

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Oral Hearing: August 22, 2007

Mailed: February 27, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Nextel Communications, Inc.

v.

Motorola, Inc.

Opposition No. 91161817
to application Serial No. 78235618

John L. Stewart, Jr. of Crowell & Moring, LLP for Nextel
Communications.

Thomas M. Williams of Brinks Hofer Gilson & Lione for
Motorola, Inc.

Before Bucher, Cataldo and Mermelstein,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

An application has been filed by Motorola, Inc. to
register on the Principal Register a sound (hereinafter
"chirp") described as follows:

an electronic chirp consisting of a tone at 911 Hz
played at a cadence of 25 ms ON, 25 ms OFF, 25 ms
ON, 25 ms OFF, 50 ms ON

as a mark for "two-way radios" in International Class 9.¹

Nextel Communications, Inc. has opposed registration under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127, on the following grounds, as amended: (1) that as used by applicant on the goods in commerce, the chirp fails to function as a mark; and (2) that even if used as a mark, the chirp is not inherently distinctive and has not acquired distinctiveness. Applicant, in its amended answer, denied the salient allegations of the notice of opposition. In addition, applicant asserted the following affirmative defenses: that opposer lacks standing to oppose the subject application; and that its chirp has acquired distinctiveness.²

The Record

The record consists of the pleadings and the file of the involved application. In addition, during its assigned testimony period, opposer took the depositions, with accompanying exhibits, of the following individuals:

¹ Application Serial No. 78235618 was filed April 9, 2003, alleging May 6, 1991 as the date of first use of the mark anywhere and in commerce.

² In addition, applicant asserted as an affirmative defense that opposer's amended notice of opposition fails to state a claim upon which relief can be granted. However, inasmuch as applicant did not file a motion to dismiss under Fed. R. Civ. P. 12(b)(6) challenging the sufficiency of the amended pleading, such affirmative defense will be given no consideration. See generally TBMP §503 and the authorities cited therein.

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Henrick Rasmussen, Radio Systems Manager of Durham, North Carolina; Thomas Hoyes, an employee of opposer; and Dr. Jacob Jacoby, a survey rebuttal expert. In addition, opposer filed notices of reliance upon the following: the file history for opposer's application Serial No. 78575442; applicant's responses to certain of opposer's interrogatories, requests for admission and requests for production of documents; printed publications available to the general public; portions of opposer's discovery deposition of applicant's Rule 30(b)(6) witness, David Klein; and portions of applicant's discovery deposition of opposer's Rule 30(b)(6) witness, Allison O'Reilly. Applicant, during its assigned testimony period, took the depositions, with accompanying exhibits, of the following individuals: David Klein, applicant's Portable Marketing Manager, Radio Systems Division; and Dr. Michael Rappeport, a consumer survey expert. In addition, applicant filed a notice of reliance upon the following: certain of opposer's responses to applicant's interrogatories; and portions of applicant's discovery deposition of opposer's Rule 30(b)(6) witness, Allison O'Reilly.

Both parties filed briefs, and opposer filed a reply brief. In addition, counsel for both parties presented arguments at an oral hearing held before the Board on August 22, 2007.

The parties have designated portions of the record as "confidential." Although the confidential testimony and evidence play a significant role in determining the issues under consideration herein, we are mindful that such materials were introduced under seal. Thus, while we are privy to this testimony and evidence, we will refer to it in only a very general fashion. Such materials, had we disclosed them in this opinion, would assist any reader beyond the parties to better understand our reasoning in reaching our decision.

Evidentiary Matters

Applicant has sought to exclude certain evidence introduced by opposer, namely, opposer's second notice of reliance upon the discovery deposition of its Rule 30(b)(6) witness, Allison O'Reilly, as well as the documents introduced as Exhibit F in opposer's first notice of reliance. In additions, both parties have raised a number of objections directed toward the probative value of their adversary's testimony and evidence.

After careful examination of the record in this case, we have determined that none of the evidence sought to be excluded is outcome determinative. Given this fact, we see no compelling reason to discuss the objections in a detailed fashion. Suffice it to say, we have considered all of the testimony and evidentiary exhibits submitted by the parties.

In doing so, we have kept in mind the various objections raised by the parties, and we have accorded whatever probative value the subject testimony and exhibits merit.

