ESTTA Tracking number: **ESTTA611852**
Filing date: **06/24/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

| | |
|---|---|
| Proceeding | 85318060 |
| Applicant | Monster Cable Products, Inc. |
| Correspondence Address | DAVID M KELLY<br>KELLY IP LLP<br>1330 CONNECTICUT AVE NW, SUITE 300<br>WASHINGTON, DC 20036<br>UNITED STATES<br>linda.mcleod@kelly-ip.com, docketing@kelly-ip.com, david.kelly@kelly-ip.com, stephanie.bald@kelly-ip.com |
| Submission | Request for Reconsideration |
| Attachments | REQUEST FOR RECONSIDERATION 6-17-14 (327055xD1162).pdf(97460 bytes )<br>Exhibit A Monster Cable (327066xD1162).pdf(529692 bytes )<br>Exhibit B Monster Cable (327062xD1162).pdf(399974 bytes )<br>Exhibit C Monster Cable (327064xD1162).pdf(329858 bytes )<br>Declaration of Jacky Hsiung (327071xD1162).pdf(34598 bytes )<br>Request for Remand 6-24.pdf(44667 bytes )<br>Declaration of Allison Kipp (328791xD1162) (328800xD1162).pdf(43787 bytes ) |
| Filer's Name | Robert D. Litowitz |
| Filer's e-mail | docketing@kelly-ip.com, cheryl.suh@kelly-ip.com |
| Signature | /Robert D. Litowitz/ |
| Date | 06/24/2014 |

Attorney Docket: 12158.0001

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Monster, Inc.
Serial Number: 85318060
Filing Date: May 11, 2011
Mark:

Examining Atty: Kim Teresa Moninghoff, Esq.
Law Office: 113

Commissioner for Trademarks

P.O. Box 1451

Alexandria, Virginia 22313-1451

**REQUEST FOR RECONSIDERATION OF FINAL OFFICE ACTION**

## I. INTRODUCTION

Applicant, Monster, Inc., requests reconsideration of the Examining Attorney's continued refusal to permit registration of Applicant's non-functional design for a headphone cable, shown above, consisting 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." (Emphasis added.) Monster's position on the merits is fully set forth in its initial request for reconsideration dated February 6, 2014. The arguments and evidence presented in that submission are incorporated by reference and will not be repeated at length here. Rather, Monster focuses on statements and conclusions in the February 13, 2014 Office Action that are unsupported by competent or reliable evidence.

Monster also submits additional evidence in the form of a declaration from Monster cable designer Jacky Hsiung, which corroborates and reinforces the evidence already of record.

First, as explained below, the Examining Attorney has not met her burden of establishing a prima facie case of functionality for Monster's ornamental cable headphone design. Indeed, the as the primary evidentiary basis for this refusal, the Examining Attorney relied upon Monster's utility patent entitled "Headphone Cable." U.S. Patent No. 8,068,633. But just because a mark appears among a utility patent's drawings does not establish a prima facie case of functionality; rather, to meet that evidentiary threshold, the patent must *claim or disclose* that the feature comprising the mark performs some utilitarian function. The presumption of functionality does not extend to features that are merely incidental, arbitrary, or ornamental.

Even assuming, however, that the Examining Attorney met the initial burden of proof by relying on Monster's utility patent for a presumption of functionality, Monster has overcome any such presumption by presenting competent evidence— in the form of a declaration from an accomplished industrial designer and distinguished professor of design Lance Rake—which explains that:

- the claims of Monster's utility patent do not recite (and thus do not require) cables with contoured edges, and for that matter, do not recite or require that the cables be "flat"
- the specification and written description of Monster's utility patent nowhere mention such contoured edges, let alone ascribe to them any function

- contours, such as found in Monster's mark, are well-recognized design elements that industrial designers, including the groundbreaking designers of the iPod and iPhone, frequently employ for their aesthetic appeal
- numerous design alternatives *without contoured edges* or *flat sides* exist for practicing the invention disclosed and claimed in Monster's utility patent, namely, a headphone cable that is *substantially* wider than it is thick.

This competent evidence stands unrefuted by anything other than unsupported statements and assertions by the Examining Attorney. As such, the Examining Attorney has not carried her burden of establishing that the proposed mark is functional. The refusal to register on functionality grounds therefore should be withdrawn on that basis below. Nonetheless, to address the Examining Attorney's unfounded comments that Professor Rake lacks sufficient expertise and experience to opine on cable design, Monster submits the declaration of Jacky Hsiung, one of Monster's cable designers. Mr. Hsiung, a skilled designer of headphone cables, confirms that Professor Rake *is* competent to opine about cable design. Mr. Hsiung furthermore corroborates Professor Rake's opinion that the curved outer contour at the heart of Monster's mark is an arbitrary ornamental design feature that is incidental to function.

Second, the Examining Attorney has not met her burden of establishing that the mark in question is merely a "generic product design." The only evidence relied upon to support this rejection are copies of third party advertisements that supposedly show headphone cables with the central feature of Monster's mark, the curved outer contour. But as the declaration of Professor Rake explains, that evidence is inconclusive—even a skilled observer such as Professor Rake cannot tell what most of the third-party cables actually look like from the images that the Examiner relies upon in support of her genericness rejection. Furthermore, even assuming that these

images do in fact reflect third-party use of cables that include Monster's contoured-edge feature, the record does not include any evidence that doing so is necessary for any functional advantage, or that consumers expect all flat headphone cable to feature such contoured edges for reasons of "function" rather than form. Instead, Professor Rake shows that numerous design alternatives exist for producing headphone cables that meet the express limitations of Monster's utility patent and/or provide all the functional advantages described in that patent, but can be produced without significant additional manufacturing cost. And Professor Rake's conclusions that numerous design alternatives to Monster's mark exist are now confirmed by Mr. Hsiung, a skilled cable designer. Significantly, none of the alternative designs of record feature Monster's mark: "**the curved outside contours of a headphone cable** that give way to sides of the cable jacket that are wider than they are thick." (Emphasis added.)

## II. DISCUSSION

### A. The Burden of Proof--Functionality

The functionality determination is a question of fact, and depends on the totality of the evidence presented in each particular case. *In re Becton, Dickinson & Co*., 675 F.3d 1368 at 1372, 102 USPQ2d at 1375 (Fed. Cir. 2012); *Valu Eng'g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1273, 61 USPQ2d 1422, 1424 (Fed. Cir. 2002); *In re Udor U.S.A., Inc.*, 89 USPQ2d 1978, 1979 (TTAB 2009); *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1338 (TTAB 1997). As noted above, the examining attorney must establish a prima facie case that the proposed trade dress mark sought to be registered is functional in order to make and maintain the §2(e)(5) functionality refusal. *See In re Becton, Dickinson & Co.*, 675 F.3d 1368, 1374, 1376; *Textron, Inc. v. U.S. Int'l Trade Comm'n,* 753 F.2d 1019, 1025, 224 USPQ 625, 629 (Fed. Cir. 1985); *In re R.M. Smith, Inc.,* 734

F.2d 1482, 1484, 222 USPQ 1, 3 (Fed. Cir. 1984). While there is no set amount of evidence that an examining attorney must present to establish a prima facie case of functionality, there must be evidentiary support for the refusal in the record. *See, e.g., In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1342, 213 USPQ 9, 16-17 (C.C.P.A. 1982) (admonishing both the examining attorney and the Board for failing to support the functionality determination with even "one iota of evidence").

The Federal Circuit considers four factors, known as the *Morton-Norwich* Factors, in evaluating whether a mark is "functional:"

> (1) the existence of a utility patent disclosing the utilitarian advantages of the design;
> (2) advertising materials in which the originator of the design touts the design's utilitarian advantages;
> (3) the availability to competitors of functionally equivalent designs; and
> (4) facts indicating that the design results in a comparatively simple or cheap method of manufacturing the product.

