

This Opinion is not a
Precedent of the TTAB

Hearing:
November 17, 2015

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December 28, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Monster Cable Products, Inc.
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Serial No. 85318060
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David M. Kelly, Robert D. Litowitz and Linda McLeod of Kelly IP LLP,
for Monster Cable Products, Inc.

Kim Teresa Moninghoff, Trademark Examining Attorney, Law Office 113,
Odette Bonnet, Managing Attorney.

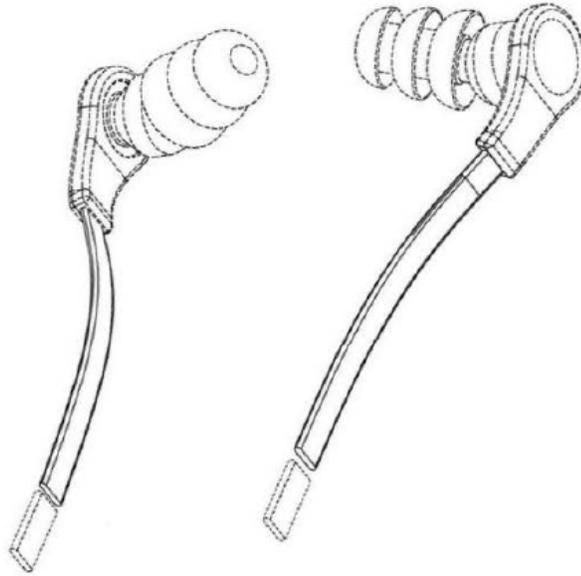
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Before Slifer, Deputy Director, and Zervas and Kuhlke, Administrative Trademark
Judges.

Opinion by Zervas, Administrative Trademark Judge:

Monster Cable Products, Inc. (“Applicant”) seeks registration on the
Supplemental Register of the proposed mark set forth below for “headphone cables
sold as an integral component of headphones” in International Class 9:¹

¹ Application Serial No. 85318060 was filed on May 11, 2011, based upon Applicant’s claim
of first use anywhere and use in commerce since at least as early as July 21, 2008.



The amended description of the proposed mark states:

The mark consists of a headphone cable having a cross-section in the form of an oblong, wherein the cable features contoured outer edges and is significantly wider than it is thick. The headphone cable is used to connect ear bud devices to a headphone splitter. The ear bud areas shown in dotted lines in the mark are not claimed as part of the mark. Additionally, no claim is made to the length of the cable or the splitting of the cable into two cables.²

The Examining Attorney issued a Final Office Action refusing registration of Applicant's mark under Trademark Section 23(c), 15 U.S.C. § 1091(c), as (i) functional, and (ii) generic. Applicant thereafter appealed, and filed three requests for remand. The Board in each instance granted the request for remand

² The Final Office Action required amendment of the description of the proposed mark, and the Examining Attorney proposed this description. *See* July 8, 2014 Office Action. Applicant accepted the description at p. 2 of its Main Brief. 45 TTABVUE 6. The requirement for a proper description therefore has been satisfied and is no longer an issue to be resolved on appeal.

and returned the application to the Examining Attorney. None of the arguments or evidence submitted with any of the requests for remand persuaded the Examining Attorney to approve the application for registration. The appeal is now fully briefed, and Applicant and the Examining Attorney presented arguments at an oral hearing held before this panel on November 17, 2015. We affirm both refusals to register.

I. Preliminary Issue

Before turning to the merits of the refusals, we address the Examining Attorney's objections in her Brief "to the finding of good cause for the Applicant's second and third requests for remand, and the evidence made of record in support thereof."³

Second request for remand and reconsideration of the refusal

On June 18, 2014, Applicant submitted its second request for remand along with a new declaration, a license agreement and two news articles.⁴ The next day, the Examining Attorney refused to reconsider the refusal, and objected to Applicant's statement of "good cause" for the remand.⁵ Specifically, the Examining Attorney stated in her Office Action that the declaration is from an employee of Applicant; that the employee's testimony relates to issues raised in prior Office Actions; and

³ Examining Attorney's Brief, 47 TTABVUE 6.

⁴ The June 18, 2014 filing consists of the request for remand and the evidence submitted therewith, but not the arguments addressing that evidence. Nonetheless, the Examining Attorney acted on the June 18, 2014 filing, issuing an Office Action on June 19, 2014. On June 24, 2014, Applicant re-filed its request, evidence and arguments. *See* 26 TTABVUE and 27 TTABVUE. The Examining Attorney issued an additional Office Action on July 8, 2014, which discussed the Applicant's arguments and evidence and entered additional evidence into the record. *See* 29 – 37 TTABVUE.

⁵ Examining Attorney's Brief, 47 TTABVUE 4, fn. 3 and 4.

that Applicant did not explain why it could not provide the declaration earlier.⁶ The Examining Attorney also objected to the remaining evidence, stating that it predates the prior request for remand and therefore could have been submitted earlier. Despite the objections, the Examining Attorney discussed the evidence submitted in the June 19, 2014 Office Action, and in subsequent Office Actions.

Third request for remand and reconsideration of the refusal

On November 12, 2014, Applicant filed a third request for remand and reconsideration of the refusal. In its request for remand, Applicant stated,

[T]he Examining Attorney [previously] objected to Internet evidence submitted by Applicant on the grounds that the web pages had not been authenticated pursuant to TMEP § 710.01(b). To provide a full record for consideration by the Board, Applicant seeks to resubmit such evidence in a format that will satisfy the Examining Attorney's objection. In addition, Applicant submits additional examples of various cable designs for the Examining Attorney to consider.⁷

The Board granted the request for remand, and the Examining Attorney considered the evidence and arguments, raising an objection to the evidence. According to the Examining Attorney, Applicant based its November 12, 2014 request for remand on the need "to address the Examining Attorney's objection to evidence provided in support of the previous request for remand, specifically, objections to photos and a web[-]link ..."; the remand request was to "resubmit ...

