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

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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APPLICATION SERIAL NO: 87/555,014
APPLICANT: WCM Industries, Inc.

FILING DATE: 08/03/2017
EX. ATTORNEY: Heather A. Sales



MARK:

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APPLICANT'S REPLY BRIEF

The Examining Attorney errs in her functionality analysis because the benefits described in Applicant's patents and touted in Applicant's advertising are not attributable to the features claimed as Applicant's mark. Applicant's mark is the specific ornamental appearance of its bath overflow cap, not the internal workings, the attachment mechanisms, or the vent that facilitates fluid flow. Moreover, the record shows that there are many alternative designs available and used by others, and that Applicant's cap is no less expensive to make than other configurations. Accordingly, Applicant's mark is not functional under Section 2(e)(5).

In addition, Applicant has more than met its burden to show that Applicant's mark has acquired distinctiveness through 18 years of exclusive use, nearly 12 million units sold, \$2.8 million in advertising and marketing expenditures, 166 signed declarations from customers and those in the industry from around the country, and dozens of alternative designs used by others. These facts show that consumers have come to associate Applicant's mark with Applicant and use it to distinguish Applicant's bath overflow cap from caps made by others. Accordingly, Applicant's mark should be allowed.

I. APPLICANT'S MARK IS NOT FUNCTIONAL UNDER SECTION 2(E)(5)

A. Applicant's Mark Includes Many Features That Have Been Disregarded.

The Examining Attorney's functionality and distinctiveness refusals improperly disregard important visual and ornamental features of Applicant's mark. It is well-settled that the "drawing depicts the mark to be registered," not the words used to describe it. 13, *In re OEP Enter., Inc.* 2019 USPQ2d

309323 (TTAB 2019). While the Examining Attorney only discusses the generally cylindrical form, smooth face, and elongated slot, all of which are not functional, Applicant's overflow drain cap has important design elements that help distinguish it from caps made by others, including a gentle convex contour on the face of the cap, a rounded edge as the cap curves from the face to the side wall, and a distinctive elongated slot with curved ends that is contained entirely in the side wall and stretches up on either side like a smile. It is this total collection of elements that make up Applicant's mark and must be considered when assessing functionality and distinctiveness. *Id.*

B. Applicant's Utility Patents Do Not Describe Any Utilitarian Advantages of the Outer Appearance of Applicant's Overflow Cap.

Applicant's utility patents do not support the conclusion that Applicant's mark is functional. In order for a patent to support a finding of functionality, it must not only show the claimed configuration, but must also show that the claimed configuration provides a utilitarian benefit. *See e.g., In re 3M Company*, 2012 USPQ2d 7701886 (TTAB 2012). Similarly, Applicant's patents include drawings that show the outer appearance of Applicant's overflow cap. However, they do not claim that outer appearance and do not attribute a utilitarian benefit to the outer appearance.

In *Traffix Devices v. Mktg. Displays*, 592 U.S. 23, 30 (2001), the Supreme Court said one can show a feature is not functional "by showing that it is merely an ornamental, incidental, or arbitrary aspect of the device." The Court found the dual spring arrangement at issue functional because it was the central advance claimed in the utility patents. However, the court made the following contrast:

In a case where a manufacturer seeks to protect arbitrary, incidental, or ornamental aspects of features of a product found in the patent claims, such as arbitrary curves in the legs or an ornamental pattern painted on the springs, a different result might obtain. *Id.* at 34.

In this case, the central advances claimed and extolled in Applicant's patents are various snap-on attachment mechanisms for overflow caps and internal structures that facilitate fluid flow. In contrast, Applicant's trademark is directed to the ornamental appearance of the cap, including the arbitrary curves and contours of the face, sidewalls, and elongated slot. Each could be very different in shape, texture, size, structure, and appearance, but they are fixed in a specific design that Applicant has used and

promoted for many years, and has come to identify Applicant's overflow drain caps and distinguish them from those of others. As such, Applicant's mark should be allowed to register.

