

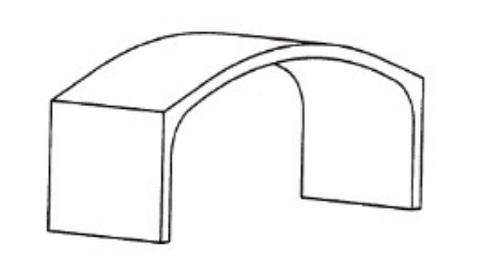
World Trademark Review Daily

**Trademark on Supplemental Register cancelled on functionality grounds
United States - Brinks Hofer Gilson & Lione**

**Cancellation
National procedures**

March 01 2011

In *Kistner Concrete Products Inc v Contech Arch Technologies Inc* (Cancellation 92,048,733, January 25 2011), the Trademark Trial and Appeal Board (TTAB), in a 57-page precedential opinion, has cancelled a design mark that covered the product configuration of a “pre-cast concrete bridge unit for constructing a bridge or culvert” (Supplemental Trademark Registration 2,670,588) on the grounds that the registered product configuration was functional. The designation was described in the registration as consisting of “the configuration of a one-piece open-bottom bridge unit, with parallel-spaced vertical side walls connected by an arched-top wall and having sharp outside corners and a width substantially greater than its length”.



The Supplemental Trademark Register contains marks which are capable of distinguishing an applicant's goods or services, but do not meet the requirements for registration on the Principal Register. Section 23(c) of the [Lanham Act](#) specifically excludes functional marks from registration on the Supplemental Register. The TTAB noted that the test to determine the functionality of marks on the Principle Register and the Supplemental Register are the same.

The TTAB's functionality inquiry turns on four factors:

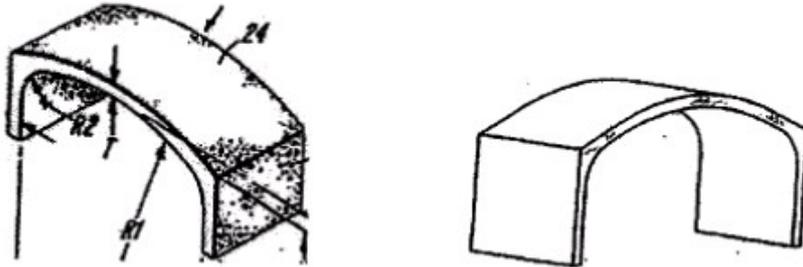
- the existence of a utility patent that discloses the utilitarian advantages of the registered design;
- advertising by the registrant that touts utilitarian advantages of the registered design;
- the availability of alternative designs; and
- whether the registered design results from a comparatively simple or inexpensive method of manufacture.

The parties were competitors in the market for pre-cast concrete bridges and culverts. The registrant owned five expired utility patents, which the petitioner alleged covered the product configuration depicted in the trademark registration. The petitioner contended that the utility patents proved that the product configuration covered by the trademark registration was functional and that the trademark registration simply acted as an invalid extension of the registrant's patent term.

The existence of the registrant's five expired utility patents strongly supported the TTAB's ultimate finding of functionality. The registrant had argued that specific geometric ratios were critical to the claims in the utility patents. The trademark registration, the registrant asserted, was not limited to these geometric ratios and, therefore, the patents did not cover the key features of the registered trademark. The TTAB, in evaluating the effect of the utility patents, made the following observations:

- The evaluation of a utility patent to determine the functionality of the trademark is not limited to the patent claims. In addition to the claims, the TTAB analysed the background of the invention, summary of the invention, figures and the preferred embodiments, all of which suggested that the product configuration covered by the trademark registration was functional.
- The fact that the description of the mark in the registrant's trademark registration lacked specific geometric ratios present in the patent claims did not “magically transform” the product's functional features from a utilitarian object into an indicator of source.
- Each embodiment of an invention described in a utility patent is functional.
- Depicted side-by-side, the TTAB concluded that the drawings in the patent registration and trademark registration were “remarkably similar.”

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The US Supreme Court, in its 2001 decision in *TrafFix Devices Inc v Marketing Displays Inc*, found that prior utility patents have “vital significance” in resolving the question of functionality, because they add “great weight” to the statutory presumption that such features are functional. Here, the TTAB found that given the great weight to be accorded such evidence, the patents were sufficient to establish, *prima facie*, that the registered design as a whole was functional. The TTAB found that the registrant’s registered design patents, asserted by the registrant as evidence of the ornamental nature of the product configuration, could not overcome the “significant probative value” of the utility patents.

The registrant’s marketing materials also touted the utilitarian benefits of its product configuration, adding support to the TTAB’s finding of functionality. Further, the TTAB contended that the availability of alternative designs did not need to be considered, since the product configuration covered by the trademark registration was shown to be functional. Despite the TTAB’s contention that they needed not be considered, the TTAB analysed several alternative designs presented by the registrant, but concluded they did not lend support to the registrant’s position.

With respect to the final factor, the TTAB explained that a product feature is functional if it affects the cost or quality of the article. In this case, the utility patents demonstrated that the product shape affected the quality of the article so the cost analysis was not necessary. Nevertheless, the TTAB concluded that this factor would support the finding of functionality of the registrant’s product configuration.

Andrew Avsec, Brinks Hofer Gilson & Lione, Chicago

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