⁶ The Examining Attorney cites TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE § 1207.02 ("Examples of circumstances that have been found to constitute good cause for a remand for additional evidence include the following: . . . The evidence was not previously available.") and §1209.04 (2015) ("No matter what the purpose, the request for remand must include a showing of good cause.").

⁷ November 12, 2014 Req. for Remand, 41 TTABVUE 4.

evidence in a format that will satisfy the Examining Attorney's objection"; the Board found good cause based on this statement and granted the remand; and the argument seeking reconsideration of the refusal did not provide any information to authenticate the previously provided exhibits.⁸ The Examining Attorney concluded that Applicant improperly used the request for remand to submit additional examples of various cable designs. She cited TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") §1207.02 (2015), and objected that Applicant has not asserted "good cause" for this new evidence and has not claimed that this evidence was unavailable earlier.⁹

The Examining Attorney's objections are directed to the Board's actions in granting the second and third requests for remand, and came to the attention of the Board after the appeal was fully briefed. It is not the practice of the Board to review Office actions, issued after remands and prior to briefing and final determination of the case, to determine whether an Examining Attorney has an objection to the grant of a request for remand.¹⁰ Once the Board grants a request to remand, which an Examining Attorney may believe is in error or does not reflect an agreement

⁸ November 19, 2014 Office Action.

⁹ Specifically, the Examining Attorney states in the November 19, 2014 Office Action at p. 2:

The applicant has provided photos ... and printouts from ... a variety of ... websites, all of which was [sic] gathered between November 4, 2014, and November 12, 2014. This type of evidence was available before the filing of the notice of appeal and at the time of the applicant's prior requests for remand. The applicant has not highlighted any particular examples of this evidence that were not available until this month.

¹⁰ The decision whether to grant or deny a request for remand is within the discretion of the Board. TBMP § 1207.02.

reached with an applicant, an Examining Attorney should promptly inform the Board after the application is remanded and prior to issuing an Office action regarding the accompanying arguments and evidence. The Board will then consider the Examining Attorney's objection, and, if well taken, will vacate the grant of the request for remand. It is not appropriate to bring such an objection to the Board's attention for the first time in a brief.

Thus, the Examining Attorney's objections to the Board's decision to grant the second and third requests to remand are overruled.

II. Substantive Refusals

We turn now to the two pending refusals before us, first on the ground of functionality, and next on the ground of genericness.

Functionality

As noted above, the present application seeks registration on the Supplemental Register. Functional matter is unregistrable, even on the Supplemental Register. Trademark Act Section 23(c) ("For the purposes of registration on the supplemental register, a mark may consist of any ... configuration of goods ... that as a whole is not functional ... but such mark must be capable of distinguishing the applicant's goods or services"). *See also, In re Heatcon, Inc.*, 116 USPQ2d 1366, 1370 (TTAB 2015), *recon. denied*, slip op. (TTAB Nov. 17, 2015). The case law addressing functionality refusals under Section 2(e)(5) of the Trademark Act, 15 U.S.C. § 1052(e)(5), for applications to register asserted marks on the Principal Register, "remains equally applicable because the issue, functionality, is the same," even

though the statutory authority for the refusal is Section 23 of the Trademark Act.¹¹ *Id.*, (citing *In re Minnesota Mining and Mfg. Co.*, 335 F.2d 836, 142 USPQ 366, 368 (CCPA 1964)).

A product feature is functional and cannot serve as a trademark “if the feature is essential to the use or purpose of the article or if it affects the cost or quality of the article.” *TrafFix Devices Inc. v. Marketing Displays Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001), (citing *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 34 USPQ2d 1161 (1995), quoting *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 214 USPQ 1, 4 n.10 (1982)). To afford registration to functional designs would inhibit legitimate competition by, in effect, granting a monopoly to a non-reputation related, or nonsource-identifying, feature of a product. *Qualitex*, 34 USPQ2d at 1163-64; *In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1, 6 (Fed. Cir. 1985) (“If the feature asserted to give a product distinctiveness is the best, or at least one, of a few superior designs for its *de facto* purpose, it follows that competition is hindered”). “To support a functionality rejection in proceedings before the Board, the PTO examining attorney must make a *prima facie* case of functionality, which if established must be rebutted by ‘competent evidence.’” *In re Becton, Dickinson and Co.*, 675 F.3d 1368, 102 USPQ2d 1372, 1376 (Fed. Cir. 2012) (quoting *In re Teledyne Indus.*, 696 F.2d 968, 217 USPQ 9, 11 (Fed. Cir. 1982)).

The Federal Circuit, our primary reviewing court, looks at four factors when it considers the issue of functionality:

¹¹ Section 2(e)(5) of the Trademark Act, 15 U.S.C. § 1052(e)(5), provides that registration of a product design may be denied if it “comprises any matter that, as a whole, is functional.”

- (1) the existence of a utility patent disclosing the utilitarian advantages of the design;
- (2) advertising materials in which the originator of the design touts the design's utilitarian advantages;
- (3) the availability to competitors of functionally equivalent designs; and
- (4) facts indicating that the design results in a comparatively simple or cheap method of manufacturing the product.

Valu Eng'g Inc. v. Rexnord Corp., 278 F.3d 1268, 61 USPQ2d 1422, 1426 (Fed. Cir. 2002), (citing *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 USPQ 9, 15-16 (CCPA 1982)). These are known as the “*Morton-Norwich* factors.”

Upon consideration of these factors, our determination of functionality is ultimately a question of fact, and depends on the totality of the evidence presented in each particular case. *Valu Eng'g*, 61 USPQ2d at 1424; *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1339 (TTAB 1997). *See also*, TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) § 1202.02(a)(iv) (October 2015).

