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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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Our Case No. 7717/138

UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

NEXTEL COMMUNICATIONS, INC.,

Opposer,

v.

MOTOROLA, INC.,

Applicant.

Opp. No.: 91/161,817

App. No.: 78/235,618

Mark: Sensory Mark

APPLICANT'S BRIEF

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I. INTRODUCTION

This opposition proceeding involves Applicant Motorola, Inc.'s application to register a sound mark created and developed by Applicant in 1983 for use in connection with its two-way radio products. The mark consists of an audible electronic tone emitted at 911 hertz and played at a particular cadence ("911 Hz Mark"). This distinctive mark has been used consistently in commerce in connection with Applicant's two-way radios since 1983; long prior to the 1991 first-use date conservatively claimed in the trademark application.

As discussed herein, Applicant's evidence establishes that the mark: (1) has been consistently used in commerce since its inception and is non-functional (Section V. B.); (2) is inherently distinctive—as conceded by Opposer's own testimonial witness Henrik Rasmussen (Section V. C.), or in the alternative; (3) has acquired distinctiveness (Section V. D.).

Opposer Nextel Communications' opposition should be denied because Opposer has failed to meet its burden of proof on the grounds raised in its Notice of Opposition. As an initial matter, Opposer's case has a significant and fatal flaw: Opposer lacks standing to oppose this application. Opposer has failed to offer proof supporting its standing allegations pleaded in its Amended Notice of Opposition. In addition, Opposer's non-use functionality challenges do not pass muster under the evidence in the record and the functionality test followed in the Federal Circuit. Finally, Opposer's distinctiveness challenges are similarly unsupported. Opposer's own witness has testified that Applicant's 911 Hz Mark is distinctive, and Opposer has introduced no evidence to counter Applicant's acquired distinctiveness evidence. Applicant's sound mark is entitled to registration. *See, e.g., Qualitex Co. v. Jacobson Products Co.*, 34 U.S.P.Q.2d 1161, 1162 (1995) (acknowledging sound marks as protectable trademarks).

II. DESCRIPTION OF THE RECORD

A. Opposer's Evidence

Opposer's record consists of:

(1) Opposer's First Notice of Reliance, which includes a file history for a different sound mark application filed by Opposer (Ser. No. 78/575,442) (an 1800 Hz tone), certain designated Applicant's Responses to Opposer's First Set of Interrogatories, certain designated portions of Applicant's Rule 30(b)(6) designee's deposition transcript, certain designated Applicant's Responses to Opposer's First Set of Requests for Admissions, certain designated Applicant's Responses to Opposer's Second Set of Requests for Admissions, certain designated Applicant's Responses to Opposer's Second Set of Interrogatories, certain documents produced by Applicant during discovery, and a portion of a periodical. (This submission will be referred to collectively herein as "Opposer's First Notice of Reliance.");

(2) Opposer's testimony deposition of Henrik Rasmussen, the Radio Systems Manager of Durham, North Carolina;

(3) Opposer's testimony deposition of Thomas Hoyes, an employee of Opposer;

(4) Opposer's Second Notice of Reliance, which includes certain designated portions of Opposer's own Rule 30(b)(6) designee's deposition transcript (This submission will be referred to as "Opposer's Second Notice of Reliance.");¹ and

(5) Opposer's testimony deposition of Dr. Jacob Jacoby, who was designated as a survey rebuttal expert.

B. Applicant's Evidence

Applicant's record consists of:

¹ Applicant requests the Board to strike Opposer's Second Notice of Reliance for the reasons set forth in Section VI. A.

(1) Applicant's Notice of Reliance, which includes certain designated Opposer's Responses to Interrogatories and certain designated portions of Opposer's Rule 30(b)(6) designee's deposition transcript. (This submission will be referred to collectively as "Applicant's Notice of Reliance.");

(2) Applicant's testimony deposition of David Klein, Applicant's Portable Marketing Manager, Radio Systems Division; and

(3) Applicant's testimony deposition of Dr. Michael Rappeport, a consumer survey expert.

III. STATEMENT OF THE ISSUES

The substantive issues before the Board in this proceeding are:

- (1) Whether Opposer has standing to oppose Applicant's 911 Hz Mark;
- (2) Whether Applicant has used the 911 Hz Mark;
- (3) Whether Applicant's 911 Hz Mark is inherently distinctive; and
- (4) Whether Applicant's 911 Hz Mark, if not inherently distinctive, has acquired distinctiveness.

IV. RECITATION OF THE FACTS

Applicant manufactures two-way radios that emit a distinctive audible electronic tone at 911 hertz (the "911 Hz Mark"). (Klein Testimony at p. 8 (lines 10-11).) The distinctive 911 Hz Mark was developed by Applicant's engineers and marketing personnel in 1983 and has been consistently used as a trademark since that date. (Klein Testimony at pp. 32 (lines 7-24) – 33 (lines 1-19) and 38 (lines 6-18).) Applicant's trademark application covering the 911 Hz Mark, the application at issue in this proceeding (Ser. No. 78/235,618), claimed May 1991 as the first use in commerce date due to changes to the technical apparatus that emits the mark from

Applicant's two-way radios, but the perceptible audible tone has remained unchanged since its inception in 1983. (Klein Testimony at pp. 36 (lines 8-24) – 37 (lines 1-14).)

Applicant's 911 Hz Mark serves two purposes in connection with Applicant's two-way radios, which are the goods identified in the application at issue. The first purpose, a non-trademark purpose, is to inform the two-way radio user that a channel is available for communication when the user presses the push-to-talk button. If the user hears the tone, the user knows that the radio is ready for communications. The second purpose is a purely trademark purpose. The 911 Hz Mark tells the user that he or she is using a "MOTOROLA®" product because it is a distinctive tone used for more than twenty years solely by Applicant and solely for use in connection with the push-to-talk feature of its radios. The 911 Hz Mark is a symbol of Applicant's high-quality goods. Applicant has carefully cultivated this trademark purpose by ensuring that the frequency and tone remained consistent from model-to-model since its inception. (Klein Testimony pp. 15 (lines 22-24) – 20 (lines 1-18).)

There is no requirement that a two-way radio manufacturer use a 911 hertz tone, or any audible tone whatsoever, in connection with its goods. The FCC, which regulates two-way radios in the United States, requires only that an LED light indicator is used to inform consumers that a channel is available for communications. Applicant coined and developed its 911 Hz Mark as a distinctive and unique way to accomplish the dual purpose of informing consumers that: (1) a channel is available for communications; and (2) the two-way radio is a "MOTOROLA®" product. In fact, prior to developing the 911 Hz Mark, Applicant did not use any audible tone to indicate that a communications channel was available. Instead, Applicant used only the required LED light indicator. (Klein Testimony at pp. 34 (lines 7-24) – 36 (lines 1-11).)

The 911 Hz Mark is not functional. There is no evidence in the record establishing that the 911 Hz Mark serves a strictly utilitarian purpose or affects the cost or quality of the product. Applicant could have chosen multiple other tones for use in connection with the push-to-talk feature of its two-way radios in 1983, but the 911 Hz Mark was selected for its aesthetic appeal. Other tones could have served the same purpose equally well. Today, with technological advancements, virtually any tone could be used to signify that a channel is available for communication, yet Applicant has consistently used its 911 Hz Mark to continue the tie-in between the radio and its source. (Klein Testimony at pp. 33 (lines 23-24) – 36 (lines 1-11).)

The 911 Hz Mark is inherently distinctive. No other two-way radio manufacturers use this tone. (Klein Testimony at pp. 40 (lines 23-24) – 41 (lines 1-10).) Opposer's own witness, Henrik Rasmussen, testified that Applicant's 911 Hz Mark was "different" from the other audible tones used by Applicant's competitors. Mr. Rasmussen testified that Applicant's products emit a "chirp" sound, while the competitors' products emit a different "beep" sound. (Rasmussen Testimony at 26 (lines 3-24) – 27 (lines 1-2).)

The 911 Hz Mark has acquired distinctiveness. Applicant has used the 911 Hz Mark in commerce since 1983. (Klein Testimony at p. 29 (lines 8-17).) Applicant's sales of two-way radio products under the mark exceed \$100,000,000 annually. (Klein Testimony at pp. 49 (lines 21-24) – 56 and related exhibits 9 and 10.) Applicant promotes the mark in an "experiential" manner at trade shows and sales presentations. (Klein Testimony at pp. 17 (lines 15-24) – 20 (lines 1-18) and pp. 94 (lines 22-24) – 96 (lines 1-15).) Applicant has an annual trade show marketing budget for its two-way radios in excess of several hundred thousand dollars. (Klein Testimony at p. 46 (lines 4-13).) Applicant commissioned a consumer survey expert, Dr.

Michael Rappeport, who found that 42% of the survey respondents recognize the 911 Hz Mark as coming from a single source. (Rappeport Testimony at pp. 35 (lines 22-24) – 36 (lines 1-7).)

Opposer does not manufacture two-way radios or any other goods. Opposer is a telecommunications *service* provider. Opposer does not use a 911 Hz tone in connection with its services, nor does it offer any products that emit a 911 Hz tone. (Applicant's Notice of Reliance at I.A. citing Opposer's Interrogatory Response No. 6.) There is no evidence in the record establishing that Opposer has any plans to offer a product in the future that emits a 911 Hz tone. In fact, Opposer does not offer its services in connection with any "true two-way radio." (Applicant's Notice of Reliance at II.A. citing O'Reilly Dep. Testimony at p. 27 (lines 20-21).) Opposer markets its communications services to the public sector through cellular handset products manufactured by *Applicant*, namely, the "Motorola i870" model. (Hoyes Testimony at p. 8 (lines 9-17).) Those products do not emit the 911 Hz Mark. Applicant's cellular handset products, which Opposer purchases and distributes, emit a different 1800 hertz tone. (Klein Testimony at p. 8.) There is no evidence in the record supporting Opposer's standing allegations pleaded in its Amended Notice of Opposition. (Amended Notice of Opposition at Para. 12.) Similarly, the evidence in the record fails to support Opposer's unpleaded standing allegations raised for the first time in Opposer's Brief. Opposer's evidence of record fails to establish its standing to oppose.

V. ARGUMENT

A. OPPOSER LACKS STANDING

Opposer has failed to introduce evidence sufficient to establish its standing to oppose Applicant's mark. Opposer has presented no evidence in support of the standing grounds pleaded in its Amended Notice of Opposition, namely, that "...Applicant has indicated that it may assert any federal registration it may obtain for the 911 Hz tone against Opposer...."

(Amended Notice of Opposition at Para. 12.) Instead, Opposer's Brief now asserts previously unpleaded arguments claiming that it has standing because it is a "competitor" of Applicant. However, the record contradicts this claim and instead corroborates Opposer's well-pleaded claim that the relationship between Applicant and Opposer is a manufacturer-customer relationship. (Amended Notice of Opposition at Para. 2.)

The Board first brought Opposer's standing deficiency to the forefront in its May 8, 2006 Order denying the parties' cross-motions for summary judgment. In that Order, the Board held that Opposer's original Notice of Opposition contained "vague and conclusory" standing allegations, particularly with respect to Opposer's "real interest." The Board required Opposer to amend its Notice to include sufficient standing allegations. *See* May 8, 2006 Order at 2, 6. In response, Opposer's Amended Notice alleged:

"Opposer has a direct commercial interest in preventing improper federal registration of the 911 Hz tone as a trademark. ... Upon information and belief, Applicant has indicated that it may assert any federal registration it may obtain for the 911 Hz tone against Opposer...." (Amended Notice at Para. 12.)

Although Opposer's Amended Notice may have satisfied the liberal pleading standards applicable to standing as set forth by the Federal Circuit in *Ritchie v. Simpson*, 50 U.S.P.Q.2d 1023 (Fed. Cir. 1999), it has not met its burden of proving these allegations at trial.² Standing, like the substantive grounds, is Opposer's burden for trial. "Allegations in support of standing which may be sufficient for pleading purposes must later be affirmatively proved by the plaintiff at trial...." T.B.M.P. § 309.03(b) *citing Ritchie v. Simpson*, 50 U.S.P.Q.2d at 1029; *Lipton Indus, Inc. v. Ralson Purina Co.*, 213 U.S.P.Q. 185, 189 (C.C.P.A. 1982). At this stage of the proceedings, the inquiry is not whether the pleading of standing is sufficient, but whether these

² Applicant has preserved its standing objection by pleading Opposer's lack of standing and failure to state a claim as affirmative defenses. *See* Applicant's Answer to Amended Notice of Opposition, at Affirmative Defenses A and B.

allegations have been proven. *See Boswell v. Mavety Media Group Ltd.*, 52 U.S.P.Q.2d 1600, 1605 (T.T.A.B. 1999).

Section 13 of the Lanham Act (15 U.S.C. § 1063) sets forth the requirements for standing in an opposition proceeding. “Any party who believes that he would be damaged by the registration of a mark upon the principal register. . . may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor....” 15 U.S.C. § 1063(a). In *Ritchie v. Simpson*, the Federal Circuit held that an opposer must meet two judicially-created requirements to establish standing: (1) the opposer must have a “real interest” in the proceedings; and (2) the opposer must have a “reasonable basis” for his belief of damage. *Ritchie*, 50 U.S.P.Q.2d at 1025-26.

