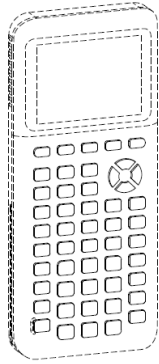


**TO THE COMMISSIONER FOR TRADEMARKS**



Mark:  
Serial Number: 87538416  
Filing Date: July 21, 2017  
Applicant: Texas Instruments Incorporated  
Applicant's Address: 12500 TI Boulevard, Dallas, TX 75243-4136

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**Response to Section 2(e)(5) rejection**

Applicant respectfully submits that a calculator's function is identified by each calculator key's legend/label, rather than each key's location. A calculator on/off key could be located anywhere relative to the calculator body/face and still serve the on/off function, as is the case with the corresponding function of many other keys. The *5-33DC-5 Configuration*, in contrast, includes unlabeled key locations and an overall layout, as earlier defined, irrespective of key legend -- that *Configuration*, therefore, is not functional. Applicant supplements the record with facts and law in support of this contention, and in response to the Office Action ("the Action") of November 20, 2017.

I. *Additional Information Required*

Applicant submits a Second Declaration of Martha Ann Sandstedt, augmenting Ms. Sandstedt's previously-filed first Declaration.<sup>1</sup> Responses from Ms. Sandstedt's Second Declaration are summarized below, generally corresponding to the additional information requests of the Action:

- (1) A written statement as to whether the applied-for mark, or any feature(s) thereof, is or has been the subject of a design or utility patent or patent application, including expired patents and abandoned patent applications.

Per Declarant, Ms. Sandstedt, there is no patent, nor patent application, for the 5-33DC-5 Configuration that is the subject of this trademark application.<sup>2</sup>

- (2) Advertising, promotional, and/or explanatory materials concerning the applied-for configuration mark, particularly materials specifically related to the design feature(s) embodied in the applied-for mark.

Please see the entirety of the first Declaration of Ms. Sandstedt, filed July 21, 2017.

- (3) A written explanation and any evidence as to whether there are alternative designs available for the feature(s) embodied in the applied-for mark, and whether such alternative designs are equally efficient and/or competitive. Applicant must also provide a written explanation and any documentation concerning similar designs used by competitors.

Per Declarant, Ms. Sandstedt, there have been no claims made as to a superior configuration arising from the 5-33DC-5 Configuration. Functional explanations of individual calculator keys located in the 5-33DC-5 Configuration, and the respective legend for each individual key, however, are provided in TI-8X calculator operating

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<sup>1</sup> Applicant filed a first Declaration from Ms. Sandstedt on July 21, 2017, with the original filing of the subject trademark application.

<sup>2</sup> Second Declaration of Martha Ann Sandstedt, paragraph 2.

manual materials. These explanations are directed to each such key, rather than the 5-33DC-5 Configuration as a collective entity or whole.<sup>3</sup> Alternative calculator designs, sold by Applicant and others, for calculators using key layouts other than the 5-33DC-5 Configuration, either as graphing calculators or other than graphing calculators, are shown in Ms. Sandstedt's Second Declaration, in Exhibits J through CC therein.<sup>4</sup>

- (4) A written statement as to whether the product design or packaging design at issue results from a comparatively simple or inexpensive method of manufacture in relation to alternative designs for the product/container. Applicant must also provide information regarding the method and/or cost of manufacture relating to applicant's goods.

Per Declarant, Ms. Sandstedt, there is no particular cost advantage or disadvantage to the 5-33DC-5 Configuration versus the product or packaging design of competitor calculators.<sup>5</sup>

- (5) Any other evidence that applicant considers relevant to the registrability of the applied-for configuration mark.

Such other evidence, and additional legal precedent and argument, are set forth below.

## ***II. The Applied-For Design is Not Functional***

“Trade dress includes the design of a product (*i.e.*, the product shape or configuration),”<sup>6</sup> and is functional if a feature of that trade dress is “essential to the use or purpose of the product or if it affects the cost or quality of the product.”<sup>7</sup> Functional

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<sup>3</sup> Second Declaration of Martha Ann Sandstedt, paragraph 3.

<sup>4</sup> Second Declaration of Martha Ann Sandstedt, paragraphs 4-7.

