angles of the U shape. All three pivot arms are attached at their middles to a central hub, which consists of a cylindrical section attached to four flat rectangular surfaces. The base includes a substantially planar platform and two main support sections, reinforced with angled ribs down the sides, that connect to a cylindrical top section of the base. This top cylinder receives the hub's cylinder. The two main supports are divided by a large,

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somewhat rounded, but generally rectangular hole";<sup>4</sup>

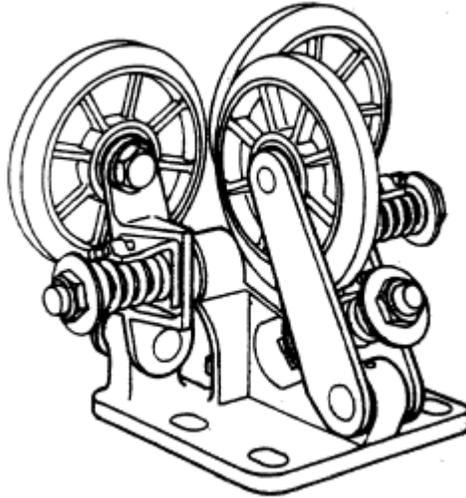


for "elevator roller guides" in International Class 7, the description of the mark is substantially identical to the description in Serial No. 76507675 with the addition of the following: "The wheels depicted by dotted lines do not form any part of the mark in this application";<sup>5</sup>

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<sup>4</sup> Application Serial No. 76507675, filed April 18, 2003, alleging January 1, 1980 as the date of first use and first use in commerce.

<sup>5</sup> Application Serial No. 76507734, filed April 18, 2003, alleging December 31, 1961 as the date of first use and first use in commerce.

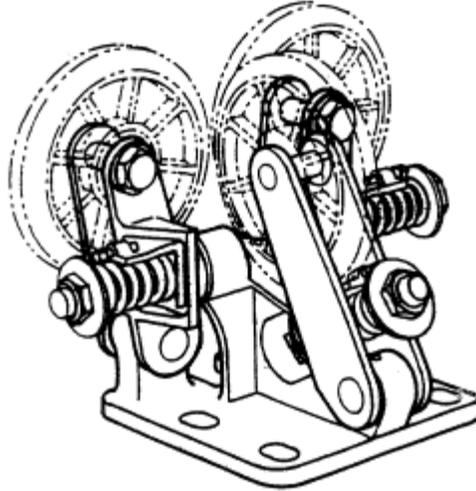


for "elevator roller guides" in International Class 7, describing the mark as follows: "The mark consists of a three-dimensional configuration of an elevator roller guide. The roller guide includes three main components: the base, three pivot arms and the spring and bolt assemblies. All three pivot arms consist of two parallel surfaces of generally elongated oval shapes. The two 'side' pivot arms have tabs that protrude from their sides. The two side pivot arms extend outwardly in a substantially V-shaped configuration from lugs cast into the base casting. The third 'face' pivot arm forms an acute angle with the base and extends upwardly from a third lug on the base and bisects the V-shaped configuration formed by the other two pivot arms. Two of the spring and bolt assemblies extend in opposite directions from each other and extend substantially parallel to the base. They are attached to a large ridge-like portion of the base. The third spring and bolt assembly forms an acute angle with the base and a 90 -degree angle with the face pivot arm. The base includes a substantially planar platform that has three lugs for attaching the pivot arms, as well as a large central ridge";<sup>6</sup>

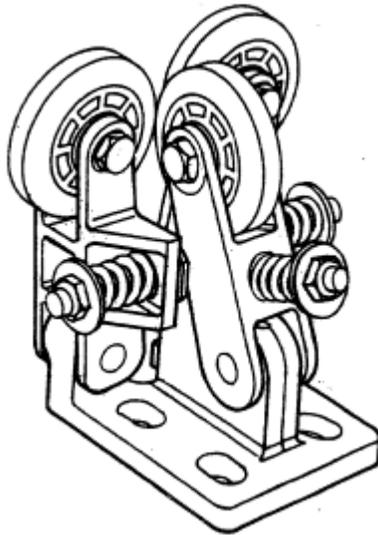
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<sup>6</sup> Application Serial No. 76507735, filed April 18, 2003, alleging January 1, 1980 as the date of first use and first use in commerce.

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for "elevator roller guides" in International Class 7, the description of the mark is substantially identical to the description in Serial No. 76507735 with the addition of the following: "The wheels depicted by dotted lines do not form any part of the mark in this application";<sup>7</sup>



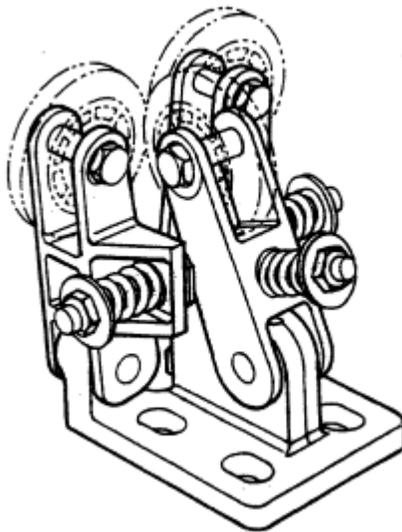
for "elevator roller guides" in International Class 7, describing the mark as follows: "The mark consists of the three-dimensional configuration of an elevator roller guide. The roller guide includes three main components: the base, three pivot arms and the spring and bolt assemblies. All three pivot arms consist of

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<sup>7</sup> Application Serial No. 76507737, filed on April 18, 2003, alleging December 31, 1961 as the date of first use and first use in commerce.

