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

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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Applicant: Monster, Inc.  
Serial Number: 85318060  
Filing Date: May 11, 2011  
Mark:



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**APPLICANT’S REPLY BRIEF**

The Examining Attorney’s brief repeats the arguments she relied upon each time she considered and rejected Monster’s Application No. 85318060 (“Monster’s mark”). The Examining Attorney persists in concluding that Monster’s headphone cable design—characterized by the type of contoured styling that has propelled other products to iconic stature—cannot be a trademark because, in her opinion, it is merely a “minor” feature that competitors may have copied. The Examining Attorney’s conclusions, however, are devoid of evidentiary support, and in fact conflict with the evidence of record. That evidence, including declarations from an expert industrial designer and from an experienced headphone cable designer, demonstrates that Monster’s mark is not functional, is not generic, and is eligible for registration on the Supplemental Register.

**A. The Examining Attorney’s Opinions Do Not Satisfy Her Burden of Proving Functionality**

From the earliest phases of this application, the Examining Attorney has displayed the unshakable position that Monster’s mark is not worthy of a trademark registration. In *Morton–Norwich Products, Inc.*, 671 F.2d 1332 (C.C.P.A. 1982), the Court of Customs and Patent Appeals rejected an examiner’s similarly “unshakable position” that the design sought to be registered there was “merely functional” and “essentially utilitarian.” *Id.* at 1334. In *Morton–Norwich*, as here, the examiner relied on “mere opinions.” *Id.* at 1342. She found Morton–Norwich’s evidence “not persuasive” and commented that “the subject matter of this trademark had not been promoted as a trademark.” *Id.* at 1335. The examiner in *Morton–Norwich* did not cite a single objective fact to support her conclusion that the applicant’s design was legally functional. Accordingly, the Court of Customs and Patent Appeals reversed the refusal of registration on functionality grounds.

In the case of Monster’s mark, the Examining Attorney has likewise relied on shaky ground to support an “unshakable position.” She has substituted “mere opinions” and “strong convictions” in place of even “one iota of evidence” (*id.*) that Monster’s cable design—featuring the central design element of contoured outer edges—is functional. Indeed, like the examiner in *Morton–Norwich*, the Examining Attorney here has ignored evidence (in this case, two expert declarations), that Monster’s mark is driven by design, not function. Those declarations prove that Monster’s design does not provide any utilitarian advantage and, indeed, is one of many designs available for achieving the benefits described in Monster’s utility patent.

Nevertheless, the Examining Attorney persists in mischaracterizing Monster’s utility patent. The Examining Attorney relies on *Becton, Dickinson* for the notion that Monster’s patent is “strong evidence” of the mark’s functionality. *In re Becton, Dickinson and Co.*, 675 F.3d

1368 (Fed. Cir. 2012). But Monster’s mark differs significantly from the mark at issue in *Becton, Dickinson*. In that case, “two important features of the proposed mark” were disclosed in Becton, Dickinson’s utility patent, and “the patent explained the utilitarian advantages” of those two features. *Id.* at 1375. Monster’s patent, on the other hand, nowhere discussed the mark’s contoured outer edges, much less ascribes to them any utilitarian advantage. *Becton, Dickinson*, therefore is distinguishable, and does not support the functionality refusal in this case.

As Monster’s patent discloses, some aspects of Monster’s design are indeed functional—by being wider than thick, the cable can lay flat and can accommodate internal wiring for different functions (music, telephone). But the Examining Attorney improperly focused solely on the proportional relationship between width and thickness, while ignoring the non-functional aspect of Monster’s mark—the contoured outer edges—that is driven by design, not function. It is improper to dissect a mark by focusing on certain portions while disregarding others. *China Healthways Inst., Inc. v. Wang*, 491 F.3d 1337, 1340 (Fed. Cir. 2007) (finding it improper to eliminate a key portion of a mark and to instead focus on the “residue”).