*In re Morton-Norwich Products, Inc.,* 671 F.2d 1332 (CCPA 1982). Functionality is a question of fact, and depends on the totality of evidence. *In re Udor U.S.A. Inc.,* 89 USPQ2d 1978, 1979. A utility patent that discloses the feature claimed as a mark may provide prima facie evidence of functionality. *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 30, 58 USPQ2d 1001, 1005 (2001); *Udor U.S.A., Inc.*, 89 USPQ2d at 1979-80. As the TMEP expressly states, however, "[i]t is important . . . to read the patent to determine whether the patent *actually claims the features presented in the proposed mark*. If it does not, or if the features are referenced in the patent, but *only as arbitrary or incidental features,* then the probative value of the patent as evidence of functionality *is substantially diminished or negated entirely*. TMEP §1202.02(a)(v)(A), citing *TrafFix*, 532 U.S. at 34, 58 USPQ2d at 1007 (noting that where a manufacturer seeks to protect arbitrary, incidental, or ornamental features of a product found in

the patent claims, such as arbitrary curves in the legs or an ornamental pattern painted on the springs, functionality will not be established if the manufacturer can prove that those aspects do not serve a purpose within the terms of utility patent).

If a prima facie case of functionality is made, the burden then shifts to the applicant to present "competent evidence" to rebut the examining attorney's prima facie case of functionality. *See In re Becton, Dickinson & Co.*, 675 F.3d at 1374; *Textron, Inc. v. U.S. Int'l Trade Comm'n*, 753 F.2d at 1025, 224 USPQ at 629; *In re R.M. Smith, Inc.*, 734 F.2d at 1484, 222 USPQ at 3; *In re Bio-Medicus Inc.*, 31 USPQ2d 1254, 1257 n.5 (TTAB 1993). The "competent evidence" standard requires proof by preponderant evidence. *In re Becton, Dickinson & Co*., 675 F.3d at 1374, 102 USPQ2d at 1377.

### B. Monster's Utility Patent Does Not Provide Prima Facie Evidence of Functionality

The salient feature of Monster's mark, the curved outer contour, is merely an "incidental or arbitrary" feature of the invention disclosed and claimed in Monster's utility patent. The actual claims of the utility patent—the claims being the portion of the patent that defines the invention— make clear that the invention consists of a headphone cable that is *substantially* wider than it is thick; that feature—the dimensional relationship between width and thickness—delivers the advantages the inventors describe in the patent—a cable that resists tangling and also provides room to house all the necessary or desired wiring.

Although the patent specification speaks to the advantages of "flat" cables, nowhere does the patent mention curved outer contours, much less ascribe any function to that feature. Plainly, the Examining Attorney did not follow the TMEP's "important" directive to "read the patent to determine whether the patent *actually claims the features presented in the proposed mark*."

Applying that directive, any presumption of functionality is entirely negated or at very least, substantially diminished.

Here, Monster's utility patent is the principal evidence of functionality presented by the Examining Attorney. But the utility patent is insufficient, because the feature at the heart of Monster's mark—the curved outer contour— is not claimed in the patent and is nowhere described or shown as a functional feature. Indeed, the patent's written description nowhere even mentions contoured edges. Accordingly, the Examining Attorney has failed to meet the burden of proving even a prima facie case of functionality.

### C. Even if Prima Facie Evidence Exists, Monster Has Overcome It With Unrefuted Evidence

If, however, Monster's utility patent is found to satisfy the prima facie threshold, Monster has overcome it with the previously submitted declaration of Professor Lance Rake and the new declaration of Mr. Hsiung. In his declaration, Professor Rake explained that:

a. The claims of Monster's utility patent do not mention or otherwise include as limitations either "flat" cables or cables with "curved outside contours."

b. Flat cables with curved outside contours are merely one of numerous possible embodiments of Monster's invention. Numerous alternative designs exist that could be produced without adding to the cost or complexity of manufacture. See Rake Declaration, Exhibit B.

This evidence stands unrefuted. In response, the Examining Attorney presented only the following unsubstantiated arguments, each of which is incorrect or misplaced, as explained below:

**Unsupported Argument 1**: Professor Rake lacks relevant experience to construe Monster's Utility patent because he is merely an industrial designer with "limited experience with utility patents."

**Response**: Professor Rake is an award winning, internationally recognized expert in industrial design, as his CV (Exhibit A to his declaration) amply demonstrates. He has served as an expert witness in numerous cases, including an International Trade Commission investigation concerning the design of USB drives, a product category that is analogous to the field of audio cables for headphones. Furthermore, Professor Rake is a named inventor or co-inventor of a host of patents and patent applications, both design patents *and* utility patents. His inventions include, inter alia, a "power system" comprising "a rail for mounting on a surface and a device for providing power to the rail," (utility patent application 12/178,402,) a fencing mask. (utility patent 6,820,286), a cover for musical instruments (design patent D265246,), and a step stool (design patent D600928).

Under Federal Rule of Evidence 702, "[a] witness who is qualified as an expert by knowledge, skill, experience, training, or education may testify in the form of an opinion of otherwise if (a) the expert's scientific, technical, or other specialized knowledge will help . . . to determine a fact in issue." Professor Rake's diverse experience with various industries, technologies, and design challenges, unquestionably qualifies him to explain and opine on the industrial design issue here, which focuses on special relationships (i.e. the width of a cable relative to its height) and is neither highly technical in nature nor unique in terms of design aesthetics. And indeed, the Examining Attorney has no basis for the premise that an industrial designer with over three decades of experience

designing a diverse spectrum of products *and* who has instructed generations of industrial designers about the core principles of design, lacks the requisite "specialized knowledge" to opine about the design issues presented here. However, to dispel any doubts, Monster now submits the declaration of Jacky Hsiung, one of Monster's cable designers and a co-inventor of Monster's '633 utility patent, the patent relied upon by the Examining Attorney here. In this declaration, Mr. Hsiung concurs with Professor Rake's observations, opinions, and conclusions regarding the design of Monster's mark, regarding Monster's utility patent, and regarding the design alternative proposed by Professor Rake. Thus, Mr. Hsiung confirms that the curved outer contours of Monster's mark are an incidental, arbitrary design *choice* that do not contribute to the functional advantages described in Monster's utility patent. Mr. Hsiung confirms that the alternative designs proposed by Professor Rake are indeed viable alternatives, each of which would provide the functional advantages described in Monster's utility patent. Finally, Mr. Hsiung confirms that these alternative designs can be manufactured without adding to the cost or complexity of manufacture.

**Unsupported Argument 2**: Professor Rake "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."

**Response**: This argument is logically unsound for two reasons:

- First, the particular third party headphones made of record by the Examining Attorney are a subset of the universe of headphones. Professor Rake merely stated that he had "not encountered any of the headphones shown in" the images

made of record by the Examining Attorney and therefore "cannot comment on whether these photographs represent actual products made and sold in the United States." He did *not* disclaim experience with headphones generally or with cables for carrying audio signals in particular.

- Second, familiarity with these particular headphone designs is irrelevant to Professor Rake's conclusion that the evidence relied upon by the Examining Attorney is vague, unclear, and so is incompetent to establish third party use of Monster's mark.

**Unsupported Argument 3**: "[I]f the curved outer contours have no functional advantage, they are such a minor element of the overall cable design, that they are insufficient to overcome the functionality of the overall cable design."