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two parallel surfaces of generally elongated oval shapes. The two 'side' pivot arms have tabs that protrude from their sides. The two side pivot arms extend outwardly in a substantially V-shaped configuration from lugs cast into the base casting. The third 'face' pivot arm forms an acute angle with the base and extends upwardly from a third lug on the base and bisects the V-shaped configuration formed by the other two pivot arms. Two of the spring and bolt assemblies extend in opposite directions from each other and extend substantially parallel to the base. They are attached to a large ridge-like portion of the base. The third spring and bolt assembly forms an acute angle with the base and a 90-degree angle with the face pivot arm. The base includes a substantially planar form that has three lugs for attaching the pivot arms, as well as a large central ridge.";<sup>8</sup> and



for "elevator roller guides" in International Class 7, the description of the mark is substantially identical to the description in Serial No. 76507677 with the addition of the following: "The wheels depicted by dotted lines do not form any part of the mark in this application";<sup>9</sup>

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<sup>8</sup> Application Serial No. 76507677, filed April 18, 2003, alleging January 1, 1980 as the date of first use and first use in commerce.

<sup>9</sup> Application Serial No. 76507741, filed April 18, 2003, alleging December 31, 1961 as the date of first use and first use in commerce.

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The proposed marks in the applications comprise four of applicant's elevator roller guides, referred to in applicant's literature as Models A, B, C and D. Models A (76507675 and 76507734) and C (76507505 and 76507507) have six wheels, but the central hubs and bases have a slightly different shape and the wheels in Model A are larger. Models B (76507735 and 76507737) and D (76507677 and 76507741) have three wheels, but the bases are slightly different in shape and the wheels in Model B are larger. Applicant seeks to register each of these models with and without the wheels for a total of eight applications.

The examining attorney refused registration under Section 2(e)(5) of the Trademark Act, 15 U.S.C. § 1052(e)(5), on the ground that applicant's alleged marks are functional, and under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052, 1127, on the ground that applicant's alleged marks are non-distinctive configurations that fail to function as trademarks. In maintaining the refusal under Sections 1, 2 and 45, the examining attorney also found that applicant did not make a sufficient evidentiary showing of acquired distinctiveness under Section 2(f), 15 U.S.C. § 1052(f).

When the refusals were made final, applicant appealed. Briefs have been filed and an oral hearing was held upon

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applicant's request. We affirm the refusals to register in each application.

#### **EVIDENCE OF RECORD**

In support of the refusals, the examining attorney submitted: (1) printouts from applicant's website; and (2) printouts from third-party websites. In response to the refusals, applicant submitted: (1) several third-party utility patents, including three utility patents owned by applicant's predecessor; (2) the declarations of Gordon Ferguson, General Manager of Eltec Systems, LLC and Wayne Chiang, ThyssenKrupp Elevator, customers of applicant; (3) industry literature from third parties discussing their elevator roller guides; (4) an agreement entered into with Bral Corporation, a supplier of applicant; (5) the declaration of Douglas W. Hamilton, III, applicant's vice-president; and (6) samples of applicant's advertising.<sup>10</sup>

#### **FUNCTIONALITY UNDER SECTION 2(e)(5)**

Under the statute, functional matter is unregistrable. 15 U.S.C. §1052(e)(5). Matter is functional if "it is essential to the use or purpose of the article or if it

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<sup>10</sup> Applicant's objection to the examining attorney's arguments in her brief regarding certain features of applicant's proposed marks is not well taken. The examining attorney did not submit new evidence, refer to extrinsic evidence or raise a new refusal; she simply responded to applicant's argument raised for the first time in its brief that she had not ascribed any function or utility to certain aspects of applicant's mark.

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affects the cost or quality of the article.” *TraFFix Devices Inc. v. Marketing Displays Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001) (citation omitted). In making our determination of functionality we apply the test first set forth in *In re Morton Norwich Products, Inc.*, 740 F.2d 1550, 213 USPQ 9 (CCPA 1982). See *Valu Engineering Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1427 (Fed. Cir. 2002); *American Flange & Manufacturing Co., Inc. v. Rieke Corporation*, 80 USPQ2d 1397 (TTAB 2006). Morton-Norwich identifies the following factors to be considered in determining whether a particular design is functional: (1) the existence of a utility patent disclosing 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 functionally equivalent designs; and (4) facts indicating that the design results in a comparatively simple or cheap method of manufacturing the product. *Morton-Norwich, supra*, 213 USPQ at 15-16.

With regard to the first factor, the existence of a utility patent “is strong evidence that the features claimed therein are functional” and “[w]here the expired patent claimed the features in question, one who seeks to establish trade dress protection must carry the heavy

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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." *TraFFix*, supra, 58 USPQ2d at 1005. Further, third-party utility patents may be relied upon as evidence; ownership of the utility patent is not relevant. *American Flange*, supra. See also *In re Virshup*, 42 USPQ2d 1402, 1405 (TTAB 1997).

The Federal Circuit has clarified the role of the third Morton-Norwich factor:

Nothing in *TraFFix* suggests that consideration of alternative designs is not properly a part of the overall mix, and we do not read the Court's observations in *TraFFix* as rendering the availability of alternative designs irrelevant. Rather, we conclude that the 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. But that does not mean that the availability of alternative designs cannot be a legitimate source of evidence to determine whether a feature is functional in the first place.