Furthermore, and particularly relevant to this proceeding, our primary reviewing court has instructed that “[w]henver a proposed mark includes both functional and non-functional features ... the critical question is the degree of utility present in the overall design of the mark.” *Becton, Dickinson*, 102 USPQ2d at 1376. “[A] mark possessed of significant functional features should not qualify for trademark protection where insignificant elements of the design are non-functional.” *Id.*

1. *Utility patent disclosing the utilitarian advantages of the design.*

The first *Morton-Norwich* factor is whether a utility patent discloses the utilitarian advantages of the design. “[T]he disclosure of a feature in the claims of a utility patent constitute strong evidence of functionality,” and “statements in a patent's specification illuminating the purpose served by a design may constitute equally strong evidence of functionality.” *Becton, Dickinson*, 102 USPQ2d at 1377 (citations and internal quotations omitted); accord *In re Mars Inc.*, 105 USPQ2d 1859, 1861 (TTAB 2013); *Kistner Concrete Products, Inc. v. Contech Arch Technologies, Inc.*, 97 USPQ2d 1912, 1920 (TTAB 2011); *In re Dietrich*, 91 USPQ2d 1622, 1627 (TTAB 2009). The utility patent need not “claim the exact configuration for which trademark protection is sought in order to undermine an applicant’s assertion that an applied-for mark is not ... functional.” *Becton, Dickinson*, 102 USPQ2d at 1377.

Applicant is the owner of U.S. Patent No. 8,068,633 B2 entitled “Headphone Cable Splitter” (“the ‘633 patent”).¹² The invention of the ‘633 patent is directed to a flat headphone cable having a unitary cable section and split cable sections, which “enables the user of a flat headphone cable to orient the unitary cable section flat against his body while the split cable sections lay flat against his face.”¹³ The patent specification identifies the specific advantages of Applicant’s flat cable design:

A flat ribbon-like cable provides advantages in that its structure is inherently more rigid and therefore less prone to tangling. Moreover, the larger cross-sectional area of a flat cable facilitates passage of

¹² Filed July 31, 2008, issued November 29, 2011. February 13, 2012 Resp. to Office Action,

¹³ February 13, 2012 Resp. to Office Action, col. 1, lines 45-53.

multiple conductors in a side-by-side configuration This provides benefits in terms of lower overall cable impedance and faster transient response as compared to conventional headphone cabling. Moreover, the flat cable can accommodate added functionality such as conductors for a microphone.

Headphone cables typically have a unitary section, in which the left and right channel conductors are combined in a single cable segment, and split left and right sections that connect to each of the left and right ear pieces. During usage of a flat headphone cable, it is desirable to orient the headphone cable so that its unitary cable section lays flat against the user's body. However, it is also desirable to orient the left and right split sections of the cable so that they lay flat against the user's face. This requires that the widths of the unitary cable section and the split cable sections be oriented in a substantially perpendicular relationship. Therefore, there is a need for a flat headphone cable incorporating a splitter that facilitates orientation of the widths of the unitary and split portions of the headphone cable in a substantially perpendicular relationship.¹⁴

Applicant's '633 patent has two claims. Claim 1, the relevant claim, claims cables with a "width" and a "thickness," wherein the width is "substantially greater than" the thickness:

A headphone cable having the following sections:

a unitary cable section having left and right audio channel conductors, said unitary cable section having a cross-sectional width and thickness, said width being substantially greater than said thickness; and

left and right cable sections electrically coupled to said left and right audio channel conductors, respectively, of said unitary cable section, and for connecting to the left and right earpieces of a headphone, said left and right cable sections *having cross-sectional widths and thicknesses, said widths being substantially greater than said thicknesses*, the left and right cable sections being oriented such that the widths of said left and right cable sections are substantially perpendicular to the width of said unitary cable section.

¹⁴ *Id.* at col. 1, lines 18-41.

(Emphasis added.)

The cable dimensions depicted in the configuration drawing and specified in the description of the proposed mark as “a cross-section in the form of an oblong ... significantly wider than it is thick” are (i) described in the specification, and (ii) claimed in Claim 1 (“A headphone cable ... [with a] width being substantially greater than [the] thickness.”). Thus, the ‘633 patent discloses and claims the feature of the invention which results in functional advantages of headphone cables that are substantially wider than thick. These functional advantages are identified as a headphone cable that is less prone to tangling and which facilitates the passage of multiple conductors in a side-by-side configuration for lower overall cable impedance and faster transient response as compared to conventional headphone cabling. Applicant agrees that there are functional advantages, stating “[a]s Monster’s patent discloses, some aspects of Monster’s design are indeed functional—by being wider than thick, the cable can lay flat and can accommodate internal wiring for different functions (music, telephone).”¹⁵ “The disclosure of a feature in the claims of a utility patent constitutes strong evidence of functionality.” *TrafFix*, 58 USPQ2d at 1006.