1. Opposer Lacks a “Real Interest”

a. Opposer Failed to Prove the Interest Pleaded in its Amended Notice of Opposition

Ritchie held that the “real interest” requirement means that an opposer is required to have a legitimate personal interest in the opposition. “In other words, the opposer must have a direct and personal stake in the outcome of the opposition.” *Id.* at 1026. In the present case, Opposer’s Amended Notice of Opposition alleges that, “Upon information and belief, Applicant has indicated that it may assert any federal registration it may obtain for the 911 Hz tone against Opposer, by seeking to prevent Opposer from obtaining products that emit the Nextel Chirp from suppliers other than Applicant....” (Amended Notice of Opposition at Para. 12.) However, there is no evidence in the record of this alleged assertion of its 911 Hz Mark by Applicant. There is nothing in the record suggesting that Applicant has asserted, or threatened to assert, its 911 Hz Mark against Opposer. Mere statements in the pleadings do not constitute evidence. *See*

T.B.M.P. § 704.06(a); *Times Mirror Magazines, Inc. v. Sutcliffe*, 205 U.S.P.Q. 656, 662 (T.T.A.B. 1979). This is a fatal flaw to Opposer's standing case.

To understand the significance of this pleading in the context of the evidence in the record, it is important to understand the distinction between the various tones that Opposer refers to in its Amended Notice of Opposition. The tone which Opposer erroneously refers to as the "Nextel Chirp" is emitted at a different pitch or frequency. Specifically, the so-called "Nextel Chirp" is an 1800 hertz tone. (Amended Notice of Opposition at Para. 11.) That 1800 hertz tone is at issue in a separate Board proceeding. In that proceeding (Opposition No. 91/164,353), Opposer has opposed Applicant's pending application to register its 1800 hertz tone as a trademark (Ser. No. 78/235,365). Opposer now attempts to blur the line between this Board proceeding, which involves Applicant's 911 Hz Mark, and proceedings involving the 1800 hertz sound mark.³ The 1800 hertz sound mark—which is not at issue in these proceedings—is emitted by certain cellular telephone handsets manufactured by Applicant. These products differ from the two-way radios at issue in this proceeding. (Klein Testimony at pp. 25 (lines 1-24) – 26 (lines 1-15).) Opposer's standing in the 1800 hertz tone opposition is based upon Applicant's assertion of its 1800 hertz tone trademark—not the 911 Hz Mark—against Opposer in the form of a Letter of Protest.⁴ Applicant did *not* assert the 911 Hz Mark—the mark at issue in these proceedings—in its Letter of Protest or elsewhere.

³ Opposer included papers from the 1800 hertz sound mark in its First Notice of Reliance at Tab A (Opposer's file history for its pending 1800 hertz sound mark (Ser. No. 78/575,442) identifying Applicant's Letter of Protest asserting Applicant's prior 1800 hertz sound mark. Opposer also included allegations regarding its 1800 hertz sound mark application in its Amended Notice of Opposition at Para. 11.

⁴ That Letter of Protest, subsequently granted, was filed against Opposer's subsequent attempt to register an identical 1800 hertz tone in connection with its communications services (Ser. No. 78/575,442).

Though Opposer may arguably have a “real interest” in the 1800 hertz tone, a real interest in the separate 1800 hertz tone proceeding does not automatically confer a real interest in this proceeding, which involves a different sound mark. To find a “real interest” in this proceeding based on Applicant’s assertion of a *different* sound mark in a *separate* proceeding would be akin to finding a real interest in *any* word mark proceeding based on an assertion of a different word mark in a different proceeding. Such a result would be unworkable.⁵

**b. Opposer’s Unpleaded “Competitor”
Theory is also Deficient**

Apparently abandoning its unsupported claim that Applicant has threatened to assert its 911 Hz Mark, Opposer’s Brief now asserts a new theory: Opposer has standing because it is a “competitor” of Applicant. Opposer is precluded from making this argument at this stage of the proceedings because it was not raised in its Amended Notice of Opposition. Nowhere in its Amended Notice did Opposer plead that it was a “competitor” of Applicant. In fact, Opposer paints a far different picture in Paragraph 2: “Opposer and Applicant have a long-standing business relationship, whereby Applicant manufactures phones, and accessories therefore, for sale by Opposer for use with Opposer’s cellular telephone and dispatch services.” (Amended Notice of Opposition at Para. 2.) Applicant was not put on notice of this new and unpleaded “competitor” theory. Raising this unpleaded argument for the first time in Opposer’s Brief constitutes unfair prejudice to Applicant and runs afoul of the Board’s notice pleading

⁵ For example, if Applicant asserted the mark “ALPHA” in a Letter of Protest granted against Opposer’s application to register an identical mark “ALPHA”, would Opposer thereby automatically have a “real interest” in opposing Applicant’s application to register the mark “ZETA”? Applicant respectfully submits that the answer is “no.” This is precisely the situation before the Board: the 911 Hz Mark at issue in this proceeding is, in effect, “ZETA” and the 1800 Hz mark at issue in the unrelated proceeding is “ALPHA.” Thus, Opposer lacks a real interest in this proceeding.

requirements. “A plaintiff may not rely on an unpleaded claim.” T.B.M.P. § 314 *citing P.A.B. Produits et Appareils de Beaute v. Satinine Societa*, 196 U.S.P.Q. 801, 804 (C.C.P.A. 1978).

Moreover, Opposer failed to disclose facts in its discovery responses that allegedly underlie the competitor standing theory asserted in its Brief. To the contrary, Opposer’s response to Applicant’s interrogatory on standing states that, “...Opposer and Applicant are business partners....” (Applicant’s Notice of Reliance at I.A. citing Opposer’s Interrogatory Response 10.) If Opposer intended to amend its well-pleaded (but later unproved) standing allegations, Opposer had a duty to amend its interrogatory responses under Fed. R. Civ. P. 26(e) to avoid prejudice and unfair surprise to Applicant. Opposer has the burden of proof on standing. Thus, its failure to amend its interrogatory response #10 to include facts allegedly supporting its competitor argument constitutes prejudice and unfair surprise to Applicant. *Cf. P.A.B. Produits*, 196 U.S.P.Q. at 805 (holding that failure to amend interrogatory response did not amount to prejudice against propounding party because responding party did *not* have burden of proof on the issue).

Opposer has failed to allege facts in its Amended Notice of Opposition—or its discovery responses—that support its “competitor” standing theory argued in Opposer’s Brief. Thus, its competitor theory should be barred.

Even if the Board excuses Opposer’s notice pleading deficiency and entertains its “competitor” theory, this argument is undercut by the evidence in the record. It is clear that Opposer’s Amended Notice of Opposition correctly characterized what the evidence would later show: the relationship between Applicant and Opposer is a manufacturer-customer relationship, not competition. Moreover, this relationship involves “phones and accessories therefore,” not the two-way radios that are at issue in this proceeding. (Amended Notice of Opposition at Para.

2.) Opposer's case for "competitor" standing—articulated for the first time in Opposer's Brief—is predicated upon testimony of Opposer's testimonial witness Thomas Hoyes, VP Public Sector, for Opposer Nextel. Mr. Hoyes was called by Opposer to testify that it provides telecommunications services to the public sector, the primary market for Applicant's traditional two-way radios. To that end, Mr. Hoyes testified that Opposer markets its services in the public sector and that Opposer considers Applicant to be a competitor because, "We're both trying to sell devices to the same customer base." (Hoyes Testimony at p. 7 (lines 1-6).) However, on cross-examination, Mr. Hoyes admitted that the cellular products with a walkie-talkie feature that Opposer distributes—allegedly in competition with Applicant—are, in fact, manufactured by Applicant:

- Q: Which products would be the competing products that you referred to?
A: ...it would be any device—any Nextel device that has the two-way radio built into the phone, the i870, the different models of the Nextel brand products.
Q: Who is the manufacturer of those products?
A: Motorola.
(Hoyes Testimony at p. 8 (lines 9-17).)

This testimony does not establish that Applicant and Opposer are competitors. It merely establishes that Opposer sells Applicant's products.

Opposer's "real interest" position is further weakened by its failure to offer proof that Opposer uses or intends to use a 911 hertz tone in commerce. Opposer's substantive grounds for opposition include descriptiveness, functionality, and Applicant's alleged non-use of the tone as a mark. (Amended Notice of Opposition at Paras. 9-10.) Opposer's use, or intent to use a 911 hertz tone, could arguably confer standing, yet there is nothing to that effect in the record. In fact, Opposer's designated 30(b)(6) witness testified that she had never even heard the 911 Hz Mark at issue in these proceedings. (Applicant's Notice of Reliance at II.A. citing O'Reilly Dep.

at p. 28 (lines 3-23).) Opposer has also conceded that it does not offer true two-way radios. (Applicant's Notice of Reliance at II.A. citing O'Reilly Dep. at p. 27 (lines 20-21).) Thus, Opposer's reliance on *American Flange & Mfg. Co. v. Rieke Corp.*, 80 U.S.P.Q.2d 1397, 1401 (T.T.A.B. 2006) is misplaced. In *American Flange*, the Board noted that Opposer was a direct competitor in the sale of goods that were "the subject matter of the marks applicant claims here." *See id.* Similarly, in *Anchor Hocking Glass Corp. v. Corning Glass Works*, 162 U.S.P.Q. 288, 291 (T.T.A.B. 1969), involving Applicant's attempt to register a floral design in connection with cookwear, the Board found standing based on evidence establishing that Opposer manufactured competing cookwear goods adorned with floral designs. *See id.* There no such evidence in this case. (Applicant's Notice of Reliance at I.A. citing Opposer's Interrog. Response 6.) ("...Opposer states that it does not market, promote, sell or distribute two-way radios that emit the 911 Hz tone as claimed in Applicant's application.").

Opposer's "information and belief," which may have been sufficient at the pleadings stage, is no longer sufficient when unsupported by the evidence of record. *See Boswell*, 52 U.S.P.Q.2d at 1605. Opposer has failed to prove the standing allegation set forth in its Amended Notice because the record does not include a single instance where Applicant "has indicated that it may assert" Applicant's 911 Hz Mark against Opposer. Consequently, Opposer's proofs do not support its pleadings: there is nothing in the record proving Opposer's claim that Applicant has "indicated that it may assert" its 911 Hz Mark against Opposer. (See Amended Notice of Opposition at Para. 12.) Opposer's asserted proofs relate to a contradictory and unpleaded "competitor" standing theory. Contradictory, because Opposer's testimonial witness Hoyes testified that the relationship is the one set forth in Para. 2 of the Amended Notice and Interrogatory Response 10: a manufacturer-customer relationship for "phones and accessories

therefor” (Amended Notice of Opposition at Para. 2.), Opposer lacks a real interest in this proceeding.

2. Opposer Lacks a “Reasonable” Belief of Damage

The second requirement in the Federal Circuit’s *Ritchie v. Simpson* standing test is the reasonableness of opposer’s belief of damage. It is not a purely subjective standard. The belief must have a “reasonable basis in fact.” *See Ritchie*, 50 U.S.P.Q.2d at 1027. The Federal Circuit has held that “a belief in likely damage can be shown by establishing a direct commercial interest.” *See Cunningham v. Laser Golf Corp.*, 55 U.S.P.Q.2d 1842, 1844 (Fed. Cir. 2000). This requirement is also fatal to Opposer’s standing.

Opposer has not proven that it has a “direct commercial interest” in the 911 Hz Mark, which covers “two-way radios.” Opposer provides telecommunications services that utilize cellular handsets manufactured by Applicant. (Amended Notice of Opposition at Para. 2; Applicant’s Notice of Reliance at II.A. citing O’Reilly Dep. at p. 25 (lines 10-14).) None of the services provided by Opposer utilize any goods that emit a 911 hertz tone. (Applicant’s Notice of Reliance at I.A. citing Opposer’s Interrogatory Response 6.) The evidence of record shows that Opposer does not offer any products or services that involve a 911 hertz tone, nor does the record contain evidence of any plans by Opposer to offer such products or services in the future. As Opposer admitted in its Interrogatory Responses, “...Opposer states that it does not market, promote, sell or distribute two-way radios that emit the 911 Hz tone as claimed in Applicant’s application.” (Applicant’s Notice of Reliance at Tab A citing Opposer’s Interrog. Response 6). In fact, Opposer is not a service provider for any “true” two-way radios—as described by Opposer’s 30(b)(6) witness O’Reilly—which are the goods at issue in this proceeding. Opposer is a service provider for cellular telephone handsets. Applicant’s 911 Hz Mark is not used in connection with those products. (Applicant’s Notice of Reliance at Tab B citing O’Reilly

deposition testimony at pp. 27 (lines 1-25) – 28 (lines 1-23); 46 (lines 24-25) – 47 (lines 1-11).)

As Mr. Klein explained, the separate 1800 hertz tone is used in connection with “consumer cell phones” while Applicant’s 911 Hz Mark is used in connection with government and enterprise two-way radio systems. (Klein Testimony at p. 25 (lines 7-23).) They are different products serving different user purposes. (Klein Testimony at pp. 25 (lines 7-24) – 27 (lines 1-12).)

Opposer’s pleaded—and unpleaded—arguments relating to its belief of damage do not have a “reasonable basis in fact.” *See Ritchie*, 50 U.S.P.Q.2d at 1027. This requirement is also fatal to Opposer’s standing.

In sum, the Board’s initial suspicions concerning Opposer’s standing to oppose Applicant’s 911 Hz Mark proved prescient. Although Opposer was able to survive the pleadings stage of this proceeding by alleging standing based upon “information and belief,” Opposer was unable to adduce such evidence at trial. Opposer has failed to offer any evidence in support of its standing allegation pleaded in the Amended Notice of Opposition, namely, its assertion that “Applicant has indicated that it may assert...its 911 Hz tone against Opposer.” (Amended Notice of Opposition at Para. 12.) The evidence of record merely shows that Applicant has asserted its prior use of a separate 1800 hertz sound mark against Opposer’s application to register the identical 1800 hertz tone. Applicant respectfully submits that its assertion of a separate mark in an separate proceeding does not confer standing for Opposer to oppose Applicant’s 911 Hz Mark in this proceeding. Opposer lacks standing to oppose Applicant’s 911 Hz Mark.

