

ESTTA Tracking number: **ESTTA435559**

Filing date: **10/13/2011**

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

Proceeding	77219184
Applicant	Bottega Veneta International S.a.r.l.
Correspondence Address	LOUIS S EDERER ARNOLD & PORTER LLP 399 PARK AVENUE, 35TH FLOOR NEW YORK, NY 10022-4690 UNITED STATES trademarkdocketing@aporter.com
Submission	Appeal Brief
Attachments	Bottega - Ex Parte Appeal Breif In Support of Application to Register Design Mark.pdf ( 25 pages )(97839 bytes )
Filer's Name	Louis S. Ederer
Filer's e-mail	louis.ederer@aporter.com, john.maltbie@aporter.com, matthew.salzmann@aporter.com
Signature	/Louis S. Ederer/
Date	10/13/2011

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

In re Application of:

Applicant: Bottega Veneta International S.a.r.l.      Examining Attorney: Steven M. Perez

Serial No.: 77/219,184      Law Office: 101

Filed: June 29, 2007

Mark:



Trademark Trial and Appeal Board  
U.S. Patent and Trademark Office  
Madison East, Concourse Level Room C 55  
600 Dulany Street  
Alexandria, VA 22314

**APPLICANT BOTTEGA VENETA INTERNATIONAL S.A.R.L.'S  
EX PARTE APPEAL BRIEF IN SUPPORT OF ITS APPLICATION  
TO REGISTER DESIGN MARK\***

ARNOLD & PORTER LLP  
399 Park Avenue  
New York, New York 10022  
(212) 715-1000

Attorneys for Applicant  
Bottega Veneta International S.a.r.l.

\* This brief is being re-submitted per the instruction of the Administrative Judges at the October 4, 2011 hearing.

**INDEX OF AUTHORITIES**

**CASES**

*Anchor Hocking Glass Corp. v. Corning Glass Works*, 162 U.S.P.Q. 288 (T.T.A.B. 1969) ..... 18

*Au-Tomotive Gold, Inc. v. Volkswagen of America, Inc.*, 80 U.S.P.Q.2d 1293 (9th Cir. 2006),  
*cert. denied*, 127 S. Ct. 1839 (2007) ..... 15

*Board of Supervisors for Louisiana State University Agricultural and Mechanical College v. Smack Apparel Co.*, 550 F.3d 465 (5th Cir. 2008), *cert. denied*, 129 S. Ct. 2759 (2009) ..... 15

*In re Bose Corp.*, 216 U.S.P.Q. 1001 (T.T.A.B. 1983), *aff’d*, 227 U.S.P.Q. 1 (Fed. Cir. 1985) ..... 19

*Brunswick Corp. v. British Seagull*, 32 U.S.P.Q.2d 1120 (Fed. Cir. 1994)..... 15

*CITC Indus. Inc. v. Levi Strauss and Co.*, 216 U.S.P.Q. 512 (T.T.A.B. 1982) ..... 16

*In re DC Comics, Inc.*, 215 U.S.P.Q. 394 (C.C.P.A. 1982)..... 15

*In re Deere & Co.*, 7 U.S.P.Q.2d 1401 (T.T.A.B. 1988) ..... 14, 15

*In re Haggar Co.*, 217 U.S.P.Q. 81 (T.T.A.B. 1982)..... 18

*In re Jockey International, Inc.*, 192 U.S.P.Q. 579 (T.T.A.B. 1976)..... 18

*Johnson & Johnson v. Actavis Group hf*, 2008 WL 228061 (S.D.N.Y. Jan. 25, 2008)..... 12

*In re Keeper Chemical Corp.*, 177 U.S.P.Q. 771 (T.T.A.B. 1973)..... 16

*In re Mogen David Wine Corp.*, 140 U.S.P.Q. 575 (C.C.P.A. 1964), *appeal after remand*,  
152 U.S.P.Q. 593 (C.C.P.A. 1967) ..... 15

*In re Morton-Norwich Products, Inc.*, 213 U.S.P.Q. 9 (C.C.P.A. 1982) ..... 6

*Pebble Beach Co. v. Tour 18 I, Ltd.*, 48 U.S.P.Q.2d 1065 (5<sup>th</sup> Cir. 1998)..... 14

*Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995) ..... 14

*Thompson Medical Co. v. Pfizer Inc.*, 753 F.2d 208 (2d Cir.1985)..... 17

*TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23 (2001) ..... 14, 15

*Villeroy & Boche Keramische Werke K.G. v. THC Sys., Inc.*, 27 U.S.P.Q.2d 1866 (2d Cir. 1993)..... 12

*Vuitton Et Fils S.A. v. J. Young Enterprises, Inc.*, 210 U.S.P.Q. 351 (9<sup>th</sup> Cir. 1981) ..... 12

*In re Watkins Glen Int’l, Inc.*, 227 U.S.P.Q. 727 (T.T.A.B. 1985)..... 16

**STATUTES AND OTHER RESOURCES**

TMEP § 1202.02..... 16

TMEP § 1212.06..... 17, 18, 19

1 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (“*McCarthy*”), §  
7:73 (4<sup>th</sup> Ed. 2004) ..... 6

*McCarthy*, § 7.80 ..... 14

*McCarthy*, § 7.81 ..... 14

*McCarthy*, § 15:51 ..... 19

*McCarthy*, § 15:30 ..... 23

## **I. INTRODUCTION**

Bottega Veneta International S.a.r.l. (“Bottega Veneta”) hereby appeals to the Trademark Trial and Appeal Board (the “Board”) from the December 14, 2009 final refusal to register its world-famous woven leather design mark. Registration was refused: (i) under Section 2(e)(5) of the Lanham Act on the ground that the mark is aesthetically functional; (ii) under Sections 1, 2 and 45 of the Lanham Act on the ground that the mark is solely decorative or ornamental in nature; and (iii) under Sections 1, 2 and 45 of the Lanham Act, on the ground that the mark consists of a nondistinctive product design or feature thereof that is not registrable on the Principal Register without sufficient proof of acquired distinctiveness. Applicant submits that all of the Examiner’s grounds for refusal to register the mark are in error, and respectfully requests that the Board reverse such refusal and pass the mark for publication.

## **II. FACTUAL BACKGROUND**

As indicated in the evidentiary record, Bottega Veneta, founded in Vicenza, Italy in 1966, is one of the most famous international fashion houses involved in the production and distribution of ready-to-wear apparel, handbags, shoes and various types of leather goods for men and women. In 1972, when Bottega Veneta opened its first store in the U.S., it had already become known as a source of the finest leather products, epitomizing the best in Italian luxury goods. In 1975, Bottega Veneta presented its first collection of handbags featuring what would become the world-famous “Bottega Weave Design,” a design appearing on the outside of the bags consisting of slim leather strips threaded together and placed at a 45-degree angle to the surface of the product. Over the years, the Bottega Weave Design has become the visual signature of the Bottega Veneta brand. Indeed, unlike other luxury brands, Bottega Veneta does not use a logo or brand name on the outside of its products, instead allowing the unique Bottega Weave Design to serve as the product’s primary source indicator. Volpi Decl. (I), ¶ 4.<sup>1</sup>

In February 2001, because of the recognition that the Bottega Weave Design had achieved over the years, Bottega Veneta began to incorporate the mark into a broader line of products, including

---

<sup>1</sup> Bottega Veneta’s references to the various declarations submitted in response to the office actions will include a reference — I, II, or III — to indicate which office action the declaration was responding to.

jewelry, home furniture and decorative accessories. Presently, Bottega Veneta products are sold in 111 company-owned Bottega Veneta stores and 309 authorized luxury retailers worldwide. In the U.S., Bottega Veneta products are sold at 19 Bottega Veneta boutiques and high-end retail department stores such as Barneys, Neiman Marcus, Saks Fifth Avenue, and Bergdorf Goodman. In addition, a full range of Bottega Veneta merchandise is available on-line at Bottega Veneta's official website, and at websites affiliated with Bottega Veneta's authorized retailers. *Id.*, ¶¶ 5-6.

