

From: Blair, Jason

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CORRESPONDENT ADDRESS:

K. DANICA RAY
DLA PIPER US LLP
401 B STREET, SUITE 1700
SAN DIEGO, CA 92101-4297

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: Vertex Group, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

sdtrademark@dlapiper.com

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed from the final refusal to register a proposed sound mark, which can be heard at http://www.uspto.gov/go/kids/soundex/78940163_0001.mp3¹ for a “personal security alarm in the nature of a child's bracelet to deter and prevent child abductions” in International Class 9. Registration was refused pursuant to Trademark Act §2(e)(5), 15 U.S.C. §1052(e)(5), on the basis that the proposed mark, when used on or in connection with the identified goods, comprises a feature of the identified goods that serves a utilitarian purpose. Registration was also refused pursuant to Trademark Act §§1, 2, and 45, 15 U.S.C. §§1051-1052 and 1127, on the basis that the proposed mark, when used on or in connection with the identified goods, does not function as a trademark to identify and distinguish applicant’s goods from those of others and to indicate their source.

¹ Although the serial number of the sound file is for the co-pending application, the marks are identical, and the link was posted on the USPTO Kids’ page for convenience. The sound can also be found internally at \\cifs005\sound\Media\76601697_0001.wav

On August 2nd, 2006, applicant submitted a use-based application for the identical sound for “personal security alarms,” which was assigned application Serial No. 78940163. Appeal briefs for that case were submitted to the Board on June 8th, 2008, and a decision from the Board is pending. The examining attorneys were not aware of the existence of the co-pending applications until late into the prosecution of each file. Had the existence of the co-pendings been discovered earlier, a request for consolidation would have been made. Due to the identical nature of the issues in this application and the 78940163 application, the examining attorney respectfully requests that the holding in this matter be consistent with the holding in the previous 78940163 appeal.

FACTS

On July 12th, 2004, applicant applied to register the proposed sound mark for “personal security alarm in the nature of a child's bracelet to deter and prevent child abductions” in International Class 9 as an intent-to-use application. On January 18th, 2007, applicant submitted a statement of use, for which the sound of the mark can be heard at the link listed above.

On October 19th, 2007, the examining attorney refused registration under Trademark Act §2(e)(5), 15 U.S.C. §1052(e)(5), on the basis that the proposed mark, when used on or in connection with the identified goods, comprises a feature of the identified goods that serves a functional or utilitarian purpose. Registration was also refused pursuant to Trademark Act §§1, 2, and 45, 15 U.S.C. §§1051-1052 and 1127, on the basis that the proposed mark, when used on or in connection with the identified goods, does not function as a trademark to identify and distinguish applicant’s goods from those of others and to indicate their source.

On January 22nd, 2008, the applicant submitted arguments in support of registration, and on March 16th, 2008, the examining attorney issued a final refusal based on both the functionality refusal and the failure to function refusal.

On June 16th, 2008, the applicant submitted a request for reconsideration to the final refusals, and also submitted copies of several radio commercials on compact disc, which are publicly accessible in the corresponding paper file folder. Copies of the contents have also been uploaded onto the US Patent & Trademark Office's intranet media folder, which can be accessed at <\\cifs005\sound\Media> under the following file names:

76601697_0002.mp3
76601697_0003.mp3
76601697_0004.mp3
76601697_0005.mp3
76601697_0006.mp3
76601697_0007.mp3
76601697_0008.mp3
76601697_0009.mp3
76601697_0010.mp3
76601697_0011.mp3
76601697_0012.mp3
76601697_0013.mp3
76601697_0014.mp3
76601697_0015.mp3
76601697_0016.mp3
76601697_0017.mp3
76601697_0018.mp3
76601697_0019.mp3
76601697_0020.mp3
and 76601697_0021.mp3.

On July 24th, 2008, the examining attorney, upon hearing the radio advertisement discs, maintained the both final refusals with respect to Trademark Act §2(e)(5), 15

U.S.C. §1052(e)(5), and with respect to Trademark Act §§1, 2, and 45, 15 U.S.C. §§1051-1052 and 1127.

On August 15th, 2008, the previous examining attorney assigned the application to the present examining attorney, so that the application may be handled consistently with the application in Serial No. 78940163.

The present appeal follows.

ARGUMENT

I. Applicant's proposed sound mark serves a functional or utilitarian purpose

The first issue in this case is whether the applicant's proposed sound mark comprises a feature of the identified goods that serves a functional or utilitarian purpose. Trademark Act Section 2(e)(5), 15 U.S.C. §1052(e)(5) prohibits the registration of a mark if it is "essential to the use or purpose of the [product]" or "it affects the cost or quality of the [product]." *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33, 58 USPQ2d 1001, 1006 (2001); TMEP §1202.02(a)(iii)(A). In the present case, the proposed sound mark does both.

Additionally, functionality refusals have not been limited to design elements. A color has been held to be functional if it yields a utilitarian or functional advantage, for example, yellow or orange for safety signs. *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994), cert. denied, 514 U.S. 1050 (1995); TMEP §1202.05(b). Using color as an analogy, sounds must also be refused if the sound yields a utilitarian or functional advantage.

