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

Proceeding	92051757
Party	Defendant Loops, LLC
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Date	01/14/2013
Attachments	Notice of Appeal.pdf (16 pages)(661862 bytes)

IN THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

LOOPS LLC, a Delaware limited liability company Appellant, vs. PHOENIX TRADING, INC., dba AMERCARE PRODUCTS INC, a Washington corporation , Appellee.	**Appeal No.**

NOTICE OF APPEAL OF THE DECISION OF
THE TRADEMARK TRIAL AND APPEAL BOARD

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/// PLEASE TAKE NOTICE that LOOPS LLC hereby appeals to the United States Court of Appeals for the Federal Circuit for review of the decision dated November 15, 2012 issued by the U.S. Patent and Trademark Office Trademark Trial and Appeal Board granting Phoenix Trading, Inc.'s Cancellation No. 92051757 against U.S. Trademark Registration No. 3,430,304 registered by LOOPS LLC. The decision was received on November 15, 2012. A copy is attached.

DATED: January 14, 2013

LEWIS KOHN & FITZWILLIAM
LIMITED LIABILITY PARTNERSHIP

By:

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LOOPS LLC

CERTIFICATE OF SERVICE

I, Kari Moyer-Henry, hereby certify that on this 14th day of January, 2013, the foregoing Notice of Appeal of the Decision of the Trademark Trial and Appeal Board was mailed first class, postage paid to:

U.S. Patent & Trademark Office
Office of General Counsel
P.O. Box 1450
Alexandria, VA 22313-1450

I, Kari Moyer-Henry, hereby certify that on this 14th day of January, 2013, the foregoing Notice of Appeal of the Decision of the Trademark Trial and Appeal Board was electronically filed with:

U.S. Patent & Trademark Office
Trademark Trial and Appeal Board
Alexandria, VA 22313
and
United States Court of Appeals for the Federal Circuit
717 Madison Place, N.W.
Washington D.C. 20439

I, Kari Moyer-Henry, hereby certify that on this 14th day of January, 2013, the foregoing Notice of Appeal of the Decision of the Trademark Trial and Appeal Board was emailed and mailed first class, postage paid to the following person and/or entity:

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I declare under penalty of perjury that the foregoing is true and correct. Executed this 14th day of January 2013, at San Diego, California.

Respectfully submitted,

Dated: January 14, 2013

Kari Moyer-Henry

PROOF OF SERVICE

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Mailed:
November 15, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Phoenix Trading Inc. dba Amercare Products, Inc.

v.

Loops, LLC

Cancellation No. 92051757

Rick Klingbeil of Rick Klingbeil PC for Phoenix Trading Inc. dba Amercare Products, Inc.

Timothy W. Fitzwilliam of Lewis Kohn & Fitzwilliam for Loops, LLC.

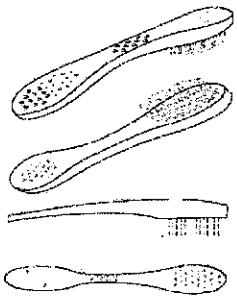
Before Quinn, Zervas and Greenbaum, Administrative Trademark Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

Phoenix Trading Inc. dba Amercare Products, Inc. (petitioner) filed on November 19, 2009, a petition to cancel three registrations owned by Loops, LLC (respondent):

(1) Registration No. 3424838 (DESIGNED FOR PRISON SAFETY) for "dental floss and toothbrushes," issued May 6, 2008 on the Supplemental Register;

(2) Registration No. 3430304 for the trade dress shown below for "toothbrushes," issued May 20, 2008 on the Principal Register;



and

(3) Registration No. 3430305 for the trade dress shown below for "toothbrushes," issued May 20, 2008 on the Principal Register.[1]

Petitioner originally alleged a claim of mere descriptiveness against Registration No. 3424838 pursuant to Section 2(e)(1) of the Trademark Act, 15