*Valu Engineering Inc. v. Rexnord Corp.*, supra, 61 USPQ2d at 1428 (footnote omitted).<sup>11</sup>

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<sup>11</sup> In *TraFFix* the Supreme Court stated:

It is proper to inquire into a 'significant non-reputation-related disadvantage' in cases of aesthetic functionality, the question involved in *Qualitex*. 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

Utility Patents

We turn first to a consideration of the various utility patents of record. The examining attorney makes the following observations:

Having examined prior patents issued to third parties for elevator roller guides made of record by the applicant, and having considered the development of the arts as applied to such devices, the Trademark Examining Attorney found no part of the configuration of the goods in question that appears to be without a functional purpose. The three wheeled roller guide is described in U.S. Patent 1,713,165 (1929). The pivotal supports for each roller and spring tension on the wheels are claimed in U.S. Patent 1,854,976 (1932), albeit in a different configuration, however, the utilitarian purpose is the same. The six wheel guide is described in U.S. Patent 3,329,240 (1967) and also in U.S. Patent 3,856,117 (1967), which has a highly similar configuration of wheels, pivot arms, and bolt and spring assemblies. The Trademark Examining Attorney notes that similar U.S. Patents 2,251,963 (1941) and 2,253,820 (1941) (for five and six wheeled roller guides) and 2,265,086 (1941) (for pressure adjusting features on elevator roller guides) may have belonged to predecessors in interest of the applicant. A supporting base structure of some sort appears to be part of all of the patents for elevator roller guides. That the component parts of roller guides may be produced in other shapes or forms that all perform the same function does not detract from the utility provided by any of the alternative forms. Granting the applicant the exclusive use of an elevator roller guide with

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feature. In *Qualitex*, by contrast, aesthetic functionality was the central question, there having been no indication that the green-gold color of the laundry press pad had any bearing on the use or purpose of the product or its cost or quality.

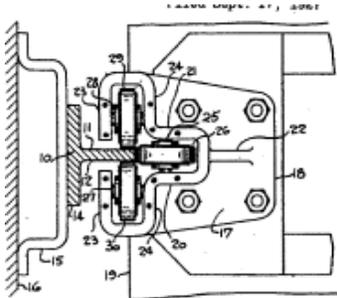
TrafFix, *supra*, 58 USPQ2d at 1006.

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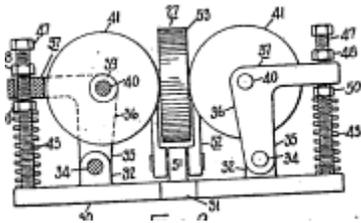
three or six wheels supported by pivotal arms with spring and bolt assemblies for the application of pressure to the wheels designed for a standard 'T' rail would severely hamper the ability of other elevator part manufacturers to provide suitable rail stability devices for use with elevators traveling on similar rails and for use with similar speeds and weight allowances. That these features were the subject of claims in prior patents clearly establishes the utilitarian nature of the features, and shows that other manufacturers of the goods have a right to those features that have now passed into the public domain by virtue of the expiration of the patents.

Br. unnumbered pp. 5-6.

Drawings from the various patents noted by the examining attorney are shown below.

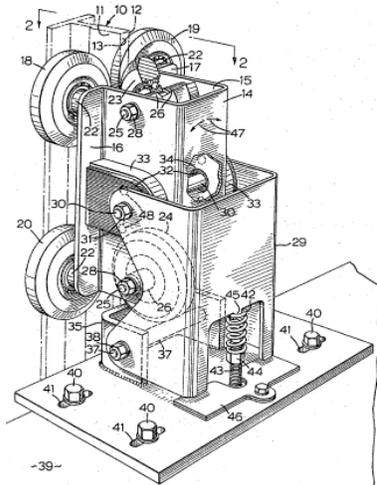


Patent No. 1713165 (three-wheeled roller guide)

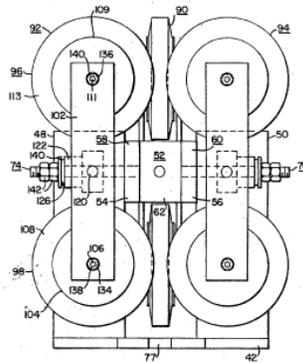


Patent No. 1854976 (pivotal supports for roller and springs)

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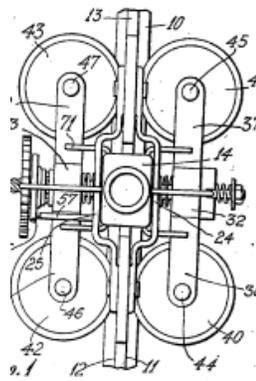
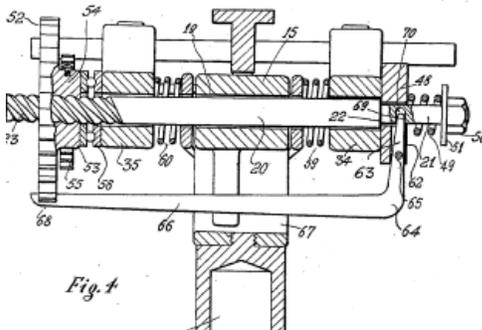


Patent No. 3329240 (six-wheeled guide)



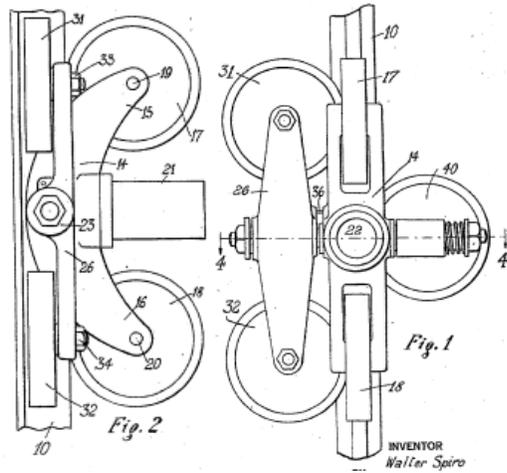
Patent No. 3856117 (six-wheeled guide)

The three patents that were assigned to applicant's predecessor-in-interest are shown below.

