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

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Party	Defendant Loops, LLC
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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,

Petitioner,

vs.

LOOPS LLC, a Delaware limited liability
company,

Registrant.

Cancellation No.: 92051757

Mark: "Designed for Prison Safety"
Reg. No.: 3,424,838

Mark: Trade Dress
Reg. No.: 3,430,304

Mark: Trade Dress
Reg. No.: 3,430,305

REGISTRANT'S BRIEF ON MERITS

Registrant, LOOPS LLC ("Loops"), a Delaware corporation and owner of all right, title and interest in an to Registration Nos. 3,424,838, 3,430,304, 3,430,305, through its counsel, hereby submits the following brief on the merits in response to the cancellation proceeding including trial brief brought by Petitioner, Phoenix Trading, Inc., dba Amercare Products. Inc. ("Amercare").

Since Petitioners have agreed to dismissal or withdraw of claims against Reg. Nos. 3,424,838 and 3,430,305, Loops requests that the remaining Reg. No. 3,430,304 be upheld as a source identifier that is not *de jure* functional.

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I. INDEX OF CASES

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II. DESCRIPTION OF RECORD

The record consists of the pleadings and other documents filed in the present cancellation proceeding. Also, the record consists of the certificates of registrations for the subject registrations and their prosecution histories in addition to U.S. Pat. No. 7,334,286 (“‘286 patent”) and its prosecution history.

III. STATEMENT OF THE ISSUES

Is the ‘304 Mark is *de jure* functional because its trade dress elements for a toothbrush including: a) a rounded handle; b) a barbell shape; and c) bowed and tapered sides, are also admitted as functional in the specification and claims of the ‘286 Patent; however where there exists other element(s) of the trade dress claim that are not functional and where an “a three-dimensional, overall appearance of a toothbrush” is set forth in the trade dress claim.

IV. RECITATION OF FACTS

Loops and its President, Steven L. Kayser maintain a principal place of business at 7152 Everett Rd., Ferndale, WA 98248. Loops and Amercare compete in the market for providing toothbrushes and other personal care products to customers, primarily prison systems. Petition, ¶ 8. Loops, for its part, offers desirable toothbrushes as a safer alternative since the flexible material used is difficult to fashion into a crudely made weapon, also typically referred to as a shank. ‘286 Patent, col. 1, lines 23-34. Loops has invested heavily in its brand recognition as offering high quality products to its customers.

On November 19, 2009, Amercare filed a Petition for Cancellation (the “Petition”) seeking cancellation of the following marks alleging:

1. Loops’ mark DESIGNED FOR PRISON SAFETY registered on the Supplemental Register, Reg. No. 3,424,838 (the “‘838 Mark”) is merely descriptive;
2. Loops’ trade dress registered on the Principal Register, Reg. No. 3,430,304 (the “‘304 Mark”) is *de jure* functional; and

3. Loops' trade dress registered on the Principal Register, Reg. No. 3,430,305 (the "305 Mark") is *de jure* functional.

In the Petition, Amercare argued the '838 Mark is merely descriptive because it: a) prevents competitors, including Amercare, from effectively marketing and selling toothbrushes and dental floss to prisons; and b) inhibits the freedom of public entities to fully and accurately describe in their bid solicitations the type and characteristics of toothbrushes and dental floss they desire for their prisons. Petition, ¶¶ 15-16. However, in Amercare's Response to Registrant's Motion for Judgment on the Pleadings, Amercare conceded that the '838 Mark should not be challenged as being "merely descriptive," since it is on the Supplemental Register.

Amercare additionally argued the '305 Mark is *de jure* functional because its trade dress elements for a toothbrush with dot and relief patterns are also included in the claims of the '286 Patent, which Loops was prosecuting concurrently with the '305 Mark. Petition, ¶¶ 35-38. However, Amercare withdrew this claim in its Partial Withdraw Re: Cancellation Claims.