<sup>5</sup> Second Declaration of Martha Ann Sandstedt, paragraph 8.

<sup>6</sup> TMEP §1202.02(a)

<sup>7</sup> *Id.* See also, *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33 (2001); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995); *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850, n.10 (1982).

marks are those that are essential to a product's use rather than merely identifying it.<sup>8</sup> Applicant acknowledges that *each individual key* in the *5-33DC-5 Configuration* has its own respective function, but that function is not defined as part of the entirety of the *Configuration*; instead, the key's function is identified by a label (or legend) on the key, and the circuitry inside the calculator housing that responds to that particular key being pushed.<sup>9</sup> In the present application, however, the application drawing page readily indicates no product configuration claim to any label of a key or individual key. Accordingly, there is insufficient evidence that the entirety of the *5-33DC-5 Configuration*, that is, the collective key layout, is *essential* to the use, or affects the cost or quality, of the calculator. Indeed, alternatives to the *5-33DC-5 Configuration* exist, as shown below, further demonstrating that the *Configuration* is not "essential" thereto.

Applicant recognizes that the Action cites to Applicant's web page indication that the TI-84 Plus family has "familiar" functionality and a "same menu structure and navigation . . . make it easy to pick up and learn." This quotation specifically refers to a "menu structure and navigation," which in part relates to: (1) subject matter that can be shown on the calculator *display*, while that display is not claimed as part of the subject trademark;<sup>10</sup> and (2) the function achieved by pressing selected *individual* keys, either individually or as part of a sequence, but the function does not mandate or render essential the relative positioning or configuration layout of keys in order to achieve the

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<sup>8</sup> *Wallace Int'l Silversmiths, Inc. v. Godinger Silver Art Co., Inc.*, 735 F.Supp. 141, 144 (S.D.N.Y. 1990).

<sup>9</sup> Second Declaration of Martha Ann Sandstedt, paragraph 9.

<sup>10</sup> The application drawing page shows the calculator display in broken lines, thereby indicating such matter as not claimed as part of the mark. *See*, 37 C.F.R. § 2.52(b)(4); TMEP 807.08.

corresponding calculator functionality.<sup>11</sup> Indeed, Exhibit L to Ms. Sandstedt’s Second Declaration illustrates a graphing calculator currently sold by Applicant under the trademark TI-*nspire*<sup>®</sup> cx and that uses a key configuration other than the 5-33DC-5 *Configuration*. The TI-*nspire*<sup>®</sup> cx calculator is operable to perform the same functions as may be achieved by the keys in the “close-up picture” referred to in the Action, but the TI-*nspire*<sup>®</sup> cx calculator accomplishes those functions without having various key legends or relative locations of keys in the 5-33DC-5 *Configuration*.<sup>12</sup>

Applicant’s web page section identified by the Action also refers to a “Built-in MathPrint<sup>™</sup> functionality.” This functionality relates to how things may be shown on the calculator display to “appear [as they do] in textbooks” and, therefore, has nothing to do with any particular key configuration.<sup>13</sup>

The Action also seems to derive from the cited “close-up picture” on Applicant’s noted web page that Applicant is “highlighting” functionality of the 5-33DC-5 *Configuration*. To the contrary, the close-up picture depicts *the familiar label/legend, and corresponding familiar known functionality, of each **individual** key*, as Applicant has for years supported a same function for each key, according to the label on the key.<sup>14</sup> As examples from some of the close-up pictured keys, the corresponding calculator user manual description of each such individual key function is paraphrased below:<sup>15</sup>

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<sup>11</sup> Second Declaration of Martha Ann Sandstedt, paragraph 10.

<sup>12</sup> *Id.*

<sup>13</sup> Second Declaration of Martha Ann Sandstedt, paragraph 12.

<sup>14</sup> Second Declaration of Martha Ann Sandstedt, paragraph 11.