**Response**: There is no basis for the statement that the curved outer contours of Monster's mark is a "minor" design element. On the contrary, Professor Rake explains that edge treatments such as Monster's curved edges, can be "important design elements and can materially affect how consumers and users of a product perceive a product . . . the edge treatment." (Rake Decl. ¶ 21.) Professor Rake further explains that in Monster's headphone cables, the curved edge treatment "has an impact on how consumers and users perceive and appreciate the product from an aesthetic standpoint" because it "convey[s] an attractive contemporary aesthetic." (*Id.)* Thus, rather than being a "minor" element, the curved outer contour is the major aesthetic design element of applicant's headphone cable, making Monster's mark eligible for registration.

**Unsupported Argument 4**: Monster has not shown that the proposed alternative designs presented by Professor Rake can be made as cheaply as Monster's current design.

**Response**: The declaration from Monster's Mr. Hsiung confirms Professor Rake's conclusion that the alternative designs he proposes can be made just as easily and cheaply as Monster's commercial embodiment.

**Unsupported Argument 5**: " "[m]any of these [alternative designs] incorporate elements that depart from the "flat" cable design referenced throughout the patent."

**Response**: This argument reflects the central fallacy that the disclosed "flat" embodiment of Monster's invention is the "preferred" embodiment for achieving the invention's functional advantages, namely, reduced tangling and ability to accommodate internal wiring. The patent itself expressly states that the disclosed embodiment is "representative of the subject matter which is *broadly contemplated* by the invention." '633 patent, col. 3, lines 1-4 (emphasis added.) Furthermore, the patent goes on to state: "The scope of the present invention fully encompasses other embodiments . . . ." *Id.* at lines 4-7. And indeed, the inventors recognized and expressly stated that other equally suitable embodiments of their invention would be "*readily apparent*" to "those of ordinary skill in the art," as they are to Professor Rake: "[I]t should be readily apparent to those of ordinary skill in the art that various changes to the *form* . . . may be made without departing from the spirit and scope of the invention as set forth in the appended claims." *Id.* at lines 17-21. And to repeat what Professor Rake, Mr. Hsiung, and the patent's claims all make clear, the claims of this and every other utility patent, not the specification, define the inventions' metes and bounds. Here, the claims neither expressly mention nor require "flat" cables. Furthermore, the Examining Attorney's comments reflect her undue focus on the "flat" portion of Monster's mark, and insufficient attention to its salient *design* feature, the curved outer contour. That analysis

conflicts with the directive set forth in the TMEP that cautions against focusing on individual features rather than the mark as a whole. *See* TMEP § 1202.02(a)(v): "Generally, dissecting the design into its individual features and analyzing the utility of each separate feature does not establish that the overall design is functional."

**Unsupported Argument 6**: "competitors would not find the alternative designs proposed by the applicant to be equivalent alternatives to the applied-for design."

**Response**: This statement is completely unsupported. Furthermore, the marketplace reveals that Monster and its competitors do, in fact, use alternative headphone cable designs. Monster's Diesel headphones feature a unique triangular cable. http://www.amazon.com/Monster-Diesel-On-Ear-Headphones-ControlTalk/dp/B006VJOOHE As noted in the attached link, these headphones feature "High-Def cable triangular lines for a tangle-free life." Monster's competitor "Zip Buds" incorporate a cable that is wider than it is thick, but does not include Monster's mark:

Other competitors, such as Sarah Skeen and Cord Crunchers, achieve tangle-resistant cables with rounded designs:

Given these diverse designs currently on the market, there is simply no basis for the Examining Attorney's conclusion that Monster's competition would not consider or use the alternative designs proposed by Professor Rake. Rather, each falls within the scope of Monster's patent, and each performs the functions described in the patent equally well. All are suitable, feasible, and practical alternatives to Monster's mark, as Mr. Hsiung confirms.

**Unsupported Argument 7**: "The applicant's examples [of alternative designs] do not show how these cables would attach to the ear buds or the splitter referenced in the patent . . . The cable styles proposed by the applicant would not fit as securely into the ear buds and splitter shown in the patent application."

**Response**: The argument relies on baseless speculation that the splitter shown in Monster's utility patent is the *only* available splitter for the myriad cable designs within the scope of the patent. The patent, however, does not specify nor require any particular splitter configuration. Rather, claim 2 simply recites "[t]he headphone cable of claim 1, further having ***a*** splitter for splitting said cable section into left and right cable sections."

As co-inventor Hsiung explains in his declaration, it would be a routine matter for a headphone designer of ordinary skill to design splitters that would accommodate each of the alternative embodiments presented in Exhibit B of Professor Rake's declaration. Doing so would not increase the difficulty or cost of manufacture.

### D. The Examining Attorney Has Not Met Her Burden of Proving Monster's Mark is Generic

The Examining Attorney has the burden of proving genericness by 'clear evidence.' "In the context of product design, genericness may be found where the design is, at a minimum, so common in the industry that it cannot be said to identify a particular source . . ." 2 McCarthy on Trademarks and Unfair Competition § 12:57 (4th ed.); *see also* 1 McCarthy on Trademarks and Unfair Competition § 8:6.50 (4th ed.). The use by competitors of a design can serve as evidence of genericnesss'." *Stuart Spector Designs Ltd. v. Fender Musical Instruments*, 94 USPQ2d 1549, 1555 (TTAB 2009) (finding applicant's guitar body generic since opposer showed numerous third parties offering guitars with similar/identical configurations). Significantly, however, doubts are resolved in favor of the applicant when the generic status of a term is in doubt." 2 McCarthy on Trademarks and Unfair Competition § 12:57 (4th ed.); *see also* 1 McCarthy on Trademarks and Unfair Competition § 8:6.50 (4th ed.).

Here, significant doubt exists regarding whether, as in *Stuart Spector v. Fender,* Monster's contoured cable design is so ubiquitous that it is incapable of distinguishing Monster's goods and should be deemed generic. Indeed, the record contains no reliable evidence of third-party use of Monster's mark. The only evidence proffered are print-outs from the Internet supposedly showing flat cables with contoured edges. That evidence is inconclusive because the images relied upon do not show the details of the headphone cables. Neither Professor Rake nor

anyone else can determine from the evidence of record whether those cables have contoured edges, flat edges, or edges with some other shape. Rake Decl. ¶ 22.

The Examining Attorney thus has no reliable basis for disagreeing with the conclusions of a skilled industrial designer set forth in a sworn declaration. Lacking clear visual evidence of widespread third-party use of Monster's mark, the Examining Attorney has not met her burden. Additionally, the Examining Attorney presents no evidence to support her assertion that third party use of Monster's mark is widespread or commercially significant.

The Examining Attorney attempts to convert the defects in this visual evidence into support for the genericness refusal, stating "if consumers cannot tell whether or not a competitor's cables incorporate applicant's design, the design cannot serve its [trademark] function . . ." But there is no evidence that given the opportunity to see clear images or actual products "consumers cannot tell whether or not competitor's" are infringing Monster's mark (and, for that, matter, its utility patent). The Examining Attorney has no credible basis for finding Monster's mark incapable of distinguishing Monster's goods from those of its competitors. And indeed, it is apparent from the images of competing products shown above that Monster's cable design is readily distinguished from competing designs, therefore is capable of distinguishing Monster's goods from the competition, and is eligible for registration.