Applicant argues, however, that the feature of its proposed mark regarding “[t]he outer contours of the cable [being] curved in a manner that results in the cable having a cross-section in the form of an oblong” is not mentioned in the specification and is not claimed in the two claims. Indeed, this feature in the outer

¹⁵ Reply Brief at 3, 48 TTABVUE 7.

contours is not in the claims or the specification. Applicant cautions that “[i]t is improper to dissect a mark by focusing on certain portions while disregarding others,”¹⁶ and heavily relies on dicta found within *TrafFix*, a case involving a trade dress dispute over wind-resistant mobile traffic stands having a “dual-spring design, four legs, a base, an upright, and a sign.” *Id.* at 1007. There, the Supreme Court found the product configuration to be functional, but advised that “[i]n a case where a manufacturer seeks to protect arbitrary, incidental, or ornamental aspects of features of a product found in the patent claims, such as arbitrary curves in the legs or an ornamental pattern painted on the springs, a different result might obtain.” Applicant argues:

Monster’s mark falls squarely within this exception carved out by the Supreme Court in *TrafFix*. Some aspects of Monster’s product may contribute to its function (as noted above, the cable being wider than it is thick allows the cable to lay flat, resist tangling, and accommodate multiple internal wiring). But Monster has shown, through competent and un-refuted expert testimony, that the curved outer contour of Monster’s mark is an “arbitrary, incidental, and ornamental aspect” of the device. ...¹⁷

The testimony Applicant mentions is the testimony of Dr. Rake, a professor of industrial design at the University of Kansas, who states at Paragraph 21 of his declaration:

Edge treatment[s] such as this can be important design elements and can materially affect how consumers and users of a product perceive a product. As one example, Apple’s computers, tablets, and phones are known as much for their innovative designs as for their technical performance, and edge treatments are significant elements of many of Apple’s designs. For example, according to Walter Isaacson,

¹⁶ *Id.*

¹⁷ Reply Brief at 4, 48 TTABVUE 8.

author of the acclaimed biography of Apple founder Steve Jobs, "Jobs spent days agonizing over just how rounded the corners [of one Apple product] should be." In my opinion, the edge treatment of Monster's cable design likewise has an impact on how consumers and users perceive and appreciate the product from an aesthetic standpoint. The rounded edges of Monster's design convey an attractive contemporary aesthetic.¹⁸

The testimony of Jacky Hsiung, an employee of Applicant and an inventor listed on the '633 patent, is also in the record. Mr. Hsiung states:¹⁹

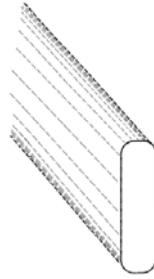
I agree with all of the statements by Professor Rake in paragraph 21 of his declaration. In particular, I agree that the "curved outside contours in Monster's cable design represent an arbitrary, ornamental design choice, not driven by function." I agree that edge treatments such as the curved outer contours of our cable design can be, and in this case are, an important design element and can materially affect consumer perceptions.

The probative value of Professor Rake's and Mr. Hsiung's testimony is tempered by the fact that the outside contours they discuss are small in size and unremarkable in shape. Further, Applicant's webpages do not mention this "attractive contemporary aesthetic," even when they discuss the functional aspects of the significantly wider than thick cable and its non-tangle feature, confirming its triviality. In addition, Applicant itself is inconsistent in identifying the specific contours of its design. The originally filed drawing depicts the cross-section of the oblong configuration as having four sides, with curves connecting each of the sides:²⁰

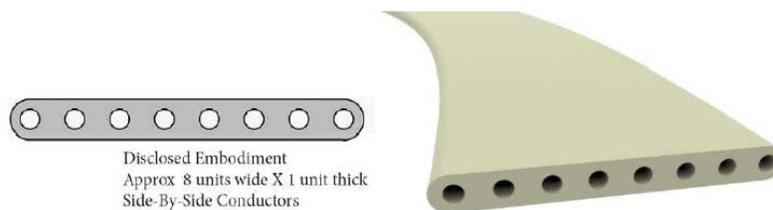
¹⁸ February 6, 2014 Req. for Recon., Rake Decl. ¶ 21, 15 TTABVUE 18.

¹⁹ June 24, 2014 Req. for Recon., Hsiung Decl. ¶ 7, 27 TTABVUE 39.

²⁰ Applicant provided the following description of its configuration in its original application:



Dr. Rake, however, in his declaration, depicts the cross-section of the oblong configuration as a flat top and bottom with two continuously curved sides connecting one another, and not having four sides: ²¹



Dr. Rake describes the sides of the cross-section of the configuration as consisting of “curved outside contours of a headphone cable that give way to sides of the cable jacket that are wider than they are thick.”²² Further, the amended drawing filed on February 13, 2012 and depicted on page 2 of this decision depicts an interior cross-section of the proposed mark, but we cannot determine its precise configuration. We therefore are not persuaded by Professor Rake’s and Mr. Hsiung’s testimony and do not agree with Applicant that the outer contours of its configuration fall within the dicta of *TrafFix*, that “[i]n a case where a manufacturer

The mark consists of the cross sectional shape of a headphone cable limited by the outside contour of the cable jacket. The dotted lines are included to suggest longitudinal shape.

²¹ February 6, 2014 Req. for Recon., Rake Decl., 15 TTABVUE 32-33.

²² *Id.* at 14.

seeks to protect arbitrary, incidental, or ornamental aspects of features of a product found in the patent claims, such as arbitrary curves in the legs or an ornamental pattern painted on the springs, a different result might obtain.” *TrafFix*, 58 USPQ2d 1007.

In our view, Applicant’s outer contours fall within the holding of *Becton, Dickinson*, 102 USPQ2d at 1376, where the Federal Circuit found that the inclusion of a few arbitrary or otherwise nonfunctional features in the design will not render a design nonfunctional when the evidence shows that the overall design is functional. *See also, Textron, Inc. v. U.S. Int’l Trade Comm’n*, 753 F.2d 1019, 1025, 224 USPQ 625, 628-29 (Fed. Cir. 1985); *In re Vico Prods. Mfg. Co.*, 229 USPQ 364, 368 (TTAB 1985). The overall cable configuration comprises “a cross-section in the form of an oblong, wherein the cable features contoured outer edges and is significantly wider than it is thick.” “Oblong” is defined as “in the form of a rectangle one of whose dimensions is greater than the other.”²³ The inclusion of the term “oblong” underscores the aspect of the configuration that it is “significantly wider than it is thick.” The evidence establishes that the outer contours are insignificant to the overall configuration of the headphone cable.²⁴ The design is a simple design, whose significant features are dictated by the functional advantages

²³ Dictionary.com based on the RANDOM HOUSE DICTIONARY (2015) (www.dictionary.reference.com). The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

²⁴ We further note that curved outer edges are simply a natural result when round cables are compressed to have a width that is greater than a thickness.

noted in the patent, stemming from its substantially larger width in comparison to its thickness. The “degree of the utility present in the overall design of the mark” leads to the conclusion that the “mark as a whole is functional” and thus “ineligible for trademark protection.” *Becton, Dickinson*, 102 USPQ2d at 1376.

