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EXAMINER BRIEF

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# UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION SERIAL NO. 77418246

MARK:



CORRESPONDENT ADDRESS:

CHARLES R CYPHER  
LAW OFFICES OF JAMES R CYPHER  
409 13th STREET 11TH FLOOR  
OAKLAND, CA 94612

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: Sutro Product Development, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

SPD-0002

CORRESPONDENT E-MAIL ADDRESS:

trademarks@cypherlaw.com

## EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed from the final refusal to register a proposed sound mark, described as “a series of three, regularly spaced, repeated clicks, wherein the clicks resemble the sound of a small metal object striking another metal object” for “eye glasses; optical glasses; sun glasses” in International Class 9. Registration was refused pursuant to Trademark Act §2(e)(5), 15 U.S.C. §1052(e)(5), on the basis that the proposed mark, when used on or in connection with the identified goods, comprises a feature of the identified goods that serves a utilitarian purpose.

### FACTS

On March 10<sup>th</sup>, 2008, applicant applied to register the proposed sound mark for “eye glasses; optical glasses; sun glasses” in International Class 9.

On November 8<sup>th</sup>, 2008, the examining attorney refused registration under Trademark Act §2(e)(5), 15 U.S.C. §1052(e)(5), on the basis that the proposed mark,

when used on or in connection with the identified goods, comprises a feature of the identified goods that serves a functional or utilitarian purpose. Registration was also refused pursuant to Trademark Act §§1, 2, and 45, 15 U.S.C. §§1051-1052 and 1127, on the basis that the proposed mark, when used on or in connection with the identified goods, does not function as a trademark to identify and distinguish applicant's goods from those of others and to indicate their source.

On May 8<sup>th</sup>, 2009, applicant submitted arguments against both the §2(e)(5) functional refusal and the §§1, 2, and 45 failure to function refusals, as well as submitted a substitute specimen.

On July 7<sup>th</sup>, 2009, the examining attorney issued a final refusal based on both the functionality refusal and the failure to function refusal.

On January 7<sup>th</sup>, 2010, applicant submitted arguments and evidence in support of a claim of acquired distinctiveness under §2(f) of the Trademark Act based on five years of use, and in the alternative requested that the application be amended to seek registration on the Supplemental Register. Applicant also submitted additional arguments against the §2(e)(5) functionality refusal, and amended the description of the mark to “a series of three, regularly spaced, repeated clicks, wherein the clicks resemble the sound of a small metal object striking another metal object.”

On February 17<sup>th</sup>, 2010, the examining attorney maintained both the §2(e)(5) functional refusal and the §§1, 2, and 45 failure to function refusals, stating that the evidence was insufficient to support a claim of acquired distinctiveness under §2(f).

On August 17<sup>th</sup>, 2010, applicant submitted additional arguments and evidence in support of a claim of acquired distinctiveness under §2(f) of the Trademark Act based on

five years of use, and also maintained the alternative request that the application be amended to seek registration on the Supplemental Register.

On September 10<sup>th</sup>, 2010, the examining attorney accepted the applicant's alternative request to amend the application to the Supplemental Register, and accordingly withdrew the refusal pursuant to Trademark Act §§1, 2, and 45, 15 U.S.C. §§1051-1052 and 1127. The examining attorney once again maintained the final refusal on the basis that the proposed mark, when used on or in connection with the identified goods, comprises a feature of the identified goods that serves a functional or utilitarian purpose under Trademark Act §2(e)(5), 15 U.S.C. §1052(e)(5).

The present appeal follows.

### **ARGUMENT**

**Applicant's proposed sound mark serves a functional or utilitarian purpose, or alternatively, is the natural byproduct of an element that serves a functional or utilitarian purpose.**

The issue in this case is whether the applicant's proposed sound mark comprises a feature of the identified goods that serves a functional or utilitarian purpose. Trademark Act Section 2(e)(5), 15 U.S.C. §1052(e)(5) prohibits the registration of a mark if it is "essential to the use or purpose of the [product]" or "it affects the cost or quality of the [product]." *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33, 58 USPQ2d 1001, 1006 (2001); TMEP §1202.02(a)(iii)(A).

Functionality refusals have not been limited to design elements. A color has been held to be functional if it yields a utilitarian or functional advantage, for example, yellow or orange for safety signs. *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32

USPQ2d 1120 (Fed. Cir. 1994), cert. denied, 514 U.S. 1050 (1995); TMEP §1202.05(b).

Using color as an analogy, sounds must also be refused if the sound yields a utilitarian or functional advantage, or results naturally from a feature providing such an advantage.

