

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Hearing:
October 4, 2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

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

Serial No. 77219184

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Bottega Veneta International S.a.r.l.

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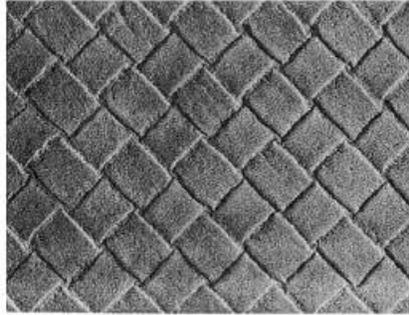
Before Seeherman, Grendel and Wellington, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Bottega Veneta International S.a.r.l. has appealed
from the final refusal of the examining attorney to
register the design shown below, for the following goods:

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 (Class 18) and

shoes (Class 25).¹



The current description of the mark is:

The mark consists of a configuration of slim, uniformly-sized strips of leather, ranging from 8 to 12 millimeters in width, interlaced to form a repeating plain or basket weave pattern placed at a 45-degree angle over all or substantially all of the goods.²

Color is not claimed as a feature of the mark, and registration is sought pursuant to Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).

Registration has been refused under Trademark Act Section 2(e)(5), 15 U.S.C. § 1052(e)(5), on the ground that

¹ Application Serial No. 77219184, filed June 29, 2007, pursuant to Section 44(e) of the Trademark Act, based on an Italian registration.

² After oral argument, the application was remanded to the examining attorney because the then-description of the mark ("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") appeared to be more expansive than the mark that applicant wishes to register. On September 10, 2012, the description of the mark was amended by examiner's amendment. Neither applicant nor the examining attorney requested additional briefing after the amendment was entered.

the proposed mark is functional, and pursuant to Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§ 1051, 1052 and 1145, on the ground that the applied-for design does not function as a trademark because it is solely ornamental.

The appeal has been fully briefed, and an oral hearing was held.³

The examining attorney's refusal on the ground that the mark is functional is based on both the concepts of utilitarian and aesthetic functionality. As the examining attorney explained in the final Office action, mailed November 24, 2009:

³ During the oral hearing the Board noted that both applicant's and the examining attorney's briefs exceeded the 25-page limit set by Trademark Rule 2.142(b)(2). Although the last page of applicant's brief was numbered "25," applicant did not take into account the title page of its brief in the number of pages submitted. Because a title page is not required, and because, at the time, it appeared that the examining attorney's brief had also exceeded the page limit, the Board allowed both applicant and the examining attorney to file revised briefs complying with the page limitation. Applicant did so on October 13, 2011. As for the examining attorney's brief, although the Patent and Trademark Office's TTABVUE database indicates that the brief is 28 pages, the Board was subsequently advised that this number of pages resulted from a computer issue that is particular to the transfer of documents from the Trademark Examining Operation's electronic processing system to the Board's TTABVUE system. Specifically, pages created in the Examining Operation's word processing application, when uploaded into the TTABVUE database, are rendered into an image-based document and different pagination can result. The brief as written was in compliance with the rules. See *In re Sela Products, LLC*, __USPQ2d__, Serial No. 77629624 (TTAB March 26, 2013). Accordingly, we have accepted the examining attorney's brief. We will refer to the brief pages with the pagination that appears in TTABVUE.

The examiner previously addressed the proposed configuration mark from viewpoints of both utilitarian and aesthetic functionality. This manner of review did not represent separate refusals but merely alternate avenues for assessing the registrability of the proposed mark under Trademark Act Sec. 2(e)(5). The proposed mark in fact raises issues of both utilitarian and aesthetic nature. On balance, however, the central question posed is one of aesthetic functionality.

At TTABVUE page 3 of his brief, the examining attorney explains that, although the initial Office action addressed potential utilitarian advantages in strength offered by the weave configuration, "subsequent review exposed a more significant competitive advantage in the aesthetic strength of the weave as a versatile, enduring and widely-used fashion motif." Id. Further, the examining attorney has explained 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." Brief, TTABVUE p. 5.⁴ In fact, the traditional "utilitarian functionality" analysis was apparently so inadequate that the examining attorney did not even discuss the Morton-Norwich factors in his brief, noting that "the final refusal of registration under Sec.

⁴ The factors set forth in *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 USPQ 9 (CCPA 1982), have been followed by the Board and our primary reviewing court, the Court of Appeals for the Federal Circuit, in determining the issue of utilitarian functionality.

