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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
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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

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**APPLICANT BOTTEGA VENETA INTERNATIONAL S.A.R.L.'S
EX PARTE APPEAL REPLY 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.

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I. INTRODUCTION

Bottega Veneta International S.a.r.l. (“Bottega Veneta”) hereby submits its *ex parte* reply brief in further support of its application to register the world-famous woven leather design which it has been using for the past 35 years and which, as shown by the overwhelming evidence of record of secondary meaning, has become synonymous with the Bottega Veneta brand. Specifically, Bottega Veneta submits this brief to: (i) respond to the Examiner’s claim that aesthetic functionality is an “established legal doctrine”; (ii) point out that even under the Examiner’s aesthetic functionality analysis, registration of the Bottega Weave Design would not hinder competition, as his purported evidentiary support for this position does not exist in the record; (iii) refute the Examiner’s attempt to resuscitate his abandoned position that the Bottega Weave Design should be refused registration on the grounds of utilitarian functionality; and (iv) note, once again, that Bottega Veneta’s application to register the Bottega Weave Design is supported by overwhelming evidence of acquired distinctiveness, much of which is simply ignored by the Examiner.

II. PRELIMINARY STATEMENT

For over three years, Bottega Veneta has been responding to, and refuting, the refusals to register issued by the Examiner. In September 2007, the Examiner issued his first Office Action, refusing registration, in large part, because the Examiner believed that the Bottega Weave Design “is functional for the goods because it represents utilitarian advantages in strength.” *See* First Office Action. Additionally, the Examiner refused registration on the grounds that the Bottega Weave Design was merely ornamental and/or failed to serve as a trademark. *Id.*

After Bottega Veneta responded to the Office Action and definitively demonstrated that, pursuant to the functionality analysis set forth in *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 U.S.P.Q. 9 (C.C.P.A. 1982), the Bottega Weave Design served no utilitarian purpose (*see* First Office Action Responses), the Examiner nevertheless continued the utilitarian functionality refusal, but then tacked on a refusal to register on the ground of aesthetic functionality (*see* Second Office Action). Specifically, based on no evidence in the record, the Examiner stated that “the look of shoes or bags made

of plainly woven leather is one which consumers want, whether they be jet-setting celebrities or modest college students.” *Id.* Further, the Examiner refused to accept the evidence of acquired distinctiveness put forward by Bottega Veneta to overcome the Examiner’s refusal on the grounds of ornamentality and failure to serve as a trademark. *Id.*

In response, Bottega Veneta, among other things, provided the Examiner with the Declaration of Elisabetta Scaglia, lead auditor and leather goods consultant for the independent National Union of Leather Industry (“UNIC”), who had tested the Bottega Weave Design’s tensile strength against a piece of whole leather as well as an individual strip of leather used in the manufacture of the Bottega Weave Design. Ms. Scaglia’s tests confirmed that the Bottega Weave Design did not provide any utilitarian advantage in strength. In fact, Ms. Scaglia found not only that whole leather was far stronger and more durable than the Bottega Weave Design, but also that the Bottega Weave Design and a single strip of leather from which is made “can withstand the same amount of tension before the leather rips and breaks apart.” *See Scaglia Decl. (II)*, ¶¶ 6-7. Thus, unlike woven fabrics (which the Examiner continues to erroneously compare the Bottega Weave to) where a woven fabric is obviously stronger than a single thread, the Bottega Weave Design does not provide any advantage of strength over the strips from which it is comprised.

Further, in response to the refusal based on aesthetic functionality, Bottega Veneta noted that the Examiner’s contention that the Bottega Weave Design could not be registered because it was popular among consumers was a notion that had been squarely rejected by a majority of the federal courts, including the Federal Circuit. Indeed, as the leading commentator on trademark law has noted, “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.” *See McCarthy on Trademarks*, § 7.81; Second Office Action.

Rather than address Bottega Veneta’s response to the Second Office Action, the Examiner took another tack, issuing a third Office Action that asked Bottega Veneta to answer twelve questions in order to “clarify” Bottega Veneta’s application. *See Third Office Action*. Bottega Veneta responded to each of

the Examiner's questions, and also submitted additional evidence on the issue of utilitarian functionality, namely, an additional declaration from Ms. Scaglia, as well as a declaration from Gianluigi Calvanese, the Scientific Director at the Italian Public Institute for Research and Testing on Leather and Tanning Materials ("SSIP"), who both conducted additional testing showing that the Bottega Weave Design provided no utilitarian advantage of strength over whole leather or the strips of leather that make up the Bottega Weave Design. *See* Scaglia Decl. (II), ¶¶ 5-8; Scaglia Decl. (III), ¶ 4; Calvanese Decl. (III), ¶ 7, Ex. A. In addition, as it had in each of its prior Office Action responses, Bottega Veneta provided additional evidence of acquired distinctiveness, including, among other things, declarations from the Presidents of Bergdorf Goodman and Saks Fifth Avenue — two of the most important luxury goods retailers in the world — attesting to the association between the Bottega Weave Design and Bottega Veneta in the public mind. *Id.*

Thereafter, apparently abandoning his position on utilitarian functionality (notably, without addressing the evidence submitted by Bottega Veneta on the issue of utilitarian functionality, *i.e.*, strength), the Examiner issued a fourth and final Office Action that refused registration solely on the basis of aesthetic functionality, determining that it would be unfair to Bottega Veneta's competitors to remove a popular design from the public domain. Additionally, and again failing to credit, or even address, much of the evidence submitted by Bottega Veneta in support of the fact that the Bottega Weave Design has acquired distinctiveness by virtue of its longstanding use, extensive advertising and promotion, commercial success, and unrefuted evidence of consumer recognition of the Bottega Weave Design as an indicator of source, the Examiner maintained his refusal on the grounds of ornamentality and failure to serve as a trademark. *See* Fourth Office Action. Given that the Examiner did not appear interested in responding to the evidence put in front of him, Bottega Veneta filed the instant appeal.

