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

Proceeding	77418246
Applicant	Sutro Product Development, Inc.
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Before the Trademark Trial and Appeal Board

In re Applicaton of:	}	
Sutro Product Development, Inc.	}	
Serial No. 77/418,246	}	Law Office 104
	}	
Filed: March 10, 2008	}	Examining Attorney:
Trademark: (a sound mark)	}	Jason Paul Blair

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Reply Brief for Appellant

Applicant would like to thank the Examiner for his Brief filed January 26, 2011. While most of the points raised by the Examiner were already addressed by Applicant in its original brief, Applicant would like to address a few of the statements made by the Examiner in support of his argument regarding whether the design results from a competitively simple, cheap or superior method of manufacturing.

The Examiner argues that sound is a natural by-product of the friction inherent in the operation of Applicant’s resistance hinge, and that it would add to the cost of the hinge to eliminate the sound.

In response Applicant would first like to say that Applicant agrees with the Examiner that the distinct sound produced by the operation of Applicant’s resistance hinge is a natural by-product of the friction developed between the cam surface and the cam follower of Applicant’s hinge.

However, Applicant disagrees with the Examiner to the extent that the Examiner suggests that competitors would be placed in a significant non-reputation-related disadvantage, if Applicant developed trademark rights in the distinct sound its resistance hinge makes.

At page 5, line 17, of his brief, the Examiner seems to suggest that resistance hinges normally make distinctive sounds like the Applicant’s. If this is the Examiner’s suggestion, it is simply not true. As noted in Jeff Sand’s declaration of January 6, 2010, at page 2 line 18: [I]t is my experience that most, if not almost all, commercially available spectacles do not make an appreciable sound when the temples are folded against the frames or opened for wearing.”

Resistance hinges for spectacles have been available to consumers at a reasonable price long before Applicant used its mark, and if Applicant develops trademark rights in its mark, competitors will continue to be able to offer spectacles with resistance hinges at competitive prices.

At page 2, line 28, of his brief, the Examiner states: “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.”

While it is true that if Applicant wanted to silence or eliminate the clicking sounds produced by its resistance hinge, and Applicant could not replace the components of its resistance hinge with alternate components or develop an alternate design, then Applicant would have to modify its hinges either by grinding down the cam surface and the cam follower, or adding a lubricant and this would add to Applicant’s cost of the hinge; however, this is not the test for functionality, and it would be unreasonable for a competitor to adopt such an approach to avoid using Applicant’s mark. Applicant, or a competitor, can use replacement components or utilize cam surfaces and cam followers that are designed differently from the start rather than modifying Applicant’s design, and as such could make a resistance hinge that sounded different, but was no more expensive than Applicant’s.

The utility patents submitted by Applicant show resistance hinges with alternate cam surfaces and cam followers that even if they produced audible sounds would produce sounds different from that of Applicant’s mark. Contrary to what the Examiner says, a third party could use the method of manufacture described in the utility patents (both of which have expired) to make a resistance hinge that would compete with Applicant’s but not produce Applicant’s mark.

Applicant believes on this point the factual record is clear, competitors would not be placed at a non-reputation-related disadvantage, and the Examiner argument is unsubstantiated.

Conclusion

Applicant respectfully renews its request for allowance of the application on the Supplemental Register. Applicant’s mark is not “functional”, the sound emitted by the hinge of its glasses can serve as a mark, and Applicant has used this sound as a mark in commerce, and thus registration on the Supplemental Register is proper.

Respectfully submitted,

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CERTIFICATE OF TRANSMISSION 37 CFR 1.8(a)(1)(C)

I hereby certify that this correspondence, including listed enclosures, is being transmitted to the United States Trademark Office via the Trademark Office’s Electronic Filing System (TEAS) on February 15, 2011.

Signed: /s Charles R. Cypher/