

**This Opinion is Not a
Precedent of the TTAB**

Hearing: August 14, 2019

Mailed: October 23, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Reelex Packaging Solutions, Inc.
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Serial Nos. 87285383 and 87285412
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for Reelex Packaging Solutions, Inc.

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Before Iancu, Under Secretary of Commerce for Intellectual Property and Director of
the U.S. Patent and Trademark Office, Thurmon, Deputy Chief Administrative
Trademark Judge and Kuhlke, Administrative Trademark Judge.

Opinion by Thurmon, Deputy Chief Administrative Trademark Judge:

In these consolidated appeals,¹ Reelex Packaging Solutions, Inc. (“Applicant”) seeks registration on the Principal Register of the two box designs shown below for “electric cables and wire” in International Class 9.²



Application Serial No. 87285383
(the '383 trade dress)



Application Serial No. 87285412
(the '412 trade dress)

The Examining Attorney refused registration, finding Applicant’s trade dress functional, nondistinctive, and does not function as a mark to indicate the source of the goods identified in the applications. 15 U.S.C. §§ 1051, 1052, 1127. We affirm the refusal to register.

¹ We consolidate the appeals because they involve common issues of law and fact with similar records. *See In re S. Malhotra & Co. AG*, 128 USPQ2d 1100, 1102 (TTAB 2018); *In re Anderson*, 101 USPQ2d 1912, 1915 (TTAB 2012). The briefs and evidence in the two appeals are nearly identical. Citations are to the record in Application Serial No. 87285383 unless otherwise noted. The specific trade dress is different in each application and where it is necessary to refer specifically to one design or the other, we do so below.

² Application Serial No. 87285383 was filed on December 30, 2016, based upon Applicant’s claim of first use anywhere and use in commerce since at least as early as January 1, 1980. Application Serial No. 87285412 was filed on the same day, but is based upon Applicant’s claim of first use anywhere and use in commerce since at least as early as January 1, 2000.

I. The Trade Dress

Applicant is trying to register two box designs, as shown in the drawings above.

The first design, the '383 trade dress, includes the following description:

The mark consists of trade dress for a coil of cable or wire, the trade dress comprising a box having six sides, four sides being rectangular and two sides being substantially square, the substantially square sides both having a length of between 12 and 14 inches, the rectangular sides each having a length of between 12 and 14 inches and a width of between 7.5 and 9 inches and a ratio of width to length of between 60% and 70%, one, and only one rectangular side having a circular hole of between 0.75 and 1.00 inches in the exact middle of the side with a tube extending through the hole and through which the coil is dispensed from the package, the tube having an outer end extending beyond an outer surface of the rectangular side, and a collar extending around the outer end of the tube on the outer surface of the rectangular side of the package, and one square side having a line folding assembly bisecting the square side.³

This description defines a box with square sides and rectangular front, back, top, and bottom, just as the image shows. Boxes within the description may range in size from 12" x 12" x 7.5" (volume = 1080 in³) to 14" x 14" x 9" (volume = 1764 in³). The trade dress has a relatively small circular hole in the center of the front of the box with a payout tube and collar positioned with the hole. On its website, Applicant refers to

³ Serial No. 87285383.

this box as the REELEX I box.⁴ In addition, on its website it is listed for use with smaller wire and cable, typically with coil diameters of 9-16 inches.⁵

The second design, the '412 trade dress, is for the design shown on the right above.

This design includes the following description:

The mark consists of trade dress for a coil of cable or wire, the trade dress comprising a box having six sides, four sides being rectangular and two sides being substantially square, the substantially square sides both having a length of between 13 and 21 inches, the rectangular sides each having a length of the same length of the square sides and a width of between 57% and 72% of the size of the length, one, and only one rectangular side having a circular hole of 4.00 inches in the exact middle of the side with a tube extending in the hole and through which the coil is dispensed from the package, one square side having a tongue and a groove at an edge adjacent the rectangular side having the circular opening, and the rectangular side having the circular opening having a tongue and a groove with the tongue of each respective side extending into the groove of each respective side at a corner therebetween.⁶

This description defines a much wider range of box sizes, from 13" x 13" x 7.4" (volume = 1,251 in³) to 21" x 21" x 15" (volume = 6,668 in³). That is a range of over five times in volume. No range is given for the size of the circular hole.⁷ Applicant refers to this design as the REELEX II box.⁸ On its website, it is listed for use with structured

⁴ Office Action of April 5, 2017, at 46-47. All citations to documents in the application records contained in the USPTO's Trademark Status & Document Retrieval ("TSDR") system are to the downloadable .pdf versions of the documents. References to the briefs on appeal refer to the Board's TTABVUE docket system.

⁵ Office Action of June 29, 2018, at 19-20.

⁶ Serial No. 87285412.

⁷ '412 Response to Office Action of October 3, 2017, at 23-24 (Frank Kotzur, Applicant's longtime employee "Kotzur declaration").

⁸ *Id.* at 22.

networking cable (e.g., Cat. 5, 6, or 7 cable), coaxial cable, and other less-flexible wire or cable.⁹

II. Refusal on the Basis of Functionality

Under the statute, functional matter is unregistrable. 15 U.S.C. § 1052(e)(5) (“No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it ... (e) Consists of a mark which ... (5) comprises any matter that, as a whole, is functional”). Matter is functional if “it is essential to the use or purpose of the article or if it affects the cost or quality of the article.” *TrafFix Devices Inc. v. Marketing Displays Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001) (citation omitted). “The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm’s reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature.” *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164-65, 115 S. Ct. 1300, 1304 (1995); *see also* J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 7:63 (5th ed. 2019).

These appeals go to the heart of the functionality doctrine, because Applicant seeks trademark protection for two boxes used with its patented system for coiling electric wire and cable. If these boxes provide important utilitarian advantages to parties that wish to use the technology disclosed in the patents after the patents’ expiration dates, providing trademark protection to Applicant could, under certain

⁹ ’412 Office Action of June 29, 2018, at 19.

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