As evidence that Monster's mark is in fact perceived by the industry as being capable of identifying the source of goods, Monster submits the Trademark License agreement between Monster and Beats Electronics, LLC granting Beats Electronics a license to use the "trademark consisting of features of a cable claimed in U.S. trademark application Ser. No. 85/318060," which, is the application at issue. Beats Electronics also was assigned one-half interest in a design patent application whose claim includes the contoured outer edge cable design also

covered by Monster's mark. (Exhibit A .) Beats Electronics is a leading brand of headphones, and its Beats by Dr. Dre brand headphones were originally manufactured for Beats by Monster. According to a news reports, Beats Electronics dominates the $1.8 billion market for headphones with 27% of the market for headphones overall and 57% of the premium headphone market (those costing over $100.) (Exhibit B.) Recently, the news media reported that Apple, Inc. purchased Beats Electronics for upwards of $3 billion. (Exhibit C.) Recognition of Monster's trademark and design patent rights in the contoured edge cable design by Beats Electronics, and the use of that mark by Beats Electronics as Monster's licensee, is further evidence that this design feature is significant and is capable of identifying the source of goods and distinguishing them from those of other manufacturers. The evidence relied on by the Examining Attorney, however, does not detract from this conclusion because the record contains no evidence that any of the alleged third-party uses cited by the Examining Attorney is commercially significant.

**E. Description Requirement**

Monster disagrees that the current description of the mark is inadequate or unclear. The current description in relevant part reads:

> 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 Examining Attorney suggests the following wording:

> The mark consist of a flat headphone cable that is wider than it is thick. The outer contours of the cable are curved in a manner that results in the cable having a cross-section in the form of an oblong.

This wording is inadequate in that it does not properly focus on the distinctive feature of Monster's mark. Monster therefore amends the Mark Description as follows:

> The mark consists of a headphone cable having a cross-section in the form of an oblong, wherein the cable features contoured outer edges and is significantly wider than it is thick.

Monster submits that this description more clearly and fairly describes the mark.

## III. Conclusion

For the reasons stated above, Monster requests that the refusals to register Monster's mark be withdrawn, and that the mark be approved for publication.

Respectfully submitted,

MONSTER, INC.

Dated: June 17, 2014

By: /Robert D. Litowitz/

David M. Kelly
david.kelly@kelly-ip.com
Linda K. McLeod
linda.mcleod@kelly-ip.com
Robert D. Litowitz
robert.litowitz@kelly-ip.com
Kelly IP, LLP
1330 Connecticut Ave., N.W.
Suite 300
Washington, D.C. 20036
Telephone: 202-808-3570
Attorneys for Applicant

EXHIBIT A

# LICENSE AGREEMENT

This License Agreement (hereafter "Agreement") is entered into as of June 30, 2012 (the "Effective Date") by and between, on the one hand, Monster, Inc. a California corporation and Monster, LLC, a Nevada limited liability company, (collectively hereafter "MONSTER"), and, on the other hand, Beats Electronics, LLC, a limited liability company organized under the laws of the State of Delaware, on the other hand (hereafter "BEATS").

## RECITALS

WHEREAS, MONSTER and BEATS entered into that certain Amended and Restated License and Promotion Agreement dated August 20, 2009, as amended on February 28, 2010 and April 30, 2011 (the "LICENSE AGREEMENT") for the branding, manufacture, promotion and sale of headphone and speaker products which are distributed and sold globally.

WHEREAS, Monster, LLC and BEATS will terminate the LICENSE AGREEMENT on June 30, 2012 and, in connection therewith, MONSTER has retained all right, title and interest in and to a trademark consisting of features of a cable claimed in U.S. trademark application, Ser. No. 85/318060 and any corresponding foreign marks and registrations (collectively, the "TRADEMARKS").

WHEREAS, BEATS desires to manufacture, promote, distribute, and sell products bearing the TRADEMARKS after such assignment and MONSTER is amenable to granting such license.

NOW, THEREFORE, in consideration of the foregoing and of the mutual covenants set forth herein and the mutual consideration exchanged between the parties related to their co-branding relationship over the past several years, MONSTER and BEATS agree to the following terms and conditions:

1) LICENSE GRANT

MONSTER hereby grants to BEATS an irrevocable, non-exclusive, perpetual, worldwide, royalty-free, fully paid-up, assignable and sub-licensable license to use the TRADEMARKS in connection with the use, manufacture, promotion, distribution, sale, offer for sale, importation and other exploitation and disposition of all products covered by the TRADEMARKS, or its contract manufacture(s) or similar sub-licensees involved in the manufacture, promotion, sale, offer for sale, importation and distribution of the above products. BEATS has no right, title, or interest in or to the TRADEMARKS other than as granted by this License.

2) TERM

The term of this Agreement shall commence on the Effective Date and remain in effect for so long as any subsisting right in the TRADEMARKS exits.

3) TERMINATION

BEATS shall have the right to terminate this Agreement at any time by providing written notification of termination to MONSTER.

4) EFFECT OF TERMINATION

Upon BEATS'S termination of this Agreement, BEATS will discontinue all use of the TRADEMARKS as soon as reasonably practicable.

5) QUALITY

Based on the history of development and co-marketing between MONSTER and BEATS, the parties are satisfied that the nature and quality of all goods sold by BEATS under the TRADEMARK conform to the standards established by MONSTER.

6) CONFIDENTIALITY

In connection with the performance of this Agreement, each of the parties may have access to certain confidential and proprietary information of the other parties. "Confidential Information" means any information that is not generally known to the public belonging or pertaining to the disclosing party that the disclosing party provides to the receiving party during the term of this Agreement, including without limitation, customer, financial, manufacturing, design concepts, profit margin, technology, and product development information and including any personal information of the principals involved with BEATS or MONSTER. Notwithstanding the foregoing, Confidential Information shall not include information which: (i) is or becomes generally available to the public through no fault of the disclosing party; (ii) is required to be disclosed by order of a court or other competent governmental agency or by applicable law; (iii) is, prior to the time of its disclosure, already in the possession of the party to which disclosure is made other than as a result of any breach of any obligation of confidentiality of which the disclosing party is aware, (iv) is independently developed without use of the Confidential Information or (v) any information as to the terms of this Agreement as is reasonably necessary for either party to share with third parties in connection with financing or transactional opportunities, provided that such parties are under written confidentiality obligations at least as protective as those hereunder. Recognizing that such information represents valuable assets and property of the parties and the harm that may befall the parties if any of such Confidential Information is disclosed, each party agrees to hold all such Confidential Information in strict confidence and not to use or otherwise disclose any such Confidential

Information to third parties without having received the prior written consent of the party to whom the Confidential Information belongs or pertains. The obligations of confidentiality created herein shall survive the expiration or any termination of this Agreement.

7) SUPERSEDING AGREEMENTS

This Agreement is the complete and exclusive statement of agreement between MONSTER and BEATS with respect to the TRADEMARKS and supersedes all prior proposals, understandings and all other agreements, oral and written, between the parties relating to the subject matter of this Agreement. The Recitals set forth above are incorporated herein as material terms of this License.

8) RELATIONSHIP OF THE PARTIES

MONSTER and BEATS are independent contractors. This Agreement does not, and shall not be construed to create an employer-employee, partner or joint venture relationship. This Agreement does not make either MONSTER or BEATS the agent or legal representative of the other for any purpose whatsoever. No representation shall be made by either party that would create an apparent agency, employment, partnership or joint venture. Neither MONSTER nor BEATS shall have the power, express or implied, to obligate or bind the other in any manner whatsoever.

9) AMENDMENTS; WAIVER

Except as provided herein, this Agreement may not be modified or altered except by written instrument duly executed by all parties. The provisions hereof may only be waived in writing by the parties hereto. No delay on the part of any party in exercising any right, power or privilege hereunder shall operate as a waiver thereof, nor any single or partial exercise of any such right, power or privilege, preclude any further exercise thereof or the exercise of any other such right, power or privilege. The rights and remedies herein provided are cumulative and are not exclusive of any rights or remedies that any party may otherwise have at law or in equity.

10) NOTICE

Any notice, request, or other communication required to be given to either party hereunder shall be in writing and may be delivered by U.S. Mail, regular or Certified, next day mail, facsimile transmission, or any other commercially acceptable means. The address of either party may be changed from time to time and any notice hereunder shall be sent to the then new address of the party giving the notice.