Sales of Bottega Veneta products from 2001 through 2007 in the U.S. exceeded \$275 million, with the Bottega Weave Design — the brand's iconic signature trademark — appearing on more than eighty percent (80%) of all products sold. Retail sales in the U.S. of goods bearing the Bottega Weave Design are growing rapidly each year, with sales of handbags bearing the Bottega Weave Design exceeding \$45 million in 2004, \$87 million in 2005, and \$111 million in 2006. *Id.*, ¶ 7.

Moreover, Bottega Veneta has consistently promoted the Bottega Weave Design as an indicator of source for its goods. Between 2001 and 2007, Bottega Veneta spent approximately \$18 million dollars on advertising. All advertisements prominently feature goods bearing the Bottega Weave Design. Indeed, for more than thirty-five years, Bottega Veneta's catalogues and advertisements have featured the Bottega Weave Design as Bottega Veneta's signature trademark, as that is the way consumers have come to recognize the goods as coming from Bottega Veneta. *Id.*, ¶ 8.

Accordingly, as demonstrated by the overwhelming evidence of record, through many years of continuous use, the Bottega Weave Design has come to be recognized by consumers and tradespeople as being singularly associated with Bottega Veneta, as attested to by executives for world-famous retailers and writers for leading mainstream and fashion publications in the U.S., as well as other well-respected publications. Moreover, as Bottega Veneta's merchandise is traditionally displayed without labels, hangtags or other external textual identifiers that would normally be attached to the goods of other manufacturers, Bottega Veneta customers have been educated to look for the key visual cue — the Bottega Weave Design — to identify Bottega Veneta products. *Id.*, ¶ 9.

### **III. PROCEDURAL HISTORY**

#### **A. The Application**

This application has a long and unusual history, having been the subject of four Office Actions totaling thousands of pages. On June 27, 2007, pursuant to Section 44(e) of the Lanham Act, 15 U.S.C. §1126(e), Bottega Veneta first applied to register the Bottega Weave Design in Class 18 for wallets, purses, handbags, shoulder bags, clutch bags, tote bags, business card cases, credit card cases, key cases, cosmetic cases sold empty, briefcases, attaché cases, valises, suitcases and duffle bags, all made in whole, or in substantial part, of leather, and in Class 25 for footwear. As indicated in Bottega Veneta's Office Action responses, the Bottega Weave Design consists of slim leather strips threaded together and placed at a 45-degree angle to the surface of the product, resulting in a design consisting of woven squares that are either 9 mm by 12 mm or 8 mm by 10 mm, together forming the Bottega Weave Design.<sup>2</sup>

#### **B. The First Office Action**

In the First Office Action dated September 3, 2007, the Examiner refused to register the Bottega Weave Design on the grounds that: (i) the mark is functional, in that the Bottega Weave Design provides the utilitarian advantage of strength, stating that "the process of weaving leather strips together results in a fabric greater than the sum of its parts in terms of strength and durability"; (ii) the mark consists of a non-distinctive product configuration requiring a showing of secondary meaning; and (iii) the mark is merely ornamental because "it merely comprises the pattern of the material from which applicant's goods are made in whole or part." *See* First Office Action.

On March 3, 2008, Bottega Veneta filed a substantive response to the First Office Action.<sup>3</sup> In response to the Examiner's utilitarian functionality refusal, Bottega Veneta demonstrated that the Bottega

---

<sup>2</sup> While the Examiner in the Fourth Office Action states that "the proposed mark as filed is presumed to encompass a weave of any dimension capable of use over all or substantially all of the goods," Bottega Veneta has repeatedly asserted that its mark is limited to these specific dimensions. If the Board requests Bottega Veneta to amend its application to make specific its claim to these dimensions, it will, of course, do so.

<sup>3</sup> The First Office Action Response was supported by the declarations of Vanni Volpi, Intellectual Property Counsel for Bottega Veneta, and Stefano Brazzale, Technical Director of Bottega Veneta.

Weave Design is not dictated by utilitarian purposes under the four factors bearing on functionality set out by the Court of Customs and Patent Appeals in *In re Morton-Norwich Prods., Inc.*, 213 U.S.P.Q. 9 (C.C.P.A. 1982), but rather has intentionally and consistently been used by Bottega Veneta to provide consumers with a visual indicator that the products originate from Bottega Veneta.<sup>4</sup> In particular, Bottega Veneta demonstrated that the Bottega Weave Design has no function, as it does not make the products on which it is used stronger or more durable. *See* Brazzale Decl. (I), ¶ 10. Additionally, Bottega Veneta demonstrated that the Bottega Weave Design was neither a non-distinctive product configuration nor merely ornamental, but rather was, at minimum, registrable under Section 2(f) of the Lanham Act based on acquired distinctiveness. Bottega Veneta’s overwhelming evidence of acquired distinctiveness included the demonstration of its longstanding use of the Bottega Weave Design; the large scale expenditures incurred in promoting and advertising goods bearing the Bottega Weave Design; the commercial success of products bearing the Bottega Weave Design; and numerous unsolicited media references to consumers’ singular association of the Bottega Weave Design with Bottega Veneta. *See* Volpi Decl. (I); First Office Action Response.

### **C. The Second Office Action**

After considering Bottega Veneta’s response, the Examiner issued a Second Office Action on July 11, 2008 continuing the refusal to register. First, the Examiner found that Bottega Veneta had failed to overcome the determination of utilitarian functionality, as Bottega Veneta “did not address the possibility that the proposed mark nonetheless enhances the strength, durability, suppleness or other

---

<sup>4</sup> As in *In re Morton-Norwich Products, Inc.*, “the determination of functionality will flow from a careful weighing of the evidence relevant to whether or not the disputed design feature is dictated by utilitarian purposes,” namely: (i) the existence of a utility patent which discloses the utilitarian advantages of the design is evidence of “functionality”; (ii) the existence of any advertising or promotion of the proponent of trademark rights which touts the functional and utilitarian advantages of the very design aspect it now seeks to protect; (iii) the existence of other alternative designs which perform the utility function equally well; and (iv) whether or not the design results from a comparatively simple, cheap or superior method of manufacturing the article. *See* 1 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (“*McCarthy*”), § 7:73 (4<sup>th</sup> Ed. 2004). As set forth in the First Office Action Response, application of these factors to the Bottega Weave Design showed that the design was not dictated by utilitarian purposes.

quality of the goods.” Second, the Examiner determined, even without utilitarian functionality, the Bottega Weave Design was not registrable under the theory of aesthetic functionality “because it provides other real and significant competitive advantages and thus should remain in the public domain.” Finally, the Examiner found Bottega Veneta’s evidence of acquired distinctiveness insufficient. In support of his various refusals, the Examiner attached images of 24 third-party handbag and footwear products bearing a woven leather design element. According to the Examiner, such third party use showed that woven leather was a “fashion look popular with consumers” and that Bottega Veneta’s “claim of exclusive use of plain woven leather is clearly unsupported.” *See* Second Office Action.