The Parties

Applicant is a manufacturer of, *inter alia*, two-way radios. Applicant's two-way radios utilize a secure network and are used by and marketed to law enforcement, military, fire and other emergency responders, as well as vehicle fleet consumers. (Klein Testimony 17:15-20:18). As early as 1983, applicant began using a 911 Hz chirp in its two-way radios. (*Id.* at 32:7-24). In 1991, a change was made to the electronic chip that produces the 911 Hz chirp in applicant's radios, but the perceptible audio tone remained unchanged (*Id.* at 36:8-37:14). Currently, applicant's annual sales of its two-way radios featuring the chirp are very substantial (*Id.* at 49:21-24, Exhibits 9, 10).

In addition, applicant admits in its answer to the amended notice of opposition that it has a long-standing business relationship with opposer, whereby applicant manufactures "phones and phone accessories that function on MOTOROLA network infrastructure operated by Opposer, and which phones and accessories are sold to Opposer for resale to Opposer's cellular service customers" (amended answer, para. 2). Applicant further admits that it manufactures phones and phone accessories for sale to opposer's direct

competitors for resale to cellular service customers (*Id.* at para. 3). Finally, applicant admits that opposer has filed application Serial No. 78575442 for the various telecommunication services recited therein.³

Opposer is one of the largest providers of cellular telephone services in the United States, with approximately 17 million subscribers to its services nationwide. Opposer further markets and sells, *inter alia*, cellular and walkie-talkie phones manufactured by applicant (Hoyes Testimony 5:17-8:17). The customers for opposer's walkie-talkie phones include the New York, D.C. Metropolitan, and Boston

³ Application Serial No. 78575442 was filed on February 25, 2005 by Nextel Communications, Inc. for a sound mark described as follows: "The sound mark consists of a tone at 1800 Hz played at a cadence of 24 milliseconds (ms) ON, 24 ms OFF, 24 ms ON, 24 ms OFF, 48 ms ON," and asserting May 16, 1997 as the date of first use anywhere and in commerce in connection with the following services:

"Telecommunication services, namely, electronic, electric and digital transmission of voice, data, pictures, music, video, and other electronic information via wireless networks; Two-way radio services; Electronic transmission of voice, text, images, data, music and information by means of two-way radios, mobile radios, cellular telephones, digital cellular telephones, mobile telephones, handheld units, namely, personal computers and digital assistants (PDAs), dispatch radios, and pagers; Paging services; Transmission of positioning, tracking, monitoring and security data via wireless communications devices; Mobile telephone communication services; Wireless Internet access services; Wireless data services for mobile devices via a wireless network for the purpose of sending and receiving electronic mail, facsimiles, data, images, music, information, text, numeric messaging and text messaging and for accessing a global communications network; Telecommunication services, namely, providing user access to telephone and Internet wired or wireless networks for the transmission of voice, data, images, music or video via a combination of persistent interconnection and instant interconnection/instant interrupt technologies; Wireless communications services," in International Class 38.

Police Departments, New York and D.C. Fire Departments, the FBI, Secret Service, and others in the federal, state, local and municipal public safety sector (*Id.* at 6:19-22).

Opposer's Standing

As noted above, applicant has asserted as an affirmative defense opposer's lack of standing to oppose registration of the proposed mark in its subject application. We note that regardless of whether applicant asserts opposer's lack of standing as an affirmative defense, opposer must prove its standing as a threshold matter in order to be heard on its substantive claims. *See, for example, Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). In its brief, applicant argues that opposer has failed to prove its allegations that applicant will assert its proposed mark against opposer. Applicant further argues that opposer's use of an 1800 Hz tone in its cell phones is unrelated to applicant's use of the involved 911 Hz chirp in its two-way radios. Thus, applicant argues that opposer lacks both a real interest in this proceeding and a reasonable belief of damage. Applicant argues in addition that opposer asserts for the first time in its brief on appeal that it is a competitor of applicant; and that such assertions are unpleaded and should be given no consideration. Applicant

argues that, in any event, opposer's competitor argument is not supported by the record in this case.

The purpose of the standing requirement is to prevent mere intermeddlers from initiating proceedings. Thus, the Federal Circuit has enunciated a liberal threshold for determining standing, namely, whether a plaintiff's belief in damage has a reasonable basis in fact and reflects a real interest in the case. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d, 1023 (Fed. Cir. 1999). See also *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988).

