

RESPONSE TO OFFICE ACTION

Applicant hereby responds to the Office Action of February 9, 2015. In the office action, the Examining Attorney issued a non-final refusal of registration of Applicant's design mark ("the Mark") based on the determinations that the Mark contains nondistinctive incapable elements of product design and request for additional information. Applicant hereby responds to each of the requirements, either in the text below or elsewhere in the TEAS Office Action Response form submitted herewith.

I. The Mark is NON-Functional

The Examining Attorney has issued a non-final refusal of registration based on a determination that the Mark contains functional elements. Applicant respectfully contends that, the Mark is non-functional for the reasons set forth below.

A. The Mark is Non-Functional Because the '585 Patent Does Cover Any of the Design Features of the Proposed Mark

In the Office Action, the Examining Attorney contends that U.S. Patent No. 8,641,585 ("the '585 patent"), directed to certain functional features of an exercise machine, tends to show that the Mark contain functional elements. However, attached as Exhibit A are more drawings with descriptions evidencing that the Mark is not functional, not part of the '585 patent, and does not contain any functional elements

When considering the effect of a patent on a proposed design mark, "[i]t is important to read the patent to determine whether the patent actually claims the features presented in the proposed mark. . . . [i]f it does not, or if the features are referenced in the patent, but only as arbitrary or incidental features, then the probative value of the patent as evidence of

functionality is substantially diminished or negated entirely.” TMEP §1202.02(a)(v)(A); *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 34, 58 U.S.P.Q.2d 1001 (S. Ct. 2001).

In this case, the Mark proposed by the Applicant comprises of unique three-dimensional shapes embodied on the M2S machine that are not part of the ‘585 patent.

Specifically and as listed in Exhibit A these shapes are:

- Laterally facing angular rail surface angled substantially from the horizontal plane
- Side-facing edges of the end plates angled substantially from the horizontal plane.
- Inwardly tapering lateral sides of a sliding platform (radiused or angular).
- front and back edges of platform are non- perpendicular to sides (radiused or angular).
- Side edges of sliding and stationary platforms overhanging longitudinal parallel rails.

Thus, the ‘585 patent does not claim, any of the features of the proposed Mark. In addition, under TMEP §1202.02(a)(v)(A), the probative value of the ‘585 patent as evidence of functionality of the Mark is “substantially diminished or negated entirely.” In fact, the ‘585 patent is strong evidence of the Non-functionality of the Mark because the basic frame referenced by the ‘585 patent lacks every feature of the Mark.

B. The Availability of Alternative Designs Demonstrates That The Mark is Non-Functional

Applicant is not claiming that his Mark include any type of rails but that the unique angles of its rails are not functional and are actually part of the unique design of Applicant’s exercise machine and its Mark. Same applies to the unique design of Applicant’s front, back, and middle platforms. Applicant is not claiming that the Mark include the functional element of these platforms but their unique and non functional design—the Mark. Applicant hereby provides the requested explanation and evidence (attached hereto as Exhibit B) and contends that this evidence tends to demonstrate the non-functionality of the Mark, specifically the

angles of the rails, platforms, and plates.

If evidence shows the existence of a number of functionally equivalent alternative designs that work “equally well,” such that competitors do not need applicant’s design to compete effectively, this factor may support non-functionality. TMEP §1202.02(a)(v)(C); *In re Dietrich*, 91 USPQ2d 1622, 1636 (TTAB 2009).

This wide variety of functionally equivalent designs for exercise machines frames, rails, plates, and platforms demonstrates that competitors do not need applicant’s design to compete effectively. Indeed, the Mark serves to create a unique commercial impression in the minds of consumers and thereby distinguish the MEGAFORMER M3S from the other exercise machines available on the market. Thus, this factor supports the non-functionality of the Mark.

C. The Mark is Non-Functional Because it Does Not Result From a Comparatively Simple or Inexpensive Method of Manufacture

The cost of applying a design mark to a product may support a finding of functionality only when the mark “results from a comparatively simple or inexpensive method of manufacture.” TMEP §1202.02(a)(v)(D); *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 850 n.10, 214 USPQ 1, 4 n.10 (1982).

In the present case, the shapes that comprise the Mark do not result from a comparatively simple or inexpensive method of manufacture, therefore this factor tends to show the non-functionality of the Mark.

II. The Mark is Non-Functional Because the Unique Shape of the Angled Rails, the Angled Plates, and Head, Foot, and Middle Platforms Are Not part of the Machine’s Function

As shown in Exhibit C, which contains images of the Mark, the unique shapes and designs are not part of the functional elements of the machine, are not included in the ‘585 patent, and are very different from the designs used by other machines as detailed in Exhibit B. Therefore, the Mark, including the rails, plates, head, foot, and middle

platforms, is not functional.

III. Applicant's Evidence Shows that the Mark Has Acquired Distinctiveness Under Section 2(f) of the Trademark Act

Applicant demonstrates that the Mark has acquired distinctiveness under 15 U.S.C. § 1052(f) because exclusive and continuous use in commerce of the Mark in connection with exercise machines for over six years. Since, as early as 2009, Applicant has consistently and exclusively used the Mark in connection with marketing, distributing, offering for sale and selling its MEGAFORMER M3S exercise machine.

Applicant has administered numerous training workshops, workouts, videos, and press regarding the use of the MEGAFORMER M3S and the Mark, throughout the United States and internationally. Therefore, the Mark is known by consumers and third parties as a source identifier associated with the MEGAFORMER M2S exercise machine.

IV. The Mark Functions as a Trademark Because It Identifies and Distinguishes Applicant's Goods and Indicates the Source of the Goods

In the office action, the Examining Attorney asserts that “rails, head, foot, and middle platforms” do not function as a mark. Applicant respectfully contends that, contrary to this assertion, the Mark functions as a trademark to identify and distinguish Applicant's goods and to indicate the source of Applicant's goods, for the reasons set forth below.

The term “trademark” includes any word, name, symbol, or device, or combination thereof used to identify and distinguish the Applicant's goods from those of others and to indicate the source of Applicant's goods. 15 U.S.C. §1127; TMEP §1202. The critical question in determining whether a proposed mark, as used in a specimen, functions as a trademark is the commercial impression it makes on the relevant public. *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1827- 28 (TTAB 2012).

The Mark, as used in specimen of record, is prominently displayed and used in a way to

draw the attention of potential purchasers to the design and to make a source-identifying commercial impression. Exhibit C shows the unique shapes of the angled rails, angled plates, and head, foot, and middle platforms.

Hence, the Mark is immediately recognizable, featured prominently, and strongly associated with the goods. Therefore, the commercial impression made on consumers by the Mark acts as a source indication.

Conclusion

For all of the aforementioned reasons, Applicant respectfully contends that that the Mark is a non-functional design, is a distinctive product design, and functions as a trademark. Accordingly, Applicant respectfully requests that Examining Attorney withdraw the refusal of registration and approve the Mark for publication.