As shown by his opposition brief, the Examiner is continuing to maintain his aesthetic functionality refusal and also continues to fail to acknowledge Bottega Veneta's overwhelming evidence of acquired distinctiveness, as if Bottega Veneta had submitted none. The Examiner only reaches this conclusion, however, after engaging in a tortured deconstruction of the Bottega Weave Design by

determining that each of the design features that make the Bottega Weave Design unique — its use of leather, its proportions and dimensions, and its orientation as used on products — is irrelevant to the consideration of registrability. At the same time, the Examiner attempts to resuscitate his earlier reliance on utilitarian functionality, all in the guise of an aesthetic functionality argument, repeatedly stating that the Bottega Weave Design provides the utilitarian advantage of strength, based once again on the mistaken and misplaced analogy of woven fabric to Bottega Veneta’s woven leather. As has been amply demonstrated, and has not been refuted on this record, the Bottega Weave Design provides no advantage of strength. Rather, it is a design that was originated by Bottega Veneta to indicate source and which over long years of continual and substantially exclusive use, advertising and promotion, and commercial success, has become an icon in the fashion industry, a design that immediately signals to consumers that products bearing the design come from Bottega Veneta.

While Bottega Veneta appreciates that its rights in the Bottega Weave Design may be relatively narrow, that does not mean that it should be denied all protection. Accordingly, Bottega Veneta requests that Board overturn the Examiner’s grounds for refusal to register the mark and pass the mark for publication.

III. ARGUMENT

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

Ignoring the numerous criticisms and outright rejections of the theory of aesthetic functionality, the Examiner claims that aesthetic functionality is an “established” legal doctrine and that Bottega Veneta “relies on opinions and commentary that are clearly outdated or misinterpreted.” Opp. Br. at 3-4. The commentary relied upon by Bottega Veneta, however, which comes from the leading treatise on issues relating to trademark law, is far from outdated. Rather, Professor McCarthy’s analysis, which has been revised as of May 2010, includes discussion of all cases purported by the Examiner to “establish[] the doctrine” of aesthetic functionality, with the exception of one, and still concludes:

“Aesthetic functionality” is an oxymoron. Ornamental aesthetic designs are the antithesis of utilitarian designs. Even if one accepts the thesis that a “freedom to compete” policy

is at the core of any rule of functionality, that policy does not support the theory of “aesthetic functionality.” As one commentator noted, “Because the range of possible aesthetic designs and configurations is as infinite as are the tastes that desire them, according trademark protection to aesthetic features would not greatly hinder competition.” Freewheeling application of the “aesthetic functionality” theory can only result in more consumer confusion as to the source of products, for “aesthetic functionality” is a potent rule of public policy overriding actual consumer perception and confusion. “Aesthetic functionality” may be a theory in search of a rationale.

McCarthy on Trademarks, § 7.81, quoting Krieger, “*The Broad Sweep of Aesthetic Functionality: A Threat to Trademark Protection of Aesthetic Product Features*,” 51 *Fordham L. Rev.* 345, 380 (1982).

Thus, contrary to the Examiner’s assertion that the U.S. Supreme Court’s passing reference to aesthetic functionality has “precedential value”(Opp. Br. at 4), Professor McCarthy recognizes that the Court’s “confusing *dictum*” in *Traffix* has “only further clouded and obscured the issue of whether aesthetic functionality is in fact to be given any weight.” *McCarthy on Trademarks*, § 7.80. Moreover, Professor McCarthy recognizes that the Federal Circuit’s ruling in *Brunswick Corp. v. British Seagull*, 35 F.3d 1527, 1532 (Fed. Cir. 1994), was not based, as the Examiner claims, on the application of the “doctrine” of aesthetic functionality (Opp. Br. at 4), but rather on the determination that an aesthetic feature, *i.e.*, the color black, without any limit to any specific well-defined shade, provided utilitarian advantages — to make the engines on which the color was used appear smaller and to allow coordination with a wider variety of boat colors. *McCarthy on Trademarks*, § 7.80. Indeed, the Court in *Brunswick* specifically recognized that “the Board specifically distinguished its *de jure* functionality analysis from the doctrine of aesthetic functionality.” *Brunswick*, at 1533.¹

As for *Au-Tomotive Gold v. Volkswagen of Am., Inc.*, 457 F.3d 1062 (9th Cir. 2006), the case hardly stands, as the Examiner claims, for the proposition that that aesthetic functionality is an “established legal doctrine.” Opp. Br. at 5. To the contrary, in *Au-Tomotive Gold*, which involved the