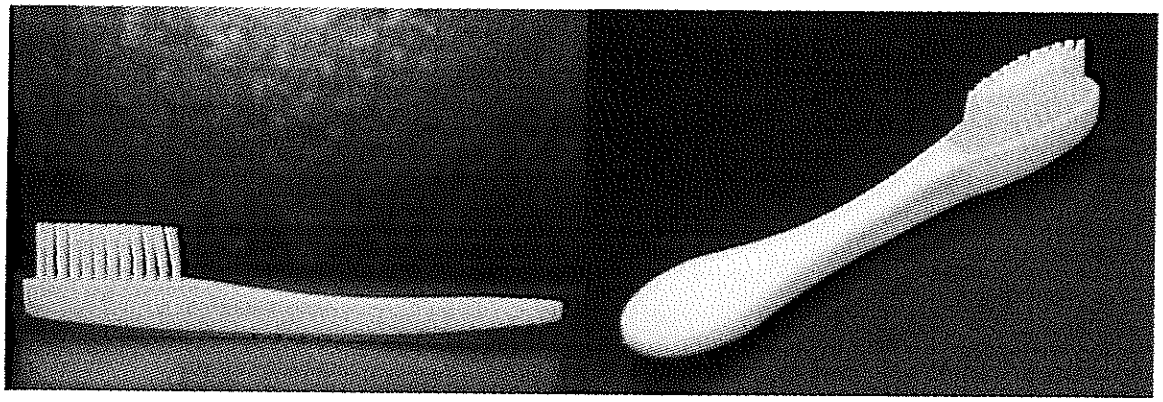
[1] We note that the trade dress registrations are on the Principal Register without claims of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), that the examining attorney did not ask respondent for information, such as whether the marks were the subjects of any patents (see TMEP §1202.02(a)(iv); 37 C.F.R. § 2.61(b)), and neither application underlying the trade dress registrations includes patents or references thereto. We also note that the trade dress registrations include multiple renditions of three-dimensional marks absent permission from the Director. 37 C.F.R. §§ 2.52(b)(2) and 2.146(a)(5). In addition, the descriptions of the marks in the trade dress registrations do not indicate what the broken or dotted lines represent, nor do they include the required statement that the matter shown in broken or dotted lines is not part of the marks. 37 C.F.R. § 2.52(b)(4).

U.S.C. §§ 1052(e)(1), and claims of *de jure* functionality and fraud against Registration Nos. 3430304 and 3430305 pursuant to Sections 2(e)(5) and 14(3) of the Trademark Act, 15 U.S.C. §§ 1052(e)(5) and 1064(3), respectively. The Board dismissed the claim against the former on December 9, 2010, and the claims against the latter on January 12, 2012. Therefore, the only remaining claims are petitioner's claims of functionality and fraud against the mark in Registration No. 3430304 ("the Registration" or "the Registered mark"). Because petitioner presented no arguments in its brief regarding its fraud claim, we deem petitioner to have waived this claim, and we have given it no further consideration. *See* TBMP §801.01 (3d ed. 2012). We focus, as did the parties, on the functionality claim.

The Registration includes the following description:

> 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 specimens of use are reproduced below:



Petitioner alleges that the Registration, "involves protection of trade dress associated with the Loops Flexbrush flexible handled toothbrush," which, in general, "asserts protection of the three-dimensional, overall appearance of a particular toothbrush design." Pet. ¶20. Petitioner further alleges that the Registration claims the following elements as protected trade dress: (1) a toothbrush with a rounded handle, (2) a general barbell shape, and (3) bowed and tapered sides all of which, according to petitioner, are described as *de jure* functional in the specification and claims of respondent's utility patent (Patent No. 7334286, "the Patent"). Pet. ¶¶21-24.

Respondent, in its answer, denied the salient allegations in support of the claim of functionality, and specifically "denies that a flexible handled toothbrush is a feature of the mark." Ans. ¶20.

The Record

The record automatically includes the pleadings, and the application file for Registration No. 3424304, which is the remaining subject of the petition for

cancellation. Trademark Rule 2.122(b). *Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352 (Fed. Cir. 2012). Petitioner also submitted, by notice of reliance, respondent's utility patent covering the product shown in the drawing of the registration sought to be cancelled. Neither party took testimony or submitted any other evidence.

Petitioner and respondent filed briefs.

The Mark and the Goods

There is no dispute that the Registered mark is a configuration of the goods, i.e., toothbrushes. The drawing and description establish that the Registered mark consists of the overall, three-dimensional appearance of a toothbrush with (1) a rounded handle, (2) a general barbell shape, and (3) bowed and tapered sides.

Petitioner's Standing

Standing is a threshold issue that must be proved by a plaintiff in every inter partes case. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999). Although petitioner did not offer any evidence regarding its standing, petitioner's standing is undisputed by respondent. In fact, citing to allegations made in paragraph 8 of the petition for cancellation, respondent affirmatively states, in its brief, that petitioner and respondent compete as vendors in the market for providing toothbrushes and other oral hygiene items to prisons and other correctional authorities. Def. Br. p.3. Accordingly, petitioner has standing. *See Ritchie v. Simpson*, 50 USPQ2d 1023 (Fed. Cir. 1999); and *Plyboo American, Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633, 1634 (TTAB 1999).