The following sections set forth Applicant’s case on the merits.

B. APPLICANT USES ITS 911 HZ MARK AS A TRADEMARK

The law is clear that sound marks are registrable in the U.S.P.T.O. as trademarks for goods. *See J. Gilson and A. Gilson LaLonde, Cinnamon Buns, Marching Ducks and Cherry-*

Scented Racecar Exhaust: Protecting Nontraditional Trademarks, 95 Trademark Rep. 773, 802-03 (July-August, 2005) (compiling a list of issued registrations for sound marks covering various goods including software (Reg. No. 2,827,972), medicated patches (2,814,082), watches (2,692,077), and beer (2,207,874)).⁶ Unlike product configuration, flavor, or color, a sound mark may be inherently distinctive and thus registrable without a showing of secondary meaning. *In re General Electric Broadcast Co., Inc.*, 199 U.S.P.Q. 560, 563 (T.T.A.B. 1978); *In re N.V. Organon*, 79 U.S.P.Q.2d 1639, 1650 (T.T.A.B. 2006).

1. Applicant's Mark is Affixed to its 2-Way Radios

Applicant's witness David Klein, who is its Portable Marketing Manager, Radio Systems Division, explained how Applicant uses its 911 Hz Mark in connection with its two-way radios. As Mr. Klein testified:

[T]he [911 Hz Mark] is representative of a Motorola product. The tone is from a Motorola product branding it audibly. It ties in the customer experience of this is a voice product, the most important thing is voice, and I need a robust solution, and then there is this branded radio that has Motorola written all over it that is presenting this tone. It's the only product that is producing this tone and it's certainly the only two-way product that produces this tone. And we have produced that same tone in these two-way products now for—consistently for a long period of time. (Klein Testimony at pp. 16 (lines 21-24) – 17 (lines 1-8).)

Opposer's first ground for opposition is that Applicant's 911 Hz Mark has not been used as a mark in commerce. (Notice of Opp. at Para. 9, citing 15 U.S.C. §§ 1051, 1052, 1127.) However, Opposer has introduced no evidence or testimony to support this claim. In contrast, Applicant's evidence establishes: (1) that the mark has been used in commerce in connection with Motorola's popular two-way radio products since at least as early as 1991; (2) that Motorola has consistently used the distinctive 911 Hz Mark in connection with these products at least as early as that date; and (3) that Motorola promotes its 911 Hz tone as a trademark. These points

⁶ A copy of the *Cinnamon Buns* article is attached hereto as Exhibit 1.

are covered in more detail in the following sections of Applicant's Brief relating to inherent distinctiveness (Section V. C.) and acquired distinctiveness (Section V. D.).

Applicant's 911 Hz Mark is an audible sound mark emitted from Applicant's two-way radio products when a channel is available for communication. When a user of Applicant's two-way radio products needs to place a call, the user presses a particular push-to-talk button on the radio. A signal is transmitted, and if a channel is available for communication, the radio will emit Applicant's 911 Hz Mark. Applicant has kept that tone constant from model to model, so the user always knows that his MOTOROLA® radio is ready for communication. Applicant has gone to great lengths to communicate that mark to its customers and end users. It is a centerpiece of Applicant's two-way radio marketing activities. It is a source-identifying tone widely recognized in the industry. (Klein Testimony at pp. 15 (lines 22-24) – 21 (lines 1-5).)

2. Applicant's Mark is a Dual-Purpose Trademark

Applicant's witness, Mr. Klein, explained that the mark is a dual-purpose trademark. Although the sound mark is emitted from Applicant's goods when a channel becomes available for communication, this does not disqualify it from registrability as a mark. As Mr. Klein testified, Applicant's mark serves two purposes: (1) Applicant's 911 Hz Mark alerts the user that a channel is available for communication; and (2) Applicant's 911 Hz Mark informs the user that he is using a MOTOROLA® product. (Klein Testimony at pp. 15 (lines 22-24) – 16 (lines 1-7).) The second purpose is indisputably a trademark use. As Mr. Klein testified:

...[T]he sales folks will use the tone to indicate... "Press the button, see, you always have the opportunity for communication." *It's the Motorola trademark of always there.* It's an indication. It's not just, "Here, feel this device and feel it." They are getting feedback that helps them know, "I'm always getting through," that kind of feeds into the experience." (Klein Testimony at p. 28 (lines 9-21) (emphasis added).)

The Board has recognized the concept of dual-purpose trademarks in other contexts. For example, the Board has allowed trademark protection for a stylized word mark notwithstanding the mark's "ornamental" aspects because the mark also served the dual purpose of indicating source. See *In re Paramount Pictures Corp.*, 217 U.S.P.Q. 292, 294 (T.T.A.B. 1983) ("Obviously, the Lanham Act does not exclude registration of a mark simply because it has an ornamental as well as a source indicating purpose."); *In re Moody's Investors Svc. Inc.*, 13 U.S.P.Q.2d 2043, 2048-49 (T.T.A.B. 1989) ("...[A] particular designation could be used, and therefore function, both as a rating symbol and as a trademark or service mark...."); *In re Jockey Int'l, Inc.*, 192 U.S.P.Q.2d 579, 582 (T.T.A.B. 1976) citing *In re The Deister Concentrator Co., Inc.*, 129 U.S.P.Q. 314, 320 (C.C.P.A. 1961).

The 911 Hz Mark was selected and developed by Applicant's engineers and marketing personnel for its aesthetic appeal. The 911 Hz Mark was selected from among several other technologically available tones in 1983. (Klein Testimony at pp. 32 (lines 7-24) – 33 (lines 1-19) and 38 (lines 6-18).) Today, technology advancements would allow an almost limitless variety of tones, yet Motorola sticks with the 911 Hz Mark for continuity and brand awareness.⁷ (Klein Testimony at pp. 39 (lines 22-24) – 40 (lines 1-22).)

Opposer has proffered no evidence establishing that anyone other than Applicant uses a 911 hertz tone in connection with two-way radios. In fact, even Opposer's witness, Mr. Rasmussen, testified that Applicant's sound mark is unique. (Rasmussen Testimony at pp. 26 (lines 3-24) – 27 (lines 1-2).) As Mr. Klein testified, at the time the tone was developed, no

⁷ Applicant's trademark application claims May 1991 as the first use in commerce date, but this is merely because of 1991 technical alterations to the apparatus that generates the sound. These changes were imperceptible to the human ear. (Klein Testimony at pp. 36 (lines 8-24) – 37 (lines 1-14).) Nonetheless, in an abundance of caution, Applicant identified the 1991 date as the first use in commerce date in the application.

other two-way radio manufacturer was using the 911 hertz tone. Today, no other manufacturer is using that tone without Applicant's authorization. (Klein Testimony at pp. 40 (lines 23-24) – 41 (lines 1-10).) Opposer attempts to muddy the waters by citing testimony from a City of Durham, NC employee, Mr. Rasmussen, who testified that other manufacturers' two-way radios emit various alert tones. (Opposer's Brief at pp. 16-18) He did *not* say that those third-party products emit a 911 hertz tone. In fact, he specifically noted that Applicant's alert tone is different. (Rasmussen Testimony at pp. 26 (lines 3-22) – 27 (lines 1-2).) Opposer also relies on Mr. Klein's testimony regarding a single third-party user of the 911 Hz Mark, but Mr. Klein's testimony clarifies that this user, EF Johnson, is an "authorized" user because EF Johnson is Applicant's customer and purchases certain models' internal "radio guts," which emit the tone, directly from Applicant. The tone is part and parcel of the technology provided by Applicant, thus Applicant controls the quality of the goods that bear the sound mark. (Klein Testimony at pp. 41 (lines 7-24) – 43 (lines 1-11).) This is not an uncontrolled third-party use that would disqualify the mark from registration through an abandonment of Applicant's trademark rights. EF Johnson has an implied license to use the sound mark in connection with the two-way radio components it purchases from Applicant. *The Nestle Co., Inc. v. Nash-Finch Co.*, 4 U.S.P.Q.2d 1085, 1088 (T.T.A.B. 1987) (recognizing that written trademark license is not required).

Mr. Klein testified that the FCC sets standards for two-way radio products. A two-way radio is not required to emit a 911 hertz tone. In fact, it is not required to emit any tones. The only required notification alert for two-way radios is a visual notification. Applicant's competitors employ an LED notification for the channel-available feature signaled by Applicant's Mark. Prior to developing its 911 Hz Mark, Applicant also used an LED notification as opposed to an audible tone. (Klein Testimony at pp. 34 (lines 7-24) – 36 (lines 1-11).) Thus,

the 911 Hz Mark is not essential to the use or purpose of the article, nor does it affect the cost or quality of the article. *See Valu Engr., Inc. v. Rexnord Corp.*, 61 U.S.P.Q.2d 1422, 1426 (Fed. Cir. 2002). Even if Applicant or a competitor deemed it necessary to use an audible tone, there is no reason why that tone would need to be a 911 hertz tone. Virtually any tone at any frequency—or a visual indicator with no tone at all—would accomplish the desired alert effect. There is no evidence in the record establishing that a two-way radio manufacturer must use a 911 hertz tone. (Klein Testimony at pp. 33 (lines 23-24) – 35 (lines 1-7).) Opposer’s witness, Mr. Rasmussen, corroborated this testimony when he characterized Applicant’s alert tone as sounding “different” than the competitors’ products using an audible alert. (Rasmussen Testimony at pp. 26 (lines 3-22) – 27 (lines 1-2).)

3. Applicant’s Mark is Not Functional

Opposer argues that the 911 Hz Mark has not been used as a mark because it is functional. *See, e.g.*, Opposer’s Brief at p. 4 (“But such alert signals are critical operational features of the types of radio systems represented by the products at issue here.”) and p. 5 (“The 911 Hz Tone, like other two-way radio signal tones, serves a specific, primary function, namely to signify the activation of one of the operations of the radios in which the tone-generating chip is embedded.”) However, Opposer did not plead Section 2(e)(5) as a ground for opposition. *See* 15 U.S.C. § 1052(e)(5). Thus, Opposer is barred from raising this argument in its Brief. *See* T.B.M.P. § 314. In any event, the record shows that Applicant’s 911 Hz Mark is not functional. A mark is functional if it is essential to the use or purpose of the article or it if affects the cost or quality of the article. *See Valu Engr., Inc.*, 61 U.S.P.Q.2d at 1426 *citing Inwood Labs., Inc. v. Ives Labs., Inc.*, 214 U.S.P.Q.2d 1, 4 (1982). Factors to consider in this analysis are: (1) the existence of a utility patent disclosing utilitarian advantages; (2) advertising touting utilitarian advantages; (3) availability to competitors of functionally equivalent designs; and (4) facts

indicating that the design results in a comparatively simple or cheap manufacturing method. *See Valu Engr.*, 61 U.S.P.Q.2d at 1426 citing *In re Morton-Norwich Prods., Inc.* 213 U.S.P.Q.2d 9, 15-16 (C.C.P.A. 1982). There is nothing in the record supporting Opposer's functionality theory.

With respect to the *Morton-Norwich* functionality factors, looking at factor (1), there is no evidence in the record of a utility patent owned by Applicant covering its 911 Hz Mark. Regarding factor (2), there is no evidence in the record of any advertising touting the "utilitarian advantages" of the 911 Hz Mark. As explained herein, any audible tone would alert the user to an available channel as effectively as the 911 Hz Mark. There is no requirement for a 911 hertz tone, nor any utilitarian advantages to the 911 hertz tone. (Klein Testimony at pp. 34 (lines 7-24) – 36 (lines 1-7).) Regarding *Morton-Norwich* factor (3), competitors are free to use other tones or LED lights to signify an available channel. As Opposer's testimonial witness Henrik Rasmussen testified, other manufacturers use a different tone. Applicant's tone is a "chirp" while the competitors use a "beep." This establishes that functionally equivalent alternative tones are available and in use. (Rasmussen Testimony at pp. 26 (lines 3-22) – 27 (lines 1-2).) Finally, with respect to factor (4), there is no evidence that the 911 Hz Mark provides any manufacturing advantages. To the contrary, the evidence establishes that other tones were available to Applicant's engineers and marketers in 1983 when the 911 Hz Mark was coined, and that additional tones are available today. Yet, Applicant continues to use the 911 Hz Mark due to its aesthetic appeal and brand function. (Klein Testimony at pp. 38 (lines 6-24) – 40 (lines 1-22).) Opposer has adduced no evidence that there is any "competitive need" for a two-way radio manufacturer—which Opposer, incidentally, is not—to use a 911 hertz tone. *See In re N.V. Organon*, 79 U.S.P.Q.2d at 1646 (considering competitive need in functionality analysis). If

Applicant is granted exclusive rights to use the 911 Hz Mark through issuance of a trademark registration, competitors will be entitled to continue doing exactly as they are today: using other tones, or LED lights, as alert signals. Applicant's registration of the 911 Hz Mark will not in any way hinder legitimate competition. *See id.* at 1649. The 911 Hz Mark is not functional under the governing functionality test.

