

**THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB**

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October 11, 2007

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Marc Lenaerts

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Serial No. 79018627

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David B. Kirschstein of Kirschstein, Ottinger, Israel & Schiffmiller, P.C. for Marc Lenaerts.

Daniel Capshaw, Trademark Examining Attorney, Law Office 110 (Chris A. F. Pedersen, Managing Attorney).

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Before Holtzman, Mermelstein and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Marc Lenaerts filed an application for the designation shown below for "energy drinks."<sup>1</sup>



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<sup>1</sup> Serial No. 79018627, filed October 20, 2005, based on a request for extension of protection under Section 66(a) of Trademark Act of 1946, 15 U.S.C. §1144f(a). Applicant disclaimed the exclusive right to use the shape of the can.

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"The mark comprises a two-dimensional design applied to containers for the goods, and said design consisting of a silver background with two incomplete elliptical designs, one at the top of the container and one at the bottom each of which includes an outer dark red band, a middle light red band, and inner dark red band."<sup>2</sup>

"The colors silver, light red and dark red are claimed as a feature of the mark."<sup>3</sup>

Registration has been refused on the Principal Register because the proposed mark is merely a decorative or ornamental feature of the goods (or packaging for the goods) and would not be perceived as a mark. Registration was therefore refused under Sections 1, 2, 3, and 45 of the Trademark Act of 1946, 15 U.S.C. §§ 1051, 1052, 1053, and 1127. The Examining Attorney contends that the designation sought to be registered is not inherently distinctive because the design encompasses the entire container and consists of common, ordinary shapes.<sup>4</sup> With respect to the design encompassing the entire container, the Examining Attorney contends that "the mark is very large relative to

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<sup>2</sup> October 30, 2006 Response.

<sup>3</sup> *Id.*

<sup>4</sup> Examining Attorney's Brief, pp. 2 and 4.

the size of the goods and would, therefore, not be perceived as an indicator of source."<sup>5</sup> Moreover, "[m]arks for energy drinks do not typically encompass the complete can without some literal portion," and thus consumers have not been conditioned to recognize such designs as trademarks.<sup>6</sup>

With respect to the contention that the designation at issue consists of common, ordinary shapes, the Examining Attorney asserts that the "mark" at issue is simply two incomplete ovals on a "non-descript monochromatic shape covering the remaining portion of the can."<sup>7</sup> Moreover, the designation sought to be registered is "merely a refinement of a commonly adopted and well-known form of ornamentation" for drinks because designs generally cover the entire can.<sup>8</sup>

It is common knowledge that cans for drinks are not blank and generally contain designs and colors covering the entire can. [Internal citation omitted]. Such designs which cover cans in their entirety, however, are not generally claimed or understood as single trademarks, especially when no literal portion is claimed to be called upon or attached to a design. Thus, applicant's design is merely a refinement of a commonly adopted and well-known form or ornamentation for drink cans which is not unusual.<sup>9</sup>

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<sup>5</sup> Examining Attorney's Brief, p. 3.

<sup>6</sup> Examining Attorney's Brief, p. 3.

<sup>7</sup> Examining Attorney's Brief, p. 5.

<sup>8</sup> Examining Attorney's Brief, p. 5.

<sup>9</sup> Examining Attorney Brief, p. 5.

Applicant argues that the Examining Attorney has failed to introduce any evidence to show that the mark sought to be registered comprises a common basic shape, that it is in use by others, and that it is simply a refinement of a commonly known and used design for energy drink cans. "The Examining Attorney has not even produced examples of what he calls simple cans with ornamental circular designs which, as already pointed out, is not what the present design comprises,"<sup>10</sup> and therefore, according to the applicant, the Examining Attorney has not made a *prima facie* case that applicant's mark is not entitled to registration. To the contrary, applicant contends that the mark sought to be registered is an arbitrary and fanciful design because incomplete ellipses (or ovals) in different colored bands are not commonplace.<sup>11</sup>

A decorative design may be both ornamental and a trademark when the design serves to advise the purchaser that the products or services identified by the design emanate from a single source. *In re E. J. Brach & Sons*, 256 F.2d 325, 118 USPQ 308, 309 (CCPA 1958) (if a design is inherently distinctive, and not mere background material, it may be registered without evidence of secondary

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<sup>10</sup> Applicant's Brief, p. 8.

<sup>11</sup> Applicant's Brief, p. 9.

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meaning). See, *In re Paramount Pictures Corp.*, 213 UPSQ 1111, 1113 (TTAB 1982). Whether a design is merely ornamental or functions as a trademark is a matter of public perception. 1 McCarthy On Trademarks and Unfair Competition §7:24 (4<sup>th</sup> ed. 2006) ("If customers perceive a design only as pleasing ornamentation, then the design is not a trademark. If customers perceive a design as not only attractive, but as an indicator of source, then it is a trademark"). See also, *Tone Brothers Inc. v. Sysco Corp.*, 28 F.3d 1192, 31 UPSQ2d 1321, 1331 (Fed. Cir. 1994) ("Thus, the focus of the inquiry is whether or not the trade dress is of such a design that buyer will immediately rely on it to differentiate the product from those of competing manufacturers; if so, it is inherently distinctive").