Analysis

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, 58 USPQ2d 1001, 1006 (2001) citing *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 34 USPQ2d 1161, 1163-1164 (1995) (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 214 USPQ 1, 4 n.10 (1982)). Functional matter cannot receive trademark protection. At its core, the functionality doctrine serves as a balance between trademark and patent law. As the Supreme Court explained in *Qualitex*:

> The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature. It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time, 35 U.S.C. §§ 154, 173, after which competitors are free to use the innovation. If a product's functional features could be used as trademarks, however, a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever (because trademarks may be renewed in perpetuity).

Qualitex Co. v. Jacobson Prods. Co. Inc., 34 USPQ2d at 1163.

We consider the following four factors in determining whether a product design is *de jure* functional: (1) the existence of a utility patent that discloses the utilitarian advantages of the design; (2) advertising by the defendant touting the utilitarian advantages of the design; (3) the availability of alternative designs; and

(4) facts pertaining to whether the design results from a comparatively simple or inexpensive method of manufacture. *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 213 USPQ 9, 15-16 (CCPA 1982); *see also Valu Eng'g Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1426 (Fed. Cir. 2002).

Our determination of functionality is, at bottom, a question of fact that depends on the totality of the evidence. *Valu Eng'g Inc. v. Rexnord Corp.*, 61 USPQ2d at 1424 (Fed. Cir. 2002). Further, our primary reviewing court has instructed that "[w]henever a proposed mark includes both functional and non-functional features . . . the critical question is the degree of utility present in the overall design of the mark." *In re Becton, Dickinson and Co.*, 675 F.3d 1368, 102 USPQ2d 1372, 1376 (Fed. Cir. 2012).

Petitioner's remaining claim for cancellation rests entirely on the first *Morton-Norwich* factor, namely, the existence of respondent's Patent for a "Toothbrush and Methods of Making and Using Same". Neither party presented evidence, and petitioner did not present any arguments, on the other *Morton-Norwich* factors. Respondent, in its brief, argues that "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," and the design does not result from a comparatively simple or inexpensive method of manufacture. Resp. Br. p.7 (emphasis in original). We therefore conclude that there is no advertising by the respondent touting the utilitarian advantages of the design, and that the design does not result from a

comparatively simple or inexpensive method of manufacture. While the background section of the Patent discloses an alternative design of a toothbrush that can be used safely in prisons, and we note respondent's further argument in its brief that "it would be illogical to suggest that any facts exist as to the unavailability of alternative designs," *id.*, petitioner does not rely on this disclosure at any time in this proceeding. Therefore, we do not have sufficient information to determine whether the disclosure is probative. In light of the foregoing, we treat these three factors as neutral. Our focus, therefore, is on the first factor.

The Supreme Court addressed the evidentiary value of a utility patent, concluding that it:

> has vital significance in resolving the trade dress claim. A utility patent is strong evidence that the features claimed therein are functional... Where the expired patent claimed the features in question, one who seeks to establish trade dress protection must carry the heavy burden of showing that the feature is not functional, for instance by showing that it is merely an ornamental, incidental, or arbitrary aspect of the device.

TrafFix Devices Inc. v. Marketing Displays Inc., 58 USPQ2d at 1005.

In determining functionality, we may consider the claims and disclosures in the patent. *See In re Bose*, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985); and *In re Howard Leight Industries LLC*, 80 USPQ2d 1507, 1511 (TTAB 2006).