4. Opposer's Case Law is Inapposite

Although Applicant's 911 Hz Mark is emitted from Applicant's goods when a channel becomes available for communication, this does not disqualify it from registrability as a mark. Opposer's cited case law does not suggest otherwise. For example, Opposer cites a series of *ex parte* cases involving faulty specimens of use. These cases include *In re Morganroth*, 208 U.S.P.Q. 284, 287 (T.T.A.B. 1980). *Morganroth* merely stands for the proposition that a word mark appearing in text must be used in a prominent manner to serve as a trademark. *See id.* at 288 (affirming refusal of application for the mark NATURALIZE YOUR HAIRCOLORING because the mark as used in the submitted specimen depicted NATURALIZE YOUR HAIRCOLORING WITH ANOTHER NEW SERVICE). Its holding bears no relevance to the present case. A cited district court case, *MicroStrategy Inc. v. Motorola, Inc.*, 58 U.S.P.Q.2d 1278, 1282-83 (4th Cir. 2001), which cites *Morganroth*, is similarly inapplicable. *Microstrategy* also held that a word mark needs to be set apart from text to be protectable as a trademark. *See id.* at 1281. The remaining *ex parte* cases in Opposer's Brief relating to specimens of use are similarly unpersuasive. *See, e.g., In re Benetton Group S.p.A.*, 48 U.S.P.Q.2d 1214, 1217 (T.T.A.B. 1998) (rejecting green design specimen because a word mark was also depicted); *In re Upper Deck Co.*, 59 U.S.P.Q.2d 1688, 1691-93 (E.D. La. 2000) (rejecting hologram mark specimen as a phantom mark and finding that the record was devoid of evidence of source-

identifying purpose); and *In re Niagara Frontier Services, Inc.*, 221 U.S.P.Q. 284, 285-86 (T.T.A.B. 1983) (rejecting specimen depicting word mark within additional phrases).

In re Moody's Investors Svc. Inc., 13 U.S.P.Q.2d 2043, 2048-49 (T.T.A.B. 1989), also cited by Opposer, is distinguishable as being yet another *ex parte* word mark specimen case, but it is notable for its discussion applicable to Applicant's dual-purpose trademark claim. In *Moody's*, the Board affirmed an Examiner's refusal to register applicant's "Aaa" service mark based on faulty specimens that failed to distinguish applicant's services. *See id.* at 2048-49. However, the Board went on to note that the applicant's asserted mark, if properly depicted in specimens, was capable of functioning as a mark. Importantly, in doing so, the Board again recognized the concept of dual purpose trademarks. "...[A] particular designation could be used, and therefore function, both as a rating symbol and as a trademark or service mark...." *Id.* at 2049.

Opposer relies heavily on *In re N.V. Organon*, 79 U.S.P.Q.2d 1639 (T.T.A.B. 2006), in support of its argument that Applicant's 911 Hz Mark cannot function as a trademark. (Opposer's Brief at pp. 29-30.) In holding that applicant's orange flavor failed to function as a mark, the Board held that flavor, like product configuration, color, and scent, can never be inherently distinctive. *See id.* at 1650. From there, the Board analyzed whether the record at issue established that the orange flavor had acquired distinctiveness and concluded that it had not. *See id.* The present case is readily distinguishable because the Board has held that sound marks, unlike other "nontraditional marks," can be inherently distinctive. *See In re General Elec.*, 199 U.S.P.Q. at 563. In fact, the Board in *Organon* specifically distinguished flavor marks from sound marks for trademark use purposes. "...[I]t is difficult to fathom exactly how a flavor could function as a source indicator in the classic sense, *unlike the situation with other*

nontraditional trademarks such as color, sound and smell, to which consumers may be exposed prior to purchase.” *Organon*, 79 U.S.P.Q.2d at 1651 (emphasis added). This holding is significant for its application to flavor marks. It has limited relevance to the sound mark issue at hand. It does not support Opposer’s arguments that Applicant’s 911 Hz Mark fails to function as a mark or that Applicant must show that its sound mark has acquired distinctiveness. (Opposer’s Brief at p. 34 ftn. 6 citing inapplicable precedent relating to the acquired distinctiveness requirement for color, product configuration, and scents.)⁸ Opposer’s claim that a sound mark applicant must demonstrate acquired distinctiveness is contrary to precedent and would require the Board to adopt a change in the law. (Opposer’s Brief at p. 28 (“Statement of Issues” bullet point 2).) Interestingly, while asserting its acquired distinctiveness argument in this proceeding, Opposer is concurrently seeking registration of an 1800 hertz sound mark on the basis of inherent distinctiveness. (Opposer’s First Notice of Reliance at Tab A (file history for Opposer’s application Serial No. 78/575,442).)

Organon also included an extensive discussion of the traditional *Morton-Norwich* factors and concluded that the flavor at issue was functional under the applicable test. *See id.* at 1645-46. The Board’s functionality ruling in that case was based on evidence not present in this case, most notably, advertising by the applicant touting utilitarian benefits of the applied-for orange flavor. *See id.* at 1645. The Board also relied upon evidence showing that orange flavoring was sold by several companies as an additive for functional purposes. *See id.* at 1641-43. Also critical to the Board’s decision was evidence that there is a competitive need for an orange flavor. *See id.* at 1648-49. There is no such evidence in this case.⁹

⁸ Applicant’s inherent distinctiveness case appears in Section V. C.

⁹ Applicant applies the *Morton-Norwich* factors in its functionality discussion appearing in Section V. B. 3.

Opposer also cites a line of cases to refute Mr. Klein's assertion that the use of the 911 Hz Mark in conjunction with the well-known MOTOROLA house mark serves to further tie-in the sound mark with the source of the goods. (Klein Testimony at pp. 17 (lines 9-24) – 19 (lines 1-8).) Opposer's Brief at p. 33, n. 5, appears to suggest that the 911 Hz Mark's trademark capacity is somehow diminished through this tie-in. Opposer cites *Textron Inc. v. Cardinal Egr. Corp.*, 164 U.S.P.Q. 397, 399 (T.T.A.B. 1969) and *Proctor & Gamble Co. v. Keystone Automotive Warehouse, Inc.*, 191 U.S.P.Q. 468, 474 (T.T.A.B. 1976) for support. These citations are curious because *Textron* recites the "frequently held" rule that "the mere use of a house or primary mark for one's goods does not preclude the adoption and use of a product mark in connection therewith." *Textron*, 164 U.S.P.Q. at 399. "There is no statutory limitation on the number of trademarks that one may use on or in connection with a particular product to indicate origin thereof in commerce." *Id.* *Proctor & Gamble* cites this same theory. *Proctor & Gamble*, 191 U.S.P.Q. at 474. *See also In re Morganroth*, 208 U.S.P.Q. at 287. As Mr. Klein explained, by tying its 911 Hz Mark to the famous MOTOROLA word mark, Applicant has sought to connect the sound mark to a specific source in the public's mind. (Klein Testimony at pp. 18 (lines 19-24) – 19 (lines 1-8); pp. 103 (lines 16-24) – 104 (lines 1-4).)

In sum, Opposer argues that because Applicant's mark *does something*, it cannot serve as a trademark. Opposer's position is that because Applicant's mark alerts the user that a channel is available, it cannot serve as a trademark. Taken to its logical conclusion, this means that even if Applicant's applied-for mark was an audible spoken "MOTOROLA" or "M-O-T-O-R-O-L-A", it would not serve as a mark if it was used in the same manner as the 911 Hz Mark, namely, for the dual purpose of: (1) an alert function, and (2) a source-identifying trademark. Surely, this argument is without merit. Consider other real-world examples of dual-purpose sound marks

such as the opening tune for the Windows operating system. This tune serves the dual purpose of: (1) alerting the user that the operating system is working, and (2) informing the user that she is using a Microsoft Windows-brand system. Or, consider the MGM “roar” sound mark. This mark performs the dual purpose of: (1) alerting the consumer that the film is about to begin; and (2) informing the user that she is viewing an MGM production. Opposer’s cited precedent does not support its position.

C. APPLICANT’S MARK IS INHERENTLY DISTINCTIVE

A sound mark can be inherently distinctive, and thus registrable, without a showing of acquired distinctiveness. *See General Electric*, 199 U.S.P.Q. at 563. Applicant’s mark is unique, different, and distinctive. It is not a commonplace sound, nor is it a sound to which listeners have been exposed under different circumstances. It is a unique sound coined by Applicant in 1983 for use in connection with its MOTOROLA two-way radio products. Applicant’s mark has a particular tone, cadence, and texture and is not a sound that is familiar to the general public, or to the relevant public, except as a source indicator. It was developed by Applicant’s engineers and marketing personnel for its aesthetic appeal. It has been consistently used since that time to ensure brand recognition for Applicant’s products. (Klein Testimony at pp. 32 (lines 6-24) – 33 (lines 1-4); 39 (lines 15-24) – 40 (lines 1-22).)

Procedurally, Opposer bears the burden of establishing that Applicant’s mark is not inherently distinctive. *Plyboo America Inc. v Smith & Fong Co.*, 51 U.S.P.Q.2d 1633, 1640 (T.T.A.B. 1999) *citing Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 6 U.S.P.Q.2d 1001, 1005 (Fed. Cir. 1988). Opposer has not met its burden. Opposer offers no evidence whatsoever as to where, how, when, or by whom the mark—or anything similar to the mark—has ever been used in connection with two-way radios or any other products. Opposer has made no evidence of record establishing that Applicant’s mark is an ordinary, non-distinctive tone when used in connection

with two-way radios. In fact, Opposer's testimonial witness, Henrik Rasmussen (the Radio System Manager of the City of Durham, North Carolina), specifically acknowledged that Applicant's mark was "different" from the other "ready-to-talk tones" emitted by other manufacturers' products:

Q: *Are there any differences among the ready-to-talk tones that are emitted by the two-way trunked radios sold by the manufacturers with which you have direct experience?*

A: *Yes.*

Q: *Would you explain, please?*

A: *A couple of examples. For instance, a Kenwood trunked radio when you push the talk button if it successfully connects it gives you a beep, a steady one tone beep. A Motorola trunked radio gives you a sound that I would describe as a chirp. So those two radios I know for a fact have a different sound. It's very short but it is different. Many of the radios though have a sound that is at least so similar that I don't perceive a difference. So, for instance, Johnson radios, Vertex, Standard, Kenwood, those radios in my experience has been that they tend to make a beep that is very, very similar and I doubt that I could tell you one of them was being used as opposed to another one just based on the sound that it made. (Rasmussen Testimony at pp. 26 (lines 3-22) – 27 (lines 1-2) (emphasis added).)*

As conceded by Opposer's witness Rasmussen, Applicant Motorola's tone is "different." He describes it as a "chirp" as opposed to the "beep" used by other manufacturers such as Johnson, Vertex, Standard, and Kenwood. (Rasmussen Testimony at pp. 26 (lines 3-22) – 27 (lines 1-2).) As revealed in his testimony, Rasmussen draws a distinction between Applicant Motorola's "chirp" as opposed to the commonplace "beep" used by the others. Based on Mr. Rasmussen's testimony, Applicant's mark is inherently distinctive. It bears noting that this witness was called by Opposer and is a non-party public sector employee.

Moreover, the Examining Attorney acknowledged the inherently distinctive nature of the mark by approving it for publication without requiring a showing of acquired distinctiveness under Section 2(f).

Opposer's cited authorities do not rebut Applicant's claim of inherent distinctiveness. Opposer attempts to suggest in pages 33-34 of Opposer's Brief that sound marks should require a showing of acquired distinctiveness. This is not the law. Sound marks are treated differently than product configuration, flavor, scent, and color. *Organon*, 79 U.S.P.Q.2d at 1651. They are protectable without a showing of acquired distinctiveness. *General Electric*, 199 U.S.P.Q. at 563. Opposer also cites to a district court case, *Ride the Ducks LLC v. Duck Boat Tours Inc.*, 75 U.S.P.Q.2d 1269 (E.D. Pa. 2005). The district court acknowledged the Board's distinction between "unique" sounds and "commonplace" sounds set forth in *General Electric*, 199 U.S.P.Q. at 563. Sounds that are unique do not require a showing of acquired distinctiveness. *See id.* at 1274. The record in this case establishes that Applicant's 911 Hz Mark is unique. Opposer has not placed any other uses of a 911 hertz tone into the record. In contrast, Mr. Klein testified that Applicant coined the mark in 1983, adopted it over other equivalent sounds, and continues to use the sound today despite the availability of other sounds. (Klein Testimony at pp. 38 (lines 6-24) – 40 (lines 1-22).) Specifically, Mr. Klein explained that the mark was developed in 1983 by selecting from an array of tones that were available at intervals of roughly 150 hertz. (Klein Testimony at pp. 32 (lines 6-24) – 33 (lines 1-19); 38 (lines 6-14).)

Mr. Klein also testified that there are no unauthorized users of the mark. (Klein Testimony at p. 41 (lines 7-10).) This testimony—coupled with Opposer's failure to introduce any evidence of unauthorized third-party use—negates Opposer's argument that Applicant has somehow failed to police its 911 Hz Mark. (Opposer's Brief at p. 14.) Notably, Opposer's witness from the City of Durham testified that Applicant's mark is different than competitors' audible tones. (Rasmussen Testimony at pp. 26 (lines 3-22) – 27 (lines 1-2).) This is a different situation than the court addressed in *Ride the Ducks*, where it found that the quacking duck

sound was not inherently distinctive and was instead a “familiar noise.” *See Ride the Ducks*, 75 U.S.P.Q.2d at 1275. There is no evidence in this record establishing that Applicant’s 911 Hz Mark is a “familiar noise.”

Opposer also argues that Applicant “has not followed through on its investigation to discover whether its competitors also use the 911 Hz Tone.” (Opposer’s Brief at pp. 5, 14.) This claim misstates Mr. Klein’s testimony. Mr. Klein did not testify that Applicant failed to follow through on an investigation. He merely stated that Applicant has been unable to operate the competitive products. He explained that the competitors’ products are not compatible with Applicant’s trunking system and that, therefore, Applicant has not been able to determine anything beyond the fact that the products use the required LED visual light indicator. (Klein Testimony at pp. 82 (lines 10-24) – 86 (lines 1-24).) This in no way suggests that Applicant failed to “follow through” on any investigation, nor does it imply that the competitors’ products use a similar audible alert tone. To the contrary, Mr. Klein testified that he inquired whether anyone on Applicant’s sales staff was aware of any competitor’s use of the 911 Hz Mark. None were. (Klein Testimony at p. 83 (lines 2-8).) Opposer has introduced no evidence of any unauthorized third-party use.

