

On My Mind Blog: How to Succeed in Registering a Product Configuration Trademark in the U.S.

04.23.2024 By [William M. Borchard](#)



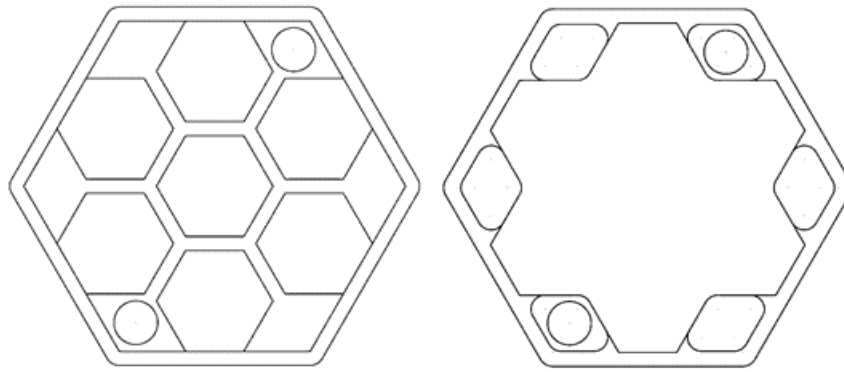
Specimen of Hex-Shaped Dice Box

The U.S. Patent and Trademark Office (USPTO) generally refuses to register the configuration of a product as a trademark when that the configuration either is functional or does not identify a single source. The Trademark Trial and Appeal Board (TTAB) usually affirms that refusal.

In the unusual case discussed below, the USPTO approved a configuration trademark. That application was challenged upon publication, but the TTAB dismissed the opposition. This case is instructive as to how to succeed in registering a product configuration trademark under appropriate circumstances.

The Issues

Three Frog, LLC (d/b/a Englewood Academy) is one of the three biggest sellers of wooden boxes specially adapted for storing dice (called “dice boxes”) or board game components. It applied to register as a trademark the configuration of the inside of its hexagonal-shaped dice box. This 2018 application claimed use since 2014.



Drawing of the Hex-Shaped Dice Box Trademark

Chris W. Taylor Jr., a designer of dice boxes, opposed the application on the grounds that the configuration was functional, and had not acquired distinctiveness to identify the Applicant as the source of the product.

The TTAB Analysis

Functionality

A trademark may be functional either from a utilitarian or aesthetic viewpoint. The Trademark Act under Sec. 2(e)(5) prohibits registration of “a mark which . . . comprises any matter that, as a whole, is functional.”

The Utilitarian Functionality Analysis. Even if a product is useful, it may not be regarded as functional for trademark purposes. The U.S. Supreme Court in [TrafFix Devices, Inc. v. Mktg. Displays, Inc.](#), 532 U.S. 23, 24 (2001), said that a design suffers from utilitarian functionality only if the design “is essential to the use or purpose of the article or if it affects the cost or quality of the article.”

The non-exclusive factors considered for a finding of utilitarian functionality are:

- (1) A utility patent has disclosed the utilitarian advantages of the design.
- (2) Advertising materials have touted the design’s utilitarian advantages.
- (3) Functionally equivalent designs are not available.
- (4) The design results in a comparatively simple or cheap method of manufacture.

In this opposition, the record did not contain any relevant utility patent, advertising materials, or evidence of a manufacturing advantage, and there were dozens of alternative dice box configurations available.

Prior to the trademark application filing, the U.S. Copyright Office had refused a claim for copyright protection of the design as being a “useful article” (defined for copyright purposes as having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information). As such, the Copyright Office determined that the design did not have the requisite copyrightable authorship. The design also consisted of separable features having common and familiar shapes, which did not have the requisite creativity. The TTAB did

not feel bound to follow this Copyright Office finding because it was not a final decision, and it was not equivalent to a finding of trademark functionality as defined by the U.S. Supreme Court.