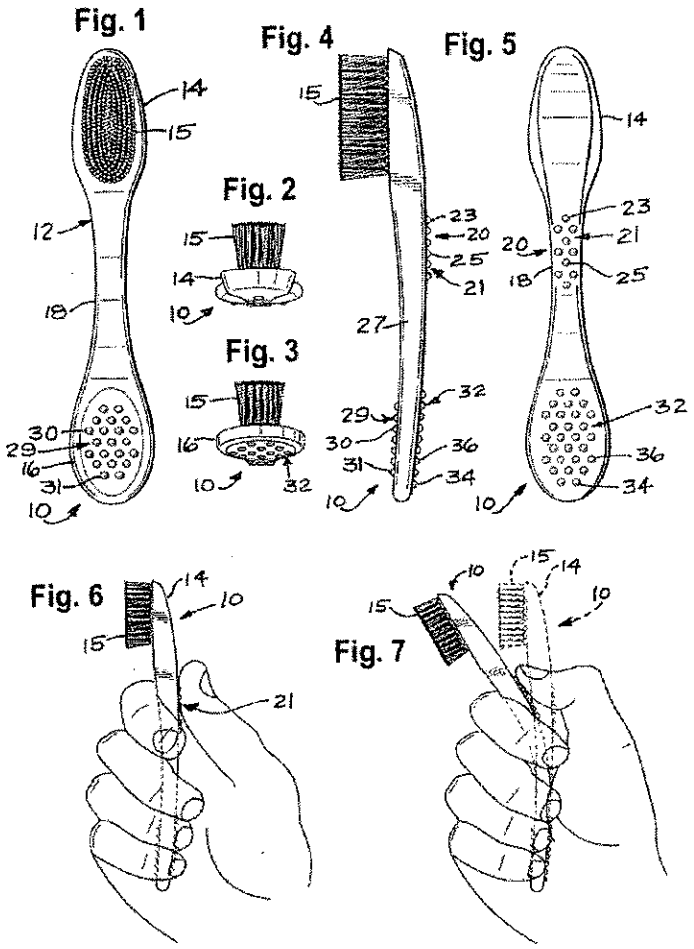
The Patent Abstract describes a toothbrush:

> wherein an elongated body has a bristle brush head portion and a handle portion. The body is composed of flexible material so that the handle portion can be grasped in the hand of the user, and the user can flex the elongated body into a substantially rigid position for teeth brushing purposes.

The "Field of the Invention" describes "such a toothbrush, which is compact in size and may be safely used by prison inmates."

The Patent includes the following seven drawings of the toothbrush:

U.S. Patent Feb. 26, 2008 US 7,334,286 B2



The figures are described as depicting: "a plain view of the underside of a toothbrush, which is constructed according to an embodiment of the invention" (Fig. 1); "a front end view of the toothbrush" (Fig. 2); "a rear end view of the toothbrush" (Fig. 3); "a side end view of the toothbrush" (Fig. 4); "a plain view of the top side of

the toothbrush of FIG. 1" (Fig. 5); and "reduced scale views similar to FIG. 4, illustrating it in the process of being used" (Figs. 6 and 7).

According to the Patent, figures 1-5 of the drawings show:

> [a] toothbrush **10**, which may be constructed in accordance with an embodiment of the invention. The toothbrush **10** includes an elongated body **12** having a bristle brush head portion **14** having a bristle brush **15** extending therefrom. The elongated body **12** includes a handle portion **16** and a narrowed intermediate portion **18** integrally connecting the head portion **14** and the handle portion **16**.

Further, "[a]s best seen in FIG. 4, the body **12** has a slightly curved side edge or curved aspect **27** between the head portion **14** and the handle portion **16**, to help facilitate the flexing of the body **12** by the hand of the user."

The following explanation in the Patent divulges the utilitarian purposes of respondent's configuration of the goods:

> Many conventional toothbrushes are designed with a lengthy handle, usually with some ergonomic design, but usually with an overall design to condition the user to grasp the handle with the entire hand and bring the entire stiff handled device to bear force and pressure on the teeth and gums. Such operation may cause pain and excessive wear and abrasion to teeth and gums. The disclosed embodiment invention eliminates or lessens much of those negative characteristics. The user of the flexible handled toothbrush **10** can use much less force and pressure on teeth and gums with a small amount of pressure using the digit such as the thumb or index finger, to guide the head portion **14**. Such construction tends to eliminate the use of the entire hand to manipulate a long, stiff conventional handle that is designed to be used with the entire hand and requiring ergonomic design to lessen the negative features of having to grasp with the entire hand a handle and twisting the wrist. A conventional long handled toothbrush requires twisting or manipulation of the hand and wrist. Whereas,

> the toothbrush **10** uses more manipulation of the digits and less wrist action to place the flexible head portion **14** onto the teeth to be cleaned.

Further, the "Background Art" section describes the problem facing prisons and other correctional facilities in "prevent[ing] the use of [an] otherwise safe device as a weapon." Many prison systems do not permit use of conventional toothbrushes "because they may be fashioned into a pointed shaft or rod or otherwise used as a shank for a sharp object such as a razor blade, which could be used to endanger other inmates as well as security personnel." The "Background Art" section further describes respondent's toothbrushes as a safer alternative to conventional toothbrushes, because respondent's toothbrushes use flexible material that is difficult to fashion into a shank.