On January 12, 2009, Bottega Veneta responded to the Second Office Action with additional declarations and supporting evidence.<sup>5</sup> With respect to utilitarian functionality, Bottega Veneta introduced additional evidence showing that Bottega Veneta products draw their suppleness, strength and durability not from the Bottega Weave Design, but from the quality of the leather used by Bottega Veneta. Moreover, Bottega Veneta demonstrated that use of the Bottega Weave Design actually *decreases* the strength and durability of the leather used by Bottega Veneta in its products. In fact, Bottega Veneta went so far as to introduce the testimony of Elisabetta Scaglia, lead auditor and leather goods consultant from the National Union of Leather Industry in Milan, Italy, who had conducted independent tests to determine the strength and resistance capabilities of the Bottega Weave Design in comparison to other leather samples, including samples of whole leather, that is, leather not cut into strips. Addressing the Examiner’s “possibility of strength” argument, Ms. Scaglia unequivocally demonstrated that the use of the Bottega Weave Design did not in any way strengthen the constitution or increase the durability of leather goods. *See* Scaglia Decl. (II), ¶ 11.

---

<sup>5</sup> The Second Office Action Response was supported by declarations from Renzo Zengiaro, the designer of the Bottega Weave Design; Elisabetta Scaglia, lead auditor and leather consultant at the independent National Union of Leather Industry in Milan, Italy; Stefano Brazzale; Joe Zee, Creative Director of Elle Magazine; C. Scott Fellows, former Global Marketing Director of Salvatore Ferragamo and Creative Director of Bally’s; Jonathan Joselove, Senior Vice President and General Manager for Neiman Marcus; Judie Conn, Senior Buyer at Gorsuch, Ltd.; retailers Elyse Walker, Jeff Malkin, Mihee Kim, and Gail Rothwell; and luxury brand consultant Jason Jobson.

As for the Examiner's newfound assertion of aesthetic functionality, Bottega Veneta demonstrated that such theory was without support in the law, and, in any event had no application to the facts of record. Moreover, Bottega Veneta demonstrated prohibiting other manufacturers from utilizing the Bottega Weave Design on their products would not put them at a competitive disadvantage, since they were free to use a virtually unlimited number of designs, including other woven leather designs, on similar products. *See* First Office Action Response, Ex. 9; Jobson Decl. (II), ¶ 10. With respect to the Examiner's 24 examples of third-party use — all of which occurred long after the Bottega Weave Design acquired distinctiveness — Bottega Veneta noted that certain third-party products were, by their own admission, imitations of the Bottega Weave Design, and that all were, at minimum, inspired by the Bottega Weave Design. *See* Volpi Decl. (II), ¶¶ 6-12. Bottega Veneta further demonstrated that the existence of these third-party products actually supported a finding of acquired distinctiveness.

Finally, in its Second Office Action Response, Bottega Veneta introduced additional evidence demonstrating the Bottega Weave Design's acquired distinctiveness, including declarations from magazine editors, executives working for Bottega Veneta's competitors, and prominent retail executives and luxury brand consultants, all showing that the Bottega Weave Design strongly indicates Bottega Veneta as the source of goods on which the design appears. *See* Second Office Action Response.

#### **D. The Third Office Action**

After considering Bottega Veneta's Second Office Action Response, the Examiner issued a Third Office Action on April 4, 2009. In this Office Action, the Examiner sought Bottega Veneta's responses to twelve specific questions, purportedly to clarify certain issues raised by Bottega Veneta's prior responses. Among other things, the Examiner requested that Bottega Veneta clarify the dimensions of the Bottega Weave Design; state whether it was claiming it "was the first manufacturer to employ plain woven leather as a primary construction material for shoes, bags and cases"; and indicate whether it uses the Bottega Weave Design on products other than handbags and footwear. Further, the Examiner attached images of 112 additional third-party woven leather products, and asked Bottega Veneta to identify which of them (and the 24 prior examples) infringed the Bottega Weave Design. *See* Third Office Action.

On October 6, 2009, Bottega Veneta responded to each of the Examiner's twelve questions, and stated its position with respect to the third-party products put forward by the Examiner. Notably, Bottega Veneta did not, as the Examiner later claimed, "dismiss[] [] all [136 third party products] as counterfeits from the past few years or goods of unverifiable vintage," nor did Bottega Veneta ever claim that "all third party uses of similar weaves throughout applicant's 35 years of use represent illegal infringements." Rather, Bottega Veneta carefully reviewed the examples put forward by the Examiner and indicated which, in its opinion, infringed the Bottega Weave Design, and which did not. Volpi Decl. (III), Ex. A, B. Further, Bottega Veneta submitted additional declarations supporting the position that the Bottega Weave Design should not be refused registration on utilitarian functionality grounds.<sup>6</sup> In addition, Bottega Veneta supplemented its evidentiary proof of acquired distinctiveness with additional evidence of advertising and promotional efforts (see Volpi Decl. (III), ¶¶ 14-17, Exs. I-K), and submitted declarations from prominent members of the fashion industry — including the Presidents of two of the world's most important retailers, Saks Fifth Avenue and Bergdorf Goodman — stating, based on first-hand knowledge and experience, that consumers recognized the Bottega Weave Design as identifying Bottega Veneta.<sup>7</sup>

#### **E. The Fourth Office Action**

On December 14, 2009, the Examiner issued a Fourth Office Action, making his refusal final. This time, however, the Examiner appeared to pull back on his utilitarian functionality refusal (although this is not entirely clear), stating that while "[t]he proposed mark in fact raises issues of both utilitarian and aesthetic nature . . . [o]n balance, however, the central question posed is one of aesthetic functionality." He then made final his refusal on the ground of aesthetic functionality. Additionally, the Examiner made final his refusal on the ground that the mark is merely ornamental in nature, or, in the

---

<sup>6</sup> The Third Office Action Response was supported by declarations from Vanni Volpi; Michele Taddei, co-founder of Bottega Veneta; Anne Falson, Corporate Communications Officer at PPR, the parent company of Bottega Veneta; Elisabetta Scaglia; and Gianluigi Calavanese from the Italian Public Institute for Research and Testing on Leather and Tanning Materials in Naples, Italy.

<sup>7</sup> These individuals included Polly Mellen, former fashion editor of *Vogue*, *Harper's Bazaar*, and *Allure* magazines; James J. Gold, President and Chief Executive Officer of Bergdorf Goodman; and Richard Frasch, President and Chief Merchandising Officer of Saks Fifth Avenue.

alternative, on the ground that the mark consists of a nondistinctive product design or feature thereof that is not registrable without sufficient proof of acquired distinctiveness. On June 10, 2010, Bottega Veneta filed its Notice of Appeal to the Board. *See* Fourth Office Action.

#### **IV. ARGUMENT**

##### **A. The Bottega Weave Design**

As a preliminary matter, Bottega Veneta would like to make clear that it is not claiming exclusive rights in every possible formation of a leather weave design, a concept that appears to be at the core of the Examiner's refusals. Rather, it seeks to register a mark consisting of leather strips of specific dimensions and placed in a specific orientation. It is the position of Bottega Veneta that the strips of leather woven in these dimensions in this specific orientation results in a unique design that has come to indicate source.

