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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77418246
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In the United States Patent and Trademark Office
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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Brief for Appellant

Introduction

The following arguments are in response to the Final Office Action of the Examiner transmitted September 10, 2010, following a Request for Reconsideration and Appeal filed by Applicant on January 7, 2010. Applicant hereby appeals from the Examiner’s refusal to register the above-identified mark, and respectfully requests that the Trademark Trial and Appeal Board reverse the Examiner’s decision.

Statement of Facts

Applicant filed the present application on March 10, 2008, for eyeglasses, optical glasses and sun glasses, alleging first use in commerce

as early as February 24, 2006. The description of the mark in the original application was as follows: “The mark is a sound. The mark consists of a series of regularly spaced, repeated clicks, wherein the clicks resemble the sound of small metal object striking another metal object.”

On November 8, 2008, the mark was rejected in a first office action. The Examiner found no likelihood of confusion, but rejected it for two other reasons. First, the Examiner found the mark to be functional and thus barred from registration. Second, the Examiner found that the mark because of its nature did not function as an indicator of source. The Examiner argued that the mark was functional because the sound resulted from the hinge’s resistance to movement, and because the sound served as an audible signal that the glasses were either opened or closed. The Examiner argued that the mark did not serve as a source indicator, because users would only perceive the sound as either a functional feature of the hinges resistance to opening and closing or as an audible signal that the glasses were opened or closed.

On May 8, 2009, Applicant responded to the office action, arguing that the mark served to distinguish the goods, and that the sound provided nothing that was either essential or advantageous to the goods. Applicants also provided a video showing how the sound was produced by the operation of the hinge.

On July 7, 2009, the Examiner renewed his rejections, making them final. With the final rejection, the Examiner submitted evidence of

Applicant's own advertising, arguing that Applicants statements that the hinge was a superior design showed that the mark was functional. The Examiner also added to his argument that the mark did not serve as an indicator of source by citing *In re Vertex LLC*, 89 USPQ2d 1964 (TTAB 2009) and *Nextel Communications, Inc. v. Motorola, Inc.* TTAB Opposition No. 91164353 (June 12, 2009) for the proposition that sounds emitted by goods in their normal course of operation do not function as trademarks.

On December 28, 2009, Applicant filed a new Power of Attorney.

On January 7, 2010, Applicant filed the current appeal and simultaneously therewith a Request for Reconsideration. In the Request, Applicant amended the definition of goods to further specify that the mark was “a series of three, repeated clicks”. Applicant also amended the application to seek registration on the Supplemental Register, if the Examiner found the Applicant's arguments of inherent or acquired distinctiveness unconvincing.

With its Request, Applicant provided the declaration of Jeff Sand who designed the spectacles for which the sound serves as a mark and in particular the hinge that makes the sound. Mr. Sand is a recognized product designer with over 15 years of experience in the industry. Of particular importance, Mr. Sand noted that temple hinges that resist movement do not need to make sounds to function, that commercially competitive, alternative designs were readily available and are known to competitors who want to

make hinges that resist movement that either produce sounds or not, and that Mr. Sand’s decision to have the hinge make the three click sound that is the subject of the application did not result in a more cost effective design. Mr. Sand also noted that certain statements found by the Examiner in Applicant’s own advertising that said that the hinge was the subject of a patent and that the design of the hinge allowed Applicant to use a lighter spring were, in fact, inaccurate.

Applicant also provided evidence that the sound is perceived as a mark and that Applicant is educating consumers to perceive the sound as an indicator of source.

Applicant also argued that the mark was inherently distinctive on the basis of Mr. Sand’s declaration that showed that applicant had used the mark exclusively for glasses since September of 2004, and that Applicant was unaware of any glasses that produced any appreciable sound when the hinges were operated. In the alternative, Applicant submitted evidence showing that the sound was perceived as a mark and so the mark had acquired distinctiveness.

On January 7, 2010, the Board accepted the appeal and suspended any action on the appeal, while the Request for Reconsideration was remanded to the Examiner.