In this case, opposer has established that it has a long-standing business relationship with applicant whereby applicant supplies opposer with cellular and walkie-talkie phones and their accessories for sale to opposer's cellular service customers. Opposer also has established that it markets its walkie-talkie phones to the same consumers as those of applicant's goods. Opposer further has established that applicant supplies phones and accessories to opposer's direct competitors for resale to their cellular service customers. Applicant acknowledges that many of the users of its two-way radios "often carry and use Applicant's cellular telephones used with Opposer's network services" (brief, p. 45).

We find that opposer's goods and services as well as applicant's goods are offered to the same consumers. Opposer's cellular phones, manufactured by applicant, and its cellular phone services appear on this record to be complimentary to applicant's two-way radios and, by applicant's admission, are often used together. In addition, the walkie-talkie phones manufactured by applicant for sale by opposer also may be used for the same or similar purposes as applicant's two-way radios. Opposer's cellular and walkie-talkie phones emit an 1800 Hz sound under specific circumstances during their use. Thus, applicant's assertion of its 911 Hz chirp as a mark may affect opposer's ability to utilize and market its 1800 Hz tone in its products, especially inasmuch as they are manufactured by applicant. As a result, we find that regardless of whether opposer and applicant are direct competitors, opposer has a reasonable basis for its belief in damage resulting from applicant's registration of its chirp, and a real interest in this case. *See Ritchie v. Simpson, supra.* See also TBMP §309.03(b) (2d ed. rev. 2004) and the authorities cited therein. Therefore, opposer has standing to bring this opposition proceeding.

Failure to Function As a Mark

Opposer contends that applicant's two-way radios emit the 911 Hz chirp as an alert tone when a particular radio

function is activated. Opposer also contends that applicant "did not engage in any 'look for' or 'listen to' advertising or otherwise feature the 911 Hz Tone as a trademark rather than as an alert tone" (brief, p. 4). Opposer further contends that consumers and potential consumers of applicant's goods "only encountered the sound in one of four circumstances, and in each case, the sound was expressly presented for its significance as an alert tone with a particular meaning" (*Id.*) rather than as a source identifier. Opposer contends in addition that applicant has provided no evidence that it has used its chirp as a mark, but rather that applicant relies upon its word mark and logo for recognition of its recited goods.

Applicant asserts that its chirp was "developed by Applicant's engineers and marketing personnel in 1983 and has been consistently used as a trademark since that date" (brief, p. 3). Applicant further asserts that the Federal Communications Commission (FCC), which regulates two-way radios in the United States, requires only that they be equipped with an LED light indicator to inform users that a channel is available for communications; and that there is no requirement that such radios emit any audible tones. Applicant asserts in addition that it developed the 911 Hz chirp to perform two functions in its two-way radios: (1) to inform the user thereof that a channel is available for

communication when the push-to-talk button is pressed; and
(2) to serve as a trademark to identify applicant as the
source of the radios.⁴

From the testimony and evidence made of record in this case, we have determined the following: Applicant's 911 Hz chirp is affixed to its two-way radios "through an electronic chip resident in the device and from which the sound originates and emanates" (See Applicant's response to Interrogatory No. 5). Two-way radios, including those manufactured by applicant and its competitors, operate on "trunked" systems that allocate frequencies as needed among various users. (Rasmussen Testimony, 20:22-21:9). When a user attempts to communicate by means of a two-way radio, the trunked system first seeks out and confirms the availability of a channel for communication. (*Id.*). If the system finds an available channel, the radio emits a sound to inform the user that communication may now commence. (*Id.* at 21:9-13). Such radios emit a different sound to

⁴ The question of whether applicant's 911 Hz chirp comprises matter that is functional under Section 2(e)(5) of the Trademark Act is not before us. In its brief, applicant notes that opposer did not plead functionality as a ground for opposition and argues that opposer thus is barred from asserting this argument at final hearing. We observe in addition that at oral hearing, counsel for opposer agreed that functionality under Section 2(e)(5) is not an issue in this case. We further observe that applicant argued in its brief that, in any event, its 911 Hz chirp is not functional. Inasmuch as the issue of functionality was neither pleaded by opposer nor tried by the express or implied consent of the parties, such arguments will be considered in the context of opposer's pleaded claims.

alert the user that no channel is available for communication. (*Id.* at 21:14-24:13). Applicant's two-way radios emit its 911 Hz chirp when a channel is available for communication. (Klein Testimony, 15:22-24). The 911 Hz chirp is one of over a dozen sounds emanating from applicant's two-way radios, most of which signify a function thereof:

Q. And for these 911 Hz radios, each emits nine to 12 different tones, is that correct?

A. I believe that is actually what I stipulated prior, but they actually generate more tones than that.

Q. And each of the tones has a different significance in terms of the operation and function that it signifies, is that right?