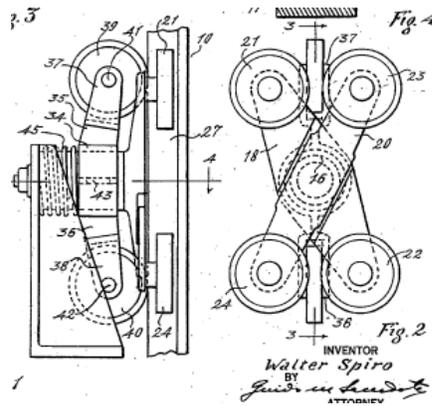


Patent No. 2265086

(pressure adjusting feature)



Patent No. 2251963



Patent No. 2253820

Patent No. 2251963, issued on August 12, 1941, is for a "roller guide for elevator cars." The patent drawings illustrate the various key features, including, diamond-shaped pivot arms, U-configured pivot arms, spring-bolt assemblies going through the pivot arms, and a parallel construction to ride on the rail. But for the absence of the oval hole in the side pivot arm, these features are virtually identical to the diamond-shaped pivot arms, the U-configured pivot arms and the spring-bolt assemblies claimed in applications Serial Nos. 76507505, 76507507,

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76507675, and 76507734. The patent discloses that it is designed to be an improvement of prior art that "may be constructed in a much simpler form, calculated to further reduce the friction in operation, while calling for a much lighter structure, adapted to be produced at considerably less cost." The design is "automatically adjustable to unbalanced loading of the elevator and to rails presenting bends and other irregularities, while preventing undue friction and noisy operation of the elevator." Further, "the guide structure comprises an elongated frame formed at each end with a bifurcated, outwardly extending support...the frame extends in front of, and parallel with the rail and the wheels or rollers are of equal diameter, and are symmetrically mounted with respect to the center of the frame...[t]he construction described thus provides a three-point rolling contact for the guide, which is possessed of a great amount of flexibility in action, inasmuch as the resilient mounting of both the yoke and sleeve make it possible for all the rolling elements to instantly adjust themselves to such bends, misalignments and inequalities as may occur at certain points in the guide rail...[t]he treads with which the wheels or rollers are equipped, being to a certain extent compressed when forced against the running surfaces of the guide rail by

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the action of springs as well as by the spring housed within the hub also serve to provide a certain amount of resilient action, insuring continuity of contact between said wheels and said rail even when some particularly sharp irregularity occurs in the guide rail...[t]he constructional details of my invention may vary from those shown without departing from the inventive idea. The drawing should, therefore, be understood as being intended for illustrative purposes only and not in a limiting sense." The patent claims, inter alia, "In an elevator guide for use in connection with a guide rail having an end riding surface and two side riding surfaces the combination, with a frame, of a yoke oscillatable in a plane substantially parallel to said end riding surface, mounted at one side of said frame, a roller at each end of said yoke adapted to ride along one of said side riding surfaces, resilient means urging said yoke and rollers against said side surface, a roller carried by the other side of said frame at a point intermediate said two rollers, adapted to ride along the other side riding surface of said rail, and resilient means urging said roller against said second mentioned side riding surface."

The role of the springs is further articulated in Patent No. 2253820 shown above. The elevator roller in