On February 17, 2010, the Examiner issued another office action, maintaining his objections that the mark was functional, that users would

not perceive the sound of a metal object striking another metal object during the operation of a hinge that resists movement as a mark, and that users would use the sound to inform them as to whether the hinges were open or closed, not as an indicator of source. The Examiner also maintained that case law supported the proposition that sounds produced by goods in their normal course of operation do not function as marks. The Examiner also continued his argument that Applicant's own advertising pointed to the functionality of the mark. The Examiner also found Applicant’s evidence of acquired distinctiveness unconvincing.

Applicant filed its response to the office action on August 17, 2010, with additional evidence of use of the sound as a mark. Applicants also renewed and expanded on all of its previous arguments.

On September 10, 2010, the Examiner renewed the rejection on the basis of functionality. Unconvinced that the mark was either inherently distinctive or had acquired distinctiveness, the Examiner entered Applicant’s request for amendment to the Supplemental Register, and as result the Examiner withdrew the rejection that the mark did not function as a mark. The Examiner’s rejection of the mark as being functional remains the only issue on appeal. The Examiner has also dropped any arguments that the sound itself was a functional feature of the goods. The Examiner now only argues that the hinge is a functional feature of the goods because the

sounds produced by the hinge are a necessary product of the operation of the hinge.

On September 14, 2010, the Board resumed the appeal, giving Applicant 60 days or until Saturday, November 13, 2010 to file its brief.

This Brief is being filed on the next succeeding business day on November 15, 2010, making it a timely filing.

ISSUE

Whether the sound made by the operation of a spectacle hinge that provides some resistance to the opening and closing of the ear temples is dictated by functional features and as such cannot be registered as a trademark?

AUTHORITIES

Section 1052 of the Lanham Act provides that, “No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it — ... (e) Consists of a mark which ... (5) comprises any matter that, as a whole, is functional. 15 U.S.C. §1052(e)(5).

The Supreme Court in the *Qualitex* case has defined functional in the following manner: “This Court consequently has explained that, “[i]n general terms, a product feature is functional,” and cannot serve as a trademark, “if it is essential to the use or purpose of the article or if it affects the cost or quality of the article,” that is, if exclusive use of the feature would put

competitors at a significant non-reputation-related disadvantage. *Inwood Laboratories, Inc.*, 456 U.S., at 850, n. 10.” *QualitexCo. v. Jacobson Prods. Co.*, 34 USPQ2d 1161, 1163-1164 (US 1995).

In an ex parte examination of an application, the Examining attorney has the initial burden of establishing a prima facie case of functionality. *In re. R. M. Smith, Inc.*, 222 USPQ 1 (Fed. Cir. 1984).

The Court of Customs and Patent Appeals has said that evidence of functionality generally falls into the following four categories:

1. The existence of a utility patent which discloses the utilitarian advantage of the design is evidence of functionality.
2. The existence of any advertising or promotion of the proponent or trademark rights which touts the functionality and utilitarian advantages of the very design aspect it now seeks to protect.
3. The existence of other alternative designs which perform the utility function equally well, and
4. Whether or not the design results from a competitively simple, cheap or superior method of manufacturing the article. See *In re Morton-Norwich Products Inc.*, 213 USPQ 9 (CCPA 1982).

ANALYSIS

As noted in the Statement of Facts, the Examiner is no longer attributing any functional features to the sound itself. The only basis remaining for the rejection is that the sound is a necessary by-product of a

functional feature and as such cannot be registered. The Examiner has identified the resistance the hinge provides to opening and closing as the functional feature that dictates the sound Applicant seeks to register.

The Examiner makes the following argument. The resistance provided by the hinge against the opening and closing of the temples is a functional feature of goods. The resistance to opening and closing of the hinges is due to friction. The sound which applicant seeks to register is a natural byproduct of the friction created by the functional feature. It would increase the cost to manufacture the product to eliminate the sound, therefore the sound is a functional feature.

