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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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This appeal is in response to the Final Office Action e-mailed March 16, 2008 and the subsequently denied Request for Reconsideration, whereby the Examining Attorney set forth the following:

1. Registration on the Principal Register is refused on the grounds that the mark appears to be functional for the identified goods.
2. Registration on the Principal Register is refused on the grounds that the mark does not function as a trademark to identify and distinguish applicant's goods from those of others and to indicate source.

REMARKS

1. The Examiner advises that registration is refused because the proposed sound mark appears to be functional because it consists of a design feature that serves a utilitarian purpose. Applicant respectfully requests reconsideration of the refusal to register and responds as follows.

The Sound Mark is Not Functional.

"In general terms, a product feature 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." *Inwood Labs. Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.10 (1982). A feature is functional "if exclusive use of the feature would put competitors at significant non-reputational-related disadvantage." *Qualtix Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995). "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. It is the province of patent law, not trademark law, to encourage invention by granting inventors monopoly over new product designs or functions for a limited time, after which competitors are free to use the innovation. If a product's functional features could be used as trademarks, however, a monopoly over such features could be obtained without regard to whether they qualify as patents that could be extended for forever." *Qualtix*, 514 U.S. at 164-165.

Applicant's mark, a sound mark, consists of descending frequency sound pulses from 2.3kHz to approximately 1.5kHz that occur four to five times per second with silence in between. This changing frequency and the number of pulses and pauses per second make up the sound mark's "Song." It is this Song of the sound mark that is the basis for Applicant's trademark application. This Song identifies the source of Applicant's personal security devices and distinguishes Applicant's products from many other personal security devices on the market. Functionality is analyzed using the *Morton-Norwich* factors. A review of the evidence in light of these factors shows that this Song is not functional as (1) it is not the subject of any patents, (2) advertising by the Applicant does not tout the Song as functional, (3) an infinite number of alternative designs to the Song are readily available and used by many competitors, and (4) the Song does not provide any advantages in regards to comparative simple or inexpensive methods of manufacture. *In re Morton-Norwich Prods. Inc.*, 213 USPQ 9, 15-16 (CCPA 1982).

1. *Applicant's Sound Mark is Not the Subject of Patent Protection.*

Applicant's Song is not, nor has it been, the subject of either a design or utility patent, including existing and/or expired patents. In addition, the Song is not, nor has it been, the subject of a patent application for either a design or utility patent, including both pending and abandoned patent applications. The Song is contained in a child safety bracelet¹, which is the subject of a utility patent application. *See* Exhibit A.² However, this patent application addresses the technology of the bracelet such as how it generates a very loud sound. *Id.* This patent application does *not* cover the Song of the sound mark and in fact, is not limited to any particular sound. *Id.*

The Examiner incorrectly describes Applicant's sound mark as "loud." It is important to remember that Applicant is not applying for the degree of loudness of the Song – in fact the decibels at which the Examiner listens to the Song depend entirely on the volume settings on

¹ Applicant is currently designing other products that will include the Song, which will also be used as personal security devices. Please see Application Serial No. 78/940163 which covers personal security devices.

² All exhibits to this Appeal Brief were previously filed via U.S. mail on June 12, 2008 along with the Request for Reconsideration. Upon request, all such exhibits can be re-filed.

his/her speakers and nothing to do with Applicant's sound mark. The **loudness** of sound mark as it is projected from Applicant's bracelet is dependant on the technology in the device and as such is properly protected under patent law by Applicant's patent application. As discussed above, this patent application covers the technology that controls at what degree of loudness *any* sound is projected from Applicant's products. In sharp contrast, Applicant's sound mark refers *only* to the particular Song regardless of the decibels at which it is played. Since this distinctive Song is not the subject of any patents or patent applications, it is not functional.

2. *Applicant's Advertising Does Not Tout the Song as Functional.*

Applicant's advertising does tout the Song as *distinctive*, in that its unique pulses at varying pitches will allow consumers to immediately identify the sound as Applicant's product. However, this advertising does not tout the Song as functional. Instead, the advertising touts the degree of *loudness* at which the Song emits from the device. *See* Exhibit B. On its website, the device is described as emitting a 115-decibel signal that can be heard from over a football field away. *Id.* Additionally, the device is labeled as "Originally engineered to accomplish its function." *Id.* In fact, it states that several versions of the engineering were rejected before "they were happy with how loud the signal was while remaining compact enough to fit on a child's wrist." *Id.* This resulted in "original engineering and patented technology." *Id.* As the Examiner states, the device does have the utilitarian advantage to the user by being easily heard, but this advantage is due to the degree of loudness of the device not the particular Song played by the device. The advertising does not tout the Song as functional.