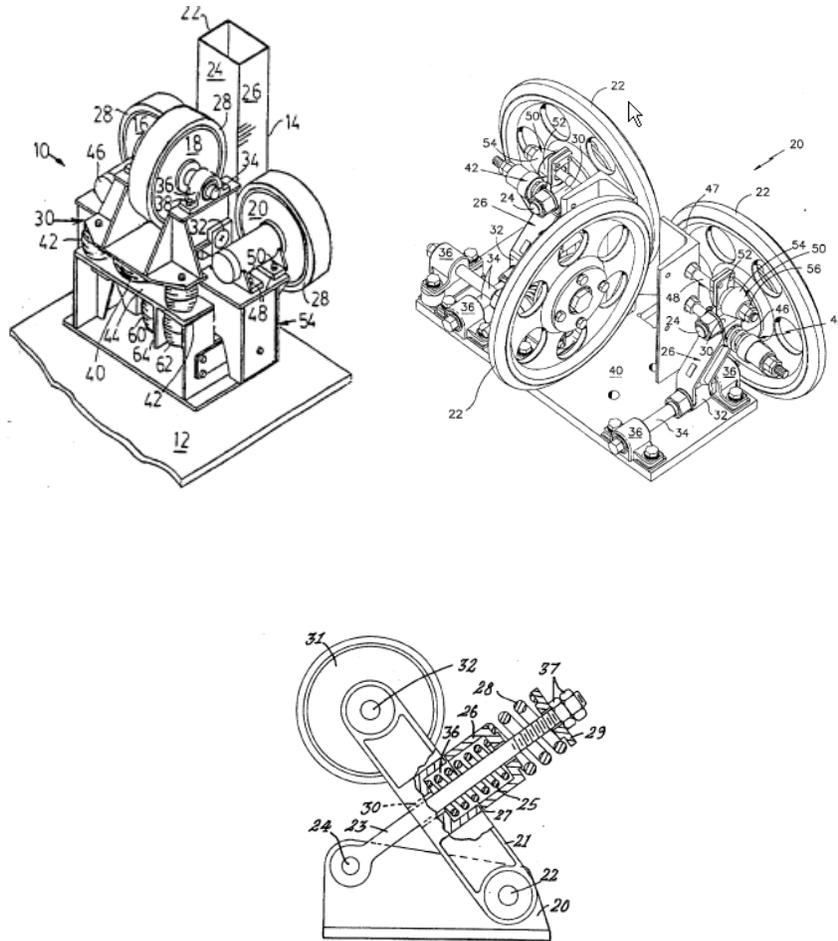
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this patent is designed so that "a single spring may be used to press the side guiding elements into contact relationship between the rollers and the guide-rail; furthermore, it will be seen that any deviation of the elevator car from its normal path in a direction transversal to the rib portion of the guide-rail, causing one or the other of the side surfaces of the rail to react against the rollers riding along the same, will result in an immediate increase in the torsion of the spring, which will thus be more effective in returning conditions to normal. Furthermore, if an abnormal condition arises due to an irregularity in the rail, causing a reaction to take place by the rail against only one of the rollers, the tension of the spring will in this case also be increased, causing the roller directly opposite to press with increased pressure against its own riding surface, thus giving rise to a counter reaction, which will be paired with the action of the arm which was previously deflected from its normal position, in returning conditions to normal. In both cases, therefore, the tension of the spring is increased under abnormal stresses, causing swinging movement of one or both arms around their common axis, and furthermore, the force exerted by the spring is utilized in its entirety in reestablishing normal

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conditions." This patent claims, inter alia, "each arm having a roller at each end, a helical spring, interposed between said arms, urging said arms to rotate each in the direction in which one of its rollers will press against one of said side riding surfaces, and the other roller will press against the opposite surface, a frame mounted on, and shiftable along said bearing, having two longitudinally spaced rollers adapted to ride along said end riding surface, and a spring urging said frame towards said end riding surface."

We further note Patent Nos. 5107963 and 6062347 showing three-wheeled elevator roller guides in alignments similar to applicant's proposed marks in application Serial Nos. 76507677, 76507735, 76507737, and 76507741 and an angled pivot arm with spring-bolt assembly similar to those depicted in Serial Nos. 76507677, 76507735, 76507737, and 76507741.



Applicant argues that "the design for which [applicant] is seeking federal registration has not been the subject of a utility or design patent or patent application." Br. p. 10. That applicant has chosen to pursue trademark protection rather than patent protection, does not render an otherwise functional configuration non-functional. As can be seen from the several utility patents made of record, each piece of applicant's elevator roller guides has a functional purpose: the diamond-shaped pivot arm, a standard yoke shape; the U-configured pivot

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arm to sit between the side pivot arms and allow room for the wheel to clear the arm and make contact with the face of the rail; the springs to present counter pressure; and the bolts to hold everything in place. It also appears that applicant's three-wheeled designs may have further utility in that the angled arms may be adjusted as noted in its advertising material discussed below.

Accordingly, we conclude that the patent evidence supports a finding that applicant's proposed marks are functional.

#### Advertising

Under this factor, we consider evidence regarding "advertising materials in which the originator of the design touts the design's utilitarian advantages." The examining attorney highlights the following from applicant's literature that discusses the attributes of the proposed marks in application Serial Nos. 76507675 and 76507734:<sup>12</sup>

ELSCO's Model A Guides set the performance standard against which all other guides are measured. When seeking optimum performance on either high speed passenger or heavy duty freight elevators, quality conscious elevator contractors through-out the world turn to the design advantages of the tandem-wheel Model A.

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<sup>12</sup> ELSCO is apparently another name for applicant.

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The "walking beam action" of the side and face wheel arms compensates for unbalanced cars or misaligned rail conditions. Fully adjustable stabilizing springs allow the elevator car to float between the rails, eliminating the bumps and vibrations that affect ride quality.

Postwise float can be precisely controlled with adjustable stops, a standard feature on the Model A Guide.

We further note the following excerpts from applicant's advertising literature:<sup>13</sup>

ELSCO's 35 years of advanced engineering and manufacturing technique have led to the development of roller guides and guide shoes to meet almost all elevator load, speed or dimensional requirements. For high speed passenger or heavy duty freight elevators. Our six-wheel Model A and C Guides set the standard for optimum performance. With six wheels, the load carrying capability of the guide is increased, and the shock of a bump is spread over a larger area.

The Model B and D Guides are three-wheel counterparts to the Model A and C Guides, and are recommended for applications where speed and capacity are moderate. ELSCO's Model E Guide offers a simpler design, yet provides optimum performance and cost effective operation on low rise, light to moderate capacity hydraulic elevators.

ELSCO Model B elevator roller guides are designed with adjustment features that provide superior riding characteristics. The installer can easily adjust ELSCO guides to compensate for adverse operating conditions and to minimize noise, bumps and vibration.