The argument made by the Examiner is flawed. First, and most importantly, the statement that it would increase the cost to manufacture the product to eliminate the sound is unsubstantiated and is contradictory to the declaration in evidence provided by Mr. Sand, dated January 6, 2010.

Mr. Sand is an award-winning product designer with over 15 years of experience. As Mr. Sand stated in his declaration at page 1, line 17, “The series of regularly spaced, repeated clicks produced by the spring hinge used in Sutro Vision eyewear when the temples of the spectacles are moved from a fully opened to a fully closed position and visa versa is not a feature of the product that is essential to the use of purpose of the article, or affects the cost or quality of the article....” At page 1, line 29, Mr. Sand goes on to say, “There is no need for movement of the cam follower with respect to the

cam surface to produce a sound for the cam follower and cam surface to provide resistance to movement.” Most importantly, Mr. Sand states, “[O]ther spring hinges could be economically designed to make numerous variation of click sounds rather than the series of regularly spaced, repeated clicks in Sutro Vision eyewear. 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. If the profiles or transitions of these mating surfaces are smooth then almost all appreciable sound of the parts moving against each other can be eliminated, such that no “clicks” are produced. It would be possible to make some of the grooves in the cam surface smooth and others abrupt such that as the temples are moved from opened to closed position there could be variations in the number as well as the spacing of the clicks. There could be no clicks, one click, or, I believe, as many as five clicks. A competitor designing such a hinge would not have to add to the cost of his hinge to create these variations in sounds.” Declaration of Mr. Sand at page 2, line 25.

To support his argument that it would add to the expense of the product to eliminate the sound, the Examiner cites an article from the Cornell Center for Materials Research, that lists a number of ways to reduce friction, yet the Examiner only cites the two ways that would require the addition of materials to the design: adding lubricants and/or adding bearings. The

Examiner then goes on to conclude that adding lubricants and bearings is the only means to make a silent hinge that resists movement and that this would add to the cost of the goods. Neither of these conclusions are reasonably drawn from the article cited by the Examiner. For example, the Examiner fails to mention the first solution suggested by the article which is the very same solution provided by Mr. Sand in his declaration. Obviously there is at least one other way to reduce friction which is to reduce the forces holding the two surfaces together, and according to Mr. Sand it is a cost-effective method. The article specifically suggests polishing surfaces or inclining a surface, Mr. Sand suggested smoothing the profiles and transitions of the surfaces. Not only does the evidentiary record not support the Examiner’s conclusion, it contradicts it.

Applicants also believe the Board can take judicial notice that many spectacles available on the market today provide resistance to the opening and closing of the temples, and yet Applicant is aware of only its own spectacles as having a hinge that makes a distinctive sound. See the declaration of Mr. Sand at page 2, line 16. This is strong evidence that hinges for spectacles can be economically manufactured which resist opening and closing that do not produce sounds.

Applicant also asks that the Board review all of the factors that can be used to determine functionality. Applicant believes that the record supports

a finding that the mark is not functional and that the Examiner has failed to make even a prima facie showing of functionality.

The fact that the sound produced by the hinge is not a required by-product of the resistance provided by the hinge can be seen when one looks at the evidence typically used for determining whether a feature is functional. As noted above, according to the Supreme Court, not all functional features are barred from registration. Only functional features that result from or are dictated by practical design considerations, impart a competitive advantage, or add to the cost or quality are barred. Applicant’s sound that is produced by a hinge that resists movement has none of these attributes.

As stated by Jeff Sand in his declaration the hinge could have been designed so as to not produce any sound and it still could have all of its functional features. In fact, the design features of the spring hinge in Sutro Vision eyewear that create sound when the spring hinge is operated do not create or have an appreciable effect on the spring hinge’s resistance to moving. See the declaration of Jeff Sand at page 2, line 11. Thus, while the hinge produces the sound, the sound is not dictated by the functional features performed by the hinge.