At page 3 of its Reply Brief, Applicant argues that *Becton, Dickinson* is distinguishable because two important features of the proposed mark were disclosed in *Becton, Dickinson’s* utility patent and the patent explained the utilitarian aspects of the two features, while in this case, Applicant’s patent does not disclose the proposed mark’s contoured outer edges or ascribe any utilitarian advantages to them. The point in *Becton, Dickinson*, however, is that every single feature need not be claimed in the patent in order for the proposed mark to be ineligible for trademark protection. *Becton, Dickinson*, 102 USPQ2d 1377 (“The Board correctly read the ‘446 patent to indicate that at least two of the important elements of the proposed mark were functional.”) The case emphasizes that “[w]henver a proposed mark includes both functional and non-functional features, as in this case, the critical question is the degree of utility present in the overall design of the mark.”²⁵

We therefore find that the ‘633 utility patent demonstrates the utilitarian advantages of the headphone cable design at issue, and that the first *Morton-Norwich* factor accordingly weighs heavily in favor of a finding of functionality. We make these findings upon consideration of the proposed mark as a whole, mindful that “[t]he wording ‘as a whole’ [in Section 23(c)] does not mean that a finding of

²⁵ *Id.* at 1376.

functionality can be avoided merely because a functional composite design includes a nonfunctional feature.” See J. T. McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 7:76 (4th ed., database updated 2015).

2. Advertising materials in which the originator of the design touts the design's utilitarian advantages.

The Examining Attorney has introduced webpages from Applicant’s website, and maintains that the webpages describe the utilitarian advantages of Applicant’s design. With regard to the contoured outer edges, the Examining Attorney states, “applicant’s advertising does not reference this design element at all (*i.e.*, even for its asserted aesthetic qualities),” and concludes that the lack of advertising “demonstrates that this design element is so minor that it does not overcome the overall functionality of the product design.”

Indeed, Applicant’s webpages advertise the flat, non-tangle, aspects of Applicant’s design, and attribute the non-tangle feature to the flat shape.²⁶ The webpages are silent about the curved outer contours, even when depicting the contours. See, *e.g.*, the following depiction and description of Applicant’s goods, taken from one of its webpages, and stating below the depiction of Applicant’s goods, “[t]he revolutionary flat Monster cable means no cord tangles --- ever”:²⁷

²⁶ See, *e.g.*, webpage from monstercable.com, submitted with August 17, 2011 Office Action, stating, “Tangle-free flat cable. Earbuds are incredibly convenient. But they’ve got one big problem: they tangle into unbelievable snarls, especially during storage. But Monster has come up with a solution: make ‘em flat! Our innovative, patent-pending design is ultra-flexible and tangle-free.”

²⁷ August 17, 2011 Office Action.



The revolutionary flat Monster cable means no cord tangles--ever

In *Becton, Dickinson*, the Federal Circuit considered advertising which promoted many features of the applicant's product but did not promote those features deemed inconsequential. The Court concluded, "[i]nstead the advertisements taken as a whole are more than substantial evidence that the proposed mark as a whole is functional." *Becton, Dickinson*, 102 USPQ2d at 1378. In the present case, Applicant's advertising addresses the configuration of the proposed mark, which depicts a headphone cable that is significantly wider than it is thick, and attributes to this shape the tangle-free nature of the headphone cable design. Although the advertising is silent about the contoured sides of the cable design, we find that Applicant's advertisements are substantial evidence that the proposed mark as a whole is functional and underscores the inconsequential nature of the contoured sides.

3. Availability to Competitors of Functionally Equivalent Designs.

Applicant submitted the following evidence to establish that there are a variety of equivalent designs:

- Professor Rake’s declaration, and exhibits, proposing ten possible alternative end contour designs which “can be used for practicing the invention disclosed and claimed in the ‘633 patent”;²⁸

- Mr. Hsiung’s declaration stating he agrees with Dr. Rake that there are numerous other aesthetic designs which can be used for practicing the invention of the ‘633 patent and that each of the alternative designs would accommodate left and right audio channel conductors and resist tangling;

- the declaration of Jacob T. Mersing, Senior Legal Assistant at Applicant’s law firm, with exhibits; Mr. Mersing testifies that he located headphone cables, promoted as eliminating tangles, for sale when visiting two large retailers in Washington, D.C., and submitted photographs of such cables; and

- the declaration of Lindsay Coleman, one of Applicant’s attorneys, with exhibits, in which Ms. Coleman submits numerous examples of headphone cables she located on the Internet. She testified that her “search returned several hundred results for ‘tangle-free’ or ‘tangle resistant’ headphones, including numerous headphones with cables that were circular or round in shape, twisted cables, zipper-style cables, rounded cables with a center inverted channel, and fabric-coated cables” For each product she located, she states that the product does “not feature a cross-section in the form of an oblong, do[es] not have contoured outer edges, and [is] not in a shape that is significantly wider than it is thick.”

The designs submitted with Mr. Mersing’s and Ms. Coleman’s declarations include headphone cables that have shapes that are (i) yarn-like or fabric wrapped, (ii) circular in cross section (round in shape), (iii) zipper-like, (iv) twisted, or (v) short in length.