<sup>15</sup> *Id.*

- 2nd: The secondary function of each key is printed above the key. When you press the 2nd key, the character, abbreviation, or word printed above the other keys becomes active for the next keystroke.
- alpha: Many keys also have a third function. These functions are printed above the keys in the same color as the alpha key. The third functions enter alphabetic characters and special symbols as well as access SOLVE and shortcut menus.
- y=: When you press the “y=” key, you may then entire, edit, or select one or more functions in the “Y= editor,” such as the entry of an equation.
- window: Press the window key to define the viewing window variables.
- zoom: Press the zoom key to adjust size (enlarge/shrink) of something depicted in the display’s viewing window
- trace: Press the trace key to move the cursor from one plotted point to the next along a graphed function.
- graph: Press the graph key to display the graph of the selected function or functions.

There is no evidence that some or all of the above *individual key* functions could not be achieved by calculators using key or label locations, or layouts, in entirely different positions relative to the calculator housing, and in no way relating to Applicant’s *collective 5-33DC-5 Configuration*. Again, Applicant itself sells a different graphing calculator (Exhibit L to Ms. Sandstedt’s Second Declaration, the TI-*nspire*<sup>®</sup> cx calculator) that accomplishes graphing functionality without the *5-33DC-5 Configuration*. Third parties also sell graphing calculators that do not use the *5-33DC-5 Configuration*. Thus, designs alternative from Applicant’s *5-33DC-5 Configuration* are certainly “practical, feasible and effective”<sup>16</sup> and available to others to compete with

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<sup>16</sup> *Schutte Bagclosures Inc. v. Kwik Lok Corporation*, 193 F.Supp.3d 245, 269-270 (2016).

Applicant's individual key functionality.<sup>17</sup> Stated simply, therefore, any "familiarity" of Applicant's individual keys goes to the function of each such key and the result that may be achieved on the calculator display. Familiarity of Applicant's 5-33DC-5 Configuration as a whole, however, goes overwhelmingly to the decades of exposure creating trademark distinctiveness as a source identifier,<sup>18</sup> not collectively as a functional unit.

Legal doctrine holds that functionality depends on the totality of the evidence.<sup>19</sup> The cumulative evidence now of record sufficiently establishes that no essential function, or cost or quality affect, is intrinsically provided by Applicant's 5-33DC-5 Configuration. Moreover, analyzing the functionality of each individual feature (e.g., each separate key in the Configuration) does not automatically establish that the overall design is functional.<sup>20</sup> Rather, "functional elements that are separately unprotectable **can be protected together** as part of a trade dress."<sup>21</sup> For example, the Coca-Cola<sup>®</sup> bottle design (see, U.S. Trademark Registration 1057884) is functional in the sense of storing a beverage, and its contours and vertical ridges certainly could be urged to serve the functionality of safe gripping of what is often a cool and condensate-covered apparatus. That bottle, however, is a well-known registered configuration and widely accepted as a

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<sup>17</sup> See also, *Time Mechanisms, Inc. v. Qonaar Corp.*, 422 F.Supp. 905, 913, 194 USPQ 500, 506 (D.N.J.1976) ("parking meter mechanism can be contained by housings of many different configurations").


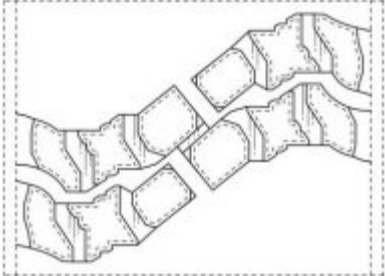
<sup>18</sup> As long as the features are known in the industry as source identifiers, the features may be found to be non-functional. *In re Koninklijke Philips Electronics N.V.*, 112 USPQ2d 1177 (T.T.A.B. 2014).

<sup>19</sup> *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 1530 (Fed. Cir. 1994). See, also, *See* 37 C.F.R. §2.61(b); *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 1340-1341 (C.C.P.A. 1982).

<sup>20</sup> See 15 U.S.C. §1052(e)(5); *Teledyne Industries Inc.*, 696 F.2d at 971, 217 USPQ at 11.

<sup>21</sup> *Le Sportsac, Inc. v. K. Mart Corp.*, 754 F.2d 71, 76 (2nd Cir. 1985). See also *Cliocks Billiards*, 58 USPQ2d at 1885 ("We emphasize here that, in evaluating functionality as well as the other elements of a trade dress claim, it is crucial that we focus not on the individual elements, but rather on the overall visual impression that the combination and arrangement of those elements create").