D. APPLICANT’S MARK HAS ACQUIRED DISTINCTIVENESS

Although Applicant respectfully submits that its mark is inherently distinctive and therefore registrable without a showing of acquired distinctiveness, the mark has indeed acquired distinctiveness for trademark purposes. 15 U.S.C. § 1052(f). However, if the Board accepts Applicant’s argument that the 911 Hz Mark is inherently distinctive, it need not consider the parties’ arguments concerning acquired distinctiveness. *See General Electric*, 199 U.S.P.Q. at 563. Procedurally, “opposer has the initial burden to present prima facie evidence or argument that upon which [the Board] could reasonably conclude that applicant’s mark has not acquired

distinctiveness.” *American Flange & Mfg. Co. v. Reicke Corp.*, 80 U.S.P.Q.2d at 1411. If opposer does so, the burden of proof shifts to applicant. *See id.* Applicant submits that Opposer has not met its burden. Nonetheless, Applicant’s case for acquired distinctiveness follows.

Applicant’s evidence of acquired distinctiveness is in the well-established form of long-term use, extensive sales and advertising, and a survey. *See, e.g., In re Owens-Corning Fiberglas Corp.*, 227 U.S.P.Q. 417, 422-24 (Fed. Cir. 1985); *In re Instant Transactions Corp. of Am.*, 201 U.S.P.Q. 957, 958 (T.T.A.B. 1979); T.M.E.P. § 1212.06(a)-(d).

1. Applicant’s Mark Has Been Used Consistently Since 1983

Applicant has used its 911 Hz Mark in connection with its two-way radio products since 1983. (Klein Testimony at p. 29 (lines 8-17).) These years of use, even considering the conservative 1991 first use date claimed in the trademark application, significantly exceed the five years recognized as prima facie evidence of acquired distinctiveness. 15 U.S.C. § 1052(f). During this time, there have been no other unauthorized users of Applicant’s 911 Hz Mark. (Klein Testimony at p. 41 (lines 7-10).)

2. Applicant’s Sales of Two-Way Radios Under the Mark Currently Exceed \$100,000,000 Annually

Applicant’s witness, Mr. Klein, provided testimony regarding the significant sales of Applicant’s two-way radio products that emit Applicant’s mark. The specific sales figures are highly confidential and Mr. Klein’s testimony regarding specific dollar amounts is therefore submitted under seal. (Klein Testimony at pp. 49 (lines 21-24) – 56 (lines 1-21) and related Exhibits 9 and 10.) However, a non-confidential summary of those figures follows.

As Mr. Klein explained, Exhibit 9 represents Applicant’s direct sales to customers. The first table represents yearly unit sales broken down by product. Each identified product emits Applicant’s mark. The second table on Exhibit 9, labeled “ASP,” represents the average selling

price for each model. The third table, labeled "NSAD," represents "net sale after discount." This is the total revenue generated by direct sales of the identified products. Each of these two-way radios emits Applicant's mark. (Klein Testimony at pp. 49 (lines 21-24) – 52 (lines 1-12) and related Exhibit 9.) As illustrated in Exhibit 9, Applicant's direct sales have been significant and have generated revenue well in excess of \$100,000,000.

Exhibit 10 represents Applicant's indirect sales, which are sales by Applicant's dealers. (Klein Testimony at p. 52 (lines 14-24).) This exhibit segregates indirect sales of "mobiles" and "portables." "Mobiles" refers to products that are installed in vehicles. (Klein Testimony at p. 53 (lines 7-17).) "Portables" refers to radios that a customer would hold in his hand. (Klein Testimony at p. 54 (lines 4-11).) The first page of Exhibit 10 identifies, by product and year beginning in 1991, Applicant's dollar sales of shared mobiles and shared portables. (Klein Testimony at pp. 53 (lines 7-24) – 54 (lines 1-22).) The second page of Exhibit 10 identifies, by product and year, the unit sales and average selling price of shared mobiles and shared portables. (Klein Testimony at pp. 54 (line 24) – 55 (lines 1-5).) Each of the two-way radios identified in Exhibit 10 emit Applicant's mark. (Klein Testimony at pp. 53 (line 24) – 54 (lines 1-15).) As illustrated in Exhibit 10, Applicant's indirect sales have been significant, with revenues in excess of \$10,000,000 per year. Exhibit 10 also confirms that Applicant has sold a significant number of products emitting Applicant's mark since at least as early as 1991, the first use date in the subject application. (Klein Testimony at p. 56 (lines 10-21).)

3. Applicant's Significant Experiential Advertising and Promotional Efforts Involving Products Sold Under the Mark

Applicant has expended significant resources in advertising and promoting its 911 Hz Mark in connection with its two-way radios. The goal of Applicant's promotional activities is getting the product in the hands of its customers. Applicant shows its customers that its two-way

radios offer reliable, always-there, instant communications. Mr. Klein described these efforts as focusing on “immediate communications capability.” Applicant’s sound mark is an integral part of that process. To that end, Applicant sets up operational two-way radio systems to show potential customers that “every time that I hit that button I will hear that tone because I’m carrying a Motorola product.” Mr. Klein went on to explain, “This is the same tone and experience customers have had since the mid, early 80s. It’s the same experience and people know that. They recognize that.” (Klein Testimony at pp. 17 (lines 15-24) – 18 (lines 1-18).) The tone, Applicant’s 911 Hz Mark, acts as a “tie-in” between the technical capability of the radio and its source. (Klein Testimony at pp. 16 (lines 18-24) – 18 (lines 1-18) and p. 97 (lines 3-10).) Mr. Klein refers to this advertising as “experiential advertising methods.” (Klein Testimony at p. 20 (lines 13-14).)

A significant portion of these “experiential advertising” activities occurs at industry trade shows. Because the mark at issue is a sound mark, and because the goods to which it is applied are products sold primarily into a limited niche of public sector and fleet consumers, traditional marketing techniques for ordinary consumer products are inapplicable. As such, Applicant does not engage in traditional print and television advertising for this mark. Instead, Applicant promotes its sound mark primarily through hands-on, one-to-one presentations at trade shows and sales presentations. (Klein Testimony at pp. 17 (lines 15-24) – 20 (lines 1-18) and pp. 94 (lines 22-24) – 96 (lines 1-15).) Although a consumer may hear other audible tones emitted by Applicant’s two-way radios, the 911 Hz Mark is featured and “highlighted” during these presentations because it signifies Applicant’s reputation for “getting through” and “reliability.” (Klein Testimony at pp. 77 (line 24) – 80 (lines 1-16).) During his cross-examination, Mr. Klein explained that this “touching and feeling and experiencing” method is a “much more powerful

method in this type of market than a presentation or brochure....” (Klein Testimony at p. 98 (lines 10-19).)

To that end, Applicant’s annual advertising and promotional budget for its two-way radios that emit the sound mark is significant. Mr. Klein provided testimony regarding various trade shows where Applicant’s mark is promoted. These trade shows include shows for fire chiefs, police, and the military. Since 2000, Applicant has attended approximately 50 such trade shows where it has promoted its 911 Hz Mark. (Klein Testimony at pp. 43 (lines 23-24) – 45 (lines 1-11) and related exhibit 3, Interrogatory 14.) Applicant’s 911 Hz Mark is an integral part of its “branding image” at trade shows. As Mr. Klein testified, it is utilized to demonstrate that “this is an exclusive tone that to my knowledge only Motorola has utilized and it’s been consistently utilized on a Motorola product so in my personal experience I would say that that is indicative of a linkage....” (Klein Testimony at pp. 45 (lines 18-24) – 46 (lines 1-13); 100 (lines 23-24) – 104 (lines 1-4).) Applicant’s specific advertising budget associated with these trade shows is highly confidential and is submitted under seal, but it is well in excess of several hundred thousand dollars per year. (Klein Testimony at p. 46 (lines 4-13).)

Opposer argues that Applicant’s advertising and promotional efforts are ineffective because they don’t include some form of “look-for” advertising. (Opposer’s Brief at pp. 44-45.) In the case of a sound mark, the argument would be that Applicant has a duty to run “listen for” advertising. To evaluate this argument, it is important to consider the nature of the products at issue. Applicant’s 911 Hz Mark is used in connection with two-way radios. These are not ordinary consumer goods that lend themselves to print, radio, and television advertising. As Mr. Klein testified, those traditional forms of advertising are ineffective for these products. (Klein Testimony at pp. 43 (lines 12-24) – 44 (lines 1-10); 96 (line 3-24) – 98 (lines 1-19).) Two-way

radio promotion is conducted through “experiential” advertising methods that involve getting the product into the consumers’ hands so they can hear the 911 Hz Mark and understand its significance as both an alert tone and a trademark. (Klein Testimony at pp. 19 (lines 9-24) – 20 (lines 1-18).) Opposer presented no evidence contradicting Mr. Klein’s expertise in the marketing of two-way radios, presumably because Opposer is not in the two-way radio market. (Applicant’s Notice of Reliance at II.A. citing O’Reilly Deposition at p. 27 (lines 20-21).)

As a practical matter, Opposer’s suggestion that Applicant’s trade show promotions are insufficient and that Applicant instead is required to conduct “look-for/listen-for” advertising is unworkable. Due to the distinctiveness of the 911 Hz Mark, it does not easily lend itself to a written or verbal explanation. Unlike a quacking duck or other commonplace sound, Applicant’s 911 Hz Mark is a unique tone. There seems to be little marketing appeal for a claim such as, “Listen for the tone at 911 hertz played at a cadence of 25 milliseconds on, 25 milliseconds off....” Opposer’s “look-for” advertising argument may have appeal in some contexts, but not in the present case involving a unique electronically-generated sound mark applied to a niche product.

4. Applicant’s Survey Shows Acquired Distinctiveness

a. Forty Two Percent (42%) Of The Relevant Universe Associates The 911 Hz Tone With A Single Source

In September 2005, Applicant commissioned Dr. Michael Rappeport of RL Associates to design and carry out a fair and unbiased test of the extent to which (if any) Applicant’s 911 Hz Mark is associated with a single source. (Rappeport Testimony at p. 11 (line 13) – p. 12 (line 3), and related exhibit 2.) One hundred and eighty in-person interviews were conducted with police officers, fire fighters, and emergency medical technicians (“EMTs”) at their workplaces.

(Rappeport Testimony at p. 14 (line 14) – p. 15 (line 20).) Those groups represent the great majority of users of two-way radio users. (*Id.* at p. 12 (line 11) – p. 13 (line 12).)

The interviews were geographically distributed throughout eight of the nine census regions of the United States at 14 different locations in each area, with no more than two interviews at any one location. (Rappeport Testimony at p. 13 (line 13) – p. 15 (line 1).) All of the interviews were run under “double blind” conditions – meaning that neither the interviewers nor the respondents knew the purpose or sponsor of the survey. (*Id.* at p. 23 (line 15) – p. 24 (line 3).)

Each respondent heard four sounds: Applicant’s 911 Hz Mark, the “startup” sound for the WINDOWS operating system, a standard “ding-dong” doorbell sound, and the sound of a paper cutter when it is being used – the latter three sounds being controls. (Rappeport Testimony at p. 16 (line 13) – p. 18 (line 16).) The sounds were played on a compact disc player, and in different sequences to avoid any rotation effect. (*Id.* at p. 18 (line 6) – p. 19 (line 4).)

Each respondent was told that he/she would be hearing four sounds, and before hearing each one, was instructed as follows:

If you happen to know what this sound is, please tell me what it is and what, if anything, you know about it. Please be as specific as possible. If you don’t happen to know what that sound is, it is okay to say so. (Rappeport Testimony at p. 20 (line 10) – p. 21 (line 6).)

The sound was then played and the interviewer recorded *verbatim* the respondent’s comments about the sound. The interviewer then asked, “Is there anything else?” (Rappeport Testimony at p. 20 (lines 7-23).)

If the respondent could identify the sound but did not mention a specific company in his/her answer, the following question was asked:

You said that sound comes from a [ANSWER FROM ABOVE]. Are you thinking of one company who makes that [ANSWER] or more than one company

who makes that [ANSWER]? (Rappeport Testimony at p. 21 (line 24) – p. 23 (line 7), and related exhibit 2 at MOT 004690-93.)

After following a three-pronged validation procedure, Dr. Rappeport tabulated one hundred and sixty four (164) of the 180 interviews for purposes of his analysis. (Rappeport Testimony p. 24 (line 4) – p. 27 (line 13).) After accounting for any “noise” through the use of the controls, Dr. Rappeport concluded that:

Fifty-two percent of respondents identified Applicant’s 911 Hz Mark as coming from a radio and/or walkie-talkie (Rappeport Testimony at p. 28 (line 12) – p. 31 (line 3), and related exhibit 2 at MOTO 004684 (“We conclude that net of noise 52% (21+27+4) recognize the ‘chirp’ sound as that made by a radio and/or walkie-talkie”));

Fifty-two percent of respondents said the source of Applicant’s 911 Hz Mark was Motorola and/or Nextel (Rappeport Testimony at p. 31 (line 4) – p. 33 (line 13), and related exhibit 2 at MOTO 004685 (“We conclude that net of noise 52% (14+29+9) associate the ‘chirp’ sound with Motorola and/or Nextel”); and

The intersection of the two groups shows that **42% of respondents recognized Applicant’s 911 Hz Mark as coming from a radio/walkie-talkie and from a single source** (Rappeport Testimony at p. 33 (line 14) – p. 36 (line 10), and related exhibit 2 at MOTO 004686 (“the data shows that approximately 42% of the relevant population recognize the ‘chirp’ sound as that made by a Motorola and/or Nextel radio and/or walkie-talkie”).