¹ Notably, the decision in *Brunswick* followed an *inter partes* proceeding between Brunswick and a competing outboard motor manufacturer. Thus, the application was not only initially approved by the Trademark Office, but the evidence of record included the showing that “people who buy outboard motors for boats like the colors of the motors to be harmonious with the colors of their vessels, and that they also find it desirable under some circumstances to reduce the perception of the size of the motors in proportion to the boats.” *Id.* at 1529.

alleged infringer's invocation of aesthetic functionality as a defense, the Ninth Circuit recognized that, "Taken to its limits, . . . [aesthetic functionality] would permit a competitor to trade on any mark simply because there is some 'aesthetic' value to the mark that consumers desire. This approach distorts both basic principles of trademark law and the doctrine of functionality in particular." *Id.* at 1064. Further, the Court remarked, "The concept of an 'aesthetic' function that is non-trademark related has enjoyed only limited application. In practice, aesthetic functionality has been limited to product features that serve an aesthetic purpose wholly independent of any source-identifying function." *Id.* at 1073. Here, the aesthetic of the Bottega Weave Design is inextricably intertwined with its source-identifying function.

The one case cited by the Examiner in his discussion of the "establishment" of aesthetic functionality not addressed by Professor McCarthy is *M-5 Steel Mfg., Inc. v. O'Hagin's Inc.*, 61 U.S.P.Q.2d 1086 (T.T.A.B. 2001). In *M-5 Steel*, which was decided following an *inter partes* proceeding, applications to register a series of metal roofing tiles and metal ventilating ducts and vents that mimicked the shapes of roof tiles made and sold by unrelated roof tile manufacturers were successfully opposed on the basis of functionality. *Id.* at 1087-88. Contrary to the Examiner's position, however, the case does not hold that "[i]t is well-established that non-utilitarian aesthetic matter may be refused registration on functionality grounds, provided that 'traditional trademark principles govern the registrability.'" Opp. Br. at 5. Instead, the Board found that while the shapes of the applicant's roof vent designs did not make the vents work better, the roof vents were nonetheless functional because "these configurations blend in or match the roof tiles with which they are used better than alternative products." *M-5 Steel*, at 1097. In other words, just as the color black did in *Brunswick*, the aesthetic features of applicant's designs served a functional purpose by providing a utilitarian advantage that would necessarily hinder competition. Notably, the Board's functionality determination was also supported by applicant's utility patent for the designs at issue, as well as the applicant's promotional literature which touted the functional aspects of the design. *Id.* Here, there is no evidence that the Bottega Weave Design is better than alternative woven leather designs or that it serves any functional purpose.

Nevertheless, even under the Examiner's framework for analyzing aesthetic functionality, it is

clear that the registration of the Bottega Weave Design would not hinder legitimate competition. Indeed, the only way that the Examiner can support his conclusion that the Bottega Weave Design is aesthetically functional is by deconstructing the mark by removing each of the aspects that set it apart from woven leather designs used by others. At the same time, he improperly expands the field of Bottega Veneta's potential competitors, going so far as to say that native craftspeople weaving straw would be threatened by registration of the Bottega Weave Design. This tortured analysis is entirely improper. When properly analyzed, it is clear that registration of the Bottega Weave Design would provide no greater hindrance to competition in the leather goods industry than the registration of any fashion house design mark that has become popular and recognized by consumers.²

1. The Examiner Improperly Expands the Scope of the Applied-For Design

While the Examiner states that “applicant’s assertion that the refusal interprets the proposed mark as woven leather in general is both mistaken and unnecessary,” (Opp. Br. at 5), he nevertheless begins his analysis of aesthetic functionality by improperly expanding the scope of Bottega Veneta’s mark.

First, the Examiner asserts that Bottega Veneta’s rights in a registration for the Bottega Weave Design — which is expressly limited to “the configuration of interlaced *woven strips of leather* forming a repeating weave pattern used over all or substantially all of the goods” — would necessarily impact the rights of manufacturers of woven products utilizing “ribbon, straw, reed, grass, wood, paper, bark, plastics or other strip materials.” Opp. Br. at 6. In support of this position, the Examiner notes that Bottega Veneta, itself, manufactures woven products using non-leather materials and refers to such products as examples of the Bottega Weave Design. Bottega Veneta fails to see how its use of non-leather materials in what has been called, for purposes of these proceedings, the Bottega Weave Design, could serve to expand the scope of protection afforded by the resulting registration of the instant application. Regardless of whether leather is considered “a requisite aspect of the [Bottega Weave

² See *McCarthy on Trademarks*, §7.79 (noting that the hindrance of competition “[a]s a useful test, . . . appears much too broad and generalized, for one could characterize the strongest word mark or logo as a feature that competitors would dearly like to imitate”).

Design] configuration” (Opp. Br. at 6), leather is, as delineated by Bottega Veneta in its application, a requisite aspect of the mark that is the subject of the instant application.