The Examining Attorney attempts to brush aside the flaws in her reasoning by describing Monster’s outer contour as “so minor that it does not overcome the overall functionality of the product design.” This conclusion not only conflicts with the evidence as, as noted in Monster’s opening brief, but also conflicts with the law. In *TrafFix Devices v. Marketing Displays, Inc.*, the Supreme Court explained that while functional features disclosed in the utility patent may not be trademarked, “incidental” features of patented designs can be eligible for registration. In that case, the manufacturer of wind-resistant temporary road signs sought trademark protection for features described in an expired utility patent. 532 U.S. 23 (2001). Those patented features—springs that kept the signs upright in strong wind—were essential to the product’s function. Even

so, the court said that “incidental” aspects of the patented design, like the arbitrary curves of the sign’s legs, *could* be eligible for trademark protection, even if they are pictured in the utility patent: “where a manufacturer seeks to protect . . . incidental . . . aspects of features of a products found in patent claims, such as arbitrary curves. . . a different result might obtain.” *Id.* at 33.

Monster’s mark falls squarely within this exception carved out by the Supreme Court in *TrafFix*. Some aspects of Monster’s product may contribute to its function (as noted above, the cable being wider than it is thick allows the cable to lay flat, resist tangling, and accommodate multiple internal wiring). But Monster has shown, through competent and *un-refuted* expert testimony, that the curved outer contour of Monster’s mark is an “arbitrary, incidental, and ornamental aspects” of the device. *Id.* at 34.

Monster’s arbitrary, incidental, and ornamental design should not be denied trademark protection based merely on the Examining Attorney’s subjective belief that the feature is not an important design element. As shown by the expert declaration of Prof. Lance Rake, Monster’s curved outer contours are anything but minor features. Rather, like the outer contours of award-winning products such as Apple’s iPod and iPhone, Monster’s curved outer contours are significant design features that define the aesthetic appearance of Monster’s product without contributing to its function. The Examining Attorney should not be permitted to impose her own lay person’s judgment in the face of Monster’s substantial evidence that proves her wrong.

The Examining Attorney’s other reasons for refusing registration, even on the supplemental register, are similarly unavailing. For example, the Examining Attorney chides Monster for not touting the curved design in advertising. Contrary to the Examining Attorney suggestion, however, nothing requires an applicant to advertise a product feature in order to prove that it is nonfunctional. While touting a functional feature’s *usefulness* cuts against

trademark protection, not promoting an *ornamental* feature's *aesthetic* virtues carries no such consequences. Of course, touting an arbitrary feature as a source identifier with "look for" advertising may buttress a claim of acquired distinctiveness. But again, not touting such an arbitrary feature cannot support a functionality rejection or otherwise deprive an applicant from seeking a trademark for an ornamental design feature.

The Examining Attorney also misses the mark when it comes to third party evidence. She claims that Monster's competitors have placed ads "touting the utilitarian advantages of similar types of flat headphone cables." (Dkt. 47, Examiner's Br., pp. 9-10.) Yet none of those ads mentions curved outer contours. They all merely mention the advantages of "flat" cable designs. And as Professor Rake's declaration illustrates, competitors have many alternatives for producing flat cables without adopting the curved outer contours of Monster's mark. His declaration illustrates ten such alternatives, each of which can provide all the functional advantages described in Monster's utility patent. (Dkt. 15, Rake Decl. ¶ 21, Ex. B.)

The Examining Attorney tries to minimize Professor Rake's alternative designs by calling them hypothetical and arguing that none of Monster's competitors have adopted any of those designs. (Dkt. 47, Examiner's Br., pp. 18-19.) First, it is not clear from the record that none of Professor Rake's designs has been commercialized. One of his proposed alternatives replaces the curved outer contours of Monster's mark with 90 degree angles. (Dkt. 15, Rake Decl. ¶ 21, Ex. B, Alt. Embodiment 1.) That design may in fact be in use, but the Examining Attorney's evidence is not legible enough to tell. Second, the Examining Attorney ignores the fact that Monster is an industry leader and innovator, with many copycats. That some of Monster's competitors may have elected to introduce "me-too" products rather than design something new does not make Monster's design legally functional.