Becton, Dickinson, 102 USPQ2d at 1378, states:

As to the third factor, if functionality is found based on other considerations, there is “no need to consider the availability of alternative designs, because the feature cannot be given trade dress protection merely because there are alternative designs available.”

²⁸ February 6, 2014 Req. for Recon., Rake ¶ 19, 15 TTABVUE 17.

Valu Eng'g, 278 F.3d at 1276. Thus, since the patent and advertising evidence established functionality, the Board did not need to analyze whether alternative designs exist.

See also, TrafFix, 58 USPQ2d at 1006 (where a feature of the device “affects ... the quality of the device,” “there is no need to proceed further to consider if there is a competitive necessity for the feature.”). Because the patent and advertising evidence discussed above establishes functionality, we need not consider the evidence of alternative designs submitted by Applicant.

Having nonetheless considered the designs submitted by Applicant, we are not persuaded that they show that the applied-for design will not have an adverse effect on competition. The question is not whether there are alternative designs that perform the same basic function but whether these designs work “equally well.”²⁹

The '633 patent identifies the benefits of Applicant's “flat” design with an elongated cross-sectional area as (i) the non-tangle feature due to its structure being inherently more rigid, (ii) the ability to pass multiple conductors in a side-by-side configuration which results in lower overall cable impedance and faster transient response as compared to conventional headphone cabling, (iii) the ability to accommodate added functionality such as conductors for a microphone, and (iv) the ability to orient the left and right split sections of the cable so that they lay flat against the user's face.³⁰ Most of the alternative designs submitted by Applicant do not offer this collection of features, and thus are not true alternatives. We hence

²⁹ *Valu Eng'g*, 61 USPQ2d at 1427, quoting, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 7:75.

³⁰ '633 patent, col. 1, lines 18-41.

find that Applicant has not established that there are functionally equivalent designs.

4. Facts Indicating that the Design Results in a Comparatively Simple or Cheap Method of Manufacture.

Applicant and the Examining Attorney have not discussed in their Briefs whether Applicant's headphone cable configuration is a design resulting from a comparatively simple or cheap method of manufacture.³¹ At best, Dr. Rake states that "[e]dge designs rarely changes [sic] the cost, tooling, or performance of a product." Thus, this fourth factor is neutral in our analysis.

Conclusion:

The '633 utility patent demonstrates the utilitarian advantages of the headphone cable design at issue, which weighs heavily in favor of a finding of functionality. Applicant's advertising addresses the non-tangle aspect of Applicant's headphone cable and attributes this feature to the fact that the cable is significantly wider than it is thick. Although silent about the contoured sides of the cable design, Applicant's patent and advertisements are substantial evidence that the proposed mark as a whole is functional, and the asserted distinctive element is imperceptible and inconsequential. The alternative designs submitted by Applicant, though they need not be considered because the patent and advertising evidence establishes functionality, are not, in any event, persuasive evidence of non-functionality because they do not offer the same set of features offered by Applicant's

³¹ Applicant and the Examining Attorney discuss whether the alternative designs proposed by Professor Rake could be manufactured without adding appreciably to the cost or complexity of manufacture. This is not the issue before us; the issue is whether the Applicant's design results in a comparatively simple or cheap method of manufacture.

configuration. Thus, considering the proposed mark as a whole, we conclude that Applicant's configuration is functional.

Genericness

A generic product design cannot be registered. Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§ 1051, 1052 and 1127; *Stuart Spector Designs Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 1554-55 (TTAB 2009). *See also, Sunrise Jewelry Manufacturing Corp. v. Fred S.A.*, 175 F.3d 1322, 50 USPQ2d 1532, 1535 (Fed. Cir. 1999) (“generic name” in Section 14(3) of the Trademark Act, 15 U.S.C. § 1064(3), “must be read expansively to encompass anything that has the potential but fails to serve as an indicator of source, such as names, words, symbols, devices, or trade dress.”). “In the context of product design, genericness may be found where the design is, at a minimum, so common in the industry that it cannot be said to identify a particular source.” *Stuart Spector*, 94 USPQ2d at 1555; *Walker & Zanger Inc. v. Paragon Industries Inc.*, 465 F.Supp.2d 956, 84 USPQ2d 1981, 1985 (N.D. Cal. 2006). “[C]ases have recognized that competitor use is evidence of genericness.” *Stuart Spector*, 94 USPQ2d at 1555, (citing *BellSouth Corp. v. DataNational Corp.*, 60 F.3d 1565, 35 USPQ2d 1554, 1558 (Fed. Cir. 1995)).

The Examining Attorney relies on competitor webpages showing headphone cable configurations which she and Applicant introduced into the record. The Examining Attorney finds that the webpages depict headphone cables which are oblong or have curved or rounded edges, the same as, or substantially similar to,

Applicant's cable, and concludes the evidence demonstrates that these features are commonly used by competitors.

Applicant disagrees, and asserts that the cable designs of record "at best lack enough visual detail to support that conclusion" and are "subject to guesswork or conjecture."³² Applicant would have us discount the Examining Attorney's evidence, because the images of headphone cables submitted by the Examining Attorney do not clearly show the details of the cables, the cross-sections of these cable designs are not in the record, and "it is not possible to determine if they are oblong in shape, and thus feature contoured outer edges, or whether they feature 90 degree angles, and thus are rectangles."³³ Applicant argues that in at least seven instances, the Examining Attorney mis-read the website evidence, and found that the designs depicted do not depict "curved outer contours."

We first address Applicant's challenge to the Examining Attorney's evidence on the basis that the images in the webpages she submitted are not clear and that the Examining Attorney did not provide images or illustrations of cross-sections of the cables she introduced into evidence. Applicant, when it submitted designs as alternatives to the applied-for configuration, also did not provide images or illustrations of the cross-sections of such designs. The declaration of Ms. Coleman, which submits the majority of the designs relied on by Applicant, includes her testimony as to what the designs look like. It appears to us that Ms. Coleman based her statements regarding the products depicted in the webpages from a review of

³² Applicant's Brief at 7, 45 TTABVUE 11.