Second, the Examiner narrowly restricts the competitive field of alternative designs to woven leather, finding that solid leather would not be a suitable design alternatives to competitors in the handbags and footwear industries. The Examiner bases this conclusion on a handful of Internet references noting that woven leather is more “breathable” and that it may evoke “a lighter or more relaxed mood associated with Spring and Summer.” Opp. Br. at 6. While these statements may exist, there is no basis to accept them as true. Accordingly, these statements, which are nothing more than statements of opinion concerning the field of fashion where opinions abound and often conflict, should be entitled to very little, if any, probative value on the issue of functionality. *See Safer, Inc. v. OMS Investments, Inc.*, 94 U.S.P.Q.2d 1031, 1040 (T.T.AB. 2010) (documents obtained from the Internet “are admissible only to show what has been printed, not the truth of what has been printed”). Moreover, these statements are contradicted by Bottega Veneta’s own use of the Bottega Weave Design, as Bottega Veneta has sold products bearing the Bottega Weave Design throughout the past 35 years (belying the suggestion that the woven leather is aesthetically functional because it evokes spring or summer) and often uses the Bottega Weave Design on structured handbags without the unstructured look that the Examiner contends “evok[es] a lighter or relaxed mood.” Opp. Br. at 6 .

Third, the Examiner asserts that the Bottega Weave Design is a plain weave, and notes the various advantages typically associated with a plain weave. As Bottega Veneta has previously pointed out, however, the Examiner’s assertion, and in fact, all of the evidence he relies on to support it, is based on the manufacture of fabric, not the weaving of leather. As explained by Stefano Brazzale, Technical Director of Bottega Veneta, a “plain weave” is a style of weaving found in textile manufacture. There is, however, no corresponding style of weaving found in the area of leather goods, as leather, unlike textiles and fabrics, is typically not “woven.” Brazzale Decl. (II), ¶ 13. Stated another way, while every article of apparel consists of woven fabric, of which the “plain weave” is one, there are no such “styles” of weaving in leather goods manufacturing, and, therefore, by allowing the Bottega Weave Design to proceed to

registration, the Trademark Office would not be removing any known “style” of weaving from the manufacture of handbags, footwear, or other leather accessories from the public domain. *See* Third Office Action Response.

Indeed, as Bottega Veneta has indicated, it is atypical for a leather good to consist of a “weave” design because the weave offers no utilitarian benefits, as is the case in fabrics and textiles. To the contrary, in the leather goods arena, the use of a weave design is unexpected, and is, initially, nothing other than ornamental. Therefore, while the Bottega Weave Design, were it used in fabric or textile manufacture, technically fits within the Wikipedia definition of a “plain weave” in that the “warp and weft are aligned so they form a simple criss-cross pattern,” that does not constitute the Bottega Weave Design a “plain weave.” Put simply, the analogy of woven fabric, and all of the attendant advantages that weaving may bring to fabric, do not apply to the woven leather design that is the subject of Bottega Veneta’s application.³

Accordingly, it is one thing for a weave design to be categorized within the broad definition of a “plain weave,” but another thing to be denied trademark protection on that basis. Many different weave designs theoretically fit within the technical definition of a “plain weave,” but that does not mean they are identical in appearance. In other words, there are a virtually unlimited number of ways a weave design could appear on leather goods. The Bottega Weave Design, consisting of the threading of thin leather strips, oriented at a 45 degree angle to the surface of the product, and resulting in woven leather squares measuring either 9 mm by 12 mm or 8 mm by 10 mm, is just one such way. Other designs could appear in different sizes, in different proportions, at different angles, and in different orientations. Indeed, just as a company may adopt a single letter design or an image of a common object as its trademark, it is the

³ Moreover, Bottega Veneta has established on this record that even if you accept the Examiner’s contention that woven fabric is stronger than the sum of its parts, *i.e.*, thread, the enhancement of strength through weaving does not carry over to leather goods. As noted above, during the course of this proceeding, independent laboratory testing has confirmed not only that the Bottega Weave Design provides no advantage of strength over whole leather, but also that the Bottega Weave Design provides no advantage of strength over the leather strips from which it is comprised. *See* Scaglia Decl. (II), ¶¶ 5-8; Scaglia Decl. (III), ¶ 4; Calvanese Decl. (III), ¶ 7, Ex. A. Thus, unlike woven fabric, the Bottega Weave Design is simply not stronger than the sum of its parts.

manner in which the company presents or stylizes that letter or object that makes it protectable as a trademark. *See, e.g., Star Indus., Inc. v. Bacardi & Co. Ltd.*, 412 F.3d 373, 383 (2d Cir. 2006) (although “basic” shapes and designs are not protectable, stylized versions of those designs are not “basic,” and are protectable when original within the relevant market).

As it happens, the appearance of the Bottega Weave Design was unique to the leather goods industry when conceived in 1975, and over many years of consistent and exclusive use, has come to identify Bottega Veneta as the single source of leather goods to which it is applied. It is not Bottega Veneta’s intention, by registering the Bottega Weave Design, to exclude all others from using any and all weave designs in connection with leather goods that meet the technical definition of a “plain weave”, rather, it is Bottega Veneta’s intention to prevent others from using designs that are so close to the Bottega Weave Design that they are confusingly similar thereto, that is, designs that cause consumers to believe the product comes from Bottega Veneta.