Furthermore, as shown in Monster’s opening brief, many competitors *have* marketed headphones with alternative cable designs that are tangle resistant without having contoured outer edges. Faced with this plethora of such alternative designs, the Examining Attorney resorts to more unsubstantiated lay speculation. She assumes, without a shred of support, that four readily available alternative designs— round, zipper-shaped, cloth, and triangular cables— cannot “include multiple side-by-side conductors.” (Dkt. 47, Examiner’s Br., p. 17.) But the ability to accommodate more wires is a function of cable width and thickness, not shape per se. There is no evidence that these alternative designs sacrifice function due to their form.

The Examining Attorney indulges in further unsupported speculation by imagining that “the zipper-style cable may scratch the wearer’s face or stick to the wearer’s clothing.” (Dkt. 47, Examiner’s Br., p. 11.) Again, she offers no support for that conclusion, despite the availability of customer reviews on Amazon.com and other Internet sites. (If “zipper” style headphone cables really do scratch faces or stick to clothing, customers would not hesitate to voice such complaints online. Yet the Examining Attorney provides no such example.)

The Examining Attorney further tries to diminish Monster’s evidence of alternative designs by claiming that some of them “were examples intended for use with over-the-ear or wireless headphones, and not the ear buds at issue.” (*Id.*) But Monster’s mark does not depend on the type of earbud used. Rather, the mark relates to the ornamental aspects of headphone cables that are suitable for use with any type of ear piece.

Finally, the Examining Attorney challenges Professor Rake’s design alternatives by claiming that there is “insufficient evidence in the record” that those alternatives are not more costly to manufacture. (*Id.* at 18-19.) As the sole support for that conclusion, she notes that Monster has previously claimed that its manufacturing processes and costs are trade secrets. (*Id.*

at 18.) Again, the Examining Attorney ignores subsequent evidence of record, namely, Professor Rake's sworn statement that each of his proposed design alternatives can be manufactured without any significant increase in cost or complexity of manufacture. (Dkt. 15, Rake Decl. ¶ 22.) Professor Rake's conclusion is corroborated by the declaration of Monster designer Jacky Hsiung, a skilled cable designer with years of experience, who states that each alternative design proposed by Professor Rake can provide all of the advantages of Monster's cable design, including resisting tangles, lying flat, and accommodating all desired wiring, *without* putting manufacturers at a competitive disadvantage because of the cost of manufacturing them. (Dkt. 27, Hsiung Decl. ¶ 8.) This substantial sworn evidence should not be marginalized in favor of the Examining Attorney's speculation regarding the manufacturing processes and costs for making plastic headphone cables.

**B. The Examining Attorney Has Not Met Her Burden of Proving Genericness**

The Examining Attorney's genericness refusal is based on her conclusion—again unsupported by competent evidence—that Monster's cable design is “commonplace.” (Dkt. 47, Examiner's Br., p. 13.) But the evidence provided by the Examining Attorney is not clear enough to permit even a skilled designer, such as Professor Rake, to “discern whether these images depict headphone cables that incorporate Applicant's design.” (Dkt. 15, Rake Decl. ¶ 22.)

Here, moreover, the burden should fall on the Examining Attorney to establish that a product design is so “commonplace” to be deemed generic. At minimum, that burden should require reliable visual evidence, not images that are subject to guesswork or conjecture. Even images of cable designs that the Examining Attorney describes as having “especially visible” contours at best lack enough visual detail to support that conclusion. (Dkt. 47, Examiner's Br.,

p. 21.) Indeed, without providing cross-sections of these cable designs, it is not possible to determine if they are oblong in shape, and thus feature contoured outer edges, or whether they feature 90 degree angles, and thus are rectangles.