This needs to be made clear because the Examiner appeared to believe that Bottega Veneta was seeking to secure exclusive rights in woven leather generally, no matter the configuration, size or orientation. To the contrary, Bottega Veneta has never asserted that the Bottega Weave Design should be "presumed to encompass a weave of any dimension capable of use over all or substantially all of the goods." *See* Fourth Office Action. Moreover, contrary to the position of the Examiner, Bottega Veneta does not take the position that every example of woven leather in the history of the fashion industry is an infringement of the Bottega Weave Design. The record amply demonstrates, however, that many of the Examiner's third-party examples were either conceded imitations of the Bottega Weave Design, were inspired by the Bottega Weave Design, or were recognized as imitations of the Bottega Weave Design.

##### **B. The Bottega Weave Design Should Not Be Refused Registration on the Ground of Aesthetic Functionality**

While throughout the review process the Examiner has alternatively stated that the Bottega Weave Design was not registrable on the ground of utilitarian functionality and/or aesthetic functionality, it appears he ultimately based his final refusal on aesthetic functionality. *See* Fourth Office Action.

Accordingly, Bottega Veneta does not address the utilitarian functionality ground here.<sup>8</sup> As for the refusal based on aesthetic functionality, Bottega Veneta has amply demonstrated that the Bottega Weave Design is not aesthetically functional. Further, as Bottega Veneta argued to the Examiner below, aesthetic functionality is a legally suspect theory that has never been directly addressed by the U.S. Supreme Court, and has been rejected by the majority of courts, including the Federal Circuit, so it should not be the basis for a refusal to register here.

**1. The Bottega Weave Design Is Not Aesthetically Functional As It Provides No Significant Competitive Advantage**

Even if aesthetic functionality were a viable ground for refusal to register, it has no application here. The Examiner contends that were the Bottega Weave Design to be registered, this would work to the disadvantage of competitors, since a popular design would be removed from the public domain. Specifically, the Examiner states that the Bottega Weave Design is aesthetically functional because registration would: (i) “remove from the public domain an aesthetic motif that has enjoyed widespread popularity for as long or longer as applicant’s own use”; (ii) prevent third party manufacturers of woven leather goods other than handbags and footwear from expanding their product lines or providing their customers with matching handbags and footwear; (iii) “effectively deprive competitors of the ability to use non-bias plain woven leather on certain types of goods” because “maintaining the orientation of the weave over the curved surface of goods such as shoes is demonstrably impractical”; and (iv) lead to the conclusion that any plain weave used in any orientation would be confusingly similar to the Bottega Weave Design. *See* Fourth Office Action.

---

<sup>8</sup> To the extent utilitarian functionality still serves as a basis for the Examiner’s refusal, Bottega Veneta maintains, as it amply demonstrated below, that application of the factors set forth *In re Morton-Norwich, supra*, demonstrates that the Bottega Weave Design was not dictated by utilitarian purposes. Specifically, (i) the Bottega Weave Design is not the subject of any utility patent; (ii) advertisements of products bearing the Bottega Weave Design do not tout the utilitarian advantages of the design; (iii) there are a multitude of other designs available to Bottega Veneta’s competitors for use in the design of handbags and footwear; and (iv) the Bottega Weave Design does not result from a comparatively simple, cheap or superior method of manufacturing the article. *See* First Office Action Response and Second Office Action Response. Further, the evidence of record is clear that the Bottega Weave Design serves no utilitarian purpose.

Notably, on this last point, the Examiner states that “it is the examiner’s view that third party use of simple plain woven leather or similar materials placed in any orientation arguably would be confusingly similar to the proposed mark.” *Id.* This view is not shared by Bottega Veneta. Instead, by going through the painstaking exercise of identifying which of 136 third party woven leather products it considered to be infringing, Bottega Veneta demonstrated that it does not claim that every plain woven design placed in any orientation would be confusingly similar to the Bottega Weave Design.<sup>9</sup> Nor has Bottega Veneta claimed that any design that is compared by the public to the Bottega Weave Design “must be viewed as an infringement.” *Id.*

Indeed, as Bottega Veneta has demonstrated, there are numerous other designs, including a multitude of woven leather constructions, that manufacturers can avail themselves of without having to copy, or in way emulate the Bottega Weave Design. *See* Volpi Decl. (I), ¶13; First Office Action Response, Ex. 9; Jobson Decl. (II), ¶ 10. Prohibiting other designers from utilizing the Bottega Weave Design would cause no greater competitive disadvantage than preventing them from adopting the trademarks and logos of their competitors. Jobson Decl. (II), ¶ 9.<sup>10</sup>

The Bottega Weave Design does not provide any specific aesthetic, ornamental or utilitarian advantage that makes it one of few superior designs available, nor is Bottega Veneta seeking to secure exclusive rights with respect to woven leather generally. Indeed, Bottega Veneta has made of record numerous alternate designs that many designers of woven products, in the same categories of goods, have utilized, including weave designs consisting of various size strips of leather and woven patterns. *See* First

---

<sup>9</sup> Of the 136 products, Bottega Veneta considered only about half to be infringements of the Bottega Weave Design. Given that the Examiner presumably put forward these particular examples of third party woven leather products because he believed Bottega Veneta might claim they were all confusingly similar to the Bottega Weave Design, this result certainly demonstrates that in no way does Bottega Veneta consider all examples of woven leather used in any orientation to infringe the Bottega Weave Design. *See* Volpi Decl. (III), Ex. A, B.

<sup>10</sup> *See, e.g., Johnson & Johnson v. Actavis Grp. hf*, 2008 WL 228061 \*3 (S.D.N.Y. Jan. 25, 2008) (use of a gold background color on product packaging did not provide competitive advantage where other colors are prevalent in the packaging of first-aid products that are customarily sold in the aisle in which the parties’ products are found); *Villeroy & Boche Keramische Werke K.G. v. THC Sys., Inc.*, 27 U.S.P.Q.2d 1866 (2d Cir. 1993).

Office Action Response, Ex. 9. Many of these woven designs have been registered by the Trademark Office, or at least have not been refused registration based on aesthetic functionality. For example, Bottega Veneta’s competitor, Christian Dior, received a Principal Register registration on March 16, 2010 for a mark similarly “consist[ing] of interlaced, woven strips of leather arranged in a repeating pattern arranged over all or substantially all of the goods.” *See* U.S. Reg. No. 3,761,379. While Christian Dior’s woven leather mark was initially refused as a merely ornamental and nondistinctive product configuration — the same grounds asserted by the Examiner here — Christian Dior was able to overcome this refusal by submitting evidence of acquired distinctiveness falling far short of the showing Bottega Veneta has made in the instant proceeding. Most importantly, however, at no time did the Examiner considering Christian Dior’s application ever interpose an aesthetic functionality objection.<sup>11</sup>

Here, the Bottega Weave Design is no more aesthetically functional, and competitors would be no more disadvantaged if it were registered, than in the case of these other designs. Accordingly, Bottega Veneta’s competitors would not be placed at a significant commercial disadvantage by Bottega Veneta’s continued exclusive use and registration of the Bottega Weave Design, because they have the choice of an unlimited number of designs and patterns, including woven designs, that will allow them to compete.