Amercare maintains its challenge to the '304 mark. Trial Brief, pp. 1-5.

VI. ARGUMENT

A. Loops Is Entitled To Judgment On Amercare's Remaining Challenge Because The '304 Mark Is Not *de jure* Functional.

A product feature is functional and cannot serve as a trademark "if the feature is essential to the use or purpose of the article or if it affects the cost or quality of the article." *TraFFix Devices Inc. v. Marketing Displays Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001) citing *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 34 USPQ2d 1161 (1995) quoting *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 214 USPQ 1, 4 n.10 (1982). The Court in *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 USPQ 9 (CCPA 1982), set forth four factors to be considered in determining whether a product design is functional:

- (1) the existence of a utility patent that discloses the utilitarian advantages of the design;

- (2) the touting by the originator of the design in advertising material of the utilitarian advantages of the design;
- (3) facts showing the unavailability to competitors of alternative designs; and
- (4) facts indicating that the design results from a relatively simple or cheap method of manufacturing the product.

The Supreme Court's decision in *TrafFix* has not altered the Morton-Norwich analysis. See *Valu Engineering, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1427 (Fed. Cir. 2002).

1. The Existence Of A Utility Patent That Discloses The Utilitarian Advantages Of The Design – *Morton-Norwich Factor One*.

Amercure's remaining claim for cancellation is based entirely on this factor of the Morton-Norwich analysis. In its argument, Americure alleges that there are three individual elements of trade dress claim that are functional as evidenced by the '286 Patent, and as a consequence, the '304 Mark is *de jure* functional. Americure's argument that the '304 Mark should be cancelled because some of the discrete elements are functional, when other elements are not functional, and where an overall appearance of a toothbrush is set forth in the trade dress claim demonstrates Americure's misunderstanding of the trademark law.

Again, the '304 trade dress claim is directed to an *three-dimensional, overall appearance* including a very detailed account of features such as a *rear end portion being larger than the front end portion*. As such, '286 patent would not and does not suggest that the specific *three-dimensional, overall appearance of a toothbrush* including all recited features taken together could be related to some functionality. Therefore, Loops is entitled to separate protection under trade dress and patent laws.

The unabridged claim language of the '304 Mark is as follows:

“The mark consists of a three-dimensional, overall appearance of a toothbrush featuring a smoothly rounded handle, having a top aspect which is generally barbell shaped with the rear end portion being larger than the front end portion and with a narrow intermediate portion smoothly interconnecting both ends, and a side aspect being slightly bowed and smoothly tapered toward its rear end.”

The ‘304 Mark is a trade dress mark. “Trade dress’ involves the total image of a product and may include features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques.” *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 980 (1983) citing *SK & F Co. v. Premo Pharmaceutical Laboratories, Inc.*, 481 F. Supp. 1184, 1187 (stating that “[t]rade dress is a complex composite of features” including, *inter alia*, size, color, texture, and graphics, which must “be considered together, not separately”), *aff’d*, 625 F.2d 1055 (3d Cir. 1980); 1 J.T. McCarthy, *Trademarks & Unfair Competition* § 8.1, at 230-31 (1973).

As the claim language of the ‘304 Mark clearly demonstrates, the trade dress protection Loops received from the USPTO is for a *three-dimensional, overall appearance of a toothbrush* described in that claim. The trade dress claim is highly detailed and particularly describes at least *a rear end portion larger than a front end portion* (hereinafter “irregular barbell shape”) that cannot, nor does Amercare allege, have anything to do with functionality.¹ In other words, while a barbell shape may have some functionality, an irregular, asymmetrical barbell shape cannot be related to functionality in any way.²