2(e)(5) is made under a rubric of aesthetic functionality focusing on the potential for significant non-reputation-related disadvantage to competitors." Id. Although at oral argument the examining attorney stated that he had not withdrawn the "utilitarian" refusal, given his acknowledgement that this analysis would not be applicable, we see no reason to engage in a traditional utilitarian functionality analysis. We merely note, in passing, that applicant's responses regarding the Morton-Norwich factors, and in particular, evidence submitted by applicant that its weave design does not add strength to the product, and does not result from a less expensive method of manufacture, apparently satisfied the examining attorney's objection that the mark confers a utilitarian advantage.⁵

We therefore turn to the refusal that applicant's mark is aesthetically functional. The doctrine of aesthetic

⁵ For example, the declaration of Stefano Brazzale, applicant's Technical Director, submitted with applicant's response filed January 13, 2009, states that "any weaving technique, when applied to leather, does not add strength to the products," but "results in the products being more delicate than those made with a single piece or portion of leather, because each thin strip of leather used to create the weave may tear or ruin more easily than the single piece of leather." Elisabetta Scaglia, the lead auditor and leather goods consultant at the National Union of Leather Industry in Milan, Italy, also provided a declaration that was submitted on January 13, 2009. She stated that she tested various pieces of leather, including whole leather and a leather sample from applicant, to determine their strength and resistance capabilities, and found that applicant's product made of woven leather is not as durable as one made from whole leather.

functionality has had many incarnations, and there has been significant criticism of some decisions that were based on the general concept of aesthetic functionality. However, the examining attorney has specifically rejected "a discredited theory which wrongly denies trademark protection to matter merely because it is visually appealing, popular or commercial[ly] successful." Brief, TTABVUE p. 6. Instead, he has approached aesthetic functionality under the rubric of competitive advantage, as discussed in *TrafFix Devices Inc. v. Marketing Displays Inc.*, 532 U.S. 23, 58 USPQ2d 1001 (2001).

The Board has recently discussed at some length the law concerning aesthetic functionality in *In re Florists' Transworld Delivery, Inc.*, 106 USPQ2d 1784 (TTAB 2013), so we need not repeat that analysis here. Suffice it to say that a mark will be deemed aesthetically functional, and therefore prohibited from registration by Section 2(e)(5) of the Trademark Act, if the exclusive appropriation of that feature would put competitors at a significant non-reputation related disadvantage. Therefore, we must consider whether registering the instant mark would have a significant effect on competition, i.e., whether there is a competitive need for others to use the particular weave design that is the subject of this application.

As a preliminary point, we set forth some excerpts from the entry for "plain weave" in Wikipedia, submitted by the examining attorney with the September 3, 2007 Office action:

In plain weave the warp and weft are aligned so that they form a simple criss-cross pattern. Each weft thread crosses the warp threads by going over one, then under the next, and so on. The next weft thread goes under the warp threads that its neighbor went over, and vice versa. Plain weave is also known as "tabby weave" or "taffeta weave."

A balanced plain weave can be identified by its checkerboard-like appearance. It is also known as one-up-one-down weave or over and under pattern. Some examples of fabric with plain weave are chiffon, organza, and taffeta.⁶

In order to show a competitive need for the applied-for weave design, the examining attorney has made of record over 1500 pages of evidence, consisting primarily of advertisements from third-party websites depicting items having weave designs. The bulk of this evidence relates to the use of weave designs on handbags and shoes. We therefore concentrate our analysis on whether there is a competitive need for the applied-for weave design for such

⁶ Applicant has asserted that "plain weave" is a concept that is applicable to fabric, not leather. Nonetheless, applicant accepts that "plain weave" describes the manner in which the leather strips are used to form its weave design. We further note that the recently amended description of the mark states that the leather strips form a "plain or basket weave pattern."

goods. If the examining attorney shows a competitive need for the use of the proposed mark for handbags, that would be sufficient for us to affirm the refusal of registration on the basis of functionality with respect to the application in Class 18; that is, the examining attorney is not required to show competitive need for the use of the proposed mark for each of the items listed in the identification for that class. Cf. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods in the application); *In re Analog Devices Inc.*, 6 USPQ2d 1808, 1810 (TTAB 1988), *aff'd without pub. op.*, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989) (if the mark is descriptive of any of the goods or services for which registration is sought, it is proper to refuse registration as to the entire class); *In re White Jasmine LLC*, 106 USPQ2d 1385, 1391 (TTAB 2013) ("The issue on appeal is whether the mark is deceptive as applied to any of the goods in the application."). Shoes, of course, are the only goods that are identified in the application in Class 25, so if the examining attorney shows a competitive need for the weave

design for shoes, the refusal of the application in that class must be affirmed.