This is legally sufficient to establish that Applicant’s 911 Hz Mark has acquired distinctiveness. *See Textron, Inc. v. Int’l Trade Comm’n*, 224 U.S.P.Q. 625, 628 (Fed. Cir. 1985) (40% and 37% respondent recognition levels have been held to be sufficient to establish acquired distinctiveness).

b. Opposer Has No Empirical Evidence In Opposition To Dr. Rappeport’s Survey

Opposer has produced no survey, or any empirical evidence, that contradicts or even

challenges Dr. Rappeport's survey.¹⁰ Opposer is therefore reduced to criticizing Dr. Rappeport's survey. None of Opposer's arguments has merit.

c. The Survey Questions, Considered As A Whole, Probed The Respondents' Understanding Of The Relationship Between The 911 Hz Tone Emitted From A Two-Way Radio And The Source Of The Tone

Opposer first argues that "the critical question" of the survey "redirected" respondents away from the sound or event and towards the product. The survey, however, does not consist of just one "critical question" but of several questions that build upon each other. They are parts of a whole. Of particular relevance to Dr. Jacoby's "redirection" criticism are the following questions that were asked after the respondents heard Applicant's 911 Hz Mark (and the three controls):

If you happen to know what this sound is, please tell me what it is and what, if anything, you know about it. Please be as specific as possible. If you don't happen to know what that sound is, it is okay to say so.

Is there anything else?

You said that sound comes from a [ANSWER FROM ABOVE]. Are you thinking of one company who makes that [ANSWER] or more than one company who makes that [ANSWER]?

When these questions are read together, as they were presented to the respondents, they expose Opposer's pretense in trying to collapse the survey into one "critical question."

The first question gives respondents who are familiar with the sound the opportunity to connect the sound with a two-way radio, or any other product. The second question gives

¹⁰ When asked why he failed to run a survey in this case, Dr. Jacoby said he understood it to be Applicant's burden of proof and that he was "too busy" to take that on. (Jacoby Testimony at p. 78 (lines 12-15).) As explained above, Opposer bears the burden of proving that Applicant's Mark is not distinctive. See *American Flange*, 80 U.S.P.Q.2d at 1411. And the limitations of Dr. Jacoby's schedule hardly justify Opposer's decision not to run a survey, particularly given that Dr. Jacoby was first contacted by Opposer about this opposition around November 2005. (Jacoby Testimony at p. 53 (lines 14-20).) Dr. Jacoby was also too busy to read the entirety of Dr. Rappeport's testimony deposition. (Jacoby Testimony at p. 99 (lines 10-15).)

respondents an opportunity to offer any other relevant information. And the third question asks whether the product *that makes the sound* – that is, the product that had just been identified by the respondent – comes from one source or more than one source.

Opposer cannot focus only on the third question (the so-called “critical question”) and ignore the other questions. Yet Opposer’s argument requires such a selective reading of the survey. If any “redirection” is taking place, it is Opposer’s attempt to steer the Board away from looking at the survey as a whole.

As discussed above, fifty two percent (52%) of respondents identified the sound as coming from a two-way radio and/or a walkie-talkie. When those respondents were then asked the so-called “critical question” – “Are you thinking of one company who makes that [two-way radio] or more than one company who makes that [two-way radio]?” – the connection between the sound and the radio (or walkie-talkie, as they case may be) had already been established. After the answers to both questions were tabulated, Dr. Rappeport found that 42% of respondents identified the sound as coming from a radio/walkie-talkie that was made by one source. This is a direct measure of acquired distinctiveness.

Secondary meaning surveys asking similar questions have been accepted by the courts. For example, in *National Football League Properties, Inc. v. Wichita Falls Sportwear, Inc.*, 215 U.S.P.Q. 175 (W.D. Wash. 1982), the defendant sold replica football jerseys bearing various indicia of NFL teams, including the teams’ nicknames (*e.g.*, “Seahawks”). The plaintiffs introduced a secondary meaning survey, described as follows:

[P]laintiffs’ survey was directed toward answering this question: When presented with football replica jerseys do people associate *such jerseys* with the National Football League or its franchised team? The data indicates a significantly high association in the public’s mind between *the jerseys* and the NFL or member clubs. ...

The level of association between *the shirt* and the NFL is not surprising. ... 215 U.S.P.Q. at 181 (emphasis added).

The Court explained that secondary meaning “tests the connection in the buyers’ mind between *the product bearing the mark* and its source” and that plaintiffs’ marks had attained secondary meaning. *Id.* (emphasis added).

Likewise, in *McNeil-PPC Inc. v. Granutec Inc.*, 37 U.S.P.Q.2d 1713 (E.D.N.C. 1995), plaintiff claimed defendant was infringing plaintiff’s trademark rights in a red and yellow combination for plaintiff’s *TYLENOL* gelcaps. Plaintiff relied on (among other things) a secondary meaning survey on the color combination. The Court found:

Forty-one percent of all respondents, and fifty-two percent of all Tylenol users, associated *the product* with a single brand. Thirty-eight percent of all respondents, and fifty percent of Tylenol users, recognized *the product* as Tylenol. ... [I]t appears that McNeil would likely succeed in a trial on the merits in establishing secondary meaning in the red and yellow trade dress of the Tylenol gelcap. *Id.* at 1716 (emphasis added).

These cases establish that the questions used in Dr. Rappeport’s survey linking the product and its source are legally proper and yielded legally meaningful results; namely, that Applicant’s 911 Hz Mark has attained secondary meaning.

Opposer also argues that the secondary meaning users give to Applicant’s 911 Hz Mark “could only have resulted from the prominent placement of Applicant’s registered trademarks and logos on the two-way radios themselves.” (Opposer’s Brief at p. 39.) However, none of the respondents was shown a two-way radio (or any device) during the survey process. The sounds heard as stimuli during the interviews were played only from a compact disc. As Dr. Rappeport explained:

Q: ... Were the respondents shown the two-way radios while they were being questioned about the chirp?

A: No, they were not shown anything. The interviewer was sent a disc. That's all the interviewer had. The disc doesn't have anything on it. I don't know what player the interviewer used, but they're using a disc

player, not a two-way radio. (Rappeport Testimony at p. 62 (lines 14-21).
See also Id. at p. 19 (lines 16-20).)

Dr. Jacoby conceded this as well. (Jacoby Testimony at p. 86 (lines 13-22).) Applicant's use of its famous MOTOROLA trademark in the marketplace, but not in the survey, cannot negatively affect the survey results.

Opposer relies on *American Flange & Manufacturing Co. v. Rieke Corp.*, 80 U.S.P.Q.2d 1397 (T.T.A.B. 2006), to support its challenge to the so-called "critical question" in the Rappeport survey. However, the survey in *American Flange* is entirely different from Dr. Rappeport's design. The survey in *American Flange* tested only whether "applicant is the party 'most commonly associated with' the product design." *Id.* at 1414. That inquiry "does not address acquired distinctiveness." *Id.* at 1415. Dr. Rappeport's design is not so limited. Instead, after first establishing a connection between the Applicant's 911 Hz Mark and radios/walkie-talkies, the survey then asks whether the Mark comes from one source or more than one source. That is a direct measure of acquired distinctiveness.

Opposer's reliance on *In re E.I. Kane*, 221 U.S.P.Q. 1203 (T.T.A.B. 1984), is also misplaced. The survey in that case asked whether "Office Movers" was a trade name. The issue before the Board, however, was whether OFFICE MOVERS, INC. functions as a service mark by identifying the applicant's services and distinguishing them from the services of others. *Id.* at 1206. Whether Office Movers is a trade name says nothing about ability of OFFICE MOVERS, INC. to be a service mark or whether it had acquired distinctiveness. There is no parallel between the facts and issues in *Kane* and those currently before the Board.

**d. The Survey Universe of Police Officers, Fire Fighters, and
Emergency Medical Technicians Was Proper And Sufficient**

Opposer argues that Dr. Rappeport tested an under-inclusive universe. The survey respondents were police officers, fire fighters, and EMTs, who are users of two-way radios.

(Rappeport Testimony at 12 (line 11) – 13 (line 12).) These groups together represent the great majority of users of two-way radios. (*Id.*)

Opposer claims that the survey should have included individuals in construction, building maintenance, private security, and event management. (Opposer's Brief at 40.) However, Opposer's argument is based on speculation, which cannot discharge Opposer's burden of proof. Dr. Jacoby admitted that he has no reason to believe that the supposed under-inclusiveness had any effect on the survey results (Jacoby Testimony at p. 79 (lines 9-17)), and he is unable to quantify what percentage of what he considers to be the proper universe was excluded from the survey. (*Id.* at p. 81 (line 19) – p. 82 (line 3).)

Dr. Rappeport, however, had reason to question police officers, fire fighters, and EMTs: they represent "the great majority" of users of two-way radios. (Rappeport Testimony at p. 12 (lines 21-24).)

e. Opposer's Remaining Criticisms Are Speculative And Without Effect

Opposer claims that "some portion" of the respondents "may have had two-way radios with them during the survey" and that this "possibility" undermines the survey results. (Opposer's Brief at 41.) But Opposer has no evidence or legitimate reason to believe that any respondents had two-way radios with them during the survey. As explained earlier, the only stimuli presented to the respondents were four sounds played from a compact disc.

The case Opposer relies on to support its speculation on this point, *Marcalus Manufacturing Co. v. Watson*, 115 U.S.P.Q. 232 (D.D.C. 1957), highlights Opposer's conjecture. In *Marcalus*, there was affirmative evidence that the survey respondents:

could either see the plaintiff's goods [bearing the alleged mark at issue] or had previously seen them, because they were located either in that person's line of vision or in the vicinity of the place where the person was standing. *Id.* at 234.

By contrast, Opposer has completely failed to adduce any corresponding evidence regarding Dr. Rappeport's survey.

In one paragraph (Opposer's Brief at p. 41 (second paragraph)), Opposer briefly lists three other supposed flaws with the implementation of Dr. Rappeport's survey. Significantly, Dr. Jacoby is unable to state that any of them, or even their combined effect, had any effect on the survey results. Consequently, even if the criticisms were valid (which they are not), they are meaningless without evidence of how they affected the survey results.

f. Applicant's Survey Shows 42% Association Between Applicant's 911 Hz Mark And A Single Source

Opposer argues that only those respondents who specifically identified Applicant as the source of the radios/walkie-talkies count as evidence of acquired distinctiveness and that by this measure, the survey shows only 11% acquired distinctiveness. (Opposer's Brief at p. 42.) This position is premised on the legal argument that it is not enough for consumers to associate Applicant's 911 Hz Mark with a single source, they must also identify it with the *correct* source. Opposer's premise is incorrect.

In *Tone Bros. v. Sysco Corp.*, 31 U.S.P.Q.2d 1321 (Fed. Cir. 1984), Tone Brothers sold spices packaged in a unique container to third party distributors, who applied their own label to the container and resold the spices to consumers. Approximately 90% of the containers were sold under private labels. Sysco came up with a similar container and Tone Brothers brought suit, claiming infringement. The district court granted summary judgment for Sysco, finding that Tone Brothers' container had not acquired secondary meaning.

The Federal Circuit reversed based on (among other things) a survey that asked respondents first, whether they could identify the container with a single manufacturer and second, if so, which manufacturer they believed the container came from. In response to the first

question, 37% of the respondents identified the container with a single manufacturer. However, with regard to the second question, respondents identified 20 different manufacturing sources. Tone Brothers was not the most-named source. In fact, more people identified Sysco as the source than identified Tone.

The Federal Circuit held that the answers to the first question alone evidenced a consumer association between Tone Brothers' container and a single source, which was all that was necessary to establish secondary meaning. *Id.* at 1329. This was required by the "single, anonymous source rule." *Id.* The fact that consumers did not know that it was Tone Brothers – and that they believed it to be others – who manufactured the spices was beside the point. *Id.* The survey, combined with other circumstantial evidence, raised a genuine issue of material fact as to secondary meaning. *Id.* at 1330. The court accordingly reversed and remanded the case for further proceedings.

Likewise here, the fact that some respondents believe the source of the 911 Hz Mark to be an entity other than Applicant does not eliminate them from the secondary meaning calculation. So long as they believe there is only one source behind that Mark, that is sufficient under *Tone Bros.* See also *In re Polar Music Int'l AB*, 221 U.S.P.Q. 315, 317-18 (Fed. Cir. 1983) ("The source of the goods does not depend on the public's perception; the public need not know appellant's role. Thus, the board's holding that 'ABBA' cannot function as a trademark for recordings because the public would not know that appellant owns the rights in 'ABBA' and that it exercises quality control over the records must be rejected"); 15 U.S.C. § 1127 (a trademark indicates the source of goods "even if that source is unknown").

The Board did not announce a new rule in *American Flange*. Instead, it invoked the long-settled single-source rule: "the applicant must show that the product design identifies a

single source.” *American Flange*, 80 U.S.P.Q.2d at 1414. The Board’s subsequent statement – that evidence showing that the public associates the product design with the applicant would satisfy applicant’s burden – does not establish that such evidence is required. In fact, there is nothing in *American Flange* that requires ignoring or subtracting answers that identify an incorrect entity as the source behind a mark. So long as respondents identify a single source, correctly or otherwise, the mark is source-identifying. Opposer asks the Board to interpret *American Flange* in a manner that destroys the single-source rule and overturns the Federal Circuit’s holding in *Tone Bros.* The Board should reject the offer.