Fourth, and finally, the Examiner ascribes functional advantages to the fact that the leather strips comprising the Bottega Weave Design are typically oriented in a 45-degree angle to the surface on which the product rests. Once again, however, the Examiner relies on concepts that are applicable to the manufacture of fabric and do not have any generally accepted application to woven leather goods. Specifically, the Examiner points to definitions found on the Internet for the terms “bias” and “drape.” Opp. Br. at 7-8. Notably, these definitions are themselves specifically limited to the use of thread and fabric, *e.g.*, “Bias: Not a political slant , but a diagonal to the way the *thread* is woven in the *fabric*” and “Drape: One of those blurry terms. It really means how the *fabric* hangs in folds. A *fabric* that drapes well will hang in nice, even folds with no peaks or points.” *See* Fourth Office Action at 569 [emphasis added]. Without any support, the Examiner applies these terms to Bottega Veneta’s use on its products bearing the Bottega Weave Design to conclude that the “the casual but controlled inward slouch and “V” shape folds present in such unstructured designs are plainly guided by the bias grain of the weave.” Opp. Br. at 8. Again, there simply is no basis for the application of these concepts to the Bottega Weave Design and completely ignores the fact that the concept of “drape” would nevertheless

have no application to Bottega Veneta's footwear or structured handbags.

Accordingly, while the Examiner states that the purported expansion of the Bottega Weave Design to cover all woven leather in general is both mistaken and unnecessary, he nevertheless arrives at his "competitive disadvantage" analysis having erroneously and improperly stripped the Bottega Weave Design of all the aspects that set it apart from the designs of its competitors.

2. Registration of the Bottega Weave Design Would Not Improperly Hinder Competition

Having stripped the Bottega Weave Design of nearly every design element that makes it unique, and now resurrecting his claim that the Bottega Weave Design serves utilitarian functions, the Examiner, not surprisingly, concludes that registration of the Bottega Weave Design would serve to hinder competition. Before doing so, however, the Examiner further disregards the evidence of record that the Bottega Weave Design uses specific measurements to achieve a unique and uniform look across its various product categories. In fact, in response to the Examiner's direct inquiry regarding the measurements of the Bottega Weave Design, Bottega Veneta stated that the length and width of the woven squares in the Bottega Weave Design are 9 mm by 12 mm for handbags, and 8 mm by 10 mm for all other small leather goods. As explained by Michele Taddei, one of the founders of Bottega Veneta, these dimensions were chosen for purely aesthetic reasons — to create a striking woven pattern for leather goods that was never used in commerce before. *See* Taddei Decl. (III), ¶¶ 2, 3.

The Examiner discounts this evidence by claiming, without explanation, that the "designation of a particular size element would only highlight the functional nature of the proposed mark." Opp. Br. at 9. While the Examiner claims to "deduce" the reasons why Bottega Veneta selected these particular dimensions for the Bottega Weave Design, these deductions are no more than rank speculation. *Id.* There is nothing in the record that refutes Bottega Veneta's clear evidence that the particular dimensions of the Bottega Weave Design were selected for aesthetic purposes. *See* Taddei Decl. (III), ¶¶ 2, 3.⁴

⁴ For example, the Examiner's suggestion that Bottega Veneta's use of smaller dimensions on small leather goods is simply because use of the larger dimension "would create aesthetic challenges for smaller
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Thus, the consideration of competitive advantage should not be limited to “whether the 45-degree angle of an otherwise functional weave is sufficient to render it registrable as a trademark.” Opp. Br. at 9. Framing the inquiry in this manner, *i.e.*, engaging in a competitive advantage analysis of a design already deemed to be functional from a utilitarian standpoint, predetermines the result. The proper inquiry should be whether the Bottega Weave Design that Bottega Veneta actually uses — a design mark consisting of leather strips threaded together and placed at a 45-degree angle to the surface on which the product rests, resulting in a weave design consisting of woven squares that are either 9 millimeters by 12 millimeters (when used on handbags), or 8 millimeters by 10 millimeters (when used on footwear and smaller leather goods) — hinders competition. In other words, the Examiner should have examined whether the Bottega Weave Design “is the best, or at least one of a few superior designs for its purpose.” *Brunswick*, 35 F.3d at 1531, *citing In re Bose Corp.*, 227 U.S.P.Q. 1, 6 (Fed. Cir. 1985).

The Examiner fails to undertake the proper inquiry, however, but rather predetermines that the Bottega Weave Design is no more than a “classic fashion motif”, no different than a simple shape or color. Opp. Br. at 9. In support of this conclusion, the Examiner relies on *Jay Franco & Sons, Inc. v. Franek*, 615 F.3d 855, 96 U.S.P.Q.2d 1404 (7th Cir. 2010). In *Jay Franco*, however, the Court of Appeals recognized that plaintiff was seeking to enforce rights in a simple geometric circle. *Id.* at 860. Moreover, as the Court found that because “there are only so many geometric shapes,” it would be unfair to take the circle shape away from competitors. *Id.* Here, however, the options available to designers of woven leather products are not so limited. Rather, the record shows that there are numerous alternative woven leather designs available for use that look nothing like the Bottega Weave Design.