Although the examining attorney submitted an inordinate amount of evidence, much of it is not persuasive because the pictured handbags and shoes display weave patterns in general, rather than the weave design described in the application, i.e., the strips are wider or the design is otherwise different from the "slim, uniformly-sized strips of leather, ranging from 8 to 12 millimeters in width, interlaced to form a repeating plain or basket weave pattern placed at a 45-degree angle over all or substantially all of the goods."⁷

Thus, items which have a "horizontal" weave, or are not made of leather or materials that simulate leather, or have strips that are much wider than 8 to 12 millimeters, or have a weave pattern on only a portion of the product, or have a weave that is not a plain weave, are not persuasive evidence that third parties have a competitive need to use the particular weave design that applicant seeks to register. Applicant is not seeking exclusive rights to all weave designs for the identified leather goods. As applicant has stated, "other designs could

appear in different sizes, at different angles, and in different orientations." Response filed October 6, 2009, p. 10 (TSDR p. 11).⁸

Similarly, some of the arguments made by the examining attorney apply to the competitive need for a weave design in general, but not for the specific weave design for which registration is sought. For example, the examining attorney has argued that woven leather is "particularly suited for some fashion purposes, such as evoking a lighter or more relaxed mood associated with Spring and Summer wardrobes." Brief, TTABVUE p. 9. However, if applicant were to obtain a registration for its particular mark, this would not deprive competitors from using a woven leather design for their goods. They would be deprived only of the right to an identical or nearly identical design comprising the elements listed in the description of applicant's mark, namely, a repeating plain or basket weave pattern, created from uniformly-sized strips of leather ranging from 8 to 12 millimeters in width, and placed at a 45-degree angle over all or substantially all of the item.

⁷ At the time the examining attorney submitted this evidence, the description of the mark was different from the current description. See footnote 2.

⁸ TSDR is the Office's Trademark Status and Document Retrieval database.

Thus, we are not persuaded by the examining attorney's contention that allowing applicant to register the mark as described in the application would deny competitors' use of both "the depicted configuration as well as confusingly similar weaves which share only certain characteristics, e.g., the same weave made from non-leather strips or not set at an angle." Brief, TTABVUE p. 8. We disagree with the examining attorney's contention that if a registration issues to applicant it would have an impact on third parties' use of such materials as "ribbon, straw, reed, grass, wood, paper, bark, plastics or other strip materials." Id.

Applicant has stated unequivocally that "it is not claiming exclusive rights in every possible formation of a leather weave design.... Rather, it seeks to register a mark consisting of leather strips of specific dimensions and placed in a specific orientation." Brief, p. 10. It has submitted examples of handbags and shoes having weave designs that it considers alternative designs that are available to competitors. Response filed March 4, 2008, Exhibit 9, TSDR pp. 537-568. These examples include products made from strips of a different size from those in applicant's design, and with weaves not set at an angle.

As to the examining attorney's concern that registration of applicant's mark would have an anticompetitive effect on manufacturers working with non-leather materials, such as grasses, reeds, or wood strips, applicant is seeking to register as a mark a design made of woven *leather*. Accordingly, a registration would not have a negative effect on the use of woven designs made from these non-leather materials. For the same reason, we are not persuaded by the examining attorney's arguments that third parties would be deterred from using any plain weave design "given the possibility of inadvertent infringement on three-dimensional goods, or the likelihood that applicant's views on coexistence would fray upon registration." Brief, TTABVUE p. 17.

Many of the examining attorney's other concerns are obviated by the fact that applicant is seeking to register a particular *leather* design. For example, the examining attorney's contention that use of a plain weave produces "a more flat, smooth, tight and fabric like surface 'conducive to printing and other finishes,'" ⁹ brief, TTABVUE p. 10, is based on statements applicable to *fabric*, not *leather*. Similarly, the examining attorney's point that "[i]f the

⁹ www.fibre2fashion.com, November 24, 2009 Office action, TSDR p. 436.

weave has no added design or finish, 'it has no right and wrong side, making either side usable,'"¹⁰ id., also is based on statements about fabric. The examining attorney also claims that applicant's diagonal placement of its plain weave in effect uses the bias of the weave. The examining attorney has submitted evidence about how bias-cut garments can be draped more gracefully. Much of this evidence refers to the cutting and draping of *fabric* for garments, not leather for the goods at issue herein. See generally, Exhibit G to November 24, 2009 Office action, TSDR pp. 503-583. In these 80 pages of exhibits, there is only one leather item that shows a weave that is placed at a 45-degree angle, an "Elliott Lucca Trieste Tote," TSDR pp. 521-526, which is advertised as having "bias-cut, woven genuine leather walls." It is not clear to us how "bias" and "bias cut," as described in the reference works and articles, would be applicable to this handbag. Thus, this evidence does not demonstrate a competitive need for the particular design that applicant seeks to register.