## **2. Aesthetic Functionality Is a Suspect Legal Theory That Should Not Be Used to Preclude Registration**

In addition to the fact that the Bottega Weave Design is not aesthetically functional, the theory of aesthetic functionality is legally suspect and has been rejected by a majority of courts, including the

---

<sup>11</sup> In 2009, Bottega Veneta’s competitor, Louis Vuitton, registered a mark “consist[ing] of squares with a checkered pattern of light and dark with the unusual contrast of weft and warp.” *See* U.S. Reg. No. 3,576,404. This registration was issued without any aesthetic functionality refusal. Louis Vuitton also owns several trademark registrations for its signature “Epi” leather, a “distinctive man-made textured pattern utilized as a surface feature.” *See* U.S. Reg. Nos. 2,263,903; 2,071,273; 1,931,144; 2,098,630; 2,058,732; and 1,841,850. At no time did any of the Examiners who reviewed these Louis Vuitton applications find Louis Vuitton’s use of its “Epi” leather pattern, which often covers the entire surface of Louis Vuitton’s products, to be aesthetically functional. Further, in 2008, Cole Haan filed an application to register a mark “consist[ing] of a weave pattern with a contracting and extending weave extending in a repeating hourglass shape on the exterior of goods.” *See* U.S. App. Ser. No. 77/580,306. While the application was refused on the ground of mere ornamentality, and Cole Haan did not respond to the Office Action, no aesthetic functionality refusal was issued by the Examiner.

Federal Circuit. *See McCarthy*, § 7.80. As Professor McCarthy has noted:

The Trademark Board has observed that decisions of the Federal Circuit “leave little doubt” that the theory of aesthetic functionality has been rejected in the Federal Circuit, is not used in the Patent and Trademark Office, where “functionality” must be determined on the basis of utilitarian aspects.

*Id.*, citing *In re Deere & Co.*, 7 U.S.P.Q.2d 1401 (T.T.A.B. 1988).

Courts have further recognized that where, as here, a finding of aesthetic functionality turns on commercial success or popularity among consumers, a refusal to register would give junior users license to freely copy even the most distinctive designs:

The logical extension of this argument would practically obliterate trademark protection for product design because a defendant could always argue that its innovative product is a widget that provides a replica of the most popular or prestigious widget on the market, thus requiring that the defendant be allowed without further analysis to copy the plaintiff’s widget.

*Pebble Beach Co. v. Tour 18 I, Ltd.*, 48 U.S.P.Q.2d 1065, 1072 (5<sup>th</sup> Cir. 1998). Thus, invoking the Examiner’s “popularity” rationale would turn trademark law on its head. *See, e.g., Vuitton et. Fils, S.A. v. J. Young Enters., Inc.*, 210 U.S.P.Q. 351, 355 (9<sup>th</sup> Cir. 1981) (rejecting the notion that “any feature of a product which contributes to the consumer appeal and saleability of the product is, as a matter of law, a functional element of the product”); *McCarthy*, § 7.81 (“The notion of ‘aesthetic functionality’ is an unwarranted and illogical expansion of the functionality policy, carrying it far outside the utilitarian rationale that created the policy.”).

While the Examiner asserts that the Supreme Court has supported aesthetic functionality as a viable legal concept in *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001), a review of the legal commentary and court decisions since then makes this far from clear. While the Supreme Court did make passing reference to the theory of aesthetic functionality in *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995) (finding a single color “may sometimes meet the basic legal requirements for use as a trademark”), that case did not address aesthetic functionality. Indeed, the Supreme Court has never directly addressed aesthetic functionality as a dispositive issue in any case.

As for *TrafFix Devices*, in which the Examiner claims the Supreme Court “acknowledge[d] []

aesthetic functionality” (*see* Fourth Office Action), the Court addressed the question “whether the existence of an expired utility patent forecloses the possibility of the patentee’s claiming trade dress protection in the product’s design.” 532 U.S. at 28. While once again the Court made passing reference to aesthetic functionality, its determination in no way turned on that theory. In fact, the Court’s reference to aesthetic functionality — and specifically its statement that “aesthetic functionality was the central question” in *Qualitex* — has been roundly criticized. Indeed, Professor McCarthy found the Court’s reference to aesthetic functionality in *TrafFix Devices* to be “incomprehensibl[e].” *See McCarthy*, § 7:80 (commenting on *TrafFix Devices*, Professor McCarthy states that “aesthetic functionality was not the question in any way in *Qualitex*, let alone the ‘central question’”).<sup>12</sup>

In addition, the Federal Circuit has consistently rejected the argument that “functionality” extends beyond its utilitarian origins to include “aesthetic functionality.” *See, e.g., In re Mogen David Wine Corp.*, 140 U.S.P.Q. 575 (C.C.P.A. 1964), *appeal after remand*, 152 U.S.P.Q. 593 (C.C.P.A. 1967); *In re Penthouse International, Ltd.*, 195 U.S.P.Q. 698 (C.C.P.A. 1977). Most recently, in *Brunswick Corp. v. British Seagull*, 32 U.S.P.Q.2d 1120 (Fed. Cir. 1994), the Federal Circuit declined to apply aesthetic functionality, holding that the purported aesthetic advantages of the color outboard motors were of a utilitarian, not aesthetic nature: “Color compatibility and ability to decrease apparent motor size are not in this case mere aesthetic features. Rather these non-trademark functions supply a competitive advantage.”<sup>13</sup> This Board has followed the same approach. *See In re Deere & Co.*, 7 U.S.P.Q.2d 1401 (T.T.A.B. 1988) (observing that decisions of the Federal Circuit “leave little doubt” that the theory of

---

<sup>12</sup> *See also Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 80 U.S.P.Q.2d 1293 (9th Cir. 2006), *cert. denied*, 127 S. Ct. 1839 (2007) (court is unable to make sense of the discussion of aesthetic functionality in *TrafFix* and *Qualitex*); *Bd. of Supervisors for Louisiana State Univ. Agric. and Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 487-88 (5th Cir. 2008), *cert. denied*, 129 S. Ct. 2759 (2009) (stating that “neither *Qualitex* nor *TrafFix* addressed aesthetic functionality as the dispositive issue . . . . We do not believe that the Court’s dictum in *TrafFix* requires us to abandon our long-settled view rejecting recognition of aesthetic functionality”).

<sup>13</sup> *See also In re DC Comics, Inc.*, 215 U.S.P.Q. 394 (C.C.P.A. 1982) (Rich, J. concurring opinion states that: “[I]t is arguable that there is no ‘doctrine’ of aesthetic functionality which stands alone, without consideration of the more traditional source identification principles of trademark law. To the extent there may be — at least with respect to *ex parte* prosecution practice — it has been previously rejected by this court.”).

aesthetic functionality has been rejected in the Federal Circuit, and therefore is not used in the Patent and Trademark Office, where “functionality” must be determined on the basis of utilitarian aspects).<sup>14</sup>

### **C. The Bottega Weave Design Is Not Merely Ornamental**

In addition to aesthetic functionality, the Examiner refused registration on the basis that the Bottega Weave Design is merely decorative or ornamental in nature and is, therefore, incapable of functioning as a source identifier. Specifically, the Examiner states that the Bottega Weave Design “merely comprises the pattern of the material from which applicant’s goods are made in whole or part.” The Examiner further concluded that the mere ornamental or decorative nature of the Bottega Weave Design is shown by the repetition of the design over the entire surface of the product, creating a “wallpaper” effect that could not be source-identifying. *See* Fourth Office Action.

