

From: Moninghoff, Kim

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Subject: U.S. TRADEMARK APPLICATION NO. 85318060 - N/A - Request for Reconsideration Denied -
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Files: oblong.jpg, 85318060.doc

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 85318060

MARK:



CORRESPONDENT ADDRESS:

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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

APPLICANT: Monster Cable Products, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

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REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 2/13/2014

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. See 37 C.F.R. §2.64(b); TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a). The requirement and refusals made final in the Office action dated September 10, 2012, are maintained and continue to be final. See TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issues, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issues in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

Mark Description Requirement

The applicant's request for reconsideration does not address the mark description requirement.

Section 23 Refusal – Functional Product Design

The applicant's request for reconsideration regarding this refusal primarily addresses the utility patent relied on by the Examining Attorney in finding the design to be functional.

Patent Claims

The applicant has argued that the patent covers cable designs where the cable sections have:

- a. Cross-sectional width and thickness, and where
- b. Said width is substantially greater than said thickness.

The applicant has described its mark as follows:

The mark consists of the curved outside contours of a headphone cable that give way to **sides of the cable jacket that are wider than they are thick**. The headphone cable is used to connect ear bud devices to a headphone splitter. The ear bud areas shown in dotted lines in the mark are not claimed as part of the mark. Additionally, no claim is made to the length of the cable or the splitting of the cable into two cables.

In other words, the applied-for mark has (1) a cross-sectional width and thickness, where said width is substantially greater than said thickness and (2) curved outer contours. Thus, the applied-for mark includes matter covered by the patent.

In determining functionality, the examining attorney is expected to consider both the numbered claims and the disclosures in the written description, drawings, and abstract of the patent. TMEP §1202.02(a)(v)(A). The examining attorney should also consider other evidence described in a patent that is relevant to the functionality of the mark at issue. *Id.*; *In re Pohl-Boskamp GmbH & Co.*, 106 USPQ2d at 1046-47. Thus, it was proper for the Examining Attorney to consider the curved outer contours shown in the patent drawings that result in an overall oblong shape.

The applicant has cited *Phillips v. AWH Corp.*, 415 F. 3d 1303, 1323 (Fed. Cir. 2005), for the proposition that a specific embodiment in the specification should not be used to limit the scope of the claims. The full scope and extent of the applicant's patent is not at issue in this case. Rather, the issue in this case is whether the design shown in the applied-for mark contains features claimed by the applicant's patent. It does—the dimensions of the cable in the mark consist of a width substantially greater than the thickness. Thus, the mark includes functional matter and is unregistrable.

Preferred Embodiment

Throughout the patent, though not in the claims, the invention is referred to as a “flat” cable. Thus, the preferred embodiment of the invention, appears to be a flat cable like that shown in the applied-for mark.

As argued by the applicant, the curved outer contours of the cable, claimed as part of the applied-for mark, are not specifically claimed in the patent or described as specific advantages, However, these

curved corners are included in the patent drawing, and thus are part of the preferred embodiment of the patent.

Where the evidence shows that the overall design is functional, the inclusion of a few arbitrary or otherwise nonfunctional features in the design will not change the result. TMEP §1202.02(a)(v); see *In re Becton, Dickinson & Co.*, 675 F.3d at 1374, 102 USPQ2d at 1376; *Textron, Inc. v. U.S. Int'l Trade Comm'n*, 753 F.2d 1019, 1025, 224 USPQ 625, 628-29 (Fed. Cir. 1985); *In re Vico Prods. Mfg. Co.*, 229 USPQ 364, 368 (TTAB 1985). Thus, if the curved outer contours have no functional advantages, they are such a minor element of the overall cable design, that they are insufficient to overcome the functionality of the overall cable design.

Comparison with Apple's Design

The applicant's argument also includes a discussion of the inclusion of curved edges in a product manufactured by Apple. The applicant analogizes this curved edge design with that the design at issue in this case to assert that the curved edges are a significant element of the mark. The applicant has not specified the particular Apple product, but since Apple's primary goods are smart phones and digital music players, and the applicant references Apple's computers, tablets, and phones, it appears that this reference to Apple's design involves some type of hand-held product, and not a cable of the type at issue in this case.

The applicant has also not explained why Steve Jobs "agoniz[ed]" over the rounded corners of the product—was it for a functional purpose, like improving the ability to hold the product, or was it for an aesthetic purpose? Further, just because Steve Jobs "agoniz[ed]" over the corner design of the unnamed Apple product does not mean that this part of the product design is significant enough to ordinary consumers to serve as a source identifier. Without further context, this statement could be read as indicating that Steve Jobs was a perfectionist who devoted significant amounts of time to product design elements that went unnoticed by consumers.

Even if the curved corners of the unidentified Apple product are significant enough to serve as a source identifier for some type of hand-held device, the applicant has provided no support for its apples-to-oranges analogy that curved outer contours would equally serve as a source identifier for the applicant's cables.

Alternative Designs

The applicant's proffered expert has provided examples of "alternative designs" that incorporate the applicant's patent, which the applicant's proffered expert states are no more expensive to manufacture than the design shown in the applied-for mark. This conclusion is based on the statement that "[e]dge designs rarely changes the cost, tooling, or performance of a product." However, many of the applicant's alternative embodiments incorporate more significant changes than just modifications to the "edge" of the design. Two incorporate numerous grooves along the length of the cable of various depths.