Moreover, while the Examiner contends that he “has made of record ample evidence of widespread third-party use of the same configuration throughout and prior to applicant’s own period of use” (Opp. Br. at 10), there is no evidence which refutes Bottega Veneta’s claim that it created the

Footnote continued from previous page
items and may render use for certain products impractical or less appealing,” (Opp. Br. at 9), is belied by the fact that the difference in dimensions between the two sizes is at most 2 millimeters. *Id.*

Bottega Weave Design in 1975 and that at the time, this design was unknown in the leather accessories industry. At most, the Examiner has collected from the Internet a number of examples of woven leather products — many of which create commercial impressions vastly different from the Bottega Weave Design — that are of indeterminate age and questionable evidentiary value. While some of the sellers of these products claim the products are “vintage,” that is not supported by a plain reading of the Examiner’s attachments. The most that can be said about the various claims of “vintage” is that they merely indicate that a product is used or second-hand. *See* Fourth Office Action, Ex. A. Simply put, there is no conclusive proof as to the “vintage” of any of the products relied on by the Examiner, much less that any of the products predate the Bottega Weave Design. *See Safer*, 94 U.S.P.Q.2d at 1040 (documents obtained from the Internet “are admissible only to show what has been printed, not the truth of what has been printed”).

In contrast, statements made by consumers on the Internet drawing comparisons between these third-party woven leather products and the Bottega Weave Design show, at a minimum, that consumers associate woven leather that looks like this with Bottega Veneta. Bottega Veneta does not assert, however, that merely because comparisons are made to its famous, source-indicating design, that such comparisons are true or that infringement has actually occurred. Accordingly, Bottega Veneta does not “regard[] comparison of third party goods to its own as evidence of infringing similarity” (Opp. Br. at 11), but rather as evidence of the association in the public mind of woven leather and Bottega Veneta.⁵

Moreover, the Examiner’s reference to the purported “competitive need to coordinate patterns” should be seen more as an attempt to remake the facts of the case in the mold of those relied on in *Deere & Co. v. Farmhand, Inc.*, 560 F. Supp. 85, 217 U.S.P.Q. 252 (S.D. Iowa), *aff’d*, 721 F.2d 253 (8th Cir. 1983), when in fact there is no such evidence in this case. In *Deere*, the Court “found that protection of John Deere green and the features that are common to [plaintiff’s and defendant’s farm loader] products

⁵ While the Examiner points to certain instances where consumers are drawing comparisons between the Bottega Weave Design and examples of third-party woven leather products that are not presented in a 45-degree angle (*see* Fourth Office Action at 670, 675, 701, 716; Ex. K at 850), Bottega Veneta does not contend that such examples are infringements of the Bottega Weave Design.

would hinder [defendant] in competition.” *Id.* at 98. This holding, however, was premised upon the evidence that John Deere not only knew that farmers “much prefer” to have their farm loaders painted the same color as their tractors, but also that John Deere knew that it would gain a competitive advantage over defendant if it could prevent defendant from using John Deere green. *Id.* at 91. There simply is no such evidence of competitive advantage here — in fact, the only evidence supplied by the Examiner on this point is an Internet posting suggesting that individuals should try to match their shoes and belts (*see* Fourth Office Action, Ex. I) — nor has there been any admission by Bottega Veneta that it would gain a competitive advantage if the Bottega Weave Design were registered.⁶

Indeed, much of the Examiner’s opposition brief seems to be premised on the notion that once Bottega Veneta has its registration in hand, it will commence suing one party after another — from native basket weavers working with grasses, reeds or wood strips, to shoe designers whose woven leather products may “inadvertently” infringe the Bottega Weave Design due the placement of the woven leather design on a curved surface — without regard to the limitations of its registered mark or the actual commercial impressions created by the purported infringers. Again, Bottega Veneta does not seek the boundless rights ascribed to the application by the Examiner. Rather, it seeks to register a mark consisting of leather strips of specific dimensions and placed in a specific orientation. The strips of leather woven in these dimensions and in this specific orientation results in a unique design that has come to indicate source. 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), and has never taken the position that every example of woven leather in the history of the fashion industry is an infringement of the Bottega Weave Design.

⁶ Further, certain of the examples cited by the Examiner simply make no sense, as not even the Internet postings put forward by the Examiner state that consumers seek to coordinate their leather fashion accessories with domestic products like pillows. *See* Fourth Office Action, Ex. I.

B. The Bottega Weave Design Should Not Be Refused Registration Under a “Traditional” Functionality Analysis

The Examiner’s reliance on aesthetic functionality as a basis to refuse registration is itself a tacit admission that the Bottega Weave Design is not functional under the traditional *Morton-Norwich* test for functionality. *See Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 32 (2001) (“Where the design is functional under the *Inwood* formulation there is no need to proceed further to consider if there is a competitive necessity for the feature.”). Nevertheless, the Examiner, as noted above, makes repeated reference in the Opposition Brief to purported utilitarian advantages offered by the Bottega Weave Design, in the guise of supporting his aesthetic functionality refusal.⁷ Bottega Veneta wishes to clarify that its design cannot be refused registration under the traditional *Morton-Norwich* test for functionality. As Bottega Veneta demonstrated during the examination of its application, the evidence of record makes clear that the Bottega Weave Design is not “essential to the use or purpose of a product . . . [nor does] it affect[] the cost or quality of a product.” *See Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 850 (1982).

