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

Proceeding	92051757
Party	Plaintiff Phoenix Trading Inc. dba Amercare Products, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEORE THE TRADEMARK TRIAL AND APPEAL BOARD

PHOENIX TRADING, INC., dba **AMERCARE PRODUCTS, INC.**, a Washington corporation; Petitioners, v. **LOOPS LLC.**, a Delaware limited liability corporation, Respondent,	Cancellation No. 92051757 **PETITIONERS' RESPONSE TO REGISTRANT'S MOTION FOR JUDGMENT ON THE PLEADINGS** Mark: "Designed for Prison Safety" Reg. No: 3,424,838 Mark: Trade Dress - Flexbrush Toothbrush Reg. No: 3,430,304 Mark: Trade Dress - Flexbrush Toothbrush Reg. No: 3,430,305

RESPONSE

1. Registration No. 3,424,838 - "Designed for Prison Safety"

Registrant argues, and Petitioners concede that the mark at issue "Designed for Prison Safety" is contained on the supplemental register, and is therefore not subject to challenge in a cancellation proceeding. Petitioners agree that the cancellation proceeding for the mark "Designed for Prison Safety" should be dismissed.

2. Registration No. 3,430,304 - Trade Dress - Overall appearance / barbell shape

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Registration No. 3,430,305 - Trade Dress - Raised dots on handle.

Here, Registrant argues that the pleadings are deficient, and this action should be dismissed on the merits because the Petition / Complaint for Cancellation ("Complaint") does not contain recitations of evidence meeting each of the four Morton-Norwich factors, or otherwise proving Petitioners' case.

Registrant's position is misguided. Petitioners are not required to put forth evidence in the Complaint sufficient to prove their claims. Instead, TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE, Second Edition, June 2003, Revision 1, March 2004 ("TBMP"), § 309.03 directs just the opposite:

> "309.03(a)(2) Elements of Complaint – In General
>
> * * * * *
>
> [A] petition to cancel must include (1) a short and plain statement of the reason(s) why petitioner believes it is or will be damaged by the registration sought to be cancelled (i.e., petitioner's standing to maintain the proceeding -- see TBMP §§ 303.03 and 309.03(b)) and (2) a short and plain statement of the ground(s) for cancellation.
>
> The elements of a claim should be stated simply, concisely, and directly. However, the pleading should include enough detail to give the defendant fair notice of the basis for each claim.
>
> * * * * *
>
> **Evidentiary matters (such as, for example, lists of publications or articles in which a term sought to be registered by an applicant is alleged to be used descriptively) should not be pleaded in a complaint. They are matters for proof, not for pleading.**" TMBP §309, (Bolding added.)

Functionality is a question of fact, *Morton-Norwich*, 671 F.2d at 1340, 213 USPQ at 15, and depends on the totality of the evidence, *In re Owens-Corning Fiberglas Corp*., 774 F.2d 1116, 1120, 227 USPQ 417, 419 (Fed.Cir.1985). *Valu Engineering, Inc. v. Rexnord Corp.*, 278 F.3d 1268 (C.A.Fed.,2002).

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In evaluating whether trade dress is *de jure* functional, the following four factors are considered: (i) the existence of an existing or expired utility patent or other evidence indicating that the design yields a utilitarian advantage; (ii) the availability of alternative designs; (iii) the extent of advertising touting the utilitarian aspects of the design; and (iv) the comparative ease and expense associated with manufacturing the design. *Valu Engineering*, 278 F.3d 1268, 1274.

In conducting this analysis, the trade dress as a whole should be examined, rather than parsing the constituent parts, bearing in mind that "[t]rade dress is the composite tapestry of visual effects." *Clicks Billiards Inc. v. Sixshooters Inc.*, 251 F.3d 1252, 1259 (9th Cir.2001). Although functional elements might separately be unprotectable, they might in the aggregate convey a visual impression rising to the level of trade dress. *Id.* The fundamental inquiry is whether the design features at issue constitute "the actual benefit that the consumer wishes to purchase," rather than "an assurance that a particular entity made, sponsored, or endorsed" the product. *Leatherman*, 199 F.3d at 1012 (quoting *Vuitton Et Fils S.A. v. J. Young Enters., Inc*., 644 F.2d 769, 774 (9th Cir.1981)).

Here, Petitioners have properly pled that the trade dress in the '304 and '305 marks is *de jure* functional and therefore should be cancelled. Proof of that claim will rely on evidence to be presented at the trail of this matter, which need not be present in the pleadings. Further, although not required to do so, Petitioners have alleged one compelling piece of evidence to back their claims of *de jure* functionality - the existing '286 utility patent.

Existence of a utility patent constitutes "strong evidence" of functionality. See *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29-30, 121 S.Ct. 1255, 149 L.Ed.2d 164 (2001). *Disc GolfAss'n, Inc. v. Champion Discs, Inc*., 158 F.3d 1002, 1008 (9th Cir.1998) is directly on point. There, the court noted that "one cannot argue that a shape is functionally advantageous in order to obtain a utility patent and later assert that the same shape is non-functional in order to obtain

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trademark protection" (quoting J.T. McCarthy, *McCarthy on Trademarks and Unfair Competition* § 7:89 at 7-208 (4th ed.1998)). A cursory comparison of the marks at issue and the '286 Patent shows that is exactly what has happened here.

Petitioners have pled a short and plain statement of their standing to maintain the proceeding -- see TBMP §§ 303.03 and 309.03(b)) and (2) a short and plain statement of the ground for cancellation - i.e., that the marks at issue are *de jure* functional. That is sufficient to defeat Registrant's Motion for Judgment on the pleadings.

Whether or not Petitioners can muster sufficient evidence to prove the marks at issue are *de jure* functional and should therefore be cancelled is a matter to be proven by introduction of evidence at trial, and not a matter to be resolved through the pleadings. If Registrants intended to file a Motion for Summary Judgement to challenge the evidence, they are free to do so, but have not.

Registrant's Motion against Petitioners' cancellation action related to the '304 and '305 marks should be denied.

CONCLUSION

Petitioners concede Registrant's Motion regarding Registration No. 3,424,838 - "Designed for Prison Safety" and have no objection to dismissal of the cancellation action related to that mark. Registrant's motions for judgment on the pleadings related to the '304 and '305 registrations are not well taken, and should be denied.

DATED: August 19, 2010.

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CERTIFICATE OF MAILING AND SERVICE

I hereby certify that on August 19, 2010, the foregoing document was electronically transmitted to:

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I further certify that a true and correct copy of the foregoing was served on the above attorney by mailing it first class United States mail on August 19, 2010 to the address shown above.

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