11) HEADINGS

Article and Section headings are for reference purposes only and shall not control or alter the meaning of this Agreement as set forth in the text.

12) SEVERABILITY

If any term, provision, covenant or restriction of this Agreement is held by a court of competent jurisdiction to be invalid, void or unenforceable, the remainder of the terms, provisions, covenants and restrictions of this Agreement shall continue in full force and effect and shall in no way be affected, impaired or invalidated. Upon such determination that any term, provision, covenant or restriction is invalid, void or unenforceable, such term, provision, covenant or restriction shall be limited or eliminated to the minimum extent necessary so that this Agreement shall otherwise remain in full force and effect and enforceable.

13) MULTIPLE COUNTERPARTS

This Agreement may be executed in two or more counterparts, each of which shall be deemed an original but all of which together constitute one and the same instrument.

14) LAW APPLIED

This Agreement and performance hereunder will be construed in accordance with the laws of the State of California without regard to the principles of conflict of laws. The parties agree and consent to the exclusive jurisdiction and venue in the State and Federal courts located in the Central District of California in Los Angeles, and waive any claim or defense of inconvenient forum or lack of personal jurisdiction in such forum under any applicable law, decision or otherwise.

IN WITNESS WHEREOF, MONSTER and BEATS have caused their respective signatures to be entered below on the dates set forth.

MONSTER, INC.

Signature: _____

Printed Name: David Togroth

Date: 12/29/12

MONSTER, LLC

Signature: _____

Printed Name: David Tognotti

Date: 11/29/12

BEATS ELECTRONICS, LLC

Signature: _____

Printed Name: LUKE WOOD

Date: _____

NGEDOCS: 1993762.1

EXHIBIT B

You've selected the U.S. Edition. Would you like to make this your default edition? Yes | No

Close

SET EDITION: U.S. | INTERNATIONAL | MÉXICO | ARABIC

TV: CNN | CNNi | CNN en Español | HLN

CNN Tech

Sign up | Log in

SEARCH

Home | TV & Video | U.S. | World | Politics | Justice | Entertainment | Tech | Health | Living | Travel | Opinion | iReport | Money | Sports

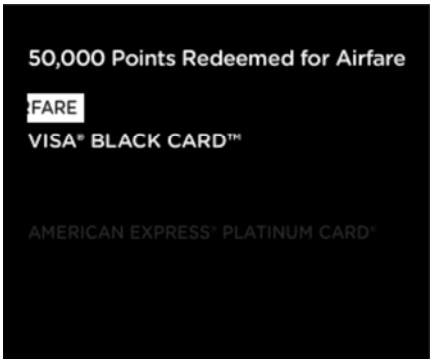
BREAKING NEWS Hillary Clinton reacts to capture of Benghazi suspect: Live on CNN at 5 p.m. ET

# How Beats headphones changed the audio world

By **Todd Leopold**, CNN
updated 5:53 PM EST, Sun January 12, 2014 |

SHARE THIS
Print
Email
More sharing
Recommend 2k

Hip-hop artist Lil' Wayne, wearing diamond-studded Beats headphones, sits courtside during the 2012 NBA All-Star Game.




ADVERTISEMENT

**STORY HIGHLIGHTS**

- Beats headphones dominate the $2 billion headphone market
- The accessories are criticized by audiophiles over their marketing, bass-heavy sound
- Beats president: We focus on premium audio and excitement of studio experience
- Brand has spawned rivals; observer says audio quality is likely to improve a lot

ADVERTISEMENT

**(CNN)** -- Kelley Zapata loves her Beats.

The University of Georgia junior first got a pair of Beats by Dre Studio headphones for Christmas in 2008. They were a revelation, she says, especially for someone used to Apple earbuds.

"I was blown away," she recalls. She's since invested in two more.

She's not alone. The audio company's lower-case "b" is ubiquitous on the ears of listeners across the country, seen on celebrities -- Lil Wayne at a Lakers game, Katie Holmes on a movie set -- and college students.

Indeed, according to the NPD Group, a marketing research company, Beats controls 27% of the $1.8 billion headphone market -- and 57% of the market for "premium" headphones, ones that cost $99 or more. On- or over-the-ear Beats retail from about $200 to $400, so you can easily spend as much on the headphones as you can on your MP3 player or contracted phone.

That's a lot of "b"uzz.

**More from CNN Video:**

Mom hugs teen who killed daughter

Actress gets licked by Richard Simmons

Pilot bails out of plane before crash

Teen caught on tape beating younger girl

Actress' dancing causes a car accident

O.J. Simpson's 'guilty' phone call

**More from CNN:**

Producer and musician Dr. Dre wearing his Beats at a Boston Red Sox game in 2010.

But along with the popularity has come a backlash. Beats have been criticized for being a marketing gimmick, a bass-heavy fashion accessory not up to the kind of high-quality audio sound they promote. Zapata admits she was initially seduced by the pitch: "I'm a big Lady Gaga fan, and she had them in her music video," she says.

For audiophiles, Beats are a sacrilege. They've filled up message boards complaining about the popular cans.

"(A) Timex with Rolex's price tag," wrote one responder to a board titled "Why the Beats hate?"

"To a lot of people, the fact that someone took our hobby and our industry and vastly perverted it to the public at large borders on offensive for a variety of reasons," added another poster.

But the audiophiles might be missing the point. What Beats has done, suggests Tyll Hertsens, is expand the market for better-quality headphones -- as witnessed by the countless headphone makers jockeying for space at the International Consumer Electronics Show in Las Vegas last week.

Building on the distinctiveness of Apple's white earbuds -- which announced their wearer owned a desirable iPod or iPhone -- Beats essentially created a new niche.

"What they did was brilliant," says Hertsens, editor of InnerFidelity, a site devoted to personal audio. "They somehow knew that people were aware enough of headphones that they could make them have some cachet."

And cachet, he observes, comes with a price.

"It used to be that a $250 price of headphones were expensive. Now that's just the norm. (Beats) raised the acceptable price of headphones," he says.

**Audio quality and design**

With that increased price has come a renewed awareness of both audio quality and design, says Hertsens.

"In the past three years or so, headphones have gotten a lot better," he says. They're on display and available for testing; people can walk into an Apple Store and truly hear the difference, he says.

Audiophiles always prized sound quality, of course. But the headphone brands they argued about -- brands such as Beyerdynamic, Grado (which has shunned advertising in its long history) and Sennheiser -- weren't widely known among consumers, particularly in an age moving toward convenience and away from component stereo systems. Along with the omnipresent Sony, perhaps the best-known name in the premium market was Bose, and Bose had its own detractors.

Few had eye-pleasing designs. The sound was what mattered, of course.

As Hertsens notes, what Beats did was change the formula. The brand dates back to the mid-2000s, when producer Dr. Dre and music mogul Jimmy Iovine were frustrated by their painstakingly crafted music being listened to through tinny earbuds.

In 2008, Beats put out the Studio, manufactured by Monster. The cans were an immediate hit.

Boy finds mummified body hanging in Dayton, Ohio, home

A year after Odin Lloyd's death, loved ones cling to memories and pain

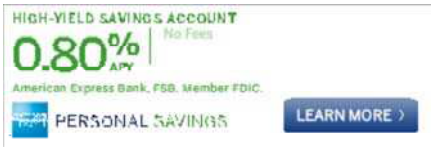
From Around the Web:

Readers Are Tired of Overpaying for Ebooks. Here's their Secret to Getting…
DailyFinance

Want a Dog That Stays Puppylike for Life? Here Is a Breed You'll Love
Vetstreet

Here Is The List of 2014's Best Credit Cards
NextAdvisor Daily

Apple's iPad gets light as Air (pictures)
CNET



ADVERTISEMENT

Sponsored links

**Scottrade® Official Site**
$7 Online Trades. Clear Pricing, Simple Acct Opening, Free Support.
www.scottrade.com

**OnProcess Technologies**
The Inventors of Service Supply Chain Optimization. Free Whitepaper
onprocess.com/SSCO_WhitePaper

**Small Speakers, Big Sound**
2013 "Speaker Of The Year" Winner Great Systems $299-$999 On Sale Now
www.orbaudio.com

The philosophy of the company hasn't changed, says Luke Wood, originally a consultant to Beats Electronics and now the company's president.