A final argument made by the examining attorney is that third parties that use a woven leather design for other fashion accessories such as belts would be hindered in expanding their product lines to shoes and handbags,

¹⁰ www.cwu.edu, taken from "Chapt 1-Fabric."

citing *Deere & Co. v. Farmhand Inc.*, 560 F.Supp. 85, 217 USPQ 252 (S.D. IA 1982), aff'd 721 F.2d 253 (8th Cir. 1983). *Deere & Co.* was an infringement action brought by the John Deere company, alleging, inter alia, that a particular shade of green was its trademark for farm machinery and equipment, and that the defendant's use of that color for its front-end loaders was an infringement. The Court applied the doctrine of aesthetic functionality because of its finding that "farmers prefer to match their loaders to their tractor." 217 USPQ at 262.

We are not persuaded that the current situation is analogous. Among other reasons, the evidence that consumers prefer to match their accessories consists of only one article, called "Matching Shoes and Belts," on the Life123 website, www.life123.com, stating that "poorly matched shoes and belts are one of those universal calling cards of bad taste." The article suggests that the material be matched, e.g., black patent leather shoes with a black patent leather belt. There is nothing in the article that indicates consumers buy their shoes to match their belts, as opposed, perhaps, to the other way around. Nor is it clear from this article that leather shoes with a weave design must be worn with a leather belt that has a weave design. Even assuming all of these things, a

registration to applicant for the proposed mark would not preclude a manufacturer of leather belts with a weave design from using a weave design on shoes, as long as the weave design did not cover all or substantially all of the shoe, and/or the weave was not placed at an angle, and/or the strips were not the size identified in the description of the proposed mark.

The examining attorney has also submitted evidence that third parties (as well as applicant) use a single design on handbags and accessories. Frankly, it is not clear to us that these examples are merely of designs being used on both types of products, as opposed to being trademarks that cover large sections of the bags and accessories; therefore, this evidence has little probative value.¹¹ See, e.g., November 24, 2009 Office Action, TSDR pp. 754-755 (Burberry handbags and belt with same plaid fabric); TSDR pp. 757-767 (Coach handbags, belts, jewelry and accessories, with "C" design covering the entirety of the items).¹²

¹¹ Thus, with respect to the examining attorney's refusal, discussed infra, that applicant's weave design would be viewed merely as ornamentation, this evidence may actually support applicant's position, in showing that it is not uncommon for companies to use trademarks to cover the entirety of handbags and accessories, as a result of which consumers would be inclined to view as a trademark the weave design covering applicant's goods.

¹² The examining attorney also contends that a registration to applicant "would deprive consumers who may be able to afford only

The foregoing discussion of the mark in issue, evidence of record and arguments concerns aesthetic features that, because of a quality of the feature itself, could make the feature aesthetically functional. See, for example, *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994), in which the black color of outboard marine engines made the engine appear smaller and provides color compatibility; *In re Florists' Transworld Delivery Inc.*, supra, in which the color black was a significant color to be used for mourning, or Halloween, or to denote elegance. This manner of showing that a product design is aesthetically functional involves establishing that the aesthetic feature possesses significance or conveys a benefit, such that it can provide a competitive advantage to an entity acquiring exclusive rights to use this feature.

However, it is also proper to look at third-party uses to ascertain whether there is a competitive need for a particular design. Certainly evidence of a great number of third parties that use a certain feature can show that the feature is necessary for companies to be able to compete

one of applicant's luxury goods the ability to coordinate a matching bag or shoes from a different manufacturer." Brief, TTABVUE p. 18. The fact that a purchaser cannot, in effect, purchase a knock-off of a trademarked product does not fall under the concept of competitive need.

effectively, i.e., the exclusive appropriation of that feature would put competitors at a significant non-reputation related disadvantage. At the same time, we must also be aware that competitive usage may not always be evidence of competitive need, but of a desire to copy or take advantage of a feature that has become associated with a single company. With that in mind, we now turn to the evidence of third-party items showing weave designs that appear to be the same or confusingly similar to the mark described in applicant's application.