The Examiner is wrong. Aside from the fact that the Bottega Weave Design does not always cover the surface of every product on which it is used, a design that covers the entire surface can still serve as an indicator of source. *See Vuitton, supra* (upholding validity of Louis Vuitton repeating design trademark on leather goods); *CITC Indus. Inc. v. Levi Strauss and Co.*, 216 U.S.P.Q. 512, 516 (T.T.A.B. 1982) (“We are not saying that a symbol or design covering the surface of a product cannot perform a trademark function or that it somehow loses its origin-indicating property when it is so used. This is clearly not the law.”); *In re Watkins Glen Int’l, Inc.*, 227 U.S.P.Q. 727 (T.T.A.B. 1985); *In re Keeper Chemical Corp.*, 177 U.S.P.Q. 771 (T.T.A.B. 1973). There is also no rule that states that if a design covers more than a certain percentage of a product’s surface area, the design cannot serve as a trademark.

It is not surprising, then, that the Trademark Office has issued numerous registrations for design marks that cover the entire surface of products (particularly in the luxury goods area, where often the design is the brand owner’s most important, recognizable “signature”). Examples include registrations

---

<sup>14</sup> The Trademark Manual of Examining Procedure warns examining attorneys to “exercise caution in the use of the term ‘aesthetic functionality,’ in light of the confusion that has historically surrounded this issue,” and further advises that “[u]se of term ‘aesthetic functionality’ may be appropriate [only] in limited circumstances . . . where the issue is one of true [utilitarian] functionality under §2(e)(5) . . . .” TMEP § 1202.02 (a)(vi).

for the aforementioned Christian Dior woven leather design (U.S. Reg. No. 3,761,379); Louis Vuitton's checkered pattern of light and dark brown with a contrast of weft and warp (U.S. Reg. No. 2,421,618); and Louis Vuitton's "épi leather" design mark of raised wavy lines in various colors (U.S. Reg. Nos. 2,421,618; 2,263,903; 2,071,273; 1,931,144; 2,098,630; 2,058,732; and 1,841,850); as well as Burberry Limited's plaid pattern design (U.S. Reg. No. 2,015,462); and Louis Vuitton's repeating LV and flower design mark (U.S. Reg. Nos. 1,643,625; 1,653,663; 1,770,131; 1,875,198; and 2,399,161).

**D. The Bottega Weave Design Is Not A Non-Distinctive Product Configuration**

As an alternative to "mere ornamentation," the Examiner concluded that the application should be refused because the mark consists of a nondistinctive product design that has not acquired distinctiveness. The evidence of record, however, overwhelmingly demonstrates that the Bottega Weave Design has acquired distinctiveness, and is, in fact, an extremely strong indicator of source.

While "[t]he kind and amount of evidence necessary to establish that a mark has acquired distinctiveness in relation to goods or services depends on the nature of the mark and the circumstances surrounding the use of the mark in each case," evidence of (i) length of use of the mark in commerce; (ii) advertising expenditures; and (iii) declarations asserting recognition of mark as source indicator, have been applied, alone or in combination, to determine acquired distinctiveness. *See* TMEP §1212.06(a)-(c). In addition, federal courts have found that proof of acquired distinctiveness may be based on unsolicited media coverage of the product; sales success; and attempts to plagiarize the mark. *See Thompson Medical Co. v. Pfizer Inc.*, 753 F.2d 208, 217 (2d Cir. 1985).

As discussed below, throughout the course of these proceedings, Bottega Veneta has introduced overwhelming and undeniable evidence of acquired distinctiveness, far more than any registered product design mark of which Bottega Veneta is aware. Inexplicably, however, the Examiner found this evidence to be insufficient, even while acknowledging that the Bottega Weave Design is "the most famous example" of the use of woven leather, and that third parties "acknowledge [the Bottega Weave Design] as an upscale and high quality reference point." *See* Fourth Office Action.

**1. The Bottega Weave Design Has Been In Continuous Use in the U.S. for More Than 35 Years**

Longstanding use of a descriptive or ornamental mark is an important factor in determining whether the mark has acquired distinctiveness. TMEP §1212.06(a); *see In re Jockey Int'l, Inc.*, 192 U.S.P.Q. 579, 582 (T.T.A.B. 1976) (inverted-Y design used on underwear found to have acquired distinctiveness where evidence showed extensive use on packaging and advertising in a manner calculated to draw the attention of prospective purchasers to the design and for them to look at the design as a designation of origin). Here, beginning with its first collection of handbags featuring the Bottega Weave Design in 1975, Bottega Veneta has consistently used the Bottega Weave Design on handbags, footwear and other products ever since. Volpi Decl. (I), ¶ 4. Indeed, in 2001, for the very reason that the Bottega Weave Design had become so recognizable and identified with Bottega Veneta, Bottega Veneta deliberately began to incorporate the design into a broader line of goods including jewelry, home furniture and decorative accessories. *Id.*, ¶ 5; Ex. 4 (photographs of Bottega Veneta products). In all, the Bottega Weave Design has been in uninterrupted and widespread use for 35 years, on millions of products.

**2. Advertising and Promotional Expenditures**

Large scale expenditures promoting and advertising goods under a particular mark, particularly where the mark is prominently featured, is a strong indication that a mark has acquired distinctiveness. *See Anchor Hocking Glass Corp. v. Corning Glass Works*, 162 U.S.P.Q. 288 (T.T.A.B. 1969) (acquired distinctiveness found based on extensive and prominent use of cornflower design in advertising); *In re Haggart Co.*, 217 U.S.P.Q. 81 (T.T.A.B. 1982) (acquired distinctiveness found based on evidence of substantial advertising and sales of clothing with a black background design); TMEP § 1212.06(b).

Here, Bottega Veneta's advertising campaigns, which have appeared in such national publications as *Vanity Fair*, *Town and Country*, *Vogue*, and *Women's Wear Daily*, have always featured the Bottega Weave Design, as all photographs focus on the unique look of the design. *See* First Office Action Response, Ex. 5; Volpi Decl. (I), ¶ 8; Volpi Decl. (III), ¶ 16, Ex. J. Further, between 2001 and 2007 alone, Bottega Veneta spent approximately \$18 million dollars advertising products bearing the Bottega

Weave Design. Volpi Decl. (I), ¶ 8. Additionally, Bottega Veneta participates in cooperative advertising with major national department store chains. For example, Neiman Marcus' advertising campaigns and catalogues feature products bearing the Bottega Weave Design on a regular basis, with Bottega Veneta contributing in excess of \$250,000 in cooperative advertising dollars from 2004 to 2007. Joselove Decl. (II), ¶ 6. Such expenditures and exposure greatly increase the likelihood that consumers will associate the design with a single seller. *See McCarthy*, §15:51.

### **3. Commercial Success**

The commercial success of products bearing a design mark is strong evidence of acquired distinctiveness. *See Thompson Medical Co., supra*. Here, sales of Bottega Veneta products in the U.S. from 2001 through 2007 exceeded \$275 million, with the Bottega Weave Design prominently appearing on the overwhelming majority of those goods. Volpi Decl. (I), ¶ 7.

### **4. Consumers and the Trade Recognize the Bottega Weave Design as a Strong Indicator of Source**

Bottega Veneta has made of record substantial evidence that consumers and tradespeople immediately recognize the Bottega Weave Design as a source indicator. Affidavits of industry experts demonstrating that consumers recognize a design as a source indicator are highly relevant in establishing acquired distinctiveness. TMEP § 1212.06(c). In particular, statements from retailers who have been in direct contact with consumers are highly competent evidence of secondary meaning. *In re Bose Corp.*, 216 U.S.P.Q. 1001, 1005 (T.T.A.B. 1983), *aff'd*, 227 U.S.P.Q. 1 (Fed. Cir. 1985) (retailer's statement that he has been in contact with many purchasers of loudspeaker systems and many would recognize the depicted design as originating with applicant). Here, Bottega Veneta has submitted statements from several fashion industry experts attesting to the distinctiveness of the Bottega Weave Design.