3. *Numerous Alternative Designs to Applicant's Song are Readily Available and Used by Many Competitors.*

Assuming the Examiner is correct, humans can hear sounds between 20 and 20,000 Hertz.³ Applicant's Song consists of descending frequency sound pulse from 2.3kHz to approximately 1.5kHz that occurs four to five times per second with silence in between. (The

³ As an example of what such frequencies sound like, the lowest note on a piano is about 16 Hertz while the highest note is about 4186 Hertz. *See* Exhibit C.

Examiner incorrectly states that Applicant's Song only consists of tones of 2.3 kHz.) This means that there are infinite combinations of frequencies left for competitors to utilize, even if such frequencies are limited to 2000 to 4000 Hertz which is what the Examiner defines as the "most easily perceive[d] sound frequencies." Not only does Applicant's Song utilize very few frequencies, Applicant's Song also consists of a specific arrangement of these frequencies which descends and pulses four to five times per second with silence in between. The added complexity of this specific arrangement reveals that an infinite number of other arrangements are readily available to competitors for use.

In fact, there are several competitors in the personal security devices market. A quick search of the internet reveals hundreds of different personal security devices. *See, e.g.,* Exhibit D. The alert sounds of these products utilize differing frequencies and differing arrangements of frequencies.⁴ Such diversity and availability in alerts demonstrates that Applicant's Song is not superior to any other alert and as such is not functional.

4. *Applicant's Song does Not Provide any Advantages in regards to Comparative Simple or Inexpensive Methods of Manufacture.*

The frequencies and arrangement of tones in Applicant's Song have no effect on the either the complexity of manufacturing Applicant's products or the expense of methods of manufacturing Applicant's products. The sound, regardless of the frequencies or arrangement, is not relevant in these areas. Therefore, granting Applicant registration for its Song would not stifle competitor's ability to make competing products and as such Applicant's Song is not functional.

The Examiner seems to argue that certain frequencies are more easily perceived by humans than other frequencies and because Applicant's sound mark falls within these frequencies that the sound is functional and should not be allowed registration. This argument goes too far as such reasoning would mean that the only sound marks capable of registration would be those than fall outside of the range of easily perceivable frequencies. It stands to reason that most owners are not interested in a sound mark that does not draw the attention of

⁴ Not all alert sounds were available for review on the internet.

consumers. Applicant is no different. Even if Applicant's sound mark falls within the range of easily perceivable frequencies, this does not make the mark functional. As discussed above, there exists an infinite number of other arrangements of these very same easily perceivable frequencies readily available to competitors for their use.

Thus, in summary, the *Morton-Norwich* factors demonstrate that Applicant's Song does not run afoul of the policies set forth by the Courts in determining functionality. Applicant's Song is not essential to the use or purpose of the product and it does not affect the product's cost or quality. Additionally, the Song does not put competitors at a significant non-reputational-related disadvantage. Thus, granting registration of Applicant's Song would not inhibit competition; instead the trademark would properly identify the source of Applicant's personal security devices and distinguish Applicant's products from the many other personal security devices on the market. As such, Applicant's mark should be allowed.

2. The Examiner advises that registration is refused because the proposed sound mark appears to not function as a trademark to identify and distinguish applicant's goods from those of others and to indicate source. Applicant respectfully requests reconsideration of the refusal to register and responds as follows.

The Sound Mark Does Identify and Distinguish Applicant's Goods.

As defined by statute a trademark functions to identify and distinguish goods from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown. 15 U.S.C. §1127. Courts have expounded on this definition and state that the several functions of a trademark include: (1) to identify one seller's goods and distinguish them from goods sold by others; (2) to signify that all goods bearing the trademark come from or are controlled by a single, albeit anonymous, source; (3) to signify that all goods bearing the trademark are of an equal level of quality; and (4) as a prime instrument in advertising and selling the goods. J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* ("McCarthy"), § 3:2 (West 2007) citing *Springfield Fire & Marine Ins. Co. v. Founders' Fire & Marine Ins. Co.*, 99 USPQ 38 (D. Cal. 1953).