First, we give no probative value to the evidence showing products that are perceived as copies of applicant's goods. This evidence does not show a legitimate competitive need for the particular weave design that applicant uses; if anything, these uses show that the weave design is recognized as applicant's trademark. See, for example, the following description on the Carrying Contraption website, www.carryingcontraption, written in July 2007, for a "Barneys Woven Leather Tote":

Here's another Bottega-Veneta-esque tote bag made of suede and python (handles).

...

This is another example of a non-BV woven leather tote bag. My prognostication is that within five years, we won't be able to tell an intrecciato¹³

¹³ "Intracciato" is translated as "intertwined, interlaced, twisted, (inter)woven, braided, plaited." The Sansoni

BV from a non-BV woven leather bag. And that's not a bad thing at all.

July 11, 2008 Office action, TSDR pp. 38-40.

A similar description, also on the Carrying Contraption website, dated July 5, 2007, for the "Falor Tote Bag," states:

Don't let the woven leather fool you--this is not a Bottega Veneta bag. And I guarantee you more and more of these bags will be imitated in the future. Too bad for BV (and label whores), woven leather can't be trademarked and will be accessible to the masses. ::gasp::

To the ladies and gentlemen who buy the intrecciato Bottega Veneta bags *only* for "quality"--get over yourselves, everyone knows you're spending the dough because the intrecciato is "exclusive" at the moment.¹⁴

July 11, 2008 Office action, TSDR pp. 42-43. A pair of combat boots is described: "Get the Bottega Venetta [sic] Style, without paying the Bottega Venneta [sic] price."

April 4, 2009 Office action, TSDR p. 298.

Hundreds of pages of the evidence submitted by the examining attorney consist of advertisements for "vintage"

Dictionaries, English-Italian, Italian-English, 3d ed. (2002). The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

¹⁴ Applicant submitted evidence, through the second declaration of Vanni Volpi, applicant's intellectual property counsel, that it brought an action against Falor in Florence, Italy, as a result of which Falor entered into a settlement agreement with applicant in which it acknowledged applicant's trademark rights

bags and shoes. Most of these are from individual sellers on sites such as eBay. Although many of these submissions show photographs of leather bags or shoes that appear to have the same or confusingly similar designs as applicant's proposed mark, this evidence is not particularly probative of competitors' current need to use such a design. The fact that an individual has found an old handbag or pair of shoes in her closet and wants to sell it,¹⁵ or that a handbag manufacturer used that woven leather design many years ago, is not evidence that competitors today have a need to use the particular weave design.¹⁶ Further, as discussed infra, we cannot discount the possibility that the third-party manufacturers deliberately copied applicant's weave design because of its connection with applicant.

in the weave design, and agreed to cease all manufacture and sale of these products.

¹⁵ "I bought these boots from Nordstrom years ago for \$700.000 wore them very lightly for a short period of time and they have remained in my closet since." Posting on ebay.com, April 4, 2009 Office action, TSDR p. 217.

¹⁶ We realize that the examining attorney has submitted evidence of "vintage" items in part to counteract applicant's claim that it is the originator of the particular leather plain weave design and third parties using this design were merely copying applicant. Even if, *arguendo*, the evidence clearly demonstrated that applicant was not the first user of this plain weave design, it would not necessarily follow either that competitors have a need to use this design, or that third parties that used the same design subsequent to applicant's adoption of it were not copying applicant's weave design.

After carefully reviewing all of the evidence showing weave designs on handbags, there are a very small number that can be considered to have the very same features as those described in applicant's mark.¹⁷ Although several others are similar, they have some distinguishing features, such that they do not totally match the description of applicant's weave design.

We are not persuaded that third-party use of the same or a confusingly similar design is so extensive that a non-reputation related competitive need to use the applied-for design on handbags has been established. Certainly the third-party examples do not show that the particular weave design applicant seeks to register is such a generally accepted decorative feature that we can conclude that there is a legitimate competitive need for others to use it. In this case the examining attorney, as noted earlier, submitted an inordinately large amount of evidence. It is clear that he did an extremely thorough job in finding such evidence including single handbags sold by individuals, and even earrings and watchbands having leather weave designs.

¹⁷ We note that in its response filed October 6, 2009, applicant identified a number of bags that it considered to be infringements. This occurred prior to the amendment to the description of its mark on September 10, 2012; in any event, it is up to us to determine which competitors' designs are the same in terms of assessing competitive need for the design that applicant seeks to register.

Accordingly, in this case, where there is such overwhelming evidence of a multitude of weave designs, the very limited number of weave designs that approximate applicant's weave design, at the very least, raises a question as to whether there is a competitive need for the design that applicant seeks to register.