In the course of examination, Bottega Veneta submitted affidavits from numerous retailers that sell Bottega Veneta products (as well as products of Bottega Veneta's competitors). These retailers have unequivocally stated that the Bottega Weave Design is not only recognized by consumers as a source indicator, but that it is an "iconic design," which consumers and the trade immediately identify with

Bottega Veneta.<sup>15</sup> Moreover, they recognize that what makes a particular design iconic and source-indicating is that it is a striking design that has been used consistently over a long period of time, particularly a design that has achieved sales success, has been extensively advertised and marketed, and has been extensively covered by the media. All pointed to the Bottega Weave Design as one such iconic, source-indicating design (*see, e.g.*, Conn Decl. (II), ¶ 6; Kim Decl. (II), ¶ 6; Rothwell Decl. (II), ¶ 6), stating, based on their experience, that consumers encountering the Bottega Weave Design immediately recognized the products come from Bottega Veneta without referring to any other source indicator such as a label or hangtag. *Id.*; Joselove Decl. (II), ¶ 7; Malkin Decl. (II), ¶¶ 1-4; Walker Decl. (II), ¶¶ 1-4.

Notably, Bottega Veneta submitted the affidavit of James J. Gold, the President and CEO of Bergdorf Goodman, one of the most highly respected and famous retailers in the world, attesting to the fact that consumers immediately identify the Bottega Weave Design with Bottega Veneta. Prior to serving as President and CEO of Bergdorf Goodman, Mr. Gold served as the Senior Vice President and General Merchandise Manager for Neiman Marcus, again one of the most famous retailers. *See* Gold Decl. (III), ¶ 1. With over 18 years of experience in the fashion business, Mr. Gold has been exposed to design collections created by every luxury goods company. Mr. Gold stated that not only are “Bottega Veneta’s products, especially those bearing Bottega Veneta’s signature ‘intrecciato’ weave design [] extremely popular at Bergdorf Goodman and Neiman Marcus stores” (*id.* at ¶ 6), but also that consumers:

immediately recognize Bottega’s Weave Design as emanating exclusively from Bottega Veneta, due to the distinctiveness of the design as well as the fact that the design, through careful marketing, has become synonymous with Bottega Veneta. As you might imagine, because of the success of Bottega Veneta’s Weave Design over the years, other competitors have occasionally attempted to imitate it; however, no individual or entity has ever achieved consumer recognition for this weave design (or any design closely

---

<sup>15</sup> *See* Declarations of Jonathan Joselove, Senior Vice President and General Merchandise Manager for Neiman Marcus; Judie Conn, of Gorsuch Ltd., a Colorado retailer; Mhee Kim, owner of “Parashu” in Los Angeles, California; Gail Rothwell, owner of “Gail Rothwell” boutique in East Hampton, New York; Jeff Malkin, owner of “Shadyside Choices” boutique in Pittsburgh, Pennsylvania; Elyse Walker, owner of “Elyse Walker” boutique in Pacific Palisades, California; James J. Gold, President and Chief Executive Officer of Bergdorf Goodman; and Richard Frasch, President and Chief Merchandising Officer of Saks Fifth Avenue.

resembling it) other than Bottega Veneta. *Id.* at ¶ 9.<sup>16</sup>

Bottega Veneta has also submitted the declarations of Joe Zee, the Creative Director of *Elle* magazine, a fashion and lifestyle publication, and Polly Mellen, former fashion editor of *Vogue*, *Harper's Bazaar*, and *Allure* magazines, four of the top fashion magazines in the world. Mr. Zee, who has worked in fashion publishing for over 20 years, testified that the Bottega Weave Design is an iconic design, and that in his experience consumers encountering products containing the Bottega Weave Design immediately recognize that the products come from Bottega Veneta, without referring to any other indicator of source. *See* Zee Decl. (II). Similarly, Ms. Mellen, who has been extensively involved in the fashion industry for over 60 years — as a stylist and editor for *Harper's Bazaar*, *Allure* and *Vogue* — testified unequivocally that consumers who encounter the Bottega Weave Design immediately recognize Bottega Veneta as the source of such products without regard to any other source indicators. *See* Mellen Decl. (III). Ms. Mellen stated that “[i]n all of my years in the fashion industry, other than Bottega Veneta imitators, I am unaware of any other designers who have used a design similar to the iconic Bottega Veneta Weave Design on handbags and small leather goods. The distinctive Bottega Weave Design is truly exclusive to Bottega Veneta and synonymous with the Bottega Veneta brand.” *Id.*, 8.

Additionally, Scott Fellows, an executive who worked for two of Bottega Veneta's largest competitors — Salvatore Ferragamo and Bally's — attested to the fact that the Bottega Weave Design is immediately recognized by consumers and tradespeople as indicating Bottega Veneta as the exclusive source of products on which it appears. *See* Fellows Decl. (II).

## **5. Unsolicited Media Coverage**

Additionally, Bottega Veneta has introduced substantial evidence that leading U.S. mainstream and fashion publications, as well as other fashion media, recognize that the Bottega Weave Design is

---

<sup>16</sup> In addition, Bottega Veneta submitted the declaration of Ronald Frasch, President and Chief Merchandising Officer of Saks Fifth Avenue, also one of the most famous retailers in the world. Mr. Frasch also attested not only to the fact that Bottega Veneta products bearing the Bottega Weave Design have been sold at Saks Fifth Avenue for approximately 25 years, but that Saks Fifth Avenue's customers immediately recognize and seek out the Bottega Weave Design. *See* Frasch Decl. (III).

singularly associated with Bottega Veneta. *See* First Office Action Response, Ex. 6; Volpi Decl. (I), ¶ 9; Volpi Decl. (II), ¶ 14, Ex. 4; Volpi Decl. (III), ¶ 15, Ex. I. Such unsolicited media coverage has been found in the following publications, *The New York Times*, *Time*, *Vanity Fair*, *GQ*, *New York Magazine*, *Travel + Leisure*, *Departures*, *Town & Country*, *W*, *Robb Report*, *Elle Décor* and *Women's Wear Daily*. *Id.* Additionally, photographs of products bearing the Bottega Weave Design have appeared in numerous publications. Famous celebrities such as Jennifer Aniston, Beyonce Knowles, Cameron Diaz, Mandy Moore, Pamela Anderson, Uma Thurman, Zooey Deschanel, Scarlett Johansson, Christina Applegate, Jessica Biel, Toni Collette, Renee Zellweger, Selma Blair, Nicole Kidman, Denise Richards, Sarah Jessica Parker, Ashley Olsen, Linda Evangelista, and socialite Aerin Lauder have been photographed carrying handbags featuring the Bottega Weave Design. *See* First Office Action, Ex. 8; Volpi Decl. (I), ¶¶ 10-11; Volpi Decl. (II), ¶ 17, Ex. 7; Volpi Decl. (III), ¶ 17, Ex. K. As this legion of media references demonstrates, there is a firmly implanted association in the minds of consumers between the Bottega Weave Design and Bottega Veneta.