Although applicant repeatedly describes its proposed mark as a “song,” the proposed mark is actually a loud, high frequency sound pulse, and the goods are personal security alarms.

As discussed in previous Office actions, the loud, high-pitched pulse is essential to the use of the product because it provides an audible signal to notify people of danger. According to applicant’s own website, “[w]hen children scream, it is often difficult to discern screams of fright from screams of delight. (The sound) is so unique and draws so much attention that everyone around can be made aware that it means there is something amiss.”

And although the range of sound frequencies is infinite, evidence attached to the previous Office actions demonstrates that human hearing is only able to detect sounds between 20 and 20,000 Hertz. Additionally, the *Fletcher-Munson* and *Robinson-Dadson* curves have scientifically proven that humans can most easily perceive sound frequencies between 2000 and 4000 Hertz. Because applicant’s sound of 2.3 kHz is within this range, it provides the utilitarian advantage of being easily heard by most people.

Applicant argues that the proposed mark is not functional because it has “no effect on... 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.” The examining attorney respectfully disagrees.

According to a report by the U.S. Consumer Product Safety Commission, which was attached to previously submitted Office actions, many alarms do not produce sounds in frequencies much lower than the applicant’s because 1) the frequencies are in the range

most easily perceived by humans, and 2) producing lower frequency sounds at the same loudness require more power to produce. This is because lower frequencies require a larger diameter speaker, which in turn take more power to make vibrate. Therefore, making a battery-powered alarm that can produce a loud sound at a lower frequency is more complex, and may require more batteries. The larger batter and larger speaker would not only add to the cost, but also increase the weight and size of the alarm, as well as lower its portability. As a result, there are several functional advantages to creating an alarm that uses frequencies similar to those in applicant's proposed mark.

Applicant also argues, "the different particular arrangements of these noises is... unimportant as long as the sound is emitted at very high decibels." To the contrary, the U.S. Consumer Product Safety Commission report also finds that in residential smoke alarms, the attention-getting ability is best if the signal is an oscillating sound in the 2000 Hertz range. Such a frequency range is best because older people lose more of their hearing perception at frequencies higher than 3000 Hertz, and the oscillating between a lower and higher frequency reaches people who may be deaf or insensitive to a certain particular frequency. Because applicant's proposed mark is within this frequency range, and also oscillates between the lower and higher frequency several times per second, applicant's proposed mark is within the criteria set forth by the U.S. Consumer Product Safety Commission for being the most functional type of alarm for getting people's attention.

In addition, applicant argues, "[t]he 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." Yet, applicant's own evidence from www.nextag.com

describes the goods as “CHILD SAFETY WATCH WITH LOUD ALERT” and “ALERT SIGNAL HEARD 100 YARDS AWAY.” And as previously stated, according to the U.S. Consumer Product Safety Commission report, many alarms do not produce sounds in frequencies much lower than the applicant’s because 1) the frequencies are in the range most easily perceived by humans, and 2) producing lower frequency sounds at the same loudness require more power to produce. This is because lower frequencies require a larger diameter speaker, which in turn take more power to make vibrate. Therefore, making a battery-powered alarm that can produce a loud sound at a lower frequency is more complex, and may require more batteries. So while the loudness of the sound itself may not be claimed as a feature of the mark, applicant’s sound was designed to fall within its certain frequency range because it can be played back by a small device in a manner that most people would perceive as loud. This loudness is a feature that applicant touts in its promotional literature, as seen by applicant’s own submitted evidence.

The examining attorney also notes that applicant has previously stated that the proposed mark is played loudly. As noted above, applicant previously stated, “the different particular arrangements of these noises is... unimportant as long as the sound is emitted at *very high decibels*.” (Emphasis added.) Applicant admits in its brief that “the device does have the utilitarian advantage to the user be being easily heard” and 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.’” But the applicant also states “th[e] advantage is due to the degree of loudness of the device not the particular Song played by the device.” As demonstrated by the U.S. Consumer

Product Safety Commission report, however, the frequency of the sound and the loudness of the sound go hand in hand. Sounds at a higher frequency would not be perceived to be as loud, and lower frequencies would require larger speakers and batteries, making the alarm not “compact enough to fit on a child’s wrist.” In short, the frequency and the loudness are not completely independent of each other. Rather, they go hand-in-hand.

Applicant goes on to argue that the mark is not functional because there are “an infinite number of other arrangements [that] are readily available to consumers.” The examining attorney, however, notes that in order for a proposed mark to be held functional, the evidence need not establish that the mark at issue is the very best design for the particular product. Rather, a finding of functionality is proper where the evidence indicates that the mark at issue provides specific utilitarian advantages that make it one of a few superior designs available. *See, e.g., In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985).