³³ Applicant's Brief at 14-15, 45 TTABVUE 18-19; Reply Brief at 7-8, 45 TTABVUE 11-12.

the images of the products contained in the web pages, and nothing more. These webpages are no clearer than the webpages submitted by the Examining Attorney. Thus, we do not accept Applicant's blanket challenge to the cable designs relied on by the Examining Attorney but nonetheless make our own determination as to what the designs show, based on the images of the designs in the record.

Next, we consider the evidence in the record of competitor uses of the same or similar designs. We have carefully studied the evidence submitted by both the Examining Attorney and Applicant, and have considered Applicant's challenges to the Examining Attorney's evidence.³⁴ Even if we discount those headphone cables that Applicant has specifically objected to, such as the seven listed in its reply brief, there is ample evidence of others using headphone cables that are oblong and utilize curved or rounded edges the same as, or highly similar to, Applicant's headphone cable design. Such designs show headphone cables which are significantly wider than thick, and have curved or rounded side contours. *See, e.g.*, cables from EDM Universe;³⁵ MEElectronics;³⁶ Velodyne;³⁷ Skullcandy – Ink'd Ear Bud Stereo

³⁴ For example, Applicant argues that certain designs are irrelevant because they comprise round cables or are shoe-lace, cloth or nylon type headphone cables.

³⁵ www.meelec.com/EDM_Universe_In_Ear_EDM_Headphones_p/ep-dlp-gn-mee.htm, accessed July 2, 2014, submitted with July 8, 2014 Office Action.

³⁶ www.youtube.com/watch?v:QBtQpC2ubg4, accessed July 2, 2014, submitted with July 8, 2014 Office Action.

³⁷ velodyne.com/vpulse-in-ear-headphones.html, www.youtube.com/watch?v=4zKe4HOre7A, amazon.com and bestbuy.com, accessed July 2, 2014, submitted with July 8, 2014 Office Action.

Headphones;³⁸ Ecko-Stomp Earbud Headphones;³⁹ SOUL by Ludacris;⁴⁰ SOUL SL99;⁴¹ GOgroove DynaMIX;⁴² Sony Extra Bass Earbuds (“a flat Y-type cord to help reduce tangles”);⁴³ Jays of Sweden (“a-JAYS One” “A Tangle-Free, Flat Cable.”);⁴⁴ JBUDS⁴⁵; and Cygnett Razor II (“Ear buds with flat ribbon cable.”).⁴⁶ *See also*, “Cicoil flat cables” webpage submitted with the August 17, 2011 Office Action depicting an oblong cross-section of a cable in an article entitled “Flat v. Round Cables,” suggesting the oblong shape and rounded or curved edges of Applicant’s configuration are features of a common shape for cables.⁴⁷

The record also includes many examples of headphone cables with a round cross-section. Curved or rounded sides are hence a common design element for a headphone cable. In *Big Island Candies, Inc. v. Cookie Corner*, 269 F.Supp.2d 1236, 1248-1249 (D. Haw. 2003), the district court found a product design for a cookie to

³⁸ Best Buy and RadioShack webpages, submitted with July 8, 2014 Office Action.

³⁹ Best Buy webpages, submitted with July 8, 2014 Office Action.

⁴⁰ RadioShack webpages, submitted with July 8, 2014 Office Action.

⁴¹ <http://soulelectronics.com/en/shop/products/sl99/>, accessed February 23, 2012, submitted with February 23, 2012 Office Action.

⁴² <http://www.gogrooveaudio.com/about-us.html>, accessed September 7, 2012, submitted with September 10, 2012 Office Action.

⁴³ Google cache of <http://store.sony.com/p/bass-headphones/en/p/MDRXB40EX>, accessed February 22, 2012, submitted with February 23, 2012 Office Action.

⁴⁴ Google cache of <http://hothardware.com/News/JAYS-Introduces-TangleFree-Flat-Cabling-On-aJAYS-Earbuds/>, accessed August 15, 2011, submitted with August 17, 2011 Office Action.

⁴⁵ <http://www.jlabaudio.com/category.php?id=5>, accessed September 7, 2012, submitted with September 10, 2012 Office Action.

⁴⁶ <http://us.cygnett.com/ipod/razor--ii-2.html>, accessed September 7, 2012, submitted with September 10, 2012 Office Action.

⁴⁷ <http://www.cicoil.com/cables/details/flatvsround.asp>, accessed August 16, 2011, submitted with August 17, 2011 Office Action.

be generic because the components of the design are basic and common. The court stated:

Based on the evidence submitted by the parties ... the court concludes that the BIC Cookie trade dress is generic. The BIC Cookie design is nothing more than a nondistinctive combination of a few basic, common design elements. Cookies are commonly rectangular and often have bull-nose corners, which naturally result from a basic and common method of making cookies. In particular, the rectangular shape is a classic shape for shortbread. Dipping cookies halfway in chocolate at various angles, including diagonally, is also common.

Applicant states that “[n]one of the advertising presented by the Examining Attorney references the curved outer contour of the cable.”⁴⁸ For those cable designs in the record which are significantly wider than thick and which do not have rounded side contours, they too are as probative as those designs which have rounded sides; together, they establish that Applicant’s configuration is nothing more than a combination of two basic common design elements.