The Examining Attorney’s imprecision and bias is seen acutely in her interpretation of images submitted by Monster to show alternative designs. In particular, Monster’s Request For Remand (Dkt. 41) included numerous images showing third-party headphone cables that do not feature contoured outer edges. In at least seven instances, however, the Examining Attorney erroneously concluded that these images show “curved outer contours.” (Dkt. 47, Examiner’s Br., pp. 22-23.) The following table describes her errors, which can be seen from reviewing Monster’s evidence and can be seen even better from the websites from which that evidence was obtained:

<b>Product</b>	<b>Examining Attorney’s Description</b>	<b>Actual Description</b>
Ecko Unltd. Lace 2	“curved outer contours are clearly visible”	“shoe lace” style cable
Maxell-Max Music Earset	“includes a side view of the curved outer contour”	Clearly not flat or wider than thick with oblong cross section and curved outer contours; side and front views show continuous rounded shape
SYBA Multimedia Oblanc	“design includes the curved outer contours”	Clearly not flat or wider than thick with oblong cross section and curved outer contours; Round fabric cable
Urbanears--Kransen	“design includes curved outer contours”	Clearly not flat or wider than thick with oblong cross section and curved outer contours; side and front views show continuous rounded shape
GGMM Humingbird Earphones	“design includes curved outer contours”	Clearly not flat or wider than thick with oblong cross section and curved outer contours; cable is round
AKG K 375	“example( ) of third-party use of applicant’s product design”	Clearly not flat or wider than thick with oblong cross section and curved outer contours; cable

<b>Product</b>	<b>Examining Attorney’s Description</b>	<b>Actual Description</b>
		is round
Harmon Kardon AE and NI	“example( ) of third-party use of applicant’s product design”	Clearly not flat or wider than thick with oblong cross section and curved outer contours; side and front views show continuous rounded shape
Klipsch X11i	“example( ) of third-party use of applicant’s product design”	Clearly not flat or wider than thick with oblong cross section and curved outer contours; round cable

These numerous errors in visualizing and describing the above cable designs call into question the Examining Attorney’s entire approach to Monster’s Application. At very least, the Board should not accept at face value the Examining Attorney’s conclusions about the extent to which Monster’s competitors have imitated Monster’s design.

The Examining Attorney cites cases regarding “material obtained from the Internet” to support using images to find Monster’s mark generic. (*Id.* at 16.) But none of the cited cases involves visual evidence. Rather, they deal with matters involving the meaning of words or whether products can be deemed “related goods.” Those cases do not give the Examining Attorney carte blanche to ignore basic principles of evidence. The standard for admissibility of photographic evidence requires that the proponent be able to affirm that the image fairly and accurately depicts what it purports to show. *See Kleveland v. U.S.*, 345 F.2d 134, 137 (2d Cir. 1965). The Examining Attorney did not satisfy this requirement— she did not attest or confirm that the images of headphone cables she relied upon are fair and accurate representations of the actual articles they purport to depict. On the other hand, Monster visited stores and examined products in person. (Dkt. 41, Mersing Decl., ¶¶ 2-3.)

Finally, this case is distinguishable from *Stuart Spector Designs, Ltd. v. Fender Musical Instruments*, 94 USPQ2d 1549 (TTAB 2009). In that case, guitar manufacturer Fender tried to

trademark designs for guitar bodies that had become ubiquitous within the music industry. In fact, Fender's designs had been used by third parties for *three decades* without Fender actively policing its alleged trademark rights. Those guitar body shapes therefore were incapable of identifying the source of any particular guitar. Furthermore, there was actual evidence from third party guitar manufacturers that the designs Fender sought to register were in widespread use. Here, in contrast, Monster introduced its cable design in 2008. And the Examining Attorney has presented no reliable evidence that other headphone manufacturers have so saturated the market that Monster's design is incapable of serving as a source identifier.

**C. Conclusion**

For the reasons stated above, the Examining Attorney's refusals to register Monster's mark should be reversed, and Monster's mark should be approved for registration on the Supplemental Register.

MONSTER, INC.

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