Petitioner argues that the Registered mark is *de jure* functional because the scope of the Patent extends to the functional characteristics of (1) a rounded handle, (2) a general barbell shape, and (3) bowed and tapered sides claimed in the Registration. However, respondent posits that the "specific combination of all of the features of the '304 Mark, functional and distinctive, is what the USPTO granted [respondent] trade dress protection for, and not simply the three elements asserted by [petitioner]", and the "specific combination of all of the features" results in a non-functional mark. Resp. Br. p.7. In support of this position, respondent points to the three-dimensional, overall appearance of the Registered mark, and what it contends is the "highly detailed" description of "a rear end portion being larger than the front end portion," specifically arguing that "while a barbell shape may have some

functionality, an irregular, asymmetrical barbell shape cannot be related to functionality in any way." Id. p.6.

As the chart below makes clear, Claims 1 and 17 in the Patent claim the essential features, and explain the utilitarian purpose, of the Registered mark, including its three-dimensional, overall appearance:[2]

Registration	Patent
Three-dimensional, overall appearance of a toothbrush	"A toothbrush comprising: an elongated body having an enlarged smoothly rounded bristle brush head portion and a handle portion the elongated body has a top side and a bottom side, the elongated body has a length along the longitudinal axis, a width along the top and bottom side extending perpendicular to the longitudinal axis and a thickness extended perpendicular to the longitudinal axis between the top and bottom side of the body;"
Rounded handle	"the handle portion being pliable and flexible along its entire length and including an enlarged smoothly rounded bulbous handle end portion to facilitate handling of the toothbrush and ... "
General barbell shape	"...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 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."
Bowed and tapered sides	"A toothbrush according to claim 1, wherein the body has a curved edge extending between the brush head and the handle portion." [Claim 17]

[2] All quotations in the chart are directly from Claim 1 in the Patent, unless otherwise noted.

	"the thickness of the elongated body at the head portion being tapered and increasing toward the intermediate portion, and at the intermediate and end portions being smoothly continuously tapered and smoothly continuously decreasing toward a narrowed tip of the end portion wherein the thickness of the elongated body is greatest at the intermediate portion;" "wherein the flexibility of the material requires a manually applied external force by the digit of the hand of the user holding the toothbrush to flex the handle portion substantially along its entire length to make the body sufficiently rigid to facilitate use of the toothbrush for teeth brushing purposes." "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."

Ultimately, we find that the Patent discloses the utilitarian advantages of the Registration, and claims the same, i.e., the overall combination of the rounded handle, general barbell shape and bowed and tapered sides results in a toothbrush that is safer than a conventional toothbrush for use in prisons and other correctional institutions, and easier for the user to hold in one hand, thereby enabling the user to clean his or her teeth more thoroughly and efficiently than competing toothbrushes. Even assuming, arguendo, that the general barbell shape is not functional, the Patent makes clear that utilitarian concerns dictate the overall design of the Registered mark. *See In re Becton, Dickinson and Co.*, 102 USPQ2d at 1376; *Textron, Inc. v. U.S. Int'l Trade Comm'n*, 753 F.2d 1019, 1025, 224 USPQ 625, 628-29 (Fed. Cir. 1985); *In re Vico Prods Mfg. Co.*, 229 USPQ 364, 368

(TTAB 1985). We are not persuaded by respondent's argument that the "specific combination of all of the features of the '304 Mark, functional and distinctive, is what the USPTO granted [respondent] trade dress protection for, and not simply the three elements asserted by [petitioner]", and the "specific combination of all of the features" results in a non-functional mark." Claim 1 of the Patent claims each of these three features.

As noted above, because neither party has made any evidence of record as to two of the other three *Morton-Norwich* factors, and petitioner does not point us to any alternative designs, we consider these factors neutral. In any event, as stated previously, "a utility patent is strong evidence that the features claimed therein are functional." *TrafFix Devices Inc. v. Marketing Displays Inc.*, 58 USPQ2d at 1005. Thus, the existence of the Patent is highly probative, and weighs heavily in favor of our finding that the Registered mark is *de jure* functional.

Decision: The petition for cancellation is granted. Registration No. 3430304 will be cancelled in due course.