A. For the most part each tone has a sole function to the radio and it's clearly delineated in the user manual and in the training guides.

(Klein Testimony, 74:1-11). Applicant has consistently utilized its 911 Hz chirp as well as the other tones emitted by its radios in order to allow users to aurally recognize the operational features they denote without having to look at the radios during operation. (Klein Discovery Deposition, 42:21-43:14; Klein Testimony 38:19-39:14). Applicant refers to this capability as "hands on, eyes off" operation of its radios. (*Id.*).

Operational tones are not unique to applicant's goods. Two-way radios manufactured by applicant's competitors also emit a number of tones to signify various operations.

(Klein Disc. Deposition, 92:14-94:15, Exhibit L; Rasmussen

Testimony, 24 :8-25 :22). These include tones, which like applicant's chirp serve to alert users when a channel is available for communication, as well as tones to alert users when no such channels are available for communication.

(Rasmussen Testimony, 24:8-25:4; 42:14-19).

Applicant does not advertise its two-way radios by means of any broadcast media. (Klein Testimony 95:14-19). Similarly, applicant's print advertisements and promotional material for its two-way radios make no reference to its 911 Hz chirp. (*Id.* at 95:20-96:19). As a result, potential consumers neither hear nor are alerted to the 911 Hz chirp in any traditional advertisements. Rather, in addition to being audible during use of applicant's goods, the chirp is encountered by potential consumers in the following circumstances. First, the chirp is heard along with the other operational tones common to applicant's two-way radios during live user training and in audio-visual training materials used therewith. (*Id.* 81:1-4). Second, the chirp, while not audible, is referred to along with the other operational tones emitted by applicant's two-way radios in the text of user manuals and other documentation therefor. (Klein Discovery Deposition, Exhibit I). Third, the chirp is audible during trade shows and demonstrations by sales representatives of applicant's two-way radios. (*Id.* at 103:23-104:1).

As has been frequently stated, "Before there can be registration, there must be a trademark." *In re Bose Corporation, d/b/a Interaudio Systems*, 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1978). The starting point for our analysis is Section 45 of the Trademark Act, as amended, where "trademark" is defined as "any word, name, symbol, or device, or any combination thereof used by a person...to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of goods, even if that source is unknown." 15 U.S.C. §1127. This section further provides that a mark shall be deemed to be in use in commerce on goods when "it is placed in any manner on the goods or their containers...and the goods are sold or transported in commerce." *Id.* Thus, the mark must be used in such a manner that it would readily be perceived as identifying the specified goods and distinguishing a single source or origin for the goods. *See In re Safariland Hunting Corp.*, 24 USPQ2d 1380 (TTAB 1992); and *In re Aerospace Optics, Inc.*, 78 USPQ2d 1861 (TTAB 2006).

A critical element in determining whether matter sought to be registered is a trademark is the impression the matter makes on the relevant public. "Implicit in the statutory definition of a 'trademark' set forth above is a requirement that there be a direct association between the matter sought

to be registered and the goods identified in the application, that is, that the matter is used in such a manner that it would be readily perceived as identifying such goods." *In re N.V. Organon*, 79 USPQ2d 1639, 1649 (TTAB 2006). Thus, in a case such as this, the critical inquiry is whether the asserted mark would be perceived as a source indicator. See *In re Brass-Craft Mfg. Co.*, 49 USPQ2d 1849 (TTAB 1998); and *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455 (TTAB 1998). To be a mark, the matter must be used in a manner calculated to project to purchasers or potential purchasers a single source or origin for the goods. See *In re Volvo*, *supra*.