...

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<sup>13</sup> Similar excerpts are in the record for each model applicant seeks to register as a trademark.

our spring-loaded roller guides have the ability to compensate for unbalanced cars or misaligned rail conditions.

...

A spring located in the hub of the wheel cluster assembly plays an integral role in the performance of these high speed roller guides. In addition to helping the roller wheels maintain constant contact with the rail, the spring action helps the car float along the rail in a controlled manner. The spring absorbs most of the shock and bumps caused by rail irregularities, isolating noise and vibration from the car.

...

This 'knee action' takes place on three sides of the rail, keeping the wheels in constant contact with the rails. These guides are also designed with a low profile for tight vertical clearances.

...

ELSCO Model C elevator roller guides are designed with adjustment features that provide superior riding characteristics. The installer can easily adjust ELSCO guides to compensate for adverse operating conditions and to minimize noise, bumps and vibration.

...

Each wheel arm assembly is individually spring mounted, allowing the guide to provide the smoothest possible ride, even when rails are rough or slightly misaligned. The wheel arm "knee action" keeps all wheels in constant contact with the rail.

These statements clearly tout the utilitarian advantages of the various features previously discussed in

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the patents. For example, the side and face wheel arms compensate for unbalanced cars, six wheels increases the load-carrying capacity of the guides, the spring-loaded roller guides compensate for unbalanced cars, and the spring in the hub of the wheel cluster absorbs shocks and bumps and helps the rollers maintain constant contact with the rail.

Accordingly, we conclude that the advertising evidence supports a finding that applicant's marks are functional.

Applicant argues that the examining attorney has failed to meet her burden to present a prima facie case of functionality because she has merely dissected the mark and pointed to certain features that may be functional but has not presented a case that the overall configuration is functional. Applicant further contends that the evidence of record does not support a functionality refusal because it is directed only to certain particular features. Applicant particularly notes that its literature does not tout the utilitarian advantages of its overall resulting configuration.

The statute prohibits registration of a mark that "comprises any matter that, as a whole, is functional." 15 U.S.C. 1052(e)(5). The issue then is how do we determine the functionality of the whole. The PTO has the burden of

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showing that a configuration is functional and it may accomplish that task by showing the functionality of various aspects of the configuration. See e.g., *In re R.M. Smith, Inc.*, 734 F.2d 1482, 222 USPQ2d 1, 2 (Fed. Cir. 1984) (“[the board] proceeded to initially review the six features claimed by Smith to comprise its mark. Upon consideration of the entire design, the board found that not only were those features themselves highly functional, except perhaps for the ribs, but that the drawing as a whole included various other highly functional elements, i.e. [b]ased on the functionality of the individual features comprising the design, the board concluded that the design as a whole was de jure functional. We agree with the board that the PTO attorney established a prima facie case of de jure functionality.”)

Applicant relies on *In re Teledyne Industries Inc.*, 696 F.2d 968, 217 USPQ2d 9 (Fed. Cir. 1982) (dissecting proposed product design into its utilitarian features not conclusive that design considered as a whole is functional) in support of its position. However, even in *Teledyne* the Federal Circuit recognized that “in most cases ...the best the PTO can probably do is to analyze a design from the standpoint of its de facto functional features, perhaps with support from technical articles, patent disclosures,

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or the applicant's own advertisements." *Teledyne, supra*, 217 USPQ at 11.

The fact that a utility patent does not exist for each of the same exact overall configurations as applicant's designs is not sufficient to rebut the evidence of record establishing functionality. The configurations are by their nature functional because the designs bring the functional features together and the configurations retain the functional aspects of their parts. They are, in the end, only the sum of their parts, inasmuch as the various patents of record show the way in which the parts are put together and interact.

Even if we were to agree with applicant's argument that the configurations include non-functional features, for example the oval-shaped holes, the clearly functional features included in applicant's descriptions of the marks, as described above, are part of the overall configurations that applicant seeks to register. As stated by the Federal Circuit, "The case law of this court and its predecessor also establishes that before an overall product configuration can be recognized as a trademark, the entire design must be arbitrary or non de jure functional." *Petersen Mfg. Co. v. Central Purchasing Inc.*, 740 F.2d 1541, 1550, 222 USPQ 562, 569 (Fed. Cir. 1984). See also

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In re Minnesota Mining and Mfg. Co., 335 F.2d 836, 142 USPQ 336 (CCPA 1964).

Alternative Designs/Cost of Manufacturing

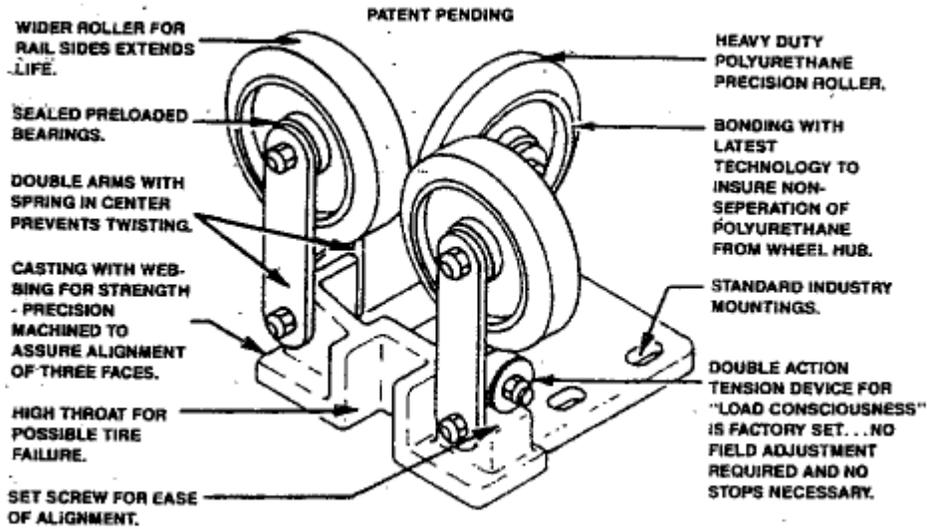
It is applicant's position that the evidence, including the third-party patents and product catalogs, far from supporting a functionality refusal, in fact, preclude a finding of functionality because they show that alternative designs exist, and that, based on the declarations, the record supports a finding that its designs do not result "in a comparatively simple or cheap method of manufacturing the products." Br. p. 12. Once again applicant relies on Teledyne to support its position.

