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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
BEFORE 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

TRIAL BRIEF

Mark: "Designed for Prison Safety"

Reg. No: 3,424,838

Reg. Date: May 6, 2008

Mark: Trade Dress - Flexbrush Toothbrush

Reg. No: 3,430,304

Reg. Date: May 20, 2008

Mark: Trade Dress - Flexbrush Toothbrush

Reg. No: 3,430,305 (Withdrawn)

Reg. Date: May 20, 2008

TRIAL BRIEF

The evidence entered by Petitioner Phoenix Trading, Inc. dba Amercare Products, Inc. ("Amercare") shows that by registrant Loops' own admissions in its patent, the elements claimed in Loops' trade dress Registration No. 3,430,304 are functional, and should therefore be cancelled.

POINTS AND AUTHORITIES

This is a simple proceeding. The evidence relied upon by Amercare includes (1) Loops'

1 Registration No. 3,430,304 and (2) Loops patent - United States Patent Number 7,334,286 B2,
2 *Toothbrush and Methods of Making and Using Same*, issued February 26, 2008.

3 Functionality is a question of fact, *Morton-Norwich*, 671 F.2d at 1340, 213 USPQ at 15, and
4 depends on the totality of the evidence, *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1120,
5 227 USPQ 417, 419 (Fed.Cir.1985). *Valu Engineering, Inc. v. Rexnord Corp.*, 278 F.3d 1268
6 (C.A.Fed.,2002).

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

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

20 Existence of a utility patent constitutes “strong evidence” of functionality. See *TrafFix Devices,*
21 *Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29-30, 121 S.Ct. 1255, 149 L.Ed.2d 164 (2001). *Disc*
22 *GolfAss'n, Inc. v. Champion Discs, Inc.*, 158 F.3d 1002, 1008 (9th Cir.1998) is directly on point.
23 There, the court noted that “one cannot argue that a shape is functionally advantageous in order to
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1 obtain a utility patent and later assert that the same shape is non-functional in order to obtain
2 trademark protection" (quoting J.T. McCarthy, McCarthy on Trademarks and Unfair Competition §
3 7:89 at 7-208 (4th ed.1998)). A cursory comparison of the marks at issue and the '286 Patent shows
4 that is exactly what has happened here.

5 Registration Number 3,424,304 ("304 Mark" or "304") involves protection of trade dress
6 associated with the Loops Flexbrush flexible handled toothbrush. In general, it asserts protection of
7 the three dimensional, overall appearance of a particular toothbrush design. Registration '304 claims
8 the following as protected trade dress:

9 (1) *toothbrush with a rounded handle* -- "overall appearance of a toothbrush featuring a
10 *smoothly rounded handle*";

11 (2) *barbell shape* -- "having a top aspect which is *generally barbell shaped* with the rear
12 end portion being larger than the front end portion and with a narrow intermediate
portion smoothly interconnecting both ends";

13 (3) *bowed and tapered sides* -- "a *side* aspect being *slightly bowed and smoothly tapered*
14 toward its rear end."

15 As shown in Patent Number 7,334,286 (" '286 Patent") obtained before the trademark
16 registration, each of the characteristics and elements claimed in the '304 Trademark Registration,
17 including the design and three-dimensional structure of the Loops Flexbrush, is *de jure* functional.
18 Element-to-element comparison of the trademark / trade dress with the corresponding descriptions in
19 the '286 Patent are set forth below:

20 **'304 Trademark:** *overall appearance of a toothbrush with a rounded handle:*

21 **'286 Patent:** "For the purposes of safety (i.e. prison market) the length of the body of
22 the toothbrush should be up to approximately 4-1/2 inches in
length." (CSMF, §11 (Patent), Col. 3, l. 18-20);

23 "an enlarged smoothly **rounded bulbous handle** end portion to facilitate
24 **handling of the toothbrush**

25 **'304 Trademark:** *barbell shape:*

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'286 Patent:

"a narrowed elongated intermediate smooth continuous portion being composed of the pliable flexible material to be limber in its unstressed condition, and integrally connecting the enlarged head portion and the enlarged handle portion substantially midway therebetween [barbell shape] **to facilitate flexing of the toothbrush with one hand of an adult user for stressing the pliable flexible material to rigidify the body for teeth brushing purposes.**"

"the intermediate portion is narrower than the width of the head portion and the end portion on the top and bottom side";

"wherein the handle portion is wider than the brush head portion with the narrowed intermediate portion therebetween";

"a narrowed elongated intermediate smooth continuous portion being composed of the pliable flexible material to be limber in its unstressed condition and integrally connected to the enlarged head portion and the enlarged handle end portion substantially midway therebetween **to facilitate flexing of the toothbrush with one hand of an adult user for stressing the pliable flexible material to rigidify the body for teeth brushing purposes...."**

'304 Trademark:

bowed and tapered sides:

'286 Patent:

"as best seen in FIG 4, the body [] has a slightly curved side edge or curved aspect [] between the head portion [] and the handle portion [] **to help facilitate the flexing of the body []** by the hand of the user."

"A toothbrush according to claim 1, wherein the body has a curved edge extending between the brush head and the handle portion."

"wherein the thickness of the elongated body at the head portion being tapered and increasing toward the intermediate portion, and at the handle portion being smoothly continuously tapered and smoothly continuously decreasing toward a narrowed tip of the handle portion wherein the thickness of the elongated body is greatest at the intermediate portion;

"wherein the material of the body is sufficiently flexible **to enable the manually applied external force to flex the handle portion into a smoothly rounded shape.**"

"wherein the flexibility of the material requires a manually applied

1 external force by the digit of the hand of the user holding the
2 toothbrush to flex the handle portion substantially along its entire
3 length **to make the body sufficient rigid to facilitate use of the**
4 **toothbrush for teeth brushing purposes."**

5 Each of the alleged trade dress elements claimed in Trademark Registration 3,430,304 are, by
6 Loops' own representations and admissions in its '286 patent for the same Flexbrush flexible handled
7 toothbrush, *de jure* functional and not subject to trade dress protection. Trademark No. 3,424,304
8 should be cancelled.

9 Further, the application for the above-discussed patent, and the trademark issued as 3,424,304
10 were pending at the same time. While it may or may not have been acceptable for Loops to make
11 both applications, it was clearly fraudulent for it to not dismiss the trademark application after it was
12 granted the '286 patent.

13 **CONCLUSION**

14 Trademark Registration Number 3,430,304 should be cancelled.

15 **DATED: December 11, 2011.**

16 **RICK KLINGBEIL, PC**

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19 Rick Klingbeil, OSB #933326
20 of Attorneys for Petitioner
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1 **CERTIFICATE OF MAILING AND SERVICE**

2 I hereby certify that on December 11, 2011, the foregoing **TRIAL BRIEF** was electronically
3 transmitted to:

4 United States Trademark Trial and Appeal Board
5 Commissioner for Trademarks
6 P.O. Box 1451
7 Alexandria, VA 22313-1451.

8 I further certify that a true and correct copy of the foregoing document was served on the
9 following attorneys, known to me to be counsel of record for Loops, Inc., by first class United States
10 Mail, in a sealed envelope, and by email to the email addresses shown below:

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16 **DATED:** December 11, 2011.

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