We point out too that there need not be an exact match in designs for the Board to consider competitor designs. In *Stuart Spector*, the Board considered designs which were “close or very similar” to the product configuration asserted to be a mark. The Board noted:

It is simply not reasonable to conclude that the average consumer of guitars, which would include non-musical parents buying a guitar for their child, could distinguish one guitar from another based solely on a millimeter of difference in the body shape. As the Board stated in *Gibson Guitar Corp.*, 61 USPQ2d [1948] 1951-52 [(TTAB 2001)], “[a]lthough guitar collectors and aficionados may well be aware of these differences, the determination of acquired distinctiveness must be made on the basis of casual guitar purchasers as well [as] people who wish to learn guitar as a hobby, or by parents for their young

⁴⁸ Applicant’s Brief at 10, 45 TTABVUE 14.

children. Such casual purchasers are not likely to note the differences between applicant's guitar configuration and those of others, let alone recognize the overall configuration as a trademark without significant education on the part of applicant.”⁴⁹

Stuart Spector, 94 USPQ2d at 1567-68.

The same is applicable here. Headphones and headphone cables are purchased and used by the general public, including casual purchasers.

Applicant has made four arguments which merit specific consideration.

1. Applicant argues that the Examining Attorney has not provided sales, advertising or marketing information for the competitor designs.⁵⁰ The Examining Attorney has, however, demonstrated that many of the competitor headphone cables she relies upon are offered for sale by major retailers such as Best Buy, RadioShack, Office Depot and Amazon. Further, the photographs Applicant submitted with Mr. Mersing’s declaration demonstrate that both Best Buy and Target sell several of the same brands of earbud-type headphones featured in the Examining Attorney’s submissions. In addition, the Examining Attorney submitted a webpage from [sony.com](http://www.sony.com) which identifies Sony Corporation as a leading manufacturer of audio technology products.⁵¹ Thus, there is no reason to discount the Sony or competitor designs which the evidence indicates are offered for sale by major retailers.

⁴⁹ Bracketed text in original.

⁵⁰ Applicant’s Brief at 15, 45 TTABVUE 19.

⁵¹ <http://www.sony.com/SCA/index.shtml>, accessed on September 7, 2012, submitted with September 10, 2012 Office Action.

We keep in mind the Federal Circuit’s statements on the evidentiary burdens on Examining Attorneys and the limited ability of Examining Attorneys to gather evidence in support of a refusal. *See In re Budge Mfg., Inc.*, 857 F.2d 773, 8 USPQ2d 1259, 1260-61 (Fed. Cir. 1988), where the Federal Circuit stated:

In *ex parte* prosecution, the burden is initially on the Patent and Trademark Office (PTO) to put forth sufficient evidence that the mark for which registration is sought meets the ... criteria of unregistrability. Mindful that the PTO has limited facilities for acquiring evidence — it cannot, for example, be expected to conduct a survey of the marketplace or obtain consumer affidavits — we conclude that the evidence of record here is sufficient to establish a *prima facie* case of deceptiveness.

Cf., *In re Pacer Technology*, 338 F.3d 1348, 67 USPQ2d 1629 (Fed. Cir. 2003) (the Federal Circuit acknowledged that it was “mindful of the reality that the PTO is an agency of limited resources”). Thus, Applicant’s argument regarding the sales, advertising or marketing of the designs relied on by the Examining Attorney is not persuasive.

2. Applicant attempts to distinguish *Stuart Spector* because the guitar designs therein were used by third parties for three decades without Fender policing its alleged trademark rights.⁵² *Stuart Spector*, 94 USPQ2d at 1549. Applicant has used its configuration for eight years. The Examining Attorney, with the tools available to her, located ample competitor uses of cable designs essentially oblong or with curved or rounded edges, the two common, basic elements of the asserted mark. Applicant’s eight years of use is not insubstantial, and, as in *Stuart Spector*, the record does not indicate any instances of enforcement of its alleged rights in its

⁵² Applicant's Brief at 9, 45 TTABVUE 13.

applied-for cable configuration during these eight years other than the representation that during prosecution of this application Applicant was in communication with one party selling flat cable headphones under the mark PUREGEAR.⁵³ Thus, we disagree that *Stuart Spector* is distinguishable from this case on the basis asserted by Applicant.

3. Applicant argues that there is no evidence regarding the market share of flat cable headphones in the wider headphone market, in which consumers have many headphone cable designs to choose from both in stores and online.⁵⁴ The volume and nature of the evidence in the record of flat headphone cables offered for sale by numerous competitors undercuts Applicant's argument; the evidence demonstrates that a substantial number of entities manufacture flat cable headphones and that they are not an insignificant portion of headphone cables offered for sale by major retailers, such as Target, Best Buy and Amazon.

4. Applicant argues that a single license agreement is evidence that its proposed mark is perceived by the industry as being capable of source-identifying significance.⁵⁵ The agreement was entered into with Beats Electronics, described as "a leading brand of headphones with over 25% of the \$1.8 billion headphone market." However, the record is silent as to what designs make up the remaining 75 percent of the market. Moreover, the agreement sets forth that Applicant and Beats have a history of developing and co-marketing products, including headphone and

⁵³ August 22, 2012 Response.

⁵⁴ Applicant's Brief at 15, 45 TTABVUE 19.

⁵⁵ *Id.*

speaker products, since 2009. Thus, it is not surprising, based on this prior history and co-development, that such an agreement was concluded. The probative value of this agreement is further diminished by the fact that it is a fully-paid up, non-exclusive license, which does not provide Applicant with any income on its alleged trademark. Further, the agreement was signed on November 29, 2012, after the Examining Attorney issued the Final Office Action, thus raising a question as to whether it was entered into for purposes of prosecuting the present application.

Upon consideration of the foregoing, we conclude that Applicant's proposed mark is a generic design for flat headphone cables, incorporating the common, basic elements of an oblong cross-section (i.e., wider than it is thick) and curved edges. Accordingly, the design is unregistrable under Section 23(c) of the Trademark Act.

Decision: The functionality and genericness refusals to register Applicant's headphone cable configuration are affirmed.