The applicant has also not provided any examples of third-party use of any of these alternative designs, whereas the Final Office action was supported by numerous examples of third-party use of the same design shown in the applied-for mark. As a result, it appears that competitors would not find the alternative designs proposed by the applicant to be equivalent alternates to the applied-for design.

Further, many of these incorporate elements that depart from the "flat" cable design referenced throughout the patent. Thus, even if they fall within the scope of the patent invention, they do not show the preferred embodiment of that invention.

Finally, these examples only show that different cables may be manufactured with the audio channels side by side. The applicant's examples do not show how these cables would be attached to the ear buds or the splitter referenced in the patent. Figure 3 of the patent shows that a cable with curved outer contours of the type shown in the applied-for mark fits securely in the splitter. Similarly, Figure 2 of the patent shows that a cable with curved outer contours appears to fit securely into ear bud style head phones. The cable styles proposed by the applicant would not fit as securely into the ear buds and splitter shown in the patent application. This raises the issue that even if there is no difference in cost in manufacturing the cables, a different cable design of the types proposed by the applicant could increase the cost of other parts of the headphones and thus would make the headphones as a whole more costly.

Applicant's Expert

The applicant has based much of its argument for the above refusals based on a declaration provided by a "technical and industry expert." The credentials provided by the applicant for this expert are primarily in the field of industrial design. The CV for the proffered expert shows limited experience with utility

patents and does not appear to include any experience in the field of design of headphone cables (whether for utility or aesthetic purposes). The proffered expert also conceded he had no familiarity with any of the third party headphone cable designs made of record by the Examining Attorney. Therefore, it appears that the proffered expert may not meet the criteria of being a person skilled in the relevant art. Further, due to his lack of documented experience with headphone cables, it appears that the proffered expert does not have the necessary experience to opine on the relative costs of the proposed alternative embodiments of the patent. In one of the applicant's previous responses, the applicant indicated that information regarding its manufacturing costs was covered by trade secret. The applicant's current response does not indicate whether the proffered expert had access to this information in forming his conclusion regarding the costs of alternative designs.

Accordingly, the Final functionality refusal is maintained and continued for the reasons discussed in the previous Office actions and above.

Section 23 Refusal – Generic Product Design

The applicant has responded to this refusal by arguing that the Examining Attorney has not provided data relating to the third-party evidence such as dates of first sale, dollar values of sales, and market penetration.

The USPTO is an agency of limited resources, and as such, it cannot be expected to shoulder the burden of conducting market research. TMEP §1202.02(b)(ii); *In re Pacer Tech.*, 338 F.3d 1348, 1352, 67 USPQ2d 1629, 1632 (Fed. Cir. 2003). The Examining Attorney has met her burden by providing a number of examples of third-party use of similar designs and has supported this evidence with printouts showing sales of these goods through U.S. retail outlets, such as bestbuy.com and amazon.com, plus additional sales related information for these sources as discussed in the Final Office action.

The applicant has also argued that it is unclear whether the applied-for mark is shown in the third-party evidence. Since many of the examples are described as "flat" cables and are thus wider than they are thick, this appears to be a claim that the applicant cannot determine whether the sides of the cables have the curved outer contours shown in the applied-for mark. The Examining Attorney has reviewed this evidence and confirms that the curved outer contours are visible in these examples and that the cables have the same appearance to the cable shown in the applicant's specimen. However, assuming, arguendo, that the applicant is correct and that the inclusion of the curved outer contours cannot be confirmed in any of the third-party examples made of record, this is further evidence that the

applicant's design is incapable of acquiring distinctiveness. If consumers cannot tell whether or not competitors' cables incorporate the applicant's design, the design cannot serve its function of distinguishing the applicant's cables from those of others in the marketplace.

Accordingly, the Final generic refusal is maintained and continued for the reasons discussed in the previous Office actions and above.

Note: The previous Office action referenced a section of the design code manual, but it appears that a copy of that reference was not attached to the Final Office action. A copy of that reference is now attached to this Office action.

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. *See* 37 C.F.R. §2.64(b); TMEP §715.03, (a)(2)(B), (a)(2)(E), (c).

Since no time remains in the six-month response and the applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

/Kim Teresa Moninghoff/

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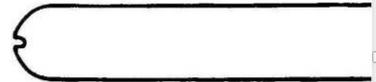
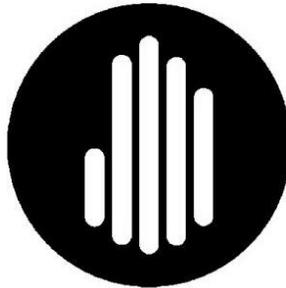
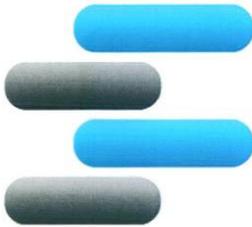


26.11.26 Oblongs as carriers for words, letters or designs.

Specific Guideline An oblong shaped figure is a geometric shape with approximately parallel sides and rounded ends.



26.11.27 Oblongs not being used as carriers for words, letters or designs.



SONOROUS

26.11.28 Miscellaneous designs with overall rectangular shape