Although competitors may choose slightly different frequencies within the same range for their alarms, the examining attorney notes that a Trademark Registration does not merely protect a mark from third party use of identical marks, but also protects the mark against third-party use for similar marks that are likely to be confused with the Registered mark. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). To expect everyday consumers to distinguish the difference between 2.3kHz and 2.2kHz or 2.4kHz sound oscillations is unreasonable. Therefore, granting a registration for the current application would in effect prevent competitors from using a range of sound frequencies that 1) are easily heard by most people, and 2) easily amplified to a loud volume by a small speaker.

Because alarms with frequencies higher than applicant's mark are harder for many people to hear, and alarms with frequencies lower than applicant's mark require a larger speaker and more battery power, making the alarms larger and less portable and convenient, applicant's mark should be refused registration for serving a functional or utilitarian purpose under Trademark Act Section 2(e)(5), 15 U.S.C. §1052(e)(5).

II. Applicant's proposed mark does not function as a trademark to identify and distinguish applicant's goods from those of others and to indicate their source

The second issue in this case is whether the applicant's proposed sound mark functions as a trademark to identify and distinguish applicant's goods from those of others and to indicate their source. Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051-1052 and 1127 prevents the registration of marks that do not function as source indicators. *In re Remington Prods., Inc.*, 3 USPQ2d 1714 (TTAB 1987); TMEP §§1202 *et seq.*

Any relevant evidence submitted with the application is reviewed and analyzed in order to determine whether a term is being properly used as a trademark. *In re Volvo Cars of North America*, 46 USPQ2d 1455 (TTAB 1998). Not all words, designs, symbols or slogans used in the sale or advertising of goods function as marks, even if they may have been adopted with the intent to do so. A designation cannot be registered unless ordinary purchasers would regard it as a source-indicator for the goods. *In re Manco, Inc.*, 24 USPQ2d 1938 (TTAB 1992); TMEP §§1202 *et seq.*

Applicant's good is a "personal security alarm in the nature of a child's bracelet to deter and prevent child abductions." As discussed in previous Office actions, the term

“ALARM” means “any sound intended to warn of approaching danger.” Applicant’s submitted mark is the sound itself. Because the sound is intended to provide a warning of danger, the applied for mark is in effect the alarm itself, rather than as a trademark for personal security alarms.

Consumers would not recognize applicant’s proposed mark as a “song,” as applicant has attempted to characterize the sound. Rather, consumers would only recognize the sound as a loud, relatively high-pitched, pulsating sound. Because sounds that are loud, relatively high-pitched, and pulsating are widely used as alarms (mostly due to the functionality of such a sound), consumers would not recognize applicant’s proposed mark as a source indicator.

Applicant argues that the applicant’s advertisements have “likely reached millions through radio alone as the radio announcements have been played over a thousand times throughout the country.” Applicant has submitted compact disc recordings of these radio advertisements, which are which are publicly accessible in the corresponding paper file folder. Copies of the contents have also been uploaded onto the US Patent & Trademark Office’s intranet media folder. Each of the radio announcements contains the same wording. Only the voice of the celebrity is changed. (For example, *Today Show* weatherman Al Roker reads one, while *Everybody Loves Raymond* star Brad Garrett reads another.) The radio advertisements all contain this wording:

“Hi, this is {name of celebrity}. The sound you are about to hear is that of a child that may need your help. {The proposed sound mark plays.} If you hear this sound, a child may be in danger. Be aware, be alert, and let’s all work together to stop child abduction.”

The examining attorney notes that these advertisements do not serve to inform consumers that the sound is intended as a source indicator. They do not tell consumers that the sound is a trademark or any other type of source indicator to the applicant. Rather, consumers would regard the advertisements as public service announcements, informing consumers of the function of the sound (supporting the Trademark Section 2(e)(5) refusal, above.) At no time do the advertisements mention that the sound means the child is wearing a particular brand of alarm. It merely reinforces to consumers that the sound serves the purpose of alerting bystanders that a child is being abducted. If anything, applicant's radio advertisements have conditioned the general public to expect that all child abduction alarms will make this sound, regardless of the manufacturer.

Because applicant's sound is an alarm itself, and because applicant's radio advertisements inform consumers that the sound has a functional purpose rather than portraying the sound as unique to applicant's own alarms, consumers will fail to see it as a source indicator. Therefore, the final refusal issued for failing to function as a trademark under Sections 1, 2, and 45 of the Trademark Act should be upheld.

CONCLUSION

Because alarms with frequencies higher than applicant's mark are harder for many people to hear, and alarms with frequencies lower than applicant's mark require a larger speaker and more battery power, making the alarms larger and less portable and convenient, applicant's mark should be refused registration for serving a functional or utilitarian purpose under Trademark Act Section 2(e)(5), 15 U.S.C. §1052(e)(5).

Furthermore, because applicant's sound is an alarm itself, and because applicant's radio advertisements inform consumers that the sound has a functional purpose rather

than portraying the sound as unique to applicant's own alarms, the final refusal issued for failing to function as a trademark under Sections 1, 2, and 45 of the Trademark Act should be upheld.

Respectfully submitted,

/Jason Paul Blair/
Examining Attorney
Law Office 104
Phone - (571) 272-8856
Fax - (571) 273-8856

Chris Doninger
Managing Attorney
Law Office - 104