Moreover, although evidence of competitive usage can be evidence of competitive need, we must also acknowledge that third parties may adopt an aesthetic feature because it has been made popular by a particular company, and consumers may wish to have items displaying this feature because of its association with the company that popularized it. For example, if the design applicant seeks to register identifies applicant as the source of the goods, and consumers are buying competitors' bags having this design to have a bag that looks like it originates with applicant, i.e., because it has the look of *applicant's* bags, this would not make the design aesthetically functional, because it is the *association* with applicant that consumers want to obtain. Thus, it is possible that some of the third parties, whether current competitors or the makers of the "vintage" goods, adopted the weave design for their products not because the design has an inherent aesthetic value, but because of the

popularity or cachet that applicant created in the design by its own efforts. As Jason Jobson stated in his declaration, "Given the level of copying that is always going to occur in the fashion industry, Bottega Veneta should not be penalized just because other manufacturers have decided to copy its Bottega Weave Design."¹⁸

Accordingly, the very limited number of third-party uses of the particular weave design, where there is such overwhelming evidence of weave designs in general, and the possibility that some third parties adopted the weave design because of its association with applicant, creates some doubt as to whether there is a competitive need for the design that applicant seeks to register.

We also conclude, with regard to the application in Class 25 for shoes, that the proposed mark is not functional. For the same reasons discussed in connection with the Class 18 handbags, i.e., the limited evidence of use of this design despite the extensive amount of evidence submitted by the examining attorney, and the possibility that some third parties adopted the weave design because of its association with applicant, raise a doubt as to whether

¹⁸ Mr. Jobson identifies himself as a self-employed luxury brand consultant who has worked in the fashion industry for more than fifteen years (and who has never worked for applicant).

competitors have a legitimate need to use a design with the particular characteristics of applicant's proposed mark.

In cases involving other grounds for refusal, there is a policy that doubt should be resolved in favor of publication of the mark. See *In re Benthin Management GmbH*, 37 USPQ2d 1332 (TTAB 1995) (surname); *In re Hines*, 32 USPQ2d 1376 (TTAB 1994) (disparaging); *In re Over Our Heads Inc.*, 16 USPQ2d 1653 (TTAB 1990) (scandalous); and *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972) (descriptive). In a case involving the issue of aesthetic functionality, where the question to be resolved is competitive need, we think that adopting this principle is particularly appropriate, since publishing the mark will allow competitors to come forward to assert and prove that they do have a competitive need to use the proposed mark if, indeed, they have such a need. Accordingly, because we have doubts about whether the proposed mark is functional for handbags and shoes (and because the evidence with respect to the goods in Class 18 relates virtually entirely to handbags), we reverse the refusal on the ground of functionality.

However, before we leave the question of aesthetic functionality, we must make a final comment. Our finding that the design is not aesthetically functional is based on

a very narrow reading of the proposed mark, and the scope of protection to which it is entitled. The examining attorney has raised the concern that, armed with a registration, applicant would attempt to prevent third parties from using various forms of a plain weave design. It does not appear that applicant has any intention of doing so; applicant specifically says that it "appreciates that its rights in the Bottega Weave Design may be relatively narrow." Reply brief, p. 6. However, to specifically address the examining attorney's concerns, we reiterate that we are finding only that the specific design for which applicant seeks registration is not aesthetically functional. We are not finding that the protection to be accorded this mark would extend to allow applicant to prevent the use, for example, of similar designs with different size leather strips, or to goods having a plain weave set at an angle but also having noticeable plain leather portions. If applicant were claiming rights to such other designs, the analysis would change, and designs having these other features would have to be considered in assessing competitive need. In effect, the reason that we have found no competitive need for applicant's proposed mark is because we are considering as probative only competitive uses of the essentially identical design.

Ornamentation and Acquired Distinctiveness

This brings us to the refusal based on the ground that applicant's proposed mark is ornamentation and does not function as a mark, and that applicant has not demonstrated that the design has acquired distinctiveness.