Digital production and technical advancements improved the sound of records but headphones were lagging, he says, thanks to a convenience culture put forth by laptops, earbuds and MP3 files. (Ironically, Wood observes, Steve Jobs "really cared about sound": "I don't think anybody at Apple thought those white earbuds were the end-all of premium sound.")

"With Beats, the idea was to take the energy and passion of how we market our music and marry that with a focus on premium audio and the excitement of what we hear in the recording studio," Wood says.

He's aware of the criticism, but points out that a fondness for certain elements of audio -- like music itself -- is subjective.

"It's really about point of view and taste," he says. He, Iovine and Dre have "all made hundreds of records and spent tens of thousands of hours in the recording studio," he says. "I think we have an educated point of view and a consistent point of view to sound, and I certainly think we come from a place where we know what we're talking about."

**The value of competition**

Beats competitors are now legion, and many have copied the Beats playbook in marketing their headphones.

There are headphones from 50 Cent (SMS, which also has a collaboration with Lucasfilm), Bob Marley's estate (House of Marley, which promotes an enviro-friendly aesthetic), Quincy Jones (manufactured by AKG) and Tony Bennett (by Koss). Lou Reed's last video was for the Parrot Zik, designed by Philippe Starck.

Even the low-key Grado now has a branded headphone, a collaboration with Bushmills Irish whiskey. Actor Elijah Wood and DJ Zach Cowie contributed to the design.

Monster, which no longer manufactures Beats, has launched a line with the producer Swizz Beatz -- a Monster investor -- called DNA. (Zapata, the Georgia student and Beats loyalist, says she's intrigued by them.)

NPD Group consumer electronics analyst Ben Arnold believes that, though the headphone market may be slowing from its double-digit growth of recent years, there's no sign of a crash. With December's sales, he expects 2013 to top $2 billion, and says sales should go up another 5-7% in 2014.

Hertsens remains lukewarm on Beats' audio quality. In a detailed "Celebrity Headphone Deathmatch" review a couple of years ago, he gave grudging marks to the Studio and deplored the slightly cheaper Solo. But he approves of the greater emphasis on design and expects the audio quality of headphones, as a whole, will improve.

"(Right now) there's nothing to compete against Beats when you're talking about, 'I'm going to give you style, I'm going to give you comfort, and I'm also going to give you sound quality,' " he says. "In a way we're indebted to Beats because they made more money available for manufacturers to compete in the marketplace and make better headphones."

Beats' Wood is planning on it. He says he's not worried about the competition, just maintaining Beats' quality.

"What we're seeing is this resurgence of premium sound. People really care and hear the difference," he says. "I think we'll see this, not just in headphones, but also in home stereos, in cars -- and ultimately the whole bar will be raised."

## From Around the Web

- The Samsung Galaxy Note Pro is a hulking behemoth (pictures) CNET
- MMORPGs to Experience Substantial Growth ThinkAdvisor
- How To Invest $100, $1,000, Or $10,000 Business Insider
- 25 worst-named tech products (pictures) CNET
- 7 Credit Cards You Should Not Ignore If You Have Excellent Credit NextAdvisor Daily
- Bose Covers Every Portable Possibility with FreeStyle and SoundTrue Headphones Electronic House

## More from CNN

- Edward Snowden's interview: 10 things we learned
- Booze-infused ice cream? Cool!
- Topless photos latest travel rage
- 30 of the world's best national parks
- Navy jet crashes into Pacific on approach to carrier
- Hospitalized Tracy Morgan upgraded to fair condition

Recommended by

**Sponsored links**

**Skullcandy® Headphones**
The Ultimate In Sound, Durability, & Fit. Bass You Can Actually Feel!
skullcandy.com

**MDM Security Guide**
Free E-Book From The Experts! What Should You Know About MDM?
maas360.com/Free_MDM_Guide

**Adorama Buys Used Gear**
Adorama Pays Top Dollar For Your Photo Video Digital Equipment
adorama.com/Used_Department


**710 Comments** CNN Login

Sort by Best Share Favorite

Join the discussion…

**canteenjesus** • 5 months ago
Although I commend Dre for his ability to sell his brand, I often find myself laughing inside when I see people wearing these. Oh you kids.
486 • Reply • Share ›

**Barbara** → canteenjesus • 5 months ago
Nice article, I learned that Beats were first made by monster? The same company that charges $40 for a hdmi cable? That explains a lot. Lol!
295 • Reply • Share ›

**Guest** → Barbara • 5 months ago
True test: **Go to the Beats web site. Tell me the driver specs! They are NEVER listed because if they list them, the competition's superiority over Beats would be obvious.** Beats is a novelty item.
226 • Reply • Share ›

**mxprivateer** → Guest • 5 months ago
You are absolutely correct. A very close friend of mine is a design engineer for a high end audio company and educated me on how beats headphones are nothing but overpriced garbage marketed as a status symbol.
127 • Reply • Share ›

**Dejandon** → mxprivateer • 5 months ago
That also sounds like a phone product from a company by name Apple
7 • Reply • Share ›

**Friedrich** → Dejandon • 5 months ago
I own a Samsung S4 and my wife an Apple iPhone 5s. Camera is

89° HI 89° LO 70°
Atlanta, GA Weather forecast

SEARCH
POWERED BY Google

Home | Video | U.S. | World | Politics | Justice | Entertainment | Tech | Health | Living | Travel | Opinion | iReport | Money | Sports
Tools & widgets | RSS | Podcasts | Blogs | CNN mobile | My profile | E-mail alerts | Desktop Alerts | CNN shop | Site map | Contact us

CNN © 2014 Cable News Network. Turner Broadcasting System, Inc. All Rights Reserved.
Terms of service | Privacy guidelines | Ad choices | Advertise with us | About us | Work for us | Help
CNN Newsource | License Footage

CNN en ESPAÑOL | CNN México | CNN Chile | CNN Expansión
العربية | 日本語 | Türkçe
CNN TV | HLN | Transcripts |

EXHIBIT C

advertisement

Do You Think the Market Is Headed for a Fall?

If you have a $1,000,000 portfolio, you should download the latest report by *Forbes* columnist Ken Fisher. In it he tells you where he thinks the stock market is headed, and why. This must-read report includes his latest stock market prediction, plus research and analysis you can use in your portfolio right now. Don't miss it!

Click Here to Download Your Report!

FISHER INVESTMENTS ™

**Great Speculations (http://www.forbes.com/sites/greatspeculations/)**

*Buys, holds, and hopes*

Opinions expressed by Forbes Contributors are their own.