Applicant's mark is the sound of a small metal object striking another metal object. The metal objects are struck in order to provide resistance to the hinges on the eyewear so that the temples "lock" into the open or closed position. Applicant's brief states "the click sounds are primarily due to the shape and material of the cam surfaces, the shape and materials of the cam follower that mates with the cam surfaces, and the spring that biases the cam surfaces."<sup>1</sup> The clicking sound is thus functional because the steps necessary to eliminate it would increase the cost of producing the product, or at the very least would require a third party to vary its method of manufacture from the method described under the applicable utility patents.

A determination of functionality is a question of fact, and depends on the totality of the evidence presented in each particular case. *Valu Eng'g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1273, 61 USPQ2d 1422, 1424 (Fed. Cir. 2002); TMEP §1202.02(a)(iv). Additionally, a determination that an applied-for mark is functional constitutes an absolute bar to registration on the Principal or Supplemental Registers, regardless of any evidence of acquired distinctiveness. Trademark Act Sections 2(e)(5) and 23(c), 15 U.S.C. §§1052(e)(5), 1091(c); see *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29, 58 USPQ2d 1001, 1006 (2001); TMEP §1202.02(a)(iii)(A). Applicant's claim of acquired distinctiveness, as well as its alternative offer to amend to the Supplemental Register are thus both rendered moot by the fact that the sound is functional.

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<sup>1</sup> Applicant's brief, p. 9.

**A) Hinges that provide resistance to opening and closing are a functional feature of eyewear**

Although applicant previously argued, “the three click hinge adds nothing functional to the sunglasses,”<sup>2</sup> applicant’s January 7<sup>th</sup>, 2010 Response to Office Action included two United States Patents, Nos. 3837735 and 3957360, which show how cam surfaces in conjunction with a spring-biased cam follower provide resistance to movement of the temples.<sup>3</sup> Utility patents claiming the features at issue are strong evidence of functionality. *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29-30, 58 USPQ2d 1001, 1005 (2001); *see* TMEP §1202.02(a)(iv), (a)(v)(A).

Applicant concedes in its brief, “[a]pplicant agrees that these patents show that a hinge that resists opening and closing is a utilitarian feature,” and “[t]he functional feature that is the subject of the utility patents is the resistance of the hinges.”<sup>4</sup> Patent No. 3837735 describes in its claim of its resistance hinge, a “cooperating cam on the hinge, said cam comprising a camming surface having a pair of spaced recesses in which said spring-biased shoes respectively engage,”<sup>5</sup> and Patent No. 3957360 describes in its claim “a cam element with spring assembly,” and also states “said element is of a metallic material.”<sup>6</sup> As a result, there is no question of fact that eyewear hinges incorporating a cam element and spring that provide resistance to their opening and closing are either functional or utilitarian, or both. The evidence in the record, along with applicant’s admissions, demonstrate that the hinges are, in fact, functional.

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<sup>2</sup> Applicant’s Response to Office Action, August 17<sup>th</sup>, 2010.

<sup>3</sup> Applicant’s Response to Office Action, January 7<sup>th</sup>, 2010, attachment pp. 20-29.

<sup>4</sup> Applicant’s brief, p. 12.

<sup>5</sup> Applicant’s Response to Office Action, January 7<sup>th</sup>, 2010, attachment p. 23, column 2, lines 57-62.

<sup>6</sup> Applicant’s Response to Office Action, January 7<sup>th</sup>, 2010, attachment p. 28, column 2, lines 31-33, 67-68.

**B) The clicking sound is a natural byproduct of the operation of the functional feature**

Applicant argues, “the functional feature that is the subject of the utility patents is the resistance of the hinges -- not the sound the hinges make,” and states, “[n]either of these patents even mention whether the hinges make any sounds when operated.”<sup>7</sup> However, the examiner notes that just because the patents fail to mention a sound does not mean that the actual operation of those hinges does not, in fact, create a sound. Nor does applicant affirmatively state that the hinge mechanisms covered under the patents do not create sound.

To the contrary, the record clearly indicates that the term “FRICTION” means “surface resistance to relative motion, as of a body sliding or rolling; the rubbing of the surface of one body against that of another,” and that one of the major byproducts of friction is sound.<sup>8</sup> Because resistance hinges in eyewear (including hinges similar in kind to the applicant’s) contain cam elements, cam followers, and spring mechanisms that slide, roll, or rub on the surface of each other, the hinges produce friction when in operation. Since sound is a common byproduct of friction, it follows that sound is a natural byproduct of the operation of eyewear hinges. Because applicant’s goods involve a ratcheting hinge mechanism that involves metallic components rubbing against each other to provide resistance, the sound produced is merely a natural byproduct of the friction created by the functional hinge mechanism, and any similar design will naturally produce a similar or even identical sound.

