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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	87285412
Applicant	Reelex Packaging Solutions, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Appellant: REELEX PACKAGING
SOLUTIONS, INC.

Serial No.: 87/285412

Examining Attorney: Suzanne Blane

Filed: December 30, 2016

Attorney Docket: REE-TM-013

APPELLANT'S BRIEF ON APPEAL

A Notice of Appeal to the Trademark Trial and Appeal Board was filed on April 2, 2019, in which Appellant appealed from the final refusal in the Office Action dated November 8, 2018.

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(1) INDEX OF CASES

In re Charles N. Van Valkenburgh, Serial No. 77025789 (TTAB, January 7, 2011).

In re Morton-Norwich Prods., Inc., 671 F.2d 1332, 213 USPQ 9 (C.C.P.A. 1982).

TrafFix Devices, Inc. v. Mktg. Displays, Inc., 532 U.S. 23, 58 USPQ2d 1001 (2001).

In re Becton, Dickinson & Co., 675 F.3d 1368, 1374, 102 USPQ2d 1372, 1376 (Fed. Cir. 2012). *In re R.M. Smith, Inc.*, 734 F.2d 1482, 1484, 222 USPQ 1, 3 (Fed. Cir. 1984).

(2) DESCRIPTION OF THE RECORD

All references to the TSDR will be with respect to the relevant document downloaded as a pdf file.

Appellant filed its application on December 30, 2016. On April 5, 2017 the Examining Attorney issued a non-final Office Action (“the first Office Action”) refusing registration on two grounds, functionality and non-distinctiveness. See Apr. 5, 2017 Office Action TSDR. The Appellant responded to the first Office Action on October 3, 2017. See Oct. 3, 2017 Response to Office Action TSDR.

In response to Appellant’s response, on November 1, 2017, the Examining Attorney approved the applied-for mark for publication on the principle register. Later, after approving the mark for publication, the Examining Attorney withdrew the mark from publication, and issued another non-final Office Action dated December 30, 2017 (“the second Office Action”). See Dec. 30, 2017 Office Action TSDR. As

noted in the second Office Action, the reason for withdrawing the application from publication was that “it was found the mark fails to function as an identification of source,” which was a new ground of refusal. Also, the Examining Attorney stated that the identification of goods required further clarification and that the specimen does not show the mark in use with the identified goods. Appellant notes that in the second Office Action, the Examining Attorney did not base refusal on grounds of functionality and Appellant considered the issue of functionality settled based on the evidence of record. Nonetheless, the Examining Attorney maintained the refusal on the ground of non-distinctiveness and added the new ground of refusal, i.e., failure to function as a trademark.

Appellant responded to the second Office Action on May 24, 2018. See May 24, 2018 Response to Office Action TSDR. In Appellant’s response, Appellant amended the mark description to clarify that the goods are identified as electric cables and wire in class 9, as suggested by the Examining Attorney in the second Office Action. On June 29, 2018 the Examining Attorney issued another non-final Office Action (“the third Office Action”). See June 29, 2018 Office Action TSDR. In the third Office Action, the Examining Attorney maintained all of the refusals in the second Office Action, and, additionally, reintroduced the functionality refusal that was raised in the first Office Action.

Appellant responded to the third Office Action on September 26, 2018. See Sep. 26, 2018 Response to Office Action TSDR. On November 11, 2018, the Examining Attorney issued a fourth, final Office Action, which maintains all of the rejections raised in the third Office Action. See Nov. 11, 2018 Office Action TSDR.

(3) STATEMENT OF THE ISSUES

- A. Whether the applied-for mark for trade dress is functional.
- B. Whether the applied-for mark has acquired distinctiveness.
- C. Whether the applied-for mark functions as an indication of source of the identified goods.

(4) RECITATION OF THE FACTS

- A. The Appellant is the developer and licensor of Reelex Licensed Packaging System, hereinafter referred to as the “Reelex System”. The Reelex System is used by cable and wire manufacturers around the world to package their cable and wire into what are known as “Reelex Packages”. Those manufacturers use proprietary winding machines that are designed, manufactured, and patented by Reelex, and Reelex knowhow to wind the cable and wire into finished coils of cable and wire. See Oct. 3, 2017 Response to Office Action, TSDR p. 35.
- B. A Reelex Package, otherwise known as a Reelex Box, includes a wound coil of cable or wire inside a box. See Oct. 3, 2017 Response to Office Action, TSDR pp. 35, and 42-48.
- C. Appellant’s proprietary winding process winds cable in a figure-eight pattern that allows the cable and wire to be “paid out” from a box without kinking and tangling. See Nov. 8, 2018 Office Action, TSDR p. 34.
- D. The applied-for trade dress is trade dress for electric cable and wire in class 9. See May 24, 2018 Response to Office Action, TSDR pp. 5 and 6.
- E. The Appellant owns U.S. Patents 5,810,272; 6,086,012; 6,341,741; 4,160,533; and 7,156,334, which relate to various aspects of manufacturing coils of cable and wire that can be packaged. See Oct. 3, 2017 Response to Office Action pp. 4-5. See Sep. 26, 2018 Response to Office Action, TSDR p. 12.
- F. None of Appellant’s patents require the features of the box described in Appellant’s applied-for trade dress. Indeed, at least U.S. Patent 6,086,012 actually teaches at least three shapes (oval, elliptical, and diamond) of the payout hole that differ from the circular hole of the applied-for trade dress. See Oct. 3, 2017 Response to Office Action, TSDR pp. 4-5.
- G. The applied-for trade dress incorporates many design elements – shape and aspect ratio of the box, as well as the shape, size, and location of the hole – which were selected for their ornamentality and distinctiveness. See Oct. 3, 2017 Response to Office Action, TSDR pp. 22-24.

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