**E. Third Party Use Does Not Preclude Registration of the Bottega Weave Design**

In the course of examination, the Examiner has put forward numerous examples of third-party woven leather products, taking the position that such third party use demonstrates that the Bottega Weave Design is not seen as the exclusive source of such products (notwithstanding the overwhelming evidence that it is). In addition, the Examiner argues that if the Trademark Office grants exclusive rights in the Bottega Weave Design, this would improperly restrict third-party access to a “classic fashion material,” presumably referring to his examples of third-party use. *See* Fourth Office Action.

Again, the Examiner is wrong. First, and most importantly, the fact that many of these third-party products are conceded imitations of the Bottega Weave Design, or were recognized by the public as such, actually supports a finding of acquired distinctiveness. Second, contrary to the Examiner's assertions, Bottega Veneta has never claimed that all the third party examples put forward by the Examiner were infringements on Bottega Veneta's rights. Third, as for the “vintage” third-party products that purportedly predate Bottega Veneta's use of the Bottega Weave Design, there is no competent evidence

that such products do, in fact, predate the Bottega Weave Design.

**1. Evidence of Intentional Copying of the Bottega Weave Design Actually Supports a Finding of Acquired Distinctiveness**

Contrary to the Examiner's position, proof of intentional copying of a design mark, actually supports a finding of acquired distinctiveness. *See McCarthy*, § 15:30. Throughout of the course of these proceedings, Bottega Veneta has submitted evidence that (i) third parties have intentionally copied the Bottega Weave Design; (ii) the retail industry is aware of this; and (iii) there is widespread discussion on the Internet about knockoffs of the Bottega Weave Design.

For example, in the Second Office Action, the Examiner referred to a woven leather bag by a manufacturer named Falor. The Examiner failed to recognize, however, that the writer recognized the bag as a Bottega Veneta knockoff, not as the use of a "classic fashion material." *See Volpi Decl. (II)*, ¶ 7. Moreover, Bottega Veneta has actually taken action against Falor for its infringement of the Bottega Weave Design. In April 2008, Bottega Veneta sued Falor in Italy, ultimately entering into a settlement agreement in which Falor acknowledged Bottega Veneta's trademark rights in the Bottega Weave Design, and agreed to cease selling infringements of the Bottega Weave Design. *Id.*, Ex. 1. This evidence was presented to the Examiner, but apparently did not persuade him.

Indeed, of the 136 third-party uses cited by the Examiner, there are numerous examples where consumers identified the woven leather designs as imitations of the Bottega Weave Design. For example, the Examiner's reference to a woven leather coin purse manufactured by Atmos was recognized as a "Bottega Veneta-esque Brick Coin Purse." *Id.*, ¶ 8. The Examiner's reference to a woven leather bag on Bloomingdale's website was also cited by the public for its similarity to the Bottega Weave Design. *Id.*, ¶ 10. And, the Examiner's reference to a Marc Jacobs woven leather bag was seen as "third-rate knock off" of a Bottega Veneta handbag. *Id.*, ¶ 11, Ex. 2. Further, Bottega Veneta submitted evidence to the Examiner demonstrating that consumers were actively commenting on the third-party imitations of the Bottega Weave Design (*id.*, ¶ 15; Ex. 5), and that it was well-known in the retail industry that third parties

were intentionally copying the Bottega Weave Design (*see* Joselove Decl., ¶ 6).<sup>17</sup>

Again, what this evidence shows is not, as the Examiner would have it, that the Bottega Weave Design is a “classic fashion material,” but rather, due to strong consumer awareness, that imitators are knocking off the Bottega Weave Design with increasing regularity. *See* Volpi Decl. (II), ¶ 12. Indeed, that is one of the reasons why Bottega Veneta is seeking this trademark registration. *Id.*

## **2. Bottega Veneta Has Never Claimed that All Uses of Woven Leather Infringe Its Rights in the Bottega Weave Design**

In the Fourth Office Action, the Examiner claims that Bottega Veneta has “dismiss[ed] [] all [136 third-party products] as counterfeits from the past few years or goods of unverifiable vintage”; claimed that “all third party uses of similar weaves throughout applicant’s 35 years of use represent illegal infringements”; and asserted that any design that is compared to the Bottega Weave Design “must be viewed as an infringement.” *See* Fourth Office Action.

Once again, the Examiner’s statements are simply not true. As noted above, Bottega Veneta is not seeking to secure for itself the exclusive right to use woven leather in any dimension, proportion, or orientation. Instead, Bottega Veneta is seeking to protect its rights in the specific configuration of the Bottega Weave Design that it has used with great success for the past 35 years. This should have been apparent to the Examiner when he caused Bottega Veneta to review his 136 third-party products. In response, Bottega Veneta did not indicate that *all* 136 products infringed the Bottega Weave Design. Instead, without the benefit of reviewing a single physical sample, Bottega Veneta indicated that it considered about half of the third party products to be infringements. *See* Volpi Decl. (II), Exs. A, B.

## **3. No Competent Evidence Supports the Examiner’s Claim of Prior Use**

Finally, while the Examiner claims that certain of his third-party examples predate Bottega

---

<sup>17</sup> Bottega Veneta has instituted a trademark enforcement program and regularly takes steps to stop unauthorized use of the Bottega Weave Design. Volpi Decl. (II), ¶ 2. As a result, Bottega Veneta has entered into numerous settlement agreements with imitators of the Bottega Weave Design. *Id.* As part of these settlements, imitators not only agreed to cease further use of the Bottega Weave Design, but also to recognize Bottega Veneta’s rights in the design on a worldwide basis. *Id.* In addition to Falor, third parties who have entered into settlements with Bottega Veneta include Fly Stile Pelle, Mara Pelletterie S.r.l., Punto Fa, S.A, Bijoux Plus S.A., Carel S.A., Maison de Famille S.A., and Caleidos S.r.l. *Id.*, Ex. 3.

Veneta's use of the Bottega Weave Design, there is no competent evidence of this. As a preliminary matter, Bottega Veneta notes that the majority of the so-called "vintage" third-party products selected by the Examiner are identified as having been manufactured in the 1980's — after the Bottega Weave Design was introduced. Moreover, many of these examples are from websites like eBay and Etsy.com where consumers are attempting to resell used products. It is well-known that online sellers use generalized terms like "vintage" to create the impression that the products were produced at a certain time, but these claims cannot be substantiated. Finally, Bottega Veneta notes that certain websites from which the Examiner's third-party examples were drawn are notorious for trafficking in counterfeit merchandise. *See* Third Office Action Response; Volpi Decl. (III), ¶ 18; Ex. L

Nevertheless, as stated in response to the Examiner's inquiry, Bottega Veneta has never claimed that it was the first manufacturer to employ woven leather as a primary construction material for handbags and footwear. Rather, Bottega Veneta has consistently maintained that it was the first to employ the Bottega Weave Design, the particular woven leather configuration that is the subject of its pending application. It is that design mark, and only that design mark, that Bottega Veneta seeks to register.

### **CONCLUSION**

For the foregoing reasons, Bottega Veneta respectfully requests that the Examiner's refusal to register the Bottega Weave Design be overturned and that the application be passed to publication.

Respectfully, submitted,

ARNOLD & PORTER LLP

By:                   /John Maltbie/                    
Louis S. Ederer, Esq.  
John Maltbie, Esq.  
399 Park Avenue  
New York, New York 10022  
Telephone: (212) 715-1000  
Facsimile: (212) 715-1399  
trademarkdocketing@aporter.com

Attorney for Applicant  
Bottega Veneta International S.a.r.l