The Examining Attorney points to five issued patents and one published patent application and contends that they describe the utilitarian benefits of Applicant's mark. While these patents are directed to inventions and features associated with bath overflow drain systems, none is directed to, or extols the utilitarian benefits of, the specific outer appearance of Applicant's mark. The main patent cited by the Examining Attorney, U.S. Pat. No. 8769736 (the "'736 patent'"), is directed to a device and method for concealing an overflow plate (42) using retention plates (178 and 182) that are positioned between the overflow plate (42) and the bathtub (6) and to which the overflow plate cover is attached. (Nov. 15, 2017, Office Action, TSDR pp. 2-9). The Examining Attorney quotes several passages in the '736 patent. However, none of these passages discusses utilitarian benefits of the outer appearance of the claimed cap design.

The Examining Attorney also relies heavily on Applicant's U.S. Patent Pub. No. US 2018/0044899 (the "'899 patent application'"), entitled "Device for Providing Improved Drainage." It focuses on features not necessary to Applicant's mark that help improve the ability of the system to drain, such as a second opening called the "vent opening (182)," which allows air into the cap as it is draining, and internal structures that facilitate fluid flow.¹ The excerpts from Applicant's patents on which the Examining Attorney relies (many of which are miss-quoted) do not describe or claim the specific appearance of the face, the curves, the side walls, the elongated slot, the edges, the height, or the circumference. Just because they specify an overflow plate cover positioned generally in line with the fluid opening of the overflow plate does not provide any information about what the cover should look

¹ The Examining Attorney also cites to two references to "vent opening 180" in the '899 patent application to argue that Applicant's elongated slot structure improves drainage. 9, Examiner's Statement, TTABVue, pp.8. Those references (Col. 7, ll. 31 and 34 in the issued US Patent 10,443,220), however, were typographical errors, and a request for Certificate of Correction was filed on October 16, 2019, to correct them to read "vent opening 182." As clearly explained in the '899 application, the improved drainage is achieved by introducing a second opening, "a vent opening 182," in addition to the "overflow opening 180," so that the air pressure from inside the overflow assembly is allowed to equalize with the air pressure outside of the overflow assembly. The claimed vent opening is not necessary to Applicant's mark. Thus, nothing in the identified patent shows that the claimed configuration increases the fluid flow capacity of an overflow system.

like to make it work, what texture it will use, whether and how many holes it might have, or what overall shape it will take. The patents do not discuss these ornamental features because they are not relevant to the inventions claimed therein, which involve the means for attaching an overflow drain plate cover to the overflow system and internal structures that improve fluid flow.

There is no evidence in the record that a bath cap that looks like Applicant's bath cap works better because of its appearance. The particular gentle curves of the face and side walls do not make water flow through it faster. The rounded ends of the elongated slot do not make the cap work better. Enclosing the entirety of the elongated slot in the sidewall does not make water leave the tub faster. Instead, these features are purely ornamental and serve to distinguish Applicant's cap from others.

The Examining Attorney also argues that the configuration is functional because it does not require screws. Again, the means by which the cap attaches is not claimed in Applicant's mark. Further, there are many other ways to design an overflow cap that snaps on as evidenced by the multitude of different third party overflow caps in the record that do not have screw holes. *See* Section I.E. below.

The Examining Attorney also contends that a cylindrical shape is functional because it can cover a cylindrical shaped drainpipe. First, there is no functional reason why a cylindrical cover must be used with a cylindrical pipe. Further, Applicant is not merely claiming a cylindrical body. Rather, Applicant is claiming the specific structure shown in the drawing of the trademark application as Applicant's mark, including the specific gentle convex contour of the face, the soft curves to the sidewall, the width and length of the elongated slot set entirely within the sidewall, and the curved ends of the elongated slot.

C. Applicant's Advertising Materials Do Not Tout Utilitarian Advantages of Applicant's Claimed Design.

The second *Morton-Norwich* factor, advertising by the applicant that touts the utilitarian advantages of the design, also fails to show that Applicant's mark is functional. The Examining Attorney points to claims in Applicant's advertising that allegedly tout the advantages of Applicant's overflow cover, such as "installs in minutes" or "high-flow capacity" and just assumes that they are attributable to Applicant's mark. However, none of these advantages is attributable to the exterior

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