**INVESTING (/INVESTING)** 5/29/2014 @ 1:36PM | 1,347 views

# What The Beats Deal Means For Apple

**Trefis Team (http://blogs.forbes.com/people/trefis/)**, Contributor

**Comment Now** **Follow Comments**

Ending weeks of rumors, Apple

(http://finapps.forbes.com/finapps/jsp/finance/compinfo/CIAtAGlance.jsp?tkr=aapl&tab=searchtabquotesdark) announced Wednesday that it would be buying popular audio products manufacturer Beats Electronics and its fledgling music service business Beats Music for about $3 billion, making it the largest acquisition in the company's history. Apple will pay roughly $2.6 billion in cash with an additional $400 million in equity that would vest over time. Apple projects that the acquisition, which is expected to close in fiscal Q4 2014, will be accretive to its fiscal 2015 earnings. The deal marks a departure of sorts for Apple, which has traditionally focused on acquiring companies with niche technologies and talent that it can incorporate into its products and services, instead of buying well known consumer brands. Following the acquisition, the Beats brand will continue to exist alongside Apple's brand. While it is likely that Apple is paying the bulk of the acquisition price for the electronics business, much of the future value could lie in the music streaming service and the talents of the Beats team. Here's a brief rundown on what the deal could mean for Apple.

Trefis has a $638 price estimate for Apple (https://www.trefis.com/company#/AAPL), which is about in line with the current market price.

**See our complete analysis for Apple stock here (http://www.trefis.com/company?hm=AAPL.trefis)**

**Audio Products Business Likely Very Profitable, But Risks Exist**

Beats Electronics primarily sells headphones, speakers and audio software. The company's wildly popular headphones retail from $99 to about $450 in the United States, while its speakers retail for upwards of $199. The premium end of the headphone market (prices $100+) in which beats operates remains the fastest growing segment in the headphones space. According to research firm NPD, the premium headphone market in the United States grew (https://www.npd.com/wps/portal/npd/us/news/press-releases/premium-us-headphone-market-surpasses-%241-billion-in-2013-according-to-npd/) by around 21% in 2013, crossing the $1 billion mark. As of June 2013, Beats held about 59% of this market (http://online.wsj.com/news/articles/SB10001424127887323423804579020692100040648). While Beats electronics hasn't disclosed historical financials since it was private, its margins are likely very healthy and should comfortably meet Apple's gross margin requirements. According to the New York Times, a pair of its high-end headphones may cost as little as $14 to manufacture. Additionally, Apple could further drive up Beats' revenues by expanding the business into new countries via Apple stores as well as select Apple Authorized Resellers.

However, we believe that there are some risks in the audio products business. With the Beats acquisition, Apple isn't exactly buying into cutting edge audio technology or intellectual property that it wouldn't be able to develop in house. Beats audio products routinely receive mixed reviews from critics who often cite them as being overpriced for the listening experience that they offer. Beats products have gained market share due to their slick design and celebrity-driven marketing, and these attributes could run the risk of being a fad.

**Apple Could See Value In Streaming Service**

While the headphones business remains the most recognizable part of Beats, the Music streaming service is likely to have been a key reason behind the acquisition. Apple is no longer the formidable digital music powerhouse that it once was, with the advent of online streaming music services such as Spotify. Unlike Apple's traditional iTunes model of making customers pay for specific content while locking them onto its platform, online music streaming services offer much more flexibility to consumers, allowing them to listen to a vast library of songs on-demand and across devices for a small monthly fee, or for free with ads. These services have seen a significant uptake over the last few years, and this has been impacting Apple's iTunes business. According to Morgan Stanley Research, revenues for Apple's iTunes have been declining (http://blogs.barrons.com/techtraderdaily/2014/05/28/apple-app-store-to-lift-services-revenue-profit-says-morgan-stanley/?mod=BOLBlog) over the last three quarters.

While Apple does offer an Internet radio service of its own, iTunes Radio, which competes with the likes of Pandora, it lacks an on-demand streaming service. On-demand streaming is becoming increasingly popular with consumers since it allows them to pick and choose the individual songs they

want to listen to. This is likely where Beats Music comes into the picture. While Apple could have developed its own on-demand streaming service, the Beats acquisition gives the company an instant entry into the space. Moreover, Beats Music has received largely positive reviews, winning praise particularly for its curation of content. Subscriptions costs about $99.99 per year or about $10 per month, and the service has signed up about 200,000 paying customers since its launch in January. Although this remains a fraction of Spotify's 10 million+ paying customers, the user base could be poised to rise with Apple's acquisition.

**Co-Founders' Industry Connections Could Be Beneficial**

Beats co-founders Jimmy Iovine and Dr. Dre are influential figures in the music industry. The duo, who are set to join Apple in undisclosed roles, will bring in a strong understanding of the market and popular culture, in addition to their deep connections within the music industry. This could prove invaluable for Apple, particularly in its negotiations with music companies, a role which was often handled by the late Steve Jobs.

**See More at Trefis (http://www.trefis.com/) | View Interactive Institutional Research (https://www.trefis.com/subscribe/email?sitelicense=institutional&from=analysis) (Powered by Trefis)**

**Get Trefis Technology (http://www.trefis.com/technology?from=analysis)**

**Like our charts?** Embed them in your own posts using the Trefis WordPress Plugin (http://wordpress.org/extend/plugins/trefis-forecast/).

Comment Now Follow Comments

**DON'T MISS...**

Recommended by

(http://www.rantlifestyle.com/2014/02/13/20-strongest-militaries-world/)

**The 20 Strongest Militaries in the World**

(http://www.rantlifestyle.com/2014/02/13/the-strongest-militaries-world/)

(http://www.forbes.com/sites/entertainment/2014/04/21/does-game-of-thrones-have-a-misogyny-problem/) Forbes

**Does 'Game Of Thrones' Have A Misogyny Problem?...**

(http://www.forbes.com/sites/entertainment/2014/04/21/does-game-of-thrones-have-a-misogyny-problem/)

(http://www.forbes.com/sites/danielnelson/2014/05/20/part-2-how-to-hit-a-home-run-selling-on-ebay/) Forbes

**Part 2: How To Hit A Home Run Selling on eBay**

(http://www.forbes.com/sites/danielnelson/2014/05/20/part-2-how-to-hit-a-home-run-selling-on-ebay/)

(http://money.cnn.com/2014/02/27/investing/young-tech-millionaire-investors/)

**CNN Money: How Young Millionaires Invest**

(http://money.cnn.com/2014/02/27/investing/young-tech-millionaire-investors/)

(http://poundwishes.com/article/10-Mistakes-You-Could-Be-Making-With-Your-Puppy.aspx) Poundwishes

**10 Mistakes New Puppy Owners Sometimes Make**
(http://poundwishes.com/article/10-Mistakes-You-Could-Be-Making-With-Your-Puppy.aspx)

(http://www.rantlifestyle.com/2014/03/21/20-hottest-female-democrat-politicians/) Rant Lifestyle

**PHOTOS: 20 Hottest Female Democratic Politicians**
(http://www.rantlifestyle.com/2014/03/21/20-hottest-female-democrat-politicians/)

(http://www.hubub.com/topic.php?id=131571) hubub

**What Does Putin Really Want? It's Not Only Crimea.**
(http://www.hubub.com/topic.php?id=131571)

(http://www.easybreathe.com/blog/cpap-study-cpap-slows-cognitive-deterioration/) easybreathe

**CPAP Study: CPAP Slows Cognitive Deterioration**
(http://www.easybreathe.com/blog/cpap-study-cpap-slows-cognitive-deterioration/)

Attorney Docket: 12158.0001

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Monster, Inc.
Serial Number: 85318060
Filing Date: May 11, 2011
Mark:

Examining Atty: Kim Teresa Moninghoff, Esq.
Law Office: 113

Commissioner for Trademarks

P.O. Box 1451

Alexandria, Virginia 22313-1451

**DECLARATION OF JACKY HSIUNG**

I, Jacky Hsiung, submit this declaration on behalf of applicant Monster, Inc.