The proper test for determining whether the designation sought to be registered is inherently distinctive involves consideration of the following factors:

- (i) whether the design is a common basic shape or design;
- (ii) whether the design is unique or unusual in the field;

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(iii) whether the design is a mere refinement of a commonly-adopted and well-known form of ornamentation for particular goods or services viewed simply as decoration for the goods and services; or,

(iv) whether the design is capable of creating a commercial impression distinct from the accompanying words.

*Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 196 UPSQ 289, 291 (CCPA 1977). See also, *In re Creative Beauty Innovations Inc.*, 56 UPSQ2d 1203, 1206-1207 (TTAB 2000) (the *Seabrook* test is a reliable method for analyzing the inherent distinctiveness of packaging trade dress); *In re File*, 48 UPSQ2d 1363, 1365 (TTAB 1998) (adopting the *Seabrook* test and holding that tubular lights running lengthwise down a bowling alley lane are merely decorative interior lighting and would not be perceived as a trademark); *In re Hudson News Co.*, 39 USPQ2d 1915, 1922 (TTAB 1996), *aff'd in decision without published opinion*, 1997 U.S. App. Lexis 15556 (Fed. Cir. June 12, 1997).

The mark at issue is the design on a can as shown above. The only evidence in this case is ten (10) registrations, on the Principal Register and not under the

provisions of Section 2(f), for designs (without any literal elements) on bottles and cans.<sup>12</sup> This demonstrates that designs on bottles and cans have been registered on the Principal Register when they are inherently distinctive.

The Examining Attorney, relying only on the design sought to be registered, concludes that the design is merely a common geometric shape that comprises nothing more than a refinement of a well-known form of ornamentation for cans specifically because the mark sought to be registered covers the entire surface of the drink can. We disagree and find that the design on the drink can is sufficiently unique and unusual as to be inherently distinctive.

As indicated *supra*, the Examining Attorney argues that "[a]pplicant's proposed mark is not inherently distinctive in this case because Applicant's design consists of common, ordinary, shapes" on a "non-descript monochromatic shape."<sup>13</sup> While ovals are common, basic geometric designs, applicant's mark is not simply an oval. Applicant's mark is two partial "ellipses" or ovals consisting of concentric

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<sup>12</sup> There were two additional registrations for designs on bottles and cans, but they had literal elements.

<sup>13</sup> Examining Attorney Brief, p. 5.

bands of different shades of red on a silver background.

It is more than just a common geometric design.

"[W]hen the design at issue is only a common geometric shape, for example, a circle, oval, square or triangle, it is not necessary for the examining attorney to provide evidence that such design is a common geometric shape. The applicant in such cases, will have to present evidence supporting its request for registration. In cases where it is not obvious that the design is commonplace, the examining attorney's obligation under the Trademark Act is to make a *prima facie* showing that applicant's container configuration is not entitled to registration." *In re Creative Beauty Innovations Inc., supra.* In the case *sub judice*, applicant's mark is not merely a common geometric shape. Therefore, it was incumbent on the Examining Attorney to submit evidence to make a *prima facie* case that applicant's mark is not inherently distinctive. However, the Examining Attorney did not submit any evidence to demonstrate that applicant's mark is a common geometric design *per se*, let alone that it is a design that is commonly used on drink cans or bottles.

Moreover, we believe that applicant's mark has a distinctive appearance that creates a separate and identifiable commercial impression despite the fact that it

covers the entire surface of the can.<sup>14</sup> If applicant were to use its design with a literal element, the composite could comprise two separate distinctive elements. Accordingly, applicant's mark is more than just a common geometric shape or design.

The Examining Attorney has also argued that "applicant's design is merely a refinement of a commonly adopted and well-known form of ornamentation for the drink cans" because "[i]t is common knowledge that cans for drinks are not blank and generally contain designs and colors covering the entire can."<sup>15</sup> However, the Examining Attorney has not made of record any other container designs that include multiple, partial ovals consisting of concentric bands of different shades of color or any variation thereof. In essence, the Examining Attorney is arguing that because drink cans commonly have designs covering their entire surface, any designs covering the

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<sup>14</sup> The Examining Attorney argues that applicant's mark is ornamental because it covers the entire surface of the drink can. (Examining Attorney, Brief, p. 2). The problem with the Examining Attorney's argument is that it appears to be based on the false premise that if the design covers the entire surface of a product, it is merely ornamental as a matter of law. The size, location, and dominance of the proposed mark as applied to the product are additional factors to consider in determining whether the proposed mark is inherently distinctive. We are not persuaded that applicant's mark is not inherently distinctive simply because it covers the entire surface of the drink can.

<sup>15</sup> Applicant's Brief, p. 5.

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entire surface of a drink can is merely a refinement of the commonly and well-known practice of decorating the entire surface of drink cans. This argument is untenable and unsupported. Accordingly, we find that applicant's mark is not a mere refinement of a commonly adopted and well-known form of ornamentation for drink cans and energy drinks in particular.

On the basis of the record before us, we conclude that applicant's proposed mark is inherently distinctive and functions as a trademark because (i) it is not a common geometric design; (ii) it is more than just merely a refinement of the common practice of using a design on a drink can; and, (iii) it creates a distinct commercial impression as a trademark.

Decision: The refusal to register is reversed.