Bottega Veneta submits that applying the four factors that bear on the functionality issue, as set out in *Morton-Norwich*, demonstrates that the Bottega Weave Design is not dictated by utilitarian purposes, 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. In fact, in the Opposition Brief, the Examiner recognizes that “[a] functionality analysis limited to the traditional ‘*Morton-Norwich* factors’ is inadequate in this instance because such an inquiry is designed to expose utilitarian advantages.” Opp. Br. at 3, citing *Morton-Norwich*. “[T]he 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:

⁷ As noted above, throughout the examination the Examiner has alternatively stated that the Bottega Weave Design was not registrable on the ground of utilitarian functionality and/or aesthetic functionality. While it appeared that he ultimately based his final refusal on aesthetic functionality (*see* Fourth Office Action), there are suggestions in his Opposition Brief that he believes that “issues of utilitarian advantage are not wholly irrelevant.” Opp. Br. at 3.

1. The existence of a utility patent which discloses the utilitarian advantages of the design is evidence of “functionality”;
2. 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;
3. The existence of other alternative designs which perform the utility function equally well; and
4. Whether or not the design results from a comparatively simple, cheap or superior method of manufacturing the article.

See McCarthy on Trademarks, § 7:73, citing *Morton-Norwich*, 671 F.2d at 1340-41.

Application of these four criteria leads to the conclusion that the Bottega Weave Design is not functional, nor dictated by utilitarian purposes, but rather is a design that has consistently been used by Bottega Veneta to identify itself as the manufacturer of the goods to the consuming public.

1. The Bottega Weave Design Is Not the Subject of Any Utility Patent

As noted above, the existence of a utility patent that discloses the utilitarian advantages of the design sought to be registered is evidence of functionality. *Morton-Norwich*, 671 F.2d at 1340-41. Indeed, during the course of these proceedings, the Examiner asked Bottega Veneta to disclose whether the Bottega Weave Design is, or has been, the subject of either a design or utility patent. In response, Bottega Veneta stated that the Bottega Veneta Weave Design is not, and has never been, the subject of a utility patent. *See Volpi Decl. (I)*, ¶ 14.

The Bottega Weave Design is, however, one of the design elements included in two design patents that have issued in the U.S. for Bottega Veneta handbags. *See First Office Action Response*, Ex. 12. Moreover, the Bottega Veneta Weave Design has been included as a design element in the numerous design patents that Bottega Veneta has registered in the European Community and Japan. *Id.*, ¶15, Ex. 11. As design patents by definition protect ornamental and nonfunctional features, this factor weighs against a finding of functionality. *See* TMEP §1202.02(a)(v)(A); *McCarthy on Trademarks* § 7.93 (“A design patent rather than detracting from a claim of nonfunctional trade dress or trademark, may support such a claim. Since a design patent is granted only for nonfunctional designs, it may be presumptive

evidence of nonfunctionality and thus support the trademark claimant.”).

2. Bottega Veneta’s Advertising Does Not Tout Utilitarian Advantages

Next, the existence of advertising touting the utilitarian aspects of a design at issue is considered evidence of functionality. TMEP §1202.02(a)(v)(B). As the evidence of record shows, Bottega Veneta’s advertising does not tout the utilitarian aspects of the Bottega Weave Design. For more than thirty-five years, Bottega Veneta’s catalogues and advertisements have featured the Bottega Weave Design as its signature trademark, not touting the functional characteristics of the goods, but rather always focusing on the unique look of the Bottega Weave Design. *See* First Office Action Response, Ex. 5 (catalogues and advertisements, including ads published in *Vogue* and *Women’s Wear Daily* dating back to 1981). Not one of the catalogues or advertisements mention the products as having enhanced strength or other utilitarian advantages.

Indeed, during the course of these proceedings, Bottega Veneta has gone to painstaking lengths to demonstrate that there simply are no utilitarian advantages inherent in the Bottega Weave Design. In response to the Examiner’s contention that the Bottega Weave Design offers the “inherent utilitarian . . . functional benefit[] of strength,” Bottega Veneta submitted samples of the Bottega Weave Design to the independent National Union of Leather Industry in Milan (“NULI”) and the Italian Public Institute for Research and Testing on Leather and Tanning Materials (“SSIP”), which is under the control of the Italian Ministry of Productive Activities, to conduct independent tests to determine whether the Bottega Weave Design adds strength and resistance capabilities to Bottega Veneta’s leather goods. The results of these tests conclusively showed that the Bottega Weave Design does not offer any functional benefit to Bottega Veneta’s products in terms of increased strength. Rather, the Bottega Weave Design, with its use of thin leather strips, was shown to be more delicate and more likely to tear than a single whole piece of leather. *See* Scaglia Decl. (II), ¶¶ 5-8; Scaglia Decl. (III), ¶ 4; Calvanese Decl. (III), ¶ 7, Ex. A.

3. Other Alternative Designs Exist that Perform the Utility Function Equally Well

With respect to the third factor to be considered in the functionality analysis — the existence of

alternative designs — it is clear that such alternative designs exist. Indeed, for a finding of functionality, the evidence needs to indicate that the configuration provides specific utilitarian advantages that make it one of few superior designs available. Moreover, an applicant can successfully rebut a claim of functionality by presenting evidence of alternative designs demonstrating that there is no “competitive need” in the industry for the applicant’s design. TMEP §1202.02(a)(iii)(A).