Opposer also relies on *I.P. Lund Trading ApS v. Kohler Co.*, 56 U.S.P.Q.2d 1776 (D. Mass. 2000), in support of its argument. But in doing so, Opposer asks the Board to follow a case that is contrary to the Federal Circuit’s *Tone Bros.* decision, which controls this proceeding. See V. Palladino, SECONDARY MEANING SURVEYS IN LIGHT OF *LUND*, 91 Trademark Law Reporter 573, 614 (May-June 2001) (*Lund* violates the well-established anonymous source rule).¹¹

The same flaws are in the other two district court cases upon which Opposer relies: *Zippo Manufacturing Co. v. Rogers Imports Inc.*, 137 U.S.P.Q. 413, 428 (S.D.N.Y. 1963) (court erroneously discounted a survey where respondents identified more than one manufacturer as the source); and *Carroll Shelby Licensing, Inc. v. Superformance Int’l, Inc.*, 251 F.Supp.2d 983, 986-87 (D. Mass. 2002) (court misapplied the anonymous source rule when it held that “Shelby must prove that the primary significance of the Cobra shape [trade dress] in the minds of consumers is to identify Shelby as the *single producer*”).

¹¹ A copy of the relevant portion of the Palladino article is attached hereto as Exhibit 2.

Opposer's argument also fails given the parties' business relationship and users' marketplace behavior. Applicant and Opposer enjoy a "manufacturer-customer" relationship with regard to cellular telephones. Applicant manufactures cellular telephones that emit a sound to indicate when a channel is available for "walkie-talkie" communication. Applicant sells its telephones to Opposer, who then offers network services, for use with Applicant's telephones, to customers at retail. Thus, there is a parallel user experience between Applicant's two-way radios and Opposer's network services: the products used in each system are manufactured by Applicant and emit a sound that informs users that an open channel is available for direct, or "walkie-talkie," communication. Applicant invites the Board to listen to both sounds, which can be found at Klein Testimony exhibit 1 (Applicant's two-way radio 911 Hz Mark) and exhibit 8 (Applicant's cellular telephone 1800 hertz tone). In fact, users of Applicant's two-way radios often carry and use Applicant's cellular telephones used with Opposer's network services. For example, police officers need to communicate with accident victims to collect information. The officer cannot use her two-way radio to contact the victim so she uses her cellular telephone, which is manufactured by Applicant and is used on a network operated by Opposer. (Klein Testimony at p. 25 (line 24) – p. 26 (line 16); Rappeport Testimony at p. 39 (line 13) – p. 41 (line 3).) Thus, Dr. Rappeport's inclusion of respondents who identified Nextel as the source of Applicant's 911 Hz Mark is proper.

VI. EVIDENTIARY OBJECTIONS

A. Opposer's Second Notice of Reliance Should be Stricken

Opposer's Second Notice of Reliance consists of deposition testimony from Ms. Allison O'Reilly, an employee of Opposer whom Opposer designated as its 30(b)(6) witness. Opposer cannot offer this testimony in evidence because it is not testimony of an adverse party. *See* 37

CFR 2.120(j)(1); T.B.M.P. § 704.09; *First Int'l Svcs. Corp. v. Chuckles, Inc.*, 5 U.S.P.Q.2d 1628, 1630 n.5 (T.T.A.B. 1988) (“...[T]he discovery deposition of an officer of a party may be offered in evidence only by an adverse party.”) Opposer attempts to offer Ms. O’Reilly’s testimony under 37 C.F.R. § 2.120(j)(4). However, the particular portions of Ms. O’Reilly’s testimony included in the Second Notice of Reliance do not fit the limited exceptions of Rule 2.120(j)(4), which are based upon fairness and correction of “misleading” designations from an adverse party. Opposer’s Second Notice of Reliance should be stricken in its entirety.

1. “Handset Testimony” regarding Blackberry

In the section labeled “Handset Testimony,” Opposer seeks to introduce Ms. O’Reilly’s testimony relating to a RIM Blackberry® product. Opposer’s basis for doing so is to “complete and clarify testimony relied on by Applicant at Page 25, Lines 10-14, by providing the witness’s complete testimony confirming that Motorola is not the only manufacturer of Nextel devices providing two-way radio capabilities.” (Opposer’s Second Notice of Reliance at 1-2.) However, Applicant’s citation to Lines 10-14 do not provide this opening. Lines 10-14 are questions and answers relating specifically to *Motorola*. It does not refer to other manufacturers, such as RIM. The designated testimony at issue appears below:

Q: Does Motorola manufacture products for use with Nextel’s dispatch services?

A: Yes.

Q: Which products?

A: Again, all handsets.

(O’Reilly Dep. at p. 25 (lines 10-14).)

If Opposer was dissatisfied with its designee’s answer or wanted to enter testimony regarding RIM or other alleged manufacturers into the record, Opposer was required to notice up Ms. O’Reilly for a testimony deposition and ask those questions, which it did not do. Rule 2.120(j)(4) does not provide this opportunity. It is also noteworthy that the testimony Opposer

seeks to include under the Rule is not even on the same page of the transcript as the allegedly “misleading” citation it claims to remedy. Under the guise of Rule 2.120(j)(4), Opposer attempts to cherry-pick testimony on other topics in an attempt to salvage its standing deficiencies. Thus, Opposer’s designations of Ms. O’Reilly’s discovery deposition testimony relating to RIM or other manufacturers do not remedy “misleading” citations and should be stricken (O’Reilly Dep. at p. 23 (lines 13-16); p. 25 (lines 15-19); p. 37 (lines 17-25); p. 38 (lines 1-2)).¹²

**2. “Acquired/Inherent Distinctiveness Testimony”
regarding Applicant’s Mark**

Opposer also improperly seeks to rely on its own witness’s discovery testimony and counsel’s objections relating to the distinctiveness of Applicant’s Mark. Again, under the guise of Rule 2.120(j)(4), Opposer seeks to add its own Rule 30(b)(6) discovery designee’s testimony into the record along with statements and objections raised by counsel. Procedurally, this is improper because it doesn’t correct any “misleading” citations by Applicant that should “in fairness be considered.” 37 C.F.R. § 2.120(j)(4). Substantively, counsel’s “calls for a legal conclusion” objections were unfounded because the questions at issue specifically called for the *factual* basis for certain allegations in Opposer’s Notice of Opposition. (*See, e.g.*, Applicant’s Notice of Reliance at II.A. citing O’Reilly Dep. at p. 33 (lines 24-25) (“... What’s the factual basis for that statement?”); p. 34 (lines 17-19, 23-24) (“Are you aware of any market studies to support the claim that the tone is not inherently distinctive?” and, “Are you aware of any focus groups that have been conducted on that question?”). None of the questions identified in Opposer’s Second Notice of Reliance were objectionable on the grounds of calling for a legal

¹² If the Board decides to accept Opposer’s Second Notice of Reliance and consider its substantive arguments, Applicant urges the Board to note that Ms. O’Reilly did *not* testify that the RIM Blackberry product emits the 911 Hz Mark, nor did she testify that Applicant has threatened to assert its 911 Hz Mark against RIM or Opposer. Thus, her testimony does not salvage Opposer’s standing deficiencies.

conclusion. Thus, even if Opposer's objections were properly of record under Rule 2.120(j)(4), which they are not, they are unfounded.

B. Evidentiary Defects in Opposer's First Notice of Reliance

Opposer's First Notice of Reliance contains an evidentiary defect in Section F. Opposer seeks to introduce certain documents produced by Applicant during discovery (MOT 4773-4774 and MOT 4796-5451) as "admissions against interest." This is not procedurally proper under the notice of reliance rules. Documents obtained from another party cannot be made of record under a notice of reliance unless they are admissible under Rule 2.122(e) as "printed publications and official records." 37 CFR § 2.120(j)(3)(ii). These documents are not "printed publications or official records" and are therefore not admissible under a notice of reliance.¹³

VII. SUMMARY AND CONCLUSION

The evidence establishes that Applicant's 911 Hz Mark is used as a mark, is not functional, and is inherently distinctive or, in the alternative, has acquired distinctiveness. Opposer has failed to establish that any more is required as a matter of law. Opposer has not satisfied its burden of proof on the grounds set forth in its Amended Notice of Opposition. Moreover, Opposer lacks standing to oppose this application. For the foregoing reasons, Applicant respectfully requests that the opposition be denied.

¹³ Applicant marked these documents as exhibits during its testimony deposition of Michael Rappeport. Thus, they are only admissible to the extent permissible under the testimony rules.

Respectfully submitted,

Dated: April 16, 2007

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EXHIBIT 1

C

The Trademark Reporter
July-August, 2005

Article and Report

***773 CINNAMON BUNS, MARCHING DUCKS
AND CHERRY-SCENTED RACECAR EXHAUST:
PROTECTING NONTRADITIONAL
TRADEMARKS [FN1]**

Jerome Gilson [FNaa1]
Anne Gilson LaLonde [FNaaa1]

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"In order to have a viable future,
brands will have to incorporate a brand
platform that fully integrates the five senses."
[FNaaaa1] **I. INTRODUCTION**

You can see, smell, taste, touch and hear them.
You can even store your firewood in them, feed your
dog with them, sit on them, clean your pool with
them and, if hunger strikes, eat them. What, if
anything, do they have in common?

Actually, they are all nontraditional trademarks,
often skirting the outer limits of trademark protection
and, in some cases, evoking head-scratching, eye-
rolling or just plain chuckling. For examples of this
singular legal genre, take the Cinnabon cinnamon
bun, [FN1] the Peabody Hotel daily March of the
Ducks, [FN2] Manhattan Oil's cherry fragrance
additive to race car fuel [FN3] and even the sound of
tourists quacking while riding in amphibious
vehicles. [FN4]

*774 Most trademarks are readily perceived as
source identifiers: word marks, design marks, logos,
acronyms and slogans. The same is true of most
forms of trade dress, *i.e.*, packaging colors and
designs. However, three-dimensional marks, such as
product and packaging configurations, we classify
along with scent, sound, color and taste as
nontraditionals, those that are not so readily
perceived as identifiers.

In the United States, the owner of a nontraditional
trademark may register it or prove that it is valid if it
distinguishes one source from another and is not
functional or descriptive. There is no legal

requirement that these marks, or indeed any marks,
be clever, profound, amusing or thought-provoking.
Still, it can fairly be said that many nontraditional
marks are inspired.

The broad Lanham Act definition of "trademark"
encompasses nontraditional marks by not excluding
them: The term "includes any word, name, symbol,
or device, or any combination thereof" that identifies
and distinguishes the goods and services of one
person from those of another and indicates their
source. [FN5] In short, according to a Supreme Court
watershed in modern American trademark law, a
trademark may be "almost anything at all that is
capable of carrying meaning." [FN6] As Cole Porter
wrote, "Anything Goes."

A. Marketplace Alarms: Lindstrom's Code Red

Branding guru Martin Lindstrom warns that "if
branding wishes to survive another century it will
need to change track. More communication in an
already overcrowded world simply won't do it." [FN7]
Even distinctive brands need more than
traditional television or print advertising in order to
reach consumers. The new track would have brands
go beyond sight and sound to reach consumers
through smell, touch and taste.

*775 Lindstrom's novel ideas do not come from
thin air. He relies on a market research study that
began with focus groups in thirteen countries
exploring the role of the senses in creating brand
loyalty to ten global brands and additional local
brands. [FN8] The study also involved an online
interview with over 2000 people in the United States,
the UK and Japan providing information on their
sensory associations, purchase intent and more, for
eighteen brands. [FN9]

According to Lindstrom, multisensory branding
done right engages consumers emotionally. He notes
that "[s]ight may convey information well, but even
at best it creates a less deeply felt emotional
response." [FN10] An emotional connection to a
brand makes the brand more compelling and
engenders consumer loyalty, Lindstrom says. [FN11]

Lindstrom urges brand owners to conduct a
sensory audit: Is the brand using all available sensory
touch points? Is the sensory experience of the brand
strong, consistent and distinctive? To what extent
does the consumer associate these sensory signals

two of its best wine customers, who claim that the scents are clearly distinguishable and that they would never associate grape with Cheery Cherry. Arbitrator Montand scoffs at the scientific report, ritualistically sniffs the respective strips, and rules unequivocally for Fuschia. There is no appeal. [FN130]

IV. FLAVOR MARKS

Unlike sound and color marks, flavor marks have not yet caught on in the marketing community. Lindstrom acknowledges that incorporating the sense of taste into a brand is "tricky" but "brands that can incorporate taste can clearly build a very strong brand platform." [FN131] Many people could likely identify the distinctive flavors of Juicy Fruit gum, Gatorade or Coca-Cola, but the producers have not rushed out to register those flavors. Searching the USPTO's database to clear the mark, then, will not give significant results; one must investigate the industry to determine whether similar products are flavored.

There is at present one pioneering flavor application pending before the USPTO. Filed on November 18, 2002, it seeks registration for "antidepressants in quick-dissolving tablets" where the mark is "an orange flavor." [FN132] In that case, a final Office Action denied registration on June 6, 2004, stating that the mark was a standard feature of the goods that would not be perceived as a source indicator and also that the mark was functional because it covered the medicinal taste of the pharmaceutical product. The applicant appealed the refusal to register and, as of this writing, the matter was before the Board.

One substantial impediment to enforcement of flavor marks is functionality. Certain flavors may be found to be functional *801 because they need to be available to the competition. Mint toothpaste for adults and bubble gum toothpaste for kids, for instance, are likely to be found functional because they are refreshing and appealing. Or those flavors may be found to be generic because they are used so frequently by different manufacturers. Courts are more likely to find flavor marks to be nonfunctional when they are added to products that are not meant to be consumed. For example, an unusual flavor-- like melon or caramel or peanut butter--added to a toothbrush or dental floss would be more likely to be protected than the same flavors for cookies or bread if food manufacturers would be more likely to have a competitive need for flavors than those who make dental hygiene products.