1. I am employed by Monster, Inc. My educational background includes a Bachelors of Science degree in Industrial Design from San Jose State University in 2003. My responsibilities at Monster have included designing electronic cables for audio and audio/visual applications. Among the products I have designed and invented are cables for audio headphones. I have personally been involved in inventing, designing, and/or developing over 100 products for Monster.
2. Among the headphone cables I have been involved in inventing, designing, and developing is the headphone design that is the subject of U.S. Patent No. 8,068,633 entitled Headphone Cable Splitter. I am a co-inventor of that patent. As described in our

patent, our invention consists of headphone cables that are substantially wider than they are thick. We describe and illustrate as an embodiment of this invention a "flat ribbon-like cable." And indeed, flat cables are one way of practicing our invention. But as we state in the patent, there are other structural and functional equivalents to a "flat" cable, and all of them that are substantially wider than they are thick would be encompassed by our invention.

3. The drawings in the patent depict a flat cable with contoured edges. The cross-section shown in the drawings reveals a cable whose cross-sectional shape is oblong; two surfaces are flat, and those flat sides give way to edges that are contoured/rounded. The contoured edges create the oblong. If the edges were 90-degree angles, the cross-sectional shape would be rectangular and would give the cable a noticeably different appearance.
4. The contoured edges were a design choice and were selected for their aesthetic and ornamental appeal. The contoured edges do not perform any function and are in fact incidental to the functions carried out by the cable. Cables according to our invention could have a variety of shapes, and do not need to have contoured edges or oblong cross-sections, to carry out the functions described in the patent. Those functions, namely, reducing tangling and accommodating wires, can be accomplished with a variety of cable designs that would fall within the scope of our patent.
5. I understand that Monster has applied for a trademark, Serial No, 853180060, for the mark consisting 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." (Emphasis added.) I have read the declaration of Lance Rake submitted by Monster in support of that trademark

application. I understand that the Examining Attorney handling this trademark application refused to give Professor Rake's declaration any weight because Professor Rake had not previously designed headphone cables.

6. Based on my many years of experience in the audio cable industry, I disagree with the Examining Attorney's conclusions regarding Professor Rake's credentials and expertise. According to his declaration, Professor Rake not only has decades of experience in industrial design, but is a Professor of Industrial Design at a major U.S. university, the University of Kansas. As a skilled designer and teacher of industrial designers, Professor Rake surely is qualified to opine on the aesthetics of cable design in general and of our design in particular. Any suggestion that he is not qualified by skill, training, and experience to comment on the visual impact of contoured edges, and the importance of such a design feature, betrays a fundamental misconception about the interplay between design and technology.
7. I agree with all of the statements by Professor Rake in paragraph 21 of his declaration. In particular , I agree that the "curved outside contours in Monster's cable design represent an arbitrary, ornamental design choice, not driven by function." I agree that edge treatments such as the curved outer contours of our cable design can be, and in this case are, an important design element and can materially affect consumer perceptions. I further agree with Professor Rake's conclusion in paragraph 19 of his declaration that "numerous [other] aesthetic designs can be used for practicing [our] invention."
8. I have reviewed the design alternatives prepared by Professor Rake and shown in Exhibit B to his declaration. I agree that each of those alternative designs can be used for practicing the invention described in the '633 patent, of which I am a co-inventor. Each

of Professor Rake's design alternatives has both width and thickness, and in each example, the width is substantially greater than the thickness. Each design alternative, moreover, can accommodate left and right audio channel conductors, and each would resist tangling. And Professor Rake's proposed alternative designs could be manufactured without adding appreciably to the cost or complexity of manufacture. Stated another way, using one of Professor Rake's designs would not put manufacturers at a competitive disadvantage because of the cost of manufacturing them.

9. Finally, there is no basis for or merit to the suggestion that Professor Rake's alternative designs are unsuitable for use with a cable splitter. Designing splitters to accommodate those designs would not be an impediment to their use.

I declare under penalty of perjury of the laws of the United States that the foregoing is true and correct under 28 U.S.C. s§ 1746. This declaration was executed on June 17, 2014.

Signature:_____/s/_____
Jacky Hsiung
Monster, Inc.

Attorney Docket: 12158.0001

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Applicant: Monster, Inc.
Serial Number: 85318060
Filing Date: May 11, 2011
Mark:

Examining Atty: Kim Teresa Moninghoff, Esq.
Law Office: 113

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

**REQUEST FOR REMAND**
**AND SUSPENSION OF APPEAL**

On June 18, 2014, Applicant filed a Request for Remand, which was to have been accompanied by an eighteen-page Request for Reconsideration, three supporting Exhibits, and a supporting declaration. On June 19, 2014, the Board granted the Request for Remand, however, the Examining Attorney denied the Request for Reconsideration. From the text of that denial, it appeared that the Examining Attorney may not have received the actual Request For Reconsideration. For example, the Examining Attorney's denial states that Applicant had not addressed a "description requirement," but in fact, the Request for Reconsideration does address that issue.

Further investigation revealed that the Request for Reconsideration document was not received by the USPTO, although the reasons remain unclear. It could be that the Request for Reconsideration was uploaded but, due to a systems error, was not successfully received. Or, the

Request for Reconsideration may have been inadvertently omitted by Applicant when the other documents were uploaded and filed, but that possibility seems unlikely.

Allison Kipp, Senior Trademark Legal Assistant at Kelly IP, LLP, filed the Request for Reconsideration and the attachments and specifically recalls attaching all of the documents including the Request for Reconsideration. An executed Declaration from Allison Kipp is attached attesting to these facts.

In any event, it appears that Examining Attorney did not have the benefit of Applicant's actual Request for Reconsideration, which explains in considerable detail the additional evidence Applicant submitted along with its Request—evidence that Applicant respectfully submits supports registration of Applicant's design mark. It further appears that this situation resulted either from computer error or possible human error, but in any event was inadvertent.

Accordingly, in view of these circumstances, remand of this application to the Examining Attorney for review and consideration of the Request for Reconsideration is warranted, and Applicant respectfully requests that this request be granted. Applicant also requests the suspension of the appeal pending disposition of the Request for Reconsideration.

MONSTER, INC.

Dated: _June 24, 2014_

By: /Robert D. Litowitz/

David M. Kelly
david.kelly@kelly-ip.com
Linda K. McLeod
linda.mcleod@kelly-ip.com
Robert D. Litowitz
robert.litowitz@kelly-ip.com
Kelly IP, LLP
1330 Connecticut Ave., N.W.
Suite 300
Washington, D.C. 20036
Telephone: 202-808-3570
Attorneys for Applicant

Attorney Docket: 12158.0001

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Monster, Inc.
Serial Number: 85318060
Filing Date: May 11, 2011
Mark:

Examining Atty: Kim Teresa Moninghoff, Esq.
Law Office: 113

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

**DECLARATION OF ALLISON KIPP**

I, Allison Kipp, hereby declare as follows:

1. I am employed as a Senior Trademark Legal Assistant at Kelly IP, LLP, 1330 Connecticut Avenue, NW, Suite 300, Washington, DC 20036 This declaration is based on my personal knowledge.

2. On July 16, 2014, I submitted the following documents via the ESTTA system:

   Request for Remand
   Request for Reconsideration
   Exhibits A-C
   Hsiung Declaration

3. To the best of my knowledge all of the above documents were uploaded.

4. I understand that the USPTO has no record of receiving the Request for Reconsideration, but I specifically recall having uploaded it, and, therefore, believe that computer error may have interfered with the successful uploading of this document.

I declare under penalty of perjury of the laws of the United States that the foregoing is true and correct under 28 U.S.C. s§ 1746. This declaration was executed on June 24, 2014.

Signature: */Allison Kipp/*

Allison Kipp
Senior Trademark Legal Assistant
Kelly IP, LLP
1330 Connecticut Avenue, NW, Suite 300
Washington, D.C. 20036
Telephone: 202-808-3570