As additional evidence of this fact, Applicant has made two utility patents of record that teach hinges with cam surfaces that resist opening and closing of the temples. Neither of these patents even mention whether

the hinges make any sounds when operated. As such it is reasonable to draw the conclusion that sound is not a necessary by-product of hinges that make sound.

The Examiner actually sites these patents as support for his argument that the functional feature is the subject of a utility patent. Applicants agree that these patents show that a hinge that resists opening and closing is a utilitarian feature; however, the key question here is whether applicant’s mark is dictated by a utilitarian feature, and in this respect the patent applications are evidence that it is not. The functional feature that is the subject of the utility patents is the resistance of the hinges not the sound the hinges make. Utility patents are only evidence of functionality when the utility patent shows the feature in question to be a useful part of the invention. *TrafFix Devices, Inc. v. Marketing Display, Inc.* 58 USPQ 2d 1001 (US 2001). These patents do not show applicant’s sound or any sound to be a useful part of the function of the hinges and as such they support Applicant’s argument that the sound is not functional.

What the patents do show is that there at least two different ways to make a hinge that resist opening and closing, and as both of these patents have expired they are clear evidence that Applicant cannot through its mark appropriate to itself hinge designs that resists opening and closing.

Applicant also asks the Board to take judicial notice that there are many commercially successful eyewear companies that do not sell eye wear

that have temples with hinges that resist opening and closing. As such, the utilitarian feature the Examiner argues dictates the mark is itself not even essential to the class of goods for which Applicant seeks registration.

Finally, exclusive use of the series of three clicks would not put competitors at a significant non-reputation-related disadvantage. As stated by Jeff Sand at page 2, line 24 of his declaration, competitors can easily make hinges that provide resistance to the opening or closing of temples without using the mark, and if for some reason, competitors wanted to provide their hinges with an audible sound, other sounds are readily available to competitors without adding any cost.

The Examiner, in support of this argument, also maintains that Applicant’s own advertising shows that the sound is functional. Applicant respectfully disagrees. None of the advertising cited by the Examiner attributes any function to the sound made by the hinges. The advertising in question merely describes the hinges as having beneficial design features, none of which have anything to do with the sound. The hinges are referred to as being able to produce sound, Applicant has coined the name “Three Click Hinge” for the hinge, but this does not mean that the various functional aspects of the hinges touted in the advertising are the result of or are related to the sounds made by the hinges.

The statement that “[w]e’ve introduced the Ratchet HingeTM, a combination of form and function that is unmatched in strength, durability

and fit” says nothing about any alleged function of the sounds produced by the hinge or how or why sounds are produced by the hinge. Similarly, the statement that the hinge is “integrated into the frame for incredible strength and durability” has nothing to do with the sounds produced by the hinge or even with the hinge's resistance to opening and closing.

The Examiner also notes that Applicant's advertising says that the design of the hinge “allows the use of a lighter, more comfortable spring, keeping the frame centered on the face without oppressive pressure”. Again, nothing in this statement says anything about sound, and in fact, Mr. Sand in his declaration at page 3, line 3 retracted this statement, saying that he merely chose to use a relatively light spring rather than the design of his hinge allowed him to use a lighter spring.

The Examiner cites two other statements made by Applicant in its advertising. The first is that “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.” In this statement, it is the “3-D lance” shape of the hinge that is responsible for creating a better anchor in the frame not the fact that the hinge makes a “three click” sound or that Applicant sometimes refers to its hinge by the sound it makes. Similarly, the statement that the “Three Click Hinge” is “10X stronger than a conventional hinge” only means that the hinge which applicant named the “Three Click

Hinge” because of the sound it makes is strong, not that the hinge is ten times stronger than conventional hinges because it makes sound. The Examiner has not shown that there is any relation between the functional and beneficial aspects of Applicant's hinge and the sound it makes.

Conclusion

Applicant respectfully requests 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 November 15, 2010.

Signed: /s Charles R. Cypher/

Table of Cases

In re Morton-Norwich Products Inc., 213 USPQ 9 (CCPA 1982).

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