The Aesthetic Functionality Analysis. The U.S. Supreme Court in [Qualitex Co. v. Jacobson Prods. Co.](#), 514 U.S. 159, 170 (1995), held that a design suffers from being aesthetically functional if “the recognition of trademark rights would significantly hinder competition.”

In this opposition, absent from the record was any evidence on how dice boxes were developed or marketed, what features purchasers sought, or why Applicant’s configuration presented a superior design. Also, alternative dice box designs were available in the marketplace.

Accordingly, the TTAB dismissed the functionality claim on both grounds.

Distinctiveness

The U.S. Supreme Court in [Wal-Mart Stores, Inc. v. Samara Bros., Inc.](#), 529 U.S. 205 (2000), acknowledged that a product design is not inherently distinctive. Therefore, even if a design is non-functional, acquired distinctiveness (called “secondary meaning”) must be established in order to register the product design as a trademark.

The factors considered for a finding of secondary meaning are:

- (1) Evidence that actual purchasers associate the mark with a particular source (typically measured by consumer surveys).
- (2) The duration, degree, and exclusivity of the design’s use.
- (3) The amount spent to advertise the product, and the nature of the advertising for it.
- (4) The amount received in sales for the product, and number of customers for it.
- (5) Intentional copying of the product’s design by others.
- (6) Unsolicited media coverage of the product embodying the alleged mark.

In this opposition, the TTAB found “somewhat persuasive” five declarations of third parties in the tabletop gaming business. Although each declaration followed the same formula in averring recognition of the Applicant’s configuration, they varied in length and detail, with each declarant plainly stating a lack of awareness of the same or a similar design. In fact, the three leading dice box companies in the industry each had unique and recognizable designs.

The evidence showed that since 2015, Applicant’s business had exponential sales growth for its product, possessed exclusivity (except for a few hobbyists), had promotional expenses exceeding \$1,000,000, and the record showed widespread advertising and distribution in various media, with promotions at conventions reaching 2 million visitors. Applicant also had sent cease-and-desist letters to copycats, and no recipient continued to manufacture copies after receiving such a letter. Further, dice box “users” were generally very involved gamers who are likely to recognize that different-shaped dice boxes originate from different companies. Finally, Applicant’s dice box configuration drew unsolicited media coverage in a variety of industry publications and websites.

Accordingly, the TTAB found the weight of the evidence clearly supported that the Applicant's dice box configuration had acquired secondary meaning. Thus, Opposer's claim of non-distinctiveness failed.

[Chris W. Taylor Jr. v. Three Frog, LLC](#), Opposition No. 91255161 (T.T.A.B. March 29, 2024).

Author's Note:

To succeed in registering a product configuration as a trademark, regardless of who has the burden of proof, you should be prepared to show as many of the following factors as possible (among other factors, if available):

Non-Functionality

1. The design elements are not essential to the use or purpose of the product.
2. The product's design does not make it comparatively simple or cheap to manufacture.
3. The product's design is not significantly superior to alternative competitive designs.
4. You have not sought or obtained a utility patent disclosing the utilitarian advantages of the product's design.
5. You have not advertised the utilitarian advantages of the product's design.
6. There are functionally equivalent alternative product designs available.

Distinctiveness

1. Survey evidence shows purchasers associate the design with a particular source.
2. You have used this design exclusively for a considerable time and to a significant degree.
3. You have taken steps to stop infringements.
4. The amount and manner of your advertising have been substantial.
5. The amount and manner of your sales, and the number of customers, have been substantial.
6. There has been intentional copying of your product design by others.
7. There has been unsolicited media coverage of your product design.

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Bill has handled domestic and international trademark and copyright matters at the highest level for over 60 years. He has counseled and represented clients on domestic and international trademark matters concerning clearance, registration, proper use, licensing, contested administrative proceedings and infringement claims. He became Senior Counsel in January 2024 and is now focusing on providing guidance and advice to other lawyers within our firm and writing informative and engaging articles on intellectual property law developments.