Consumers may not see flavor in a product as a trademark. To them, it may be just another feature of the goods. Artichoke-flavored thermometers, for example, may be just another interesting invention and not one that indicates that the products come from a particular source. The penguin-shaped cocktail shaker casts a long shadow.

Flavor marks are almost certainly not protectable without acquired distinctiveness, just as color and scent marks cannot be inherently distinctive. This status puts such marks at a decided disadvantage in enforcement actions, particularly in dilution actions where the mark must be famous and not just distinctive.

V. TACTILE MARKS

The sensation of touch can be healing, relaxing, or stimulating. In terms of a brand, the feeling and textures of a product can play on a consumer's emotions and can also relate directly to his or her perception of quality. [FN133]

To date, there are no known application or enforcement activities for tactile marks in the United States. Perhaps some enterprising marketer will attempt to overcome the functionality problem and register the sensation of bubble wrap for a soft drink, the sensation of fur for a perfume or the sensation of sandpaper for a computer printer.

VI. SOUND MARKS

Sound marks are probably the most memorable nontraditional trademarks. One's memory bank contains hundreds of melodies, songs and tone combinations. These are definitely capable of identifying and distinguishing goods and can be registered if *802 consumers associate them with the source of goods. [FN134] They can include musical tones, spoken or sung words, animal noises or any other sound. It is surprising that more are not registered.

Sound is "emotionally direct," as Lindstrom notes. [FN135] Music can affect purchasers in stores and restaurants, just as the piped-in sound in Disney World can improve the mood of visitors.

There is nothing new about protecting audio marks. The granddaddy of all sound marks is the NBC chimes. First registered as a service mark for radio just after passage of the Lanham Act and later re-registered for television, the well-known mark is "a sequence of chime-like musical notes which are in

the key of C and sound the notes G, E, C, the 'G' being the one just below middle C, the 'E' the one just above middle C, and the 'C' being middle C" [FN136] And in the twenty-first century, the Intel audio logo for computer hardware and software, microprocessors, integrated circuits and semiconductor devices has become widely-known and registered. [FN137] Here is just a sampling of some other sound marks registered with the USPTO:

- For software for notifying consumers of weather alerts, "a series of five chirps similar to the chirping sound of a cricket" (Reg. No. 2827972)

- For "Medicated transdermal patches, plasters, pads, gels and sprays for the temporary relief of the aches of rheumatoid arthritis," "the word 'HISAMITSU' sung over the sound of four musical tones, e, a, e, and f sharp. The first three notes being quarter notes and the final note being a tied quarter and half note" (Reg. No. 2814082)

- For watches, non-metal key chains, cookie jars and Christmas tree ornaments and dolls, "the sound of a childlike human giggle which represents the Pillsbury Doughboy giggle" (Reg. No. 2692077)

- For canned and frozen vegetables, "the sound of a deep, male, human-like voice saying 'Ho-Ho-Ho' in even intervals with each 'Ho' dropping in pitch" (Reg. No. 2519203)

- For "automatic produce misting units for delivering a timed water mist to fruits and vegetables in display cases," "the sounds of thunder and rain" (Reg. No. 2203470)

***803** • For insurance underwriting services, "the sound of a duck quacking the word 'AFLAC'" (Reg. No. 2607415)

- For beer, "the sound of a howling wolf" (Reg. No. 2207874)

- For "Commercial and residential building construction; building repair; installation of siding," "the sound of a kiss made when, for example, one is 'blowing a kiss' to another person, as exemplified in the sound recording included with this application" (Reg. No. 2524758)

Clearing sound marks will be challenging

because there are so few in the USPTO database; many more are in use but their owners have not attempted to register them and there is no common law database of sound marks. [FN138] Therefore, sound marks may be the most difficult nontraditional, albeit the most recognizable, marks to clear. Search the USPTO TESS database for "sound" or "melody" or "music" or "musical" or "noise" or "audio" within the description of the marks to see some of the sound marks that are registered or have been applied for. Beyond that database, however, clearing a particular melody or sound will be quite difficult.

Melodies and songs are good candidates for registration and enforcement. [FN139] For example, "Sweet Georgia Brown," the Harlem Globetrotters' theme song, often accompanied by whistling and finger-snapping, is registered for "entertainment services in the nature of basketball exhibitions" [FN140] and has been associated with stars of yore such as Curly Neal and Sweetwater Clifton and the popular barnstorming team for decades. And segments of George Gershwin's masterpiece "Rhapsody in Blue" have become, through consistent and substantial advertising over many years, intimately associated with United Air Lines. Melodies and musical arrangements often are or become source indicators when used as theme songs of radio or television programs or of performers. However, source indication must be proved. Just because the first four notes of Beethoven's Fifth Symphony are widely recognized does not mean they are associated with any product or service, although they may become so.

Beethoven's Fifth and noisy duck calls appear to have little in common, but they could both be classic nontraditional marks. However, a recent district court opinion determined that the sound of duck calls made during "amphibious tours" was not inherently ***804** distinctive and lacked secondary meaning. [FN141] The plaintiffs in that case own a registration for "a quacking noise made by tour guides and tour participants by use of duck call devices throughout various portions of the tours." The services for which the mark is registered are "tour guide services over land and water by amphibious vehicles." [FN142] In denying a motion for a preliminary injunction, the court relied on the Trademark Trial and Appeal Board's vintage *General Electric* decision in holding that the sound of quacking was too familiar a noise to qualify as inherently distinctive. [FN143] The court went on to find that the plaintiffs had not used the mark long enough for it to have achieved secondary meaning, that their advertising did not emphasize the sound mark and that they "presented no evidence that

a person apprehending a quacking noise on the streets of Philadelphia would reflexively think of the services provided by [plaintiffs]." One can only envision with wonderment a consumer survey interviewer stopping Philadelphia citizens on Broad Street and inquiring of their quacking noise association, if any.

Still, the duck noisemaker case is an important case of first impression. To date there is no other reported case involving a claim of sound trademark infringement, and even though it was not decided after trial on the merits the court's handling of the issues is likely to be influential as future such cases develop. The case also gives new authority to the Board's differentiation between sound marks and typical marks that are applied directly to goods: a sound mark "depends upon aural perception of the listener which may be as fleeting as the sound itself unless, of course, the sound is so inherently different or distinctive that it attaches to the subliminal mind of the listener to be awakened when heard and to be associated with the source or event with which it is struck." [FN144]

Sound marks that are unique or different may be registered on the Principal Register without evidence of acquired distinctiveness, but sounds "that resemble or imitate 'commonplace' sounds or those to which listeners have been exposed under different circumstances" must, in order to be registered, be accompanied by evidence that purchasers or prospective purchasers recognize the sound and associate it with a *805 single source. [FN145] This distinction is similar to the categorization of word marks, from generic to fanciful. In one case, the Board required evidence that the sound of a ship's bell had become distinctive to the average person and identified and distinguished the applicant's radio broadcasting services "to those exposed to such services." [FN146]

Applicants for sound marks need not submit a drawing of the mark, [FN147] but may submit audio cassettes, compact disks or a musical score as specimens. [FN148] In addition, where the sound mark is comprised of music or words set to music, applicants may submit the specimen in .wav format. Because .wav files cannot be sent as an attachment to a TEAS filing, the applicant must send a .wav file after filing the application, as an attachment to an e-mail message to TEAS@uspto.gov, with instructions that the .wav file should be associated with "the application filed under Serial No. ____." [FN149] Applicants must also describe the sound mark clearly on the application. [FN150]

In an infringement case, sound marks will fare just as regular word and logo marks. Courts will likely find the highly distinctive ones to be stronger and the more commonplace ones to be weaker just as the court in the duck noisemaker case found that the sound of a duck quacking was too familiar to be inherently distinctive. [FN151] Courts should be able to categorize and compare sound marks just as they do for more traditional marks. Note that enforcement of musical sound marks may also raise a copyright infringement claim along with the trademark or service mark infringement claim, and that copyright claims carry statutory penalties that trademark law (except for counterfeiting) does not have. [FN152]

Dilution claims are going to be difficult for those sound marks that lack acquired distinctiveness. As for the others, however, a plaintiff may show that they are famous just as distinctive word and logo marks are. The NBC chimes, and Intel's audio logo, for example, are surely famous under dilution standards, and the use *806 of an identical or very similar sound mark could well dilute the distinctive quality of the chimes or the audio logo.

VII. MOTION MARKS

A trademark may identify and distinguish goods by using images in motion, perhaps on a television, movie or computer screen. [FN153] These marks are typically the closest to traditional logo marks of all the nontraditional trademarks; they just add the dimension of movement.

The USPTO has registered several motion marks, including the following:

- For high intensity search lights, the mark "consists of a preprogrammed rotating sequence of a plurality of high intensity columns of light projected into the sky to locate a source at the base thereof" (Reg. No. 2323892)

- For banking services, the mark "consists of the numeral '0' that begins as a whole frame and shrinks into the size of a number on a bank check and grows to a full size frame on the screen" (Reg. No. 2756210)

- For "promoting public awareness of the negative effects of smoking," the mark "consists of a stylized capital letter 'Y' within a loosely defined circle orbited clockwise by a second, smaller, loosely defined circle

EXHIBIT 2

The Trademark Reporter[®]

SECONDARY MEANING SURVEYS IN LIGHT OF LUND

*By Vincent N. Palladino**

I. INTRODUCTION

Three related decisions involving product features¹ raise basic questions about how to assess secondary meaning, including the techniques that should be used in surveying that issue. In the seriousness of certain misconceptions, the Lund decisions may rival the Ninth Circuit's misguided purchaser motivation test, which briefly, but genuinely, unnerved the trademark community twenty years ago.²

The issue in *Lund* was whether defendant's sale of a faucet that resembled plaintiff's faucet violated trademark (trade dress) rights plaintiff claimed to have in certain allegedly non-functional features of its faucet. In *Lund I*, the district court awarded plaintiff a preliminary injunction on a dilution theory and dismissed plaintiff's infringement claim. The First Circuit in *Lund II* affirmed dismissal of the infringement claim, reversed the preliminary injunction award and remanded the case. In *Lund III*, the district court held that plaintiff was not entitled to relief on a motion for summary judgment on the dilution claim.

Lund II and *Lund III* ignore or misstate the issues that are involved in surveying secondary meaning. As a result, the *Lund III* district court approved a fundamentally flawed survey technique, which fails to distinguish among the concepts of

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1. *I.P. Lund Trading ApS v. Kohler Co.*, 11 F Supp2d 112 (D Mass 1998) ("*Lund I*"), motion for a stay of the injunction pending appeal denied *I.P. Lund Trading ApS v. Kohler Co.*, 11 F Supp2d 127 (D Mass 1998); *I.P. Lund Trading ApS v. Kohler Co.*, 163 F3d 27, 49 USPQ2d 1225 (CA 1 1998) ("*Lund II*"); *I.P. Lund Trading ApS v. Kohler Co.*, 118 F Supp2d 92, 56 USPQ2d 1776 (D Mass 2000) ("*Lund III*").

2. See generally Vincent N. Palladino, *Genericness and The Trademark Clarification Act of 1984: Five Years Later*, 79 TMR 657 (1989), discussing the Ninth Circuit's decision in *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, 684 F2d 1316, 216 USPQ 588 (CA 9 1982), and subsequent amendment of the Lanham Act, Pub L No 98-620, 98 Stat 3335 (1984).

with products from another source (defendant). Put another way, defendants' very act of infringement (if that is what it is) will interfere with, if not defeat, plaintiff's attempt to enforce its rights. And the more closely defendant's mark resembles plaintiff's mark, the harder it will be for plaintiff to make its case, because the public will be more likely to associate the mark with the products of both plaintiff and defendant, not with the products of plaintiff alone.

2. The Problem of Anonymous Source

As discussed in *Surveying Secondary Meaning*, asking if respondents associate a claimed trademark with the products of one or more than one company may leave defendant wondering whether or not the single unidentified company whose product consumers have in mind, in fact, is the plaintiff. Thus, defendant may prefer two related questions:

Do you associate [claimed trademark] with [product identification] of one, or more than one, company?

If [product identification] of one company, which company?¹¹⁷

Faced with this issue, the Lund III district court refused to credit a survey that allegedly established association of plaintiff's faucet design with the products of one company¹¹⁸ because the survey did not ask respondents to identify the company by name¹¹⁹ and a different survey suggested that some respondents attributed the faucet design to defendant or third parties.¹²⁰ One problem with the court's approach is that it adds a burden to plaintiff's case that plaintiff should not have to shoulder in view of the anonymous source rule.¹²¹ Under that rule, plaintiff should not be required to show that survey respondents can identify plaintiff by name as the single source of the products with which they associate the claimed trademark.

3. Addressing the Problems

The two problems discussed above should encourage plaintiffs to move quickly against defendants that they believe are infringing their rights and to conduct promptly any secondary meaning surveys that may be needed to make out their case. The problems

117. See Palladino, *Surveying Secondary Meaning*, supra note 43 at 168-69.

118. Lund III, supra note 1 at 110, 56 USPQ2d at 1791.

119. Ibid.

120. Id at 106, 56 USPQ2d at 1788.

121. See generally Palladino, *Surveying Secondary Meaning*, supra note 43 at 169.

CERTIFICATE OF SERVICE

I hereby certify that a true copy of APPLICANT'S BRIEF was served on counsel for
Opposer on April 16, 2007, electronically and via First Class Mail, postage prepaid:

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