In this case, it is undisputed that applicant's 911 Hz chirp serves as an alert tone informing users of applicant's two-way radios that a channel is available for communication. It is also undisputed that the only time consumers of applicant's two-way radios hear the chirp is during use of such radios as the designated auditory signal that a channel is available for communication. In other words, the 911 Hz chirp is only heard during operation of this particular feature of applicant's goods.⁵ Moreover, it is undisputed that the two-way radios manufactured by applicant's competitors also emit a tone to signal the

⁵ The asserted use of the 911 Hz chirp during live training and at trade shows is through demonstrations of applicant's radios.

availability of a channel for communication. It further is undisputed that both applicant's two-way radios and those of its competitors emit numerous tones, each of which signals the operation of a feature thereof. Thus, on this record we find that applicant's 911 Hz chirp is merely one of many tones emitted by various two-way radios to denote the operation of a particular feature thereof.

Applicant asserts that the 911 Hz chirp is a "dual-purpose trademark" that is "emitted from Applicant's goods when a channel becomes available for communications" and also "informs the user that he is using a MOTOROLA® product." (Brief, p. 17). Applicant explains that the chirp is used in connection with its two-way radios in the following way:

The tone is from a Motorola product branding it audibly. It ties in the customer experience of this is a voice product, the most important thing is voice, and I need a robust solution, and then there is this branded radio that has Motorola written all over it that is presenting this tone. It's the only product that is producing this tone and it's certainly the only two-way product that produces this tone. And we have produced that same tone in these two-way products now for-consistently for a long period of time.

(Klein Testimony 16:21-17:8). Specifically with regard to the chirp's purported trademark significance, applicant asserts as follows:

...[t]he sales folks will use the tone to indicate... "Press the button, see, you always have the opportunity for communication." *It's the Motorola trademark of always there. It's an indication.*

It's not just, "Here, feel this device and feel it." They're getting feedback that helps them know, "I'm always getting through," that kind of feeds into the experience.

(*Id.* at 28:9-21 emphasis added). Applicant refers to such exposure by potential consumers to the 911 Hz chirp as "experiential advertising" of its goods occurring primarily at trade shows. (Brief, p. 32). Applicant claims that such "'experiential' advertising methods that involve getting the product into the consumers' hands so they can hear the 911 Hz Mark and understand its significance as both an alert tone and a trademark" (*Id.* at 34) are more effective than traditional promotional methods for its goods.

However, applicant's "experiential advertising" fails to support use of its 911 Hz chirp as a mark for several reasons. First, the hands-on demonstrations appear to promote the goods as a robust and reliable voice product. To the extent that the 911 Hz chirp is a feature of such demonstrations, its significance appears to be as an indicator of the reliability of the goods rather than as an indicator of source. As applicant's witness states above: "It's an indication...They're getting feedback that helps them know, "I'm always getting through..." Thus, applicant's own sales personnel utilize the 911 Hz chirp during demonstrations of its goods to denote its primary function, namely, to signify the availability of a reliable channel for communication. Applicant's assertion that its chirp

serves a trademark function during these demonstrations rings hollow given that such demonstrations tout the chirp as an indication that a channel is available and that the user can rely on that availability, not as a source identifier for its goods.

Second, we are not persuaded by applicant's claim that consumers will associate the chirp with applicant's goods because such goods are also marked on every surface and at nearly every angle with applicant's other word and design marks. (Klein Testimony 18:23-19:2). Essentially, applicant suggests that because the 911 Hz chirp emanates from two-way radios bearing numerous of its marks, users or potential users thereof will ascribe a source identifying function to the chirp. However, applicant cites to no authority for its contention that the presence of other marks on its goods will elevate a feature-specific sound such as its chirp to a trademark, especially when applicant's own sales demonstrations emphasize the primary significance of the chirp as a signal that a communications channel is available for use.⁶

⁶ We note that applicant commissioned a survey in support of its argument that its 911 Hz chirp has acquired distinctiveness as a trademark. While as indicated below we are not reaching the issues of inherent or acquired distinctiveness, we nonetheless have considered applicant's testimony and evidence on those issues for support of its contention that the 911 Hz chirp functions as a mark. Much of this testimony and evidence, including the survey and its results, were filed under seal. We may briefly state that we did not find additional support for