In Teledyne the Federal Circuit noted that the applicant had not shown that commercially feasible alternatives existed and thus had not rebutted the examining attorney's prima facie case. Applicant here argues that evidence of such alternatives exist in this case. However, since Teledyne, the United States Supreme Court in Traffix has addressed the relevance of commercial alternatives as noted above. The Federal Circuit in Valu Engineering clearly stated that "once a product feature is found functional based on other considerations ... the feature cannot be given trade dress protection merely because there are alternative designs available." Valu

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Engineering, supra, 61 USPQ2d at 1427. Thus, the fact that other competitive alternatives may exist, does not alter the initial finding that the configuration is functional and, thus, unregistrable.

In addition, we note that some of the alternative designs are very similar to applicant's designs. An example from the Hollister-Whitney Elevator Corporation is depicted below with a "patent pending" statement.



The primary difference between this design and applicant's three-wheeled design is the angle at which the arms are placed. As noted in applicant's literature, its arms have the added utility of being adjustable.

Finally, while applicant has provided examples of alternative elevator roller guides and the declarations of Mr. Ferguson and Mr. Chiang attesting to the fact that each of applicant's guides "is one of many feasible, efficient

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and competitive designs," it has not explained how its designs are not superior to these other designs. It may be that applicant's configurations perform better than the alternative designs, but at more expense, so while the other designs may compete on price they do not compete on performance.

With regard to the cost of manufacturing, the examining attorney noted that:

The relative costs of competing goods has not been addressed by any party except for the statement from one party, Mr. Hamilton, the applicant's Vice President, who states that he is "not aware of any fact that in any way suggests that the design of the Model A roller guide results from a simple or inexpensive method of manufacture as compared to alternative designs." Similar statements are made for the various models. Nonetheless, no actual evidence has been made of record showing comparable roller guides and the relative costs of manufacture...The applicant does not address whether the various designs or expenses of the applicant's goods is comparable to that of others. Rather, the applicant is "not aware that its goods result from a simple or inexpensive method of manufacturing as compared to alternative designs." In any event, the Court in *TraFFix* held that "where the design is functional under the *Inwood* formulation there is no need to proceed further to consider competitive necessity."

Br. unnumbered pp. 11-12 (citations omitted).

Applicant argues that the examining attorney has conceded that she has no basis for making an assertion that [applicant's] configurations affect the cost of the

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article. Br. p. 6. However, the information regarding the comparative costs of manufacturing for different designs resides with the applicant and applicant did not provide more than the one statement from its vice president that he is not aware that its goods result from a simple or inexpensive method of manufacturing. Moreover, even if its elevator guides are not "comparatively simple or cheap" to manufacture, this does not mean that the design is not functional. In re American National Can Co., 41 USPQ2d 1841, 1844 (TTAB 1997).

Accordingly, we conclude that the evidence of alternative designs and cost of manufacturing does not support a finding of non-functionality.

Because all or substantially all of applicant's overall designs are dictated by the function they perform, we affirm the refusals based on functionality. See In re Vico Products Mfg. Co., 229 USPQ 364, 368 (TTAB 1985).

Once a configuration is found to be functional, a showing of acquired distinctiveness cannot transform it into a trademark. However, for completeness we address the failure to function refusal and applicant's evidence submitted in support of its claim of acquired distinctiveness below.

**FAILURE TO FUNCTION UNDER SECTIONS 1, 2 AND 45**

In response to the refusals based on lack of inherent distinctiveness applicant argues that its marks have acquired distinctiveness. In support of its assertion of acquired distinctiveness, applicant relies on: (1) the declaration of Douglas W. Hamilton, III; (2) the declaration of Gordon Ferguson; (3) the declaration of Wayne Chiang; (3) the Bral Corporation agreement; and (4) applicant's advertising.

Product design, as a matter of law, is not inherently distinctive and can only be registered upon a showing of acquired distinctiveness. *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1068 (2000); *In re Ennco Display Systems, Inc.*, 56 USPQ2d 1279 TTAB (2000). Refusals based on failure to function may be overcome by a showing of acquired distinctiveness under Section 2(f) of the Trademark Act. The burden of proving a prima facie case of acquired distinctiveness in an ex parte proceeding rests with applicant. *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988). An applicant must show that the primary significance of the product configuration in the minds of consumers is not the product but the source of that product in order to establish acquired distinctiveness. See *In re*

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Steelbuilding.com, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005); In re Ennco Display Systems Inc., supra. Acquired distinctiveness may be shown by direct and/or circumstantial evidence. Direct evidence includes actual testimony, declarations or surveys of consumers as to their state of mind. Circumstantial evidence is evidence from which consumer association might be inferred, such as years of use, extensive amount of sales and advertising, and any similar evidence showing wide exposure of the mark to consumers. In re Ennco, 56 USPQ2d at 1283. See also 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, Sections 15:30, 15:61, 15:66 and 15:70 (4th ed. 2005).