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<sup>7</sup> Applicant’s brief, pp. 11-12.

<sup>8</sup> See evidence from September 10<sup>th</sup>, 2010 Outgoing Office Action, attachment pp. 2-8.

In order to reduce or eliminate the sound, applicant would have to develop a system to either greatly reduce the friction created when operating the hinge mechanism, which could be achieved through the addition of lubricants or bearings, or shield or cover the mechanism in order to muffle the sound created. However, either adding lubricants or bearings to greatly reduce the friction, or shielding the mechanism to muffle the sound would unequivocally increase the difficulty and cost of manufacturing the product.<sup>9</sup>

Applicant also states, “there is at least one other way to reduce friction which is to reduce the forces holding the two surfaces together,” and “suggests polishing surfaces or inclining a surface.”<sup>10</sup> These processes would also increase the cost because the surfaces in the hinge would need to be polished or planed before assembly. Performing any of these friction-reducing operations would add a step to the manufacturing process, thus increasing manufacturing time and/or cost. Thus, the current sound emanating as a result of the operation of the hinges is a functional feature of the goods.

Put another way, because the clicking sound naturally emanates as a result of the friction caused by the surfaces within the functional resistance hinge rubbing or striking against each other, and because eliminating such a sound would require an additional step in the manufacturing process, the sound itself is also a functional feature of the goods.

**C) Applicant’s advertising material promotes the utilitarian advantages of the “Three Click Hinge.”**

Applicant’s own advertising is strong evidence that the matter sought to be registered is functional when it extols specific utilitarian advantages of the applied-for

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<sup>9</sup> See evidence from September 10th, 2010 Outgoing Office Action, attachment pp. 9-18.

<sup>10</sup> Applicant’s brief, p. 10.



product. TMEP §1202.02(a)(v)(B); *see, e.g., In re Gibson Guitar Corp.*, 61 USPQ2d 1948 (TTAB 2001).

Applicant's advertising states that the three click hinge is functional and serves as an advantage over other sunglasses. For example, applicant's advertising states, "[w]e've introduced the Ratchet Hinge™, a combination of form and function that is unmatched in strength, durability and fit," and that the hinge is "integrated into the frame for incredible strength and durability," and that it "allows the use of a lighter, more comfortable spring, keeping the frame centered on the face without oppressive pressure."<sup>11</sup>

Furthermore, applicant's own submitted advertising states "the new Three Click Hinge used in this collection addresses the weakest point in conventional eyewear construction. The hinge uses a revolutionary 3-D lance design that anchors the hinge into the frame from all directions," and goes on to state that the "Three Click Hinge" is "10X stronger than a conventional hinge."<sup>12</sup>

Applicant argues that such advertising "only means that the hinge... is strong, not that the hinge is stronger because it makes a sound."<sup>13</sup> However, nothing in the record would explain why consumers would encounter the phrase "Three Click Hinge," and go on to *only* relate the utilitarian advantages to the term "Hinge." To the contrary, since nearly all eyewear contains a hinge mechanism, consumers would regard the "Three Click" element as having the utilitarian advantage of being "unmatched in strength, durability and fit."

## **CONCLUSION**

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<sup>11</sup> See July 7<sup>th</sup>, 2009 Outgoing Office Action, attachment pp. 2, 5, and 7.

<sup>12</sup> *Id.*

<sup>13</sup> Applicant's brief, pp. 14-15.

The record clearly shows that 1) the sound sought to be registered is a natural result of the friction caused by two metal surfaces rubbing or sliding against each other in an eyewear hinge that provides resistance; 2) the applicant agrees that a hinge that resists opening and closing is a utilitarian feature; and 3) because taking steps to reduce friction and/or muffle the mechanism in an attempt to eliminate the natural resulting sound would add an extra step to the manufacturing process. The final refusal issued due to the mark serving a functional or utilitarian purpose under Trademark Act §2(e)(5), 15 U.S.C. §1052(e)(5) should thus be upheld.

Respectfully submitted,

/Jason Paul Blair/  
Examining Attorney  
Law Office 104  
Phone - (571) 272-8856  
Fax - (571) 273-8856

Chris Doninger  
Managing Attorney  
Law Office - 104