

**UNITED STATES PATENT AND TRADEMARK OFFICE**  
**Trademark Trial and Appeal Board**  
P.O. Box 1451  
Alexandria, VA 22313-1451

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In re Bottega Veneta  
International S.a.r.l.

Serial No. 77219184

Filed: June 29, 2007

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**By the Trademark Trial and Appeal Board:**

This appeal has been fully briefed, and an oral hearing was held on October 4, 2011. It is noted that the description of the mark at issue is:

The mark consists of the configuration of interlaced woven strips of leather forming a repeating weave pattern used over all or substantially all of the goods.

However, upon review of the papers filed by applicant and the examining attorney, it appears that the description of the mark is far more expansive than is the mark that applicant actually wishes to register. For example, in the response filed by applicant on October 6, 2009, applicant states:

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 weave design consisting of woven squares that are either 9 millimeters by 12 millimeters or 8 millimeters by 10 millimeters, and forming the Bottega Weave Design.

Applicant has further explained that the dimensions recited above refer to the length and width of the woven squares in the design, with the 9mm by 12mm dimensions used for

handbags and the 8mm by 10 mm dimensions used for all other small leather goods.

This information was provided in response to questions the examining attorney had raised in the April 4, 2009 Office action, inquiries the examining attorney stated were "required to clarify the intended parameters of the proposed mark." Brief, unnumbered p. 3. The examining attorney has summarized the mark as combining the following characteristics:

1. The configuration is composed of uniform woven leather strips.
2. The leather strips are arranged perpendicularly in a plain (or basket) weave manner.
3. The plain woven leather fabric is oriented so that the strips appear at a 45-degree angle.
4. The resulting configuration forms the surface of footwear, handbags and other fashion goods.

It is obviously important for our determination of the issues involved in this case, and particularly the issue of whether the mark has acquired distinctiveness, that we know precisely what the mark is that applicant seeks to register. It is also important that, should applicant obtain a registration, competitors should know exactly what the mark is for which applicant will have exclusive rights. The examining attorney has recognized the need for clarity in the description of the mark, noting in the April 4, 2009 Office action that even a subtle distinction in the description, involving the presence or absence of the words "the configuration of," could be important, such that he required an amendment of the description to provide such clarification.

In these circumstances, we think it appropriate to remand the application to the examining attorney to consider whether an amendment should be made to the description of the mark to provide more details as to the actual mark which applicant uses and for which registration is sought, in accordance with the representations regarding the mark, referenced above, that have been made by applicant and the examining attorney.<sup>1</sup> Accordingly, proceedings in the appeal

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<sup>1</sup> For example, based on the language quoted above from applicant's response and the examining attorney's brief, the description might be: The mark consists of a configuration of uniform slim interlaced woven strips of leather placed at a 45-degree angle to the surface of the product, resulting in a plain or basket weave design consisting of woven squares that are

are suspended, and the application is remanded to the examining attorney.

Within thirty days, if the examining attorney thinks it appropriate, he should issue an Office action requiring a more detailed description of the mark. If he believes it will advance prosecution, he is encouraged to contact applicant by telephone to discuss the description and, if possible, resolve the question by an examiner's amendment. If applicant does not comply with the requirement for an amended description of the mark, the examining attorney is reminded that a final refusal cannot issue until applicant has had an opportunity to respond. If a final refusal ultimately issues on the requirement for a more definite description of the mark, the file should be returned to the Board, which will then take appropriate action with respect to the appeal.

If the examining attorney believes that no amendment to the description is required, he should, within thirty days, issue an Office action to this effect and return the file to the Board, which will then proceed with a decision on the appeal.

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either 9 millimeters by 12 millimeters or 8 millimeters by 10 millimeters, depending on the article on which it is applied, and forming a repeating weave pattern used over all or substantially all of the goods.