

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: February 27, 2008  
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re MGA Entertainment, Inc.

Serial No. 76596389

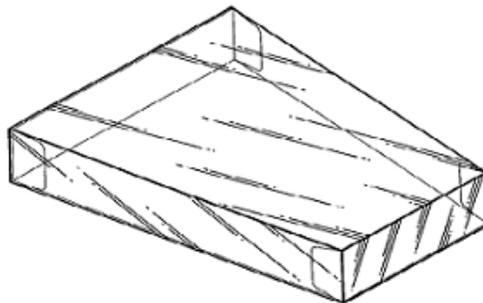
Joel D. Voelzke, Law Office of Joel D. Voelzke for MGA  
Entertainment, Inc.

Melvin T. Axilbund, Trademark Examining Attorney, Law  
Office 113 (Odette Bonnet, Managing Attorney).

Before Hairston, Kuhlke and Cataldo, Administrative  
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

MGA Entertainment, Inc. seeks registration on the  
Principal Register of the box design shown below,



with a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, for goods identified as:

trapezoidal plastic boxes for toys, games and playthings, namely, dolls, doll clothing, doll accessories, playsets, children's play cosmetics, plush toys, toy action figures and accessories therefore, action figure play environments, action skill games, toy vehicles and playsets, toy scooters, board games, card games; and athletic protective pads, namely, arm pads, knee pads, elbow pads and wrist pads for cycling, skating, snowboarding and skateboarding in International Class 16.<sup>1</sup>

The application includes the following statement: "The mark consists of a configuration of a trapezoidal plastic box."

The trademark examining attorney has finally refused registration under Sections 1, 2, and 45 of the Trademark Act on the ground that the identified goods are not goods in trade of applicant.<sup>2</sup>

Applicant has appealed. Both applicant and the examining attorney have filed briefs.

Before turning to the merits of the appeal, we must

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<sup>1</sup> Serial No. 76596389, filed on June 7, 2004, claiming first use dates of May 21, 2001. We note that the Board, in a decision mailed August 17, 2007, affirmed the refusal to register in applicant's companion application Serial No. 76603323.

<sup>2</sup> During the prosecution of the application, applicant amended the application to add goods in International Class 28. The examining attorney made final a requirement that applicant delete from the application the Class 28 goods. Applicant states in its brief that it is not appealing from this requirement. Thus, we consider the Class 28 goods to be deleted from the application.

discuss an evidentiary matter. Applicant, for the first time with its appeal brief, submitted a copy of a third-party registration (No. 2068191) in support of its position that the box design is registrable. The examining attorney, in his appeal brief, has objected to this evidence as untimely. Trademark Rule 2.142(d) provides that the record in an application should be complete prior to the filing of an appeal. Additional evidence filed after appeal normally will be given no consideration. TBMP §1207.01 (2d ed. rev. 2004). In view of the foregoing, the examining attorney's objection is sustained, and the third-party registration submitted with applicant's appeal brief has not been considered in reaching our determination. We hasten to add that this third-party registration, even if considered, would not compel a different result in this case.

We now turn to the refusal to register on the ground that the "trapezoidal plastic boxes for toys, games and playthings, namely, dolls, doll clothing, doll accessories, playsets, children's play cosmetics, plush toys, toy action figures and accessories therefore, action figure play environments, action skill games, toy vehicles and playsets, toy scooters, board games, card games; and athletic protective pads, namely, arm pads, knee pads,

elbow pads and wrist pads for cycling, skating, snowboarding and skateboarding" are not goods in trade. The examining attorney maintains that "[m]aking and selling toys is applicant's business" (Brief at unnumbered 6), and that the trapezoidal plastic boxes function as a means for conveying applicant's toys at point of sale. Further, the examining attorney argues that there is no evidence that applicant communicates to purchasers of its toys that the plastic boxes have a use beyond holding the goods at point of sale. Thus, the examining attorney argues that purchasers would have no reason to view these plastic boxes as having additional functions.

It is applicant's position that the identified trapezoidal plastic boxes for toys, games and playthings are goods in trade. Applicant maintains that its plastic boxes have use beyond simply holding the goods at point of sale. Applicant argues that the plastic boxes in which the goods are packaged "can be reused by consumers as storage boxes for the goods, and are therefore not mere packaging that is necessarily thrown away." (Brief at 3). In this regard, applicant's counsel, Sam Khare, states in his declaration:

Unlike traditional plastic blister packaging or some plastic clamshell packaging, MGA's trapezoidal plastic boxes are reusable. They are

designed to be opened and re-closed numerous times. The child who purchases one of MGA's Bratz® dolls can therefore remove the doll from the package, play with it, and when he or she is finished replace the doll into the package and display the doll in an attractive trapezoidal display box on the child's shelf when she is not playing with the doll. The package can therefore function not only as the packaging in which the consumer receives the goods, but an ongoing display box for use by the consumer. Furthermore, the box may be used to store numerous accessories that our dolls are typically sold with.