Applicant's mark performs all of these functions and therefore is a proper trademark. Before addressing these specific trademark functions, clarification is necessary concerning the use of the word "alarm" in Applicant's identification of goods as it appears that this word has been misconstrued. The Examiner correctly states that Applicant's identification of goods is "personal security alarms." But the Examiner then argues that the word "alarm" in this identification means "any sound intended to warn of approaching danger." Using this definition, the Examiner goes on to state that Applicant's sound mark is that very alarm - the alarm referred to in the identification of goods - so that since the product is the sound mark then the sound cannot function as a trademark. This is an incorrect interpretation of the word "alarm" as used by Applicant because Applicant's goods are not the sound of the alarm. Applicant's products are actual *devices*⁵ which serve to call attention to possible danger by emitting bright lights and loud noises. As discussed above, the different particular arrangements of these noises is endless and unimportant as long as the sound is emitted at very high decibels. Thus, the true meaning of "alarm" in Applicant's identification of goods is not a sound but "an automatic device that serves to call attention or to warn." *See* evidence attached to Office Action. Hence, Applicant's product is not the same as the sound mark.

In regards to whether Applicant's sound mark functions as a trademark, a review of Applicant's products and advertisements⁶ reveal that the mark serves the functions of identifying and distinguishing Applicant's products from others, of signifying that all goods bearing the sound mark come from a single source, and of signifying the quality of the devices sold by Applicant. In addition, Applicant uses this mark aurally whenever possible in advertising and when aural sound is not possible Applicant refers to the mark.

Repetitive use of a mark, as opposed to occasional and isolated use, makes it more likely to be perceived as a mark. McCarthy § 3:3. Through such repetition, the mark forms a separate commercial impression. *Id.* Applicant's website, www.amberwatch.com, and the website of a

⁵ Currently, Applicant sells bracelets but the products are to being expanded to include other devices such as cell phones. *See* Exhibit E.

⁶ Because this application was filed on an intent-to-use basis, there is no specimen of record. However, during conversations with counsel, the Examiner requested to hear the sound mark and counsel directed the Examiner to Applicant's website (www.amberwatch.com) which includes a picture of the product and a link where the sound mark can be heard.

non-profit foundation associated with the Applicant, www.amberwatchfoundation.com, reveal the extensive advertisement and media coverage for Applicant's products. These websites and related advertisement and media coverage also demonstrate Applicant's extensive use and reference to the sound mark. *See* Exhibits B & F; *see also* videos available for viewing on the websites ("Videos"). In describing their product, Applicant repeatedly refers to the unique sound.⁷ *Id.* When possible in advertisement, Applicant plays the sound mark. *Id.* Applicant has also begun a radio and television campaign in which celebrities advertise the product and the sound mark is played. *See* Exhibit G (advertisement information) and Exhibit H (radio announcements). This campaign has likely reached millions through radio alone as the radio announcements have been played over a thousand times throughout the country. *See* Exhibit I (radio invoices). In addition, the media has also reported on Applicant and its devices. *See* Exhibit J (excerpt from CNN's Prime Time). Also, Applicant's devices are widely available for purchase through several popular websites as well as Target and television's Home Shopping Network. *See* Exhibit K. Applicant uses such advertisements to tout the quality of its products. *See* Exhibits A & F; *see also* Videos. Through such advertisement and media coverage, the sound mark has formed a separate commercial impression. This separate commercial impression distinguishes Applicant's products from the hundreds of other products on the market. *See* Exhibit D.

Given that Applicant's sound mark fulfills all the functions of a trademark and creates a separate commercial impression, Applicant asserts that the mark is not functional and requests that the mark be allowed to register.

⁷ Such references are sometimes called "look-for" advertising and "look-for" advertising has been found to favor a finding of use as a trademark as it adds to the separate commercial impression. *See* McCarthy §§3:3 & 7:30.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests that this mark be allowed to proceed to registration.

Respectfully submitted,

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