There is no fixed rule for the amount of proof necessary to demonstrate acquired distinctiveness, however, the burden is heavier for configurations. In re Ennco, 56 USPQ2d at 1283 (product configurations face a heavy burden to establish secondary meaning). See also Yamaha, supra, 6 USPQ2d at 1008 (evidence required to show acquired distinctiveness is directly proportional to the degree of non-distinctiveness of the mark at issue).

After careful review of the evidence of record, we agree with the examining attorney that applicant's evidence

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of acquired distinctiveness is insufficient to permit registration of the configurations under Section 2(f).

Applicant claims to have sold between 22,000 and 60,000 units of each of its elevator rollers since 1998 and spent approximately \$100,000 on advertising via the catalogs and brochures. Hamilton Decl. ¶ 5.

While the sales volume figures may demonstrate the growing popularity of the product, mere figures demonstrating successful product sales are not probative of purchaser recognition of a configuration as an indication of source. See *Braun Inc. v. Dynamics Corp.*, 975 F.2d 815, 827, 24 USPQ2d 1121, 1133 (Fed. Cir. 1992) (“[L]arge consumer demand for Braun’s blender does not permit a finding the public necessarily associated the blender design with Braun.”); *In re Bongrain Int’l (American) Corp.*, 894 F.2d 1316, 1318, 13 USPQ2d 1727, 1729 (Fed. Cir. 1990) (growth in sales may be indicative of popularity of product itself rather than recognition as denoting origin). Moreover, it is well established that compelling sales and advertising figures do not always amount to a finding of acquired distinctiveness. See *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (\$85,000,000 in annual sales revenues and \$2,000,000 in advertising expenditures found insufficient to establish acquired

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distinctiveness); Goodyear Tire & Rubber Co. v. Interco Tire Corp., 49 USPQ2d 1705 (TTAB 1998) (\$56,000,000 sales revenues and 740,000 tires sold insufficient to show acquired distinctiveness of tire tread design).

Although there may have been substantial sales and some expenditures on advertising, the more important question is how is the alleged mark being used, i.e., in what manner have consumers been exposed to the alleged mark so that we can impute consumer association between the configurations and the product producer. To determine whether a configuration has acquired distinctiveness, advertisements must show promotion of the configuration as a trademark.

Here, there is nothing of record that shows that the alleged marks are being promoted as source indicators. The examples in the record simply show a picture of the product. Applicant's contention appears to be that because pictures of the products appear near applicant's trade name or trademark ELSCO they serve as source-identifying marks. As the examining attorney stated:

The photo is not promoted in a source identifying manner, but is merely used in the promotion of the goods in the context of providing information about the goods identified in the accompanying picture for the applicant's various models of elevator roller guides

Br. unnumbered p. 14.

We see nothing in the record to show that the advertising promotes the configurations in a way that would imbue them with source-identifying significance; rather, the advertising simply shows the product like any advertising would. Applicant has not presented evidence of advertising or promotional efforts that focus upon the trademark significance of the configurations claimed as marks.

Applicant also submitted an agreement between it and one of its suppliers that includes the following statements:

4. Bral hereby expressly acknowledges that Hamilton and/or a related company is the owner of certain trademarks including but not limited to the marks consisting of (1) the red and black colors for roller guides and roller guide parts; and, (2) the product configurations for ELSCO's roller guides including but not limited to the product configurations of Model A, Model B, Model C and Model D roller guides.

5. Bral further agrees not to infringe upon any of Hamilton's or any related company's trademarks including but not limited to those identified in paragraph 4.

6. Bral hereby agrees not to contest the validity of Hamilton's or any related company's trademarks including but not limited to those identified in paragraph 4 in any proceeding including but not limited to any proceeding brought by Hamilton or any related company for enforcement of its trademarks.

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Bral Agreement.

As noted by the examining attorney:

The statement does not state that it does or does not believe the configurations to identify the source of ELSCO's goods, but is merely recognition of ELSCO's claims of ownership for the product configurations, and further agrees not to infringe on any of the referenced marks.

Br. p. 15.

Finally, applicant submitted two consumer declarations which include the following statements:

The configuration of ELSCO'S Models A, B, C and D roller guides with and without wheels also identify ELSCO as the source of the roller guide. The configuration of each ELSCO's Models A, B, C and D roller guides is one of many feasible, efficient and competitive designs.

Chiang and Ferguson Decls.

We do not find these two identical declarations to be particularly persuasive. This conclusory statement is made without particularity as to how consumers are exposed to the alleged marks. In addition, the record does not reveal the extent of applicant's potential customer base and whether these two declarations are sufficiently representative of most potential purchasers.

Accordingly, based upon consideration of all the evidence in the record, we find that applicant has failed to establish that the configurations involved in the

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applications before us have acquired distinctiveness within the meaning of Section 2(f).

**Decision:** The refusals to register the configurations claimed as marks in each application on the grounds that the configurations are functional, or not inherently distinctive and have not been shown to have acquired distinctiveness are affirmed.