Here, the Bottega Weave Design does not provide specific utilitarian advantages that make it one of few superior designs available, nor is Bottega Veneta seeking to secure a right with respect to woven leather generally, but rather only in the specific look achieved by the Bottega Weave Design. Again, Bottega Veneta is seeking to register a design mark consisting of leather strips threaded together and placed at a 45-degree angle to the surface on which the product rests, resulting in a weave design consisting of woven squares that are either 9 millimeters by 12 millimeters (when used on handbags) or 8 millimeters by 10 millimeters (when used on footwear and smaller leather goods), and forming the Bottega Weave Design. The use of these particular materials, in this specific orientation, and in these specific measurements, results in a unique design that when used by Bottega Veneta across its product lines, immediately serves to indicate to consumers that Bottega Veneta is the source of the product.

Even accepting the Examiner’s limitation of alternative designs to woven leather designs, the evidence of record is replete with examples of woven leather products from numerous other manufacturers and designers that create very different commercial impressions than the impression created by the Bottega Weave Design. *See* Brazzale Decl. (I), ¶13; Volpi Decl. (I), ¶13; First Office Action Response, Ex. 9.

4. The Bottega Weave Design Does Not Result From a Comparatively Simple, Cheap or Superior Method of Manufacturing

Finally, evidence that “a design results from a comparatively simple or inexpensive method of manufacture will support a finding that the design is functional.” TMEP 1202.02(a)(v)(D); *Inwood Laboratories, Inc.*, 456 U.S. at 850 (a product feature is functional if it essential to the use or purpose of the product or if it affects the cost or quality of the product). There is no such evidence here. To the

contrary, the evidence shows that Bottega Veneta's method of manufacture is extremely time consuming.

Indeed, in order to maintain the Bottega Veneta identity, each product featuring the Bottega Weave Design is woven by hand using fine strips of leather of varying lengths, tanned and cut using unique methods developed and perfected by Bottega Veneta's artisans through the years. Brazzale Decl. (I), ¶7. Every day at least 200 skilled artisans dedicate themselves to the weaving of Bottega Veneta's weave design, and, on average, an artisan will weave, in an hour, enough of the unique Bottega Weave Design to incorporate into the design one side of a medium-sized bag. *Id.*, ¶9. Accordingly, Bottega Veneta's use of the Bottega Weave Design makes products more difficult to make and more expensive to manufacture, as it is done by hand, which results in limited production. *Id.*

C. The Bottega Weave Design Is Not Purely Ornamental

While the Examiner continues to assert that the Bottega Weave Design is purely ornamental, it is obvious, based on the evidence of record that the Bottega Weave Design is not only recognized as an indicator of source, but that it is uniquely associated in the public mind with Bottega Veneta. Moreover, the Examiner's contention that Bottega Veneta Weave "is ornamental because it comprises the pattern of the material from which [Bottega Veneta]'s goods are made in whole or in part," is based on no more than the Examiner's unsupported view that the Bottega Weave Design "presents the commonplace appearance of the simplest form of woven leather." Opp. Br. at 15. Again, the Examiner's determination ignores all of the design elements — size, proportion, and orientation — that set the Bottega Weave Design apart and make it recognizable by consumers.

Further, contrary to the Examiner's position, a design that covers the entire surface can still serve as an indicator of source. *See 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.

D. Bottega Veneta Has Submitted Sufficient Evidence of Secondary Meaning to Overcome the Examiner’s Refusals Based on Ornamentality and Non-Distinctive Product Feature

Despite the overwhelming evidence of record demonstrating that Bottega Weave Design has acquired distinctiveness as a single source indicator, the Examiner continues to maintain, without explanation, that Bottega Veneta has failed to make such a showing. Specifically, the Examiner contends that Bottega Veneta’s evidence “merely confirms the unquestioned fact that the purported mark is in use . . . [but] does not demonstrate that consumers necessarily regard applicant as the sole source for bags and shoes made from the woven configuration.” Opp. Br. at 17. The Examiner’s assertion, however, completely ignores the vast evidence of record demonstrating that internationally-renowned publications such as *The New York Times*, the daily required reading of the fashion industry, *Women’s Wear Daily*, and numerous other news, fashion and lifestyle magazines, have all specifically recognized what the Examiner claims Bottega Veneta has failed to show — that the Bottega Weave Design is uniquely associated with Bottega Veneta. See First Office Action Response, Ex. 6, 8; Volpi Decl. (I), ¶ 9-11; Volpi Decl. (II), ¶ 14, 17, Ex. 4; Volpi Decl. (III), ¶ 15, 17, Ex. I, K.

Moreover, as discussed above, the numerous examples of references on the Internet drawing comparisons between various third-party woven leather products and Bottega Veneta’s use of the Bottega Weave Design further demonstrates that the association between the Bottega Weave Design and Bottega Veneta is firmly entrenched in the public mind. The Examiner’s contention that Bottega Veneta “fails to consider that such comparisons may refer to overall product design and not just to a use of plain woven leather,” is simply not supported by the record.

Finally, the Examiner does nothing to counter, and indeed, ignores the numerous affidavits submitted on behalf of Bottega Veneta from noted industry experts, designers, and retailers. 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 individuals 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.⁸ 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

⁸ *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 ¶ 9.⁹

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)*.

None of this evidence has been addressed by the Examiner and accordingly unequivocally supports Bottega Veneta's contention that the Bottega Weave Design has achieved secondary meaning through acquired distinctiveness.

⁹ 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)*.

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