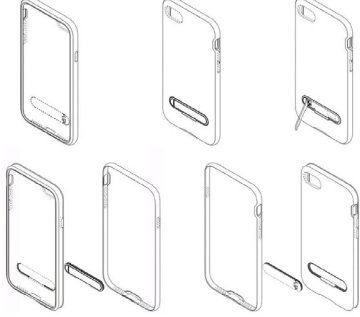
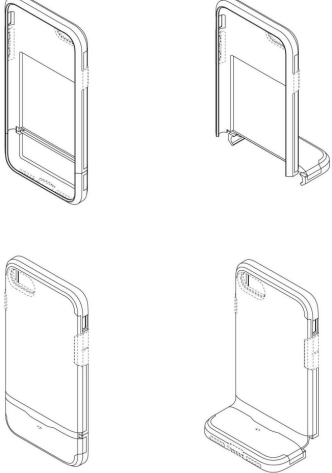
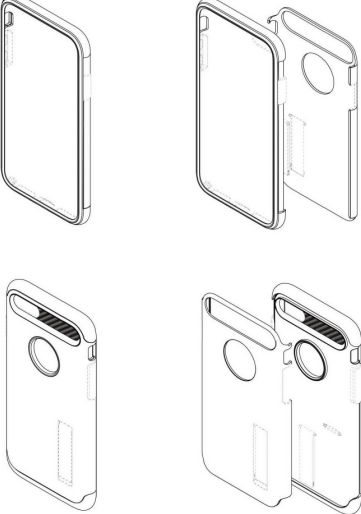
distinctive source identifier. Such an example confirms the law that a feature or features can be functional and still be a source-identifying protectable trademark.<sup>22</sup> Likewise, the following table illustrates myriad examples of trademark registrations to configurations as a whole, where in ***each*** case the original application was rejected under Section 2(e)(5). On subsequent submission of *Morton-Norwich* factors<sup>23</sup> evidence, however, each rejection was withdrawn and the application advanced toward registration:

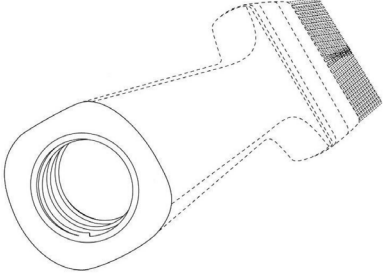
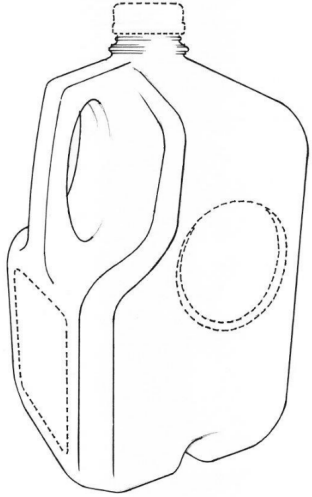
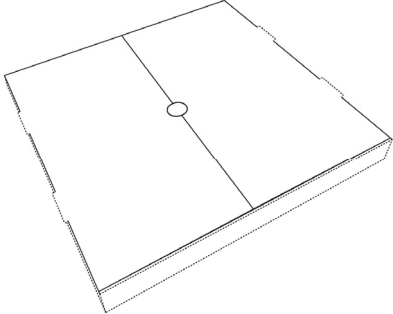
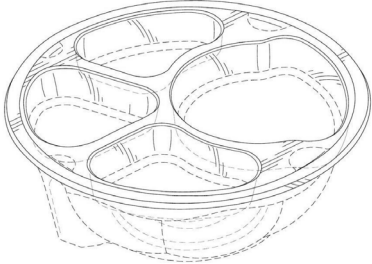
Reg. No.	Drawing	Goods
5418305		footwear
5420158		Tires

