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EXAMINER BRIEF

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APPLICANT: Bottega Veneta International S.a.r.l.

CORRESPONDENT'S REFERENCE/DOCKET NO:

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant appeals the examining attorney's final refusal of the proposed mark comprising a configuration of woven leather used over all or substantially all of the goods, namely, "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," in Class 18; and "footwear," in Class 25.

Registration was refused because the configuration is functional for such goods under Trademark Act Section 2(e)(5), 15 U.S.C. §1052(e)(5). In the alternative, registration was refused under Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051-1052, 1127, because the proposed mark is solely decorative or ornamental and does not function as a trademark. Lastly, in the event the configuration may be deemed capable of registration, registration was refused under Sections 1, 2 and 45 because the proposed mark consists of a nondistinctive product design or design feature for which applicant has not demonstrated acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. §1052(f).

I. THE PROPOSED MARK IS FUNCTIONAL UNDER TRADEMARK ACT SEC.

2(E)(5)

A. BACKGROUND – FRAMING THE FUNCTIONALITY ANALYSIS

A feature is functional, and cannot serve as a trademark, if it is “essential to the use or purpose of the article or if it affects the cost or quality of the article.” *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33, 58 USPQ2d 1001, 1006 (2001); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165, 34 USPQ2d 1161, 1163-64 (1995); TMEP §1202.02(a)(iii)(A). A feature also is functional if its exclusive use would place competitors at a “significant non-reputation-related disadvantage”. *TrafFix*, 532 U.S. at 33, 58 USPQ2d at 1006. This alternate standard is particularly applicable where the feature presents competitive advantages that are not necessarily categorized as utilitarian in nature, *i.e.*, instances of aesthetic functionality. *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120, 1122-23 (Fed. Cir. 1994), cert. denied, 514 U.S. 1050 (1995); TMEP §1202.02(a)(vi).

In this case, the functionality refusal set forth in the initial Office action addressed potential utilitarian advantages in strength offered by the woven configuration of the proposed mark. Supporting evidence included statements that applicant’s goal “was to manufacture supple, but sufficiently sturdy, bags by weaving fine strips of leather together so as to make them stronger”.¹ However, subsequent review exposed a more significant competitive advantage in the aesthetic strength of the weave as a versatile, enduring and widely-used fashion motif. As such, the Sec. 2(e)(5) refusal was continued and restated to incorporate an aesthetic functionality analysis.

Also influencing examination were statements by the Applicant seeming to equate the

¹ Office Action of Sept. 3, 2007, at page 3. **NOTE:** Cited page numbers correspond to pagination in the USPTO’s TICS database and match those found in the “You are currently on page _” window atop correspondence viewed online at USPTO.GOV. However, references to applicant’s brief are to pagination as it appears on the page.

appearance of the proposed mark with the “painstaking manufacturing process”² chosen to create it, resulting in a single proprietary construct understood (at least by the Applicant) as “The Bottega Veneta Weave Design”. This view is apparent in applicant’s discussion of the proposed mark as a “leather weaving technique” and “a unique weave design, never before used for leather goods products”.³ Elsewhere, applicant stresses that “the Bottega Veneta Weave Design makes products more difficult to make and more expensive to manufacture, as it is done by hand, which results in limited production.”⁴

While manufacturing standards and methods may affect the quality of goods or help explain applicant’s references to strength, they are not matter subject to trademark protection. TMEP § 1301.01(a)(i). A further Office action consisting largely of third party examples and related inquiries was required to clarify the intended parameters of the proposed mark. The results, detailed in the Final Office action, summarize the configuration 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.

Although not visible on the drawing page, the fourth characteristic is pertinent because the actual or perceived orientation of the weave is affected by the three-dimensional surface on which it appears. The fashion purpose of the proposed mark also shapes the analysis of functionality. Notably, a specific weave or strip dimension is not listed as a characteristic of the

² See Response of March 4, 2008, at page 8-9.

³ See Office action of September 3, 2007, at page 46; Response of January 13, 2009, at page 17; also Response of March 3, 2008 beginning at page 37 (describing the technique used to create the proposed mark).

⁴ Response of March 4, 2008, at page 9.

proposed mark. Applicant has not identified a single strip size and confirms its use of different sized strips to adjust the visual scale of the configuration. Nonetheless, the potential relevance of this aspect of the configuration is addressed below.

The combination of characteristics as woven leather fabric set at an angle on fashion goods suggests that the configuration as a whole “is employed strictly for aesthetic reasons,”⁵ at least by the applicant. 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. *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 1340-1341, 213 USPQ 9, 15-16 (C.C.P.A. 1982). Thus, the final refusal of registration under Sec. 2(e)(5) is made under a rubric of aesthetic functionality focusing on the potential for significant non-reputation-related disadvantage to competitors. As the Examining Attorney will note, however, issues of utilitarian advantage are not wholly irrelevant, particularly with respect to confusingly similar configurations which do not share all characteristics of the proposed mark.

B. AESTHETIC FUNCTIONALITY AS ESTABLISHED LEGAL DOCTRINE

Applicant’s response to the Sec. 2(e)(5) refusal consists in large part of an attack on aesthetic functionality as a “suspect legal theory” that is widely rejected, including by the Federal Circuit and the Trademark Trial and Appeal Board. This conclusion is without merit as it relies on opinions and commentary that are clearly outdated or misinterpreted.

As indicated, the U.S. Supreme Court has expressly acknowledged aesthetic functionality as a valid legal concept. *TrafFix*, 532 U.S. at 33, 58 USPQ2d at