In short, the record simply does not support applicant's claim that it uses the 911 Hz chirp as a trademark. There is no evidence, for example, that applicant has attempted to promote recognition by consumers or potential consumers of the 911 Hz chirp as a trademark either in its printed advertisements, training manuals or classes, at trade show demonstrations, or on its website. (*Id.* at 102:14-107:1). Further, applicant acknowledges there is no evidence that it indicates to consumers or potential consumers that its 911 Hz chirp is intended to serve as a trademark for its goods. (*Id.*). To the contrary and as discussed above, applicant's promotional materials and live demonstrations focus on the chirp as an operational alert signal denoting the availability of a communication channel. Thus, as used by applicant, the chirp appears to signal the availability of a feature of its goods, rather than indicating the source thereof. *See, for example, In re Moody's Investors Services, Inc.*, 13 USPQ2d 2043, 2048-9 (TTAB 1989). As noted, applicant's radios emit a dozen or more sounds to indicate various features, although it admitted at oral argument that none of these other tones are trademarks. But applicant does not explain why the 911 Hz chirp would be viewed any differently than the various other

applicant's contention that its 911 Hz chirp functions as a mark among these submissions.

tones produced by its radios, i.e., as simply an indication that a particular feature of the radio is available or functioning.

We observe that the primary purpose of the 911 Hz chirp as an alert tone to signify the availability of a channel does not per se preclude it from serving as a source identifier for applicant's goods. However, in order for the chirp to function as a mark, applicant must first take the necessary actions to use and promote it as such. See Section 45 of the Trademark Act, *supra*. The "mere intent that a term function as a trademark is not enough in and of itself, any more than attachment of the trademark symbol would be, to make a term a trademark." *In re Manco Inc.*, 24 USPQ2d 1938 (TTAB 1992) (THINK GREEN failed to function as a mark for, inter alia, mailing and shipping cardboard boxes). See also *In re Volvo*, *supra* (DRIVE SAFELY failed to function as a mark for automobiles and structural parts therefor); *In re Remington Products, Inc.*, 3 USPQ2d 1714 (TTAB 1987) (PROUDLY MADE IN THE USA failed to function as a mark for electric shavers and parts thereof); and *In re Morganroth*, 208 USPQ 284 (TTAB 1980) (NATUR-ALL-IZE YOUR HAIR COLORING failed to function as a mark for hair styling salon services).

Nor does the fact that applicant may be the first and only user of the 911 Hz chirp qualify such a tone as a mark.

"Even assuming the applicant's mark is an artistically creative, unique symbol, it is well settled that not all unique symbols qualify for the Lanham Act's protection." *In re Illinois Bronze Powder & Paint Co.*, 188 USPQ 459, 462 (TTAB 1975). Accordingly, while applicant's applied-for chirp may be unique in the sense that only applicant's two-way radios emit such a tone, the record demonstrates that such a chirp is not unique in the sense that it has an "original, distinctive, and peculiar" character which conveys a trademark significance. *See, e.g., In re E S Robbins Corp.*, 30 USPQ2d 1540, 1542 (TTAB 1992).

Based upon the foregoing we conclude that applicant's 911 Hz chirp fails to function as a mark under Trademark Act Sections 1, 2 and 45 as used in connection with its two-way radios.

Inherent and Acquired Distinctiveness

Having determined above that applicant's 911 Hz chirp fails to function as a trademark, we need not and do not reach the issue of whether the proposed mark is inherently distinctive or has acquired distinctiveness.

DECISION: The opposition is sustained on the ground that applicant's designation fails to function as a mark, and registration to applicant is refused.

* * * *

Concurring opinion by Bucher, Administrative Trademark Judge:

The late Judge Nies always made her points so well:

"Trademarks are useful tools of a competitive society, providing consumers with the means for choosing from among different producers. The tenet which precludes recognition of functional designs as trademarks is one of the balance points. Our society is better served if functional containers (as well as functional product designs and highly descriptive or generic terms) remain available for use among competitors. To the extent this causes a modicum of confusion of the public, it will be tolerated. There is, indeed, no overriding requirement in the law that comparable goods be distinguishable in the marketplace. On the other hand, a merchant who wishes to set himself apart has no dearth of means to do so. One who chooses a commonplace design for his package, or one different from competitors only in essentially functional features, even if he is the first to do so, must expect to have to identify himself as the source of goods by his labelling or some other device."

In re Water Gremlin Company, 208 USPQ 89, 91 (CCPA 1980).