Applicant seeks registration pursuant to Section 2(f) of the Act, claiming that its mark has acquired distinctiveness. By doing so, applicant has admitted that its proposed mark is not inherently distinctive. *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) (where an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the statute accepts a lack of inherent distinctiveness as an established fact). Therefore, we consider the examining attorney's arguments and evidence that the proposed mark is purely ornamental in connection with applicant's evidence of acquired distinctiveness, as part of our determination of whether applicant's evidence shows that what would initially be viewed as merely ornamental has come to be recognized by the consuming public as a source indicator for applicant's goods.¹⁹ In making this determination, we must consider the

¹⁹ The examining attorney makes the statement that "[a] determination that the proposed mark is ... purely ornamental

evidence of acquired distinctiveness in relation to the degree of inherent distinctiveness of the design sought to be registered, or more accurately, the lack thereof. In re K-T Zoe Furniture Inc., 16 F.3d 390, 29 USPQ2d 1787, 1789 (Fed. Cir. 1994) (the showing that may be deemed adequate will of course depend on the particular facts; the requisite weight of evidence will vary with the degree of descriptiveness of the mark); In re Lorillard Licensing Co., 99 USPQ2d 1312, 1316 (TTAB 2011) (the greater the descriptiveness or non-distinctiveness of the proposed mark, the greater the burden is on an applicant to demonstrate acquired distinctiveness).

The evidence submitted by the examining attorney in connection with the functionality refusal shows that woven leather designs, and particularly designs in plain weave, are often used for handbags and shoes. As a result, customers are not likely to view such designs as a source-identifier unless there has been significant promotion that the design is a trademark. In other words, applicant has a

constitutes an absolute bar to registration on the Principal Register, regardless of any evidence of acquired distinctiveness." Brief, TTABVUE p. 23. However, that is not correct. If a design has acquired distinctiveness, then it would not be purely ornamental, and it would be registrable pursuant to Section 2(f).

heavy burden to demonstrate that its applied-for weave design would be recognized as a trademark.

Applicant has submitted a significant amount of evidence in support of its claim of acquired distinctiveness.

According to the declaration of Vanni Volpi, submitted with its March 4, 2008 response, applicant's weave design was first used on handbags in 1975. ¶ 4. As of 2008, applicant's goods were sold at 19 of its own Bottega Veneta boutiques and at such high-end retail stores as Neiman Marcus, Saks Fifth Avenue, and Bergdorf Goodman. ¶ 6. From 2001 through 2007 sales of applicant's products in the United States exceeded \$275 million, and the weave design appeared on over 80% of the goods. ¶ 7. The bulk of the sales amounts were for handbags. Advertising expenditures in the United States during this time period totaled \$18 million. ¶ 8. (A later declaration by Mr. Volpi, submitted with the October 6, 2009 response, states that between 2005 and 2009 applicant spent over \$22.9 million advertising products bearing its weave design in U.S. magazines.) For over 35 years applicant's catalogs and ads have featured products with the weave design as its trademark. ¶8.²⁰ In

²⁰ In reviewing the catalogs, we note that not all of the items featured therein show the mark sought to be registered. For

1996 the introduction to its U.S. catalog referred to its "signature woven handbags," and all of the handbags in that catalog bore the design that is the applied-for mark. Advertisements and "editorials" featuring items with the applied-for weave design have appeared in such magazines as Vogue, Women's Wear Daily, O, Elle, New York, Hollywood Life, Time and Marie Claire. Many of these advertisements and editorials specifically reference the intrecciato weave design. See, for example, response filed January 13, 2009, TSDR pp. 207, 214, 221, 226, 229.

Applicant has also submitted numerous newspaper and magazine articles in which its "signature" weave design is noted, e.g.:²¹

You don't have to look at the label to know that this soft and slouchy handbag is from Bottega Veneta. Their "Intrecciato" woven leather speaks for itself.
Distinction, March 2002, TSDR p. 290.

Bottega Veneta takes pride in not having a logo, but the brand flaunts its signature woven leather as a hallmark in its first New England Store.
WWD, November 20, 2007, TSDR p. 291.

The venerable Italian label, known for its signature woven-leather goods, proves a chain wallet can and should look grown up.

example, some of the shoes and handbags have the weave design, but only on a small portion of the item. See response filed March 4, 2008, showing, in the 1993 catalog, a shoe with the weave design only on the vamp. TSDR p. 69; another page features a shoe with the weave design only on the toe cap and a handbag with the sides and upper area in plain leather. TSDR p. 71.

²¹ Submitted with March 4, 2008 response.

GQ, December 2005, TSDR p. 293.

Luxury retailer emphasizes shoes, handbags in classic woven leather (subtitle)
It all comes back to the line's signature look, sans logos or labels, which are handbags and shoes featuring intrecciato woven leather.
Palm Beach Daily News, November 26, 2001, TSDR p. 310.

...In the 1970s, its [applicant's] intricately woven rustic-looking designs were sufficiently identifiable to inspire the company's slogan, "When your own initials are enough."
New York Times, March 27, 2008, submitted with January 13, 2009 response, TSDR p. 173.