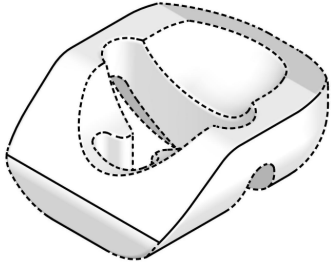
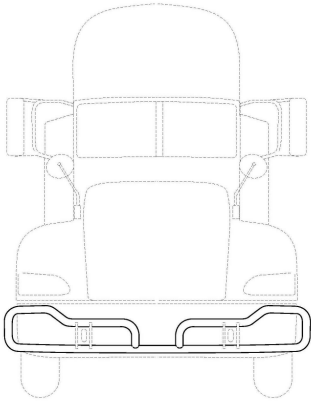
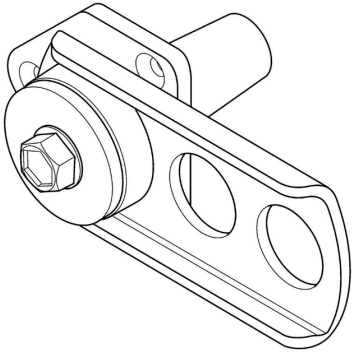
<sup>22</sup> *Clicks Billiards Inc. v. Sixshooters Inc.*, 58 USPQ2d 1881, 1886 (9th Cir. 2001).

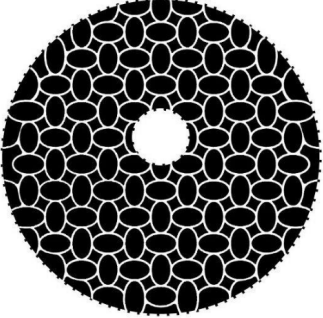
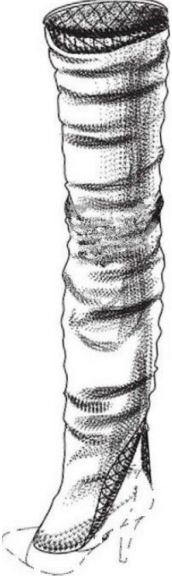
<sup>23</sup> *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1340-41, 213 USPQ 9, 15-16 (C.C.P.A. 1982); these factors are represented by Applicant’s responses in Section I of this response (*i.e.*, “Additional Information Required”). *See also*, *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 1374-75, 102 USPQ2d 1372, 1377 (Fed. Cir. 2012).



<b>5420072</b>		Cases for mobile phones; Cell phone cases; Protective cases for smartphones; Protective covers and cases for cell phones and portable media players.
<b>5420071</b>		Cases for mobile phones; Cell phone cases; Protective cases for smartphones; Protective covers and cases for cell phones and portable media players
<b>5420068</b>		Cases for mobile phones; Cell phone cases; Protective cases for smartphones; Protective covers and cases for cell phones and portable media players

<b>5409306</b>		Paint brushes
<b>5347987</b>		Milk
<b>5293258</b>		Pizza
<b>4770529</b>		salad kits consisting primarily of processed lettuces and also containing salad dressing, and one more of vegetables, fruit, nuts, eggs, cheese, meat, poultry, croutons, tortilla chips, flat bread

		chips
<b>5352938</b>		MEDICAL AND SURGICAL SUPPLIES, NAMELY, PATIENT POSITIONING MEDICAL DEVICES IN THE NATURE OF HEAD CUSHIONS
<b>5352261</b>		Land vehicle parts, namely, grill guards for semis, tractor trailers, trucks and land vehicles; protective grill shields for semis, tractor trailers, trucks and land vehicles; structural parts for land vehicles namely, guards for the protection of automotive grills, air intakes, headlights and other front-mounted features
<b>5272931</b>		Metal door latches

5201909		fitted polishing pads for use with hand-held polishing machines
5163014		Clothing, namely, a portion of a single pant leg which can be worn alone or in pairs, which is comprised of leather and other animal skins, silk, cotton, wool, embroidery, woven and man-made-fabrics and which is designed to give the mere appearance, illusion, impression of wearing the upper portion of boot.

Merely from the drawings in the above table,<sup>24</sup> one can readily identify singular functional attributes. Each design as a collective whole, however, was held a *non-functional* registrable product configuration.

### III. *Conclusion*

In view of the record, Applicant respectfully requests withdrawal of the rejection Under Section 2(e)(5).

<sup>24</sup> Each drawing in the table is taken directly from the TESS record file for the respective identified registration.

Respectfully submitted,  
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Dated: March 21, 2018