* * * *

Based upon the way this case was litigated, I agree with my colleagues that we must sustain this opposition for precisely the reasons Judge Cataldo has delineated. Yet I fear that the litigants have tried this opposition in a way that ignored the chirping elephant in the room.

The Motorola "chirp" is an operational feature of its hand-held, portable, two-way radio transceiver. The record is clear that the transceiver "chirps," and that the chirp

alerts the user to an open channel. Among a dozen or more sounds the radio emits is the involved tone or chirp. This alert tone is broadcast at a specific frequency, having an on/off cadence measured in milliseconds. Yet such tones are ubiquitous in handheld, portable transceivers and cellular telephones, for as applicant admits, wireless devices for commercial and personal usage manufactured by unnamed competitors emit a variety of similar operational tones having unknown frequencies and varying cadences.

Fortunately, for more than six decades the magnificent infrastructure of our Trademark Act has proven pliable enough to extend trademark protections well beyond words and symbols.⁷ We have gone places that Senator Lanham never envisioned.⁸ However, when confronted with a novel, non-traditional trademark, the decision-maker is compelled to focus upon whether exclusive use of this claimed feature

⁷ *TraFFix Devices Inc. v. Marketing Displays Inc.*, 532 U.S. 23, 58 USPQ2d 1001 (2001); *Brunswick Corp. v. British Seagull*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994), cert. denied, 514 U.S. 1050 (1995); *In re Owens-Corning Fiberglas Corporation*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985); *Inwood Laboratories, Inc., v. Ives Laboratories, Inc.*, 456 U.S. 844, 214 USPQ 1 (1982); and *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 USPQ 9 (CCPA 1982).

⁸ *In re Slokevage*, 441 F.3d 957, 78 USPQ2d 1395 (Fed. Cir. 2006); *In re N. V. Organon*, 79 USPQ2d 1639 (TTAB 2006); and *In re Clarke*, 17 USPQ2d 1238 (TTAB 1990).

"would put competitors at a significant non-reputation based disadvantage."⁹

The record shows that both Motorola and Sprint/Nextel have pending applications before the United States Patent and Trademark Office for their respective alert tones. When during *ex parte* examination the United States Patent and Trademark Office's Examining Operations failed to make any "functionality" inquiries, these major players evidently both made a strategic decision to bypass this particular concern as well.

In the event the above issue (e.g., whether or not Motorola's exclusive use of the 911 Hz chirp is consistent with the preservation of effective competition among the manufacturers and merchants of a defined set of these handheld wireless devices) is thoroughly litigated before the appropriate tribunal, the focus should then turn to whether or not the feature actually functions as a mark. Like flavor, single color and scent, an operational radio tone should never be deemed inherently distinctive. As the Supreme Court reaffirmed in *Wal-Mart Stores Inc. v. Samara Brothers Inc.*, 529 U.S. 205, 54 USPQ2d 1065 (2000), the involved tribunal should adopt a predictive inquiry (in the

⁹ *Qualitex Co. v. Jacobson Prods. Co.* 514 U.S. 159, 165, 34 USPQ2d 1161, 1164 (1995); and *Valu Eng'g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1277, 61 USPQ2d 1422, 1430 (Fed. Cir. 2002).

instant case, for a sound mark) adopted by the predecessor to our primary reviewing court for making trade dress determinations. *Seabrook Foods, Inc., v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 196 USPQ 289 (CCPA 1977). In fact, an analogy to the *Seabrook* test provides a good overlay for the evidence discussed at length in the majority opinion herein. Provided the matter is indeed capable under the *Seabrook* test of being readily recognized by consumers as a source indicator, deferred recognition should remain the law, and a registration should issue only upon a substantial showing of acquired distinctiveness. *In re D.C. Comics, Inc.*, 689 F.2d 1042, 215 USPQ 394, 402 (CCPA 1982) (Nies, J., concurring). Whether this showing came forward during *ex parte* examination or as a result of an adversarial proceeding, sustained promotional efforts encouraging prospective consumers, for example, to "listen for the Motorola chirp," would bolster the case. The demonstration of a successful penetration of the marketplace with such advertising campaigns would support a showing of acquired distinctiveness as a source indicator for this alleged dual-use chirp. At such a juncture, direct evidence of consumer perceptions drawn from a valid survey that could withstand the adversary process should help the proponent of registrability overcome further challenges.

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