The *métier* of Bottega was working soft glove leather by hand and weaving it into a distinctive crosshatched pattern, called *intrecciato*. The *intrecciato* bag soon became an international status symbol, and Maier, in his revamp of the company, has made the pattern the leitmotif of the whole house, applying it to everything from his signature Cabat bag ... to silver picture frames, floor lamps, desks, china, and crystal tumblers.
Vanity Fair, September 2008, submitted with January 13, 2009 response, TSDR p. 177.

Applicant has also submitted numerous declarations from individuals involved in the fashion industry, testifying as to the recognition of its weave design. Jason Jobson, identified in footnote 17, considers applicant's weave design as "iconic" for handbags, "such that the customer and the trade can identify the source of the design simply by looking at it." Exhibit E to January 13, 2009 response, ¶ 4.

Jonathan Joselove, the senior vice president, general merchandise manager for Neiman Marcus Stores, states that applicant is recognized "for the distinctiveness of the woven leather design" and "I would say that consumers encountering Bottega's Weave Design immediately recognize that the handbags come from Bottega Veneta solely from the weave design alone, and without reference to any other indicia of source, such as labels or hangtags." Exhibit F to January 13, 2009 response, ¶ 7.

Judie Conn, a senior buyer at Gorsuch Ltd., who has been in the business of retailing fashion items for over 30 years, states:

In my experience, consumers encountering products such as handbags and shoes containing Bottega's Weave Design immediately recognize that the products come from Bottega Veneta, from the weave without reference to any other indication of source, such as labels or hangtags. Without signage customers see the bags and say, "Oh, you have Bottega Veneta."

Exhibit G to January 13, 2009 response, ¶ 8.²²

Perhaps most persuasive in showing recognition of applicant's weave design are the descriptions by the public either referencing the weave design or describing third-

²² We have quoted statements from three of the declarations, but point out that declarations from many additional people in the fashion industry are of record.

party products as looking like applicant's weave. See the following examples:

A consumer comment about an Atmos woven leather coin purse, states: Atmos has offered up their Bottega Veneta-esque Brick Coin Purse...
www.Elifestyle.com. July 11, 2008 Office action, TSDR p. 47.

Review on Bag Snob, www.bagsnob.com, by "Bag Snob Tina" about a Marc Jacobs Elsa Woven Leather Bag: I'm a little bit Chanel, I'm a little bit Bottega ... It's almost as if "someone" took a little bit of "something" when they hallucinated this bag.. But woven leather with garish gold chains... For that amount I can buy a REAL Chanel or a REAL Bottega and not some third rate knock off.
Response filed January 13, 2009, TSDR p. 69.

"Article" on <http://jezebel.com>, March 27, 2008, states: You know Bottega. They make those basketweave-y leather bags. ... The idea is that Bottega's bags are getting popular because they are more "understated" than flashy Louis Vuitton bags, and people are sick of logos. You know, the basketweave, it is not quite like a logo. No one knows where it's from. Until they do. And then they recognize it everywhere they see it. So it's like a logo, but subtler.
Response filed January 13, 2009, TSDR p. 192.

Comments on The Purse Blog about a Miu Miu Woven Leather Hobo:

"I know, I know, Bottega Veneta is *the* woven leather genius..." TSDR p. 151;
"I don't like it. It looks like a BV bag but BV is much better." TSDR p. 153;
"I think that it is unoriginal in the fact that the woven leather is 'BV inspired' to say the least." Id.
November 24, 2009 Office action

The evidence we have detailed herein, as well as the other evidence of record, amply demonstrates that

applicant's weave design is recognized by consumers as a trademark for applicant's goods.²³ Accordingly, after reviewing all of the evidence of record, and considering applicant's and the examining attorney's arguments, we find that applicant has met its burden of proving that the applied-for design has acquired distinctiveness as a trademark for the identified goods.

Decision: We reverse the refusals on the grounds that the mark is functional and is merely ornamentation, and find that applicant has demonstrated that the design has acquired distinctiveness as a trademark. We also repeat our previous statement that our finding that the design is not aesthetically functional is based on a very narrow reading of the proposed mark, and the scope of protection to which it is entitled.

²³ The examining attorney has not addressed the question of acquired distinctiveness specifically with respect to the non-handbag items identified in Class 18, and therefore we have not discussed such evidence in detail. However, we point out that there is evidence in the record of advertisements and articles with respect to applicant's use of this design on such items, as well as on shoes. Further, the acquired distinctiveness of the mark in connection with handbags is so strong, and the other Class 18 items are so closely related to handbags, that the acquired distinctiveness of the mark would transfer to these goods in any case. See TMEP § 1212.09(a) and cases cited therein.