Furthermore, even if certain of the aspects of the ‘304 Mark are functional, or even many of them combined, courts have repeatedly recognized that “one may have a protectable [trade dress] interest in a combination of features or elements that includes one or more functional features.” *American Greetings Corp. v. Dan-Dee Imports, Inc.*, 807 F.2d 1136, 1143 (1986) citing *LeSportsac, Inc. v. K Mart Corp.*, 754 F.2d 71, 75 (2d Cir. 1983); *John H. Harland Co.* 711 F.2d at 984; *In re Morton-Norwich Products*, 671 F.2d at 1339; *Dallas Cowboys Cheerleaders v. Pussycat Cinema*, 604 F.2d 200, 203-04 (2d Cir. 1979); *Truck Equipment*

¹ Registrant’s “three-dimensional, overall appearance” claim is vastly more detailed than the simple “bullet-shaped earplug” at issue in *In re Howard Leight Industries, LLC*, 80 USPQ2d 1507 (TTAB 2006).

² Registrant’s “three-dimensional, overall appearance” claim is also unlike the “dual-spring design” claim at issue in *TraFFix*; there, the “dual-spring design” was *also* the central advance claimed in the expired utility patents. 58 USPQ at 1005.

Service Co. v. Fruehauf Corp., 536 F.2d 1210, 1217 (8th Cir.), cert. denied, 429 U.S. 861 (1976); cf. infra. *Freixenet*, 731 F.2d at 153 (combination of non-protectable and distinctive elements may constitute protectable trade dress).

Again, “[i]t is the overall physical appearance of [Loops’] trade dress which is critical.” *Ciba-Geigy Corp. v. Bolar Pharmaceuticals Co.*, 747 F.2d 844, 851 (3d Cir. 1984), cert. denied, 471 U.S. 1137 (1985); *Freixenet, S.A. v. Admiral Wine & Liquor Co.*, 731 F.2d 148, 153 (3d Cir. 1984) (“total package”). Trade dress law does not permit selective dissection of a claim to prove overall functionality. The specific combination of all of the features of the ‘304 Mark, functional and distinctive, is what the USPTO granted Loops trade dress protection for, and not simply the three elements asserted by Amercare.

Based on this analysis alone, Amercare’s claim for cancellation of the ‘304 Mark must fail.

2. Remaining Morton-Norwich Factors.

Amercare has not pursued discovery nor made any arguments that speak to the other three Morton-Norwich factors. However, suffice it to say, it would be completely illogical to believe that any advertising touting the utilitarian benefits of a *three-dimensional overall appearance* to include an irregular barbell shape as described in the ‘304 Mark would exist. Therefore, discovery conducted to this matter would have resulted in judicial and economic waste. Similarly, it would be illogical to suggest that any facts exist as to the unavailability of alternative designs. In other words, a fact finder can plainly recognize the ease with which competitors, including Amercare, could change the *three-dimensional, overall appearance*. And further, one can readily discern that the highly specific design is not related to a relatively simple or cheap method of manufacturing.

VI SUMMARY

The Supreme Court’s holding in *TrafFix* makes it clear that features described in patent claims may also be protectable trade dress: “In a case where a manufacturer seeks to protect

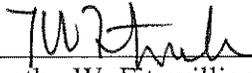
arbitrary, incidental, or ornamental aspects of features of a product found in the patent claims, such as arbitrary curves in the legs or an ornamental patten painted on the springs, a different result might obtain. There the manufacturer could perhaps prove that those aspects do not serve a purpose within the terms of the utility patent.” 58 USPQ2d at 1007.

As stated herein, a trade dress source identifier involves the total image of the product as set forth in the ‘304 claim description. Amercare, in its Trial Brief, attempts to parcel out portions of the ‘304 description and argue functionality of the bit portion. This attempt is legally flawed since the entire claim must be considered. Rather, it is readily obvious that all features taken together, to include, *the rear end portion being larger than the front end portion*, and a *tapered* side aspect, are not related to functionality.

Accordingly, for the reasons set forth above, Loops is entitled to judgment upholding its ‘304 Mark as a source identifier that is not *de jure* functional.

Respectfully submitted,

Dated: January 9, 2012



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