In addition, applicant submitted copies of five third-party registrations for product configuration marks, which according to applicant are similar in nature to its mark, thereby demonstrating that applicant's mark is entitled to registration.

The Board has held that collateral products which serve the purpose of promoting a party's primary goods and which have more than a mere incidental function in relation to the primary goods may constitute goods in trade. In re Snap-On Tools Corp., 159 USPQ 254 (TTAB 1968) [ball point pens which are used to promote applicant's tools, but which possess utilitarian function and purpose, and have been sold to applicant's franchised dealers and transported in commerce under mark, constitute goods in trade]; and In re United Merchants & Manufacturers, Inc., 154 USPQ 625 (TTAB 1967) [calendar which is used as advertising device to

promote applicant's plastic film, but which possesses, in and of itself, a utilitarian function and purpose, and has been regularly distributed in commerce for several years, constitutes goods in trade].

On the other hand, in *Ex parte Bank of America National Trust and Savings Association*, 118 USPQ 165 (Comm'r Pats. 1958), it was held that a mark was not registrable for bank passbooks, checks and other printed forms, where such materials were used only as necessary tools in the performance of banking services, and the applicant was not engaged in printing or selling forms as commodities in trade. Further, in *In re Douglas Aircraft Co., Inc.*, 123 USPQ 272 (TTAB 1959), the Board held that pamphlets, booklets, brochures, bulletins, and letterheads which serve only to advertise, explain and publicize the goods in which an applicant deals do not constitute goods of such applicant. In *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768 (TTAB 1994), the Board found that an applicant's purported game that was not clearly labeled as a game and consisted merely of three photocopied pages, stapled together without any packaging, served only to promote applicant's band and other products, and was not a bona fide game but rather an advertising flier for applicant's band. The Board also noted that there was no

real substance or entertainment value to the purported game, that the flier/game had been distributed primarily as a give-away, and the record showed only one advertisement which made reference to a game.

We note that there is no evidence that applicant is a manufacturer of boxes or that applicant is engaged in selling boxes as commodities in trade. With respect to applicant's Bratz<sup>®</sup> dolls, in particular, we are not persuaded by applicant's argument that because the plastic boxes may be used to store these dolls and accessories when they are not being played with, such boxes have additional utility and thus constitute goods in trade. Any number of products may be stored by consumers in their original boxes or packaging when not being used (e.g., shoes may be stored in their original cardboard boxes, coffee beans may be stored in their original bags, and DVDs may be stored in their original plastic boxes). Indeed, doll collectors especially may choose to store their dolls in the original boxes to keep the dolls in mint condition. However, the mere fact that original boxes or packaging may be used to store products does not infuse such boxes or packaging with additional utility such that they constitute goods in trade. Because many products are stored in the containers in which they are sold, consumers are likely to regard the

plastic boxes as nothing more than point of sale containers, as opposed to separate goods in trade.

Further, there is no indication that the Bratz<sup>®</sup> plastic doll boxes are specifically labeled as display boxes for the dolls. Also, there is no evidence that applicant advertises or promotes the plastic boxes as display boxes for the dolls. Thus, we are not convinced on this record that consumers recognize the plastic boxes as such. Again, we believe consumers would view the plastic boxes as nothing more than point of sale containers for the Bratz<sup>®</sup> dolls.

In view of the foregoing, we are not persuaded that the trapezoidal plastic boxes have additional utility such that they constitute goods in trade.

Insofar as the third-party registrations relied upon by applicant are concerned, they do not compel a different result herein. While uniform treatment under the Trademark Act is an administrative goal, our task in this appeal is to determine, based on the record before us, whether applicant's identified goods constitute goods in trade. As is often stated, each case must be decided on its own merits. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ["Even if some prior registrations had some characteristics similar to

[applicant's] application, the PTO's allowance of such prior registrations does not bind the Board or this court."].

In sum, the goods in this case, trapezoidal plastic boxes for toys, games and playthings, are unlike the ball point pens and calendars in Snap-On Tools and United Merchants & Manufacturers, Inc., respectively. We agree with the examining attorney that such goods are incidental to applicant's primary goods, namely, toys, games and playthings, and are not goods in trade of applicant.

**Decision:** The refusal to register applicant's box design on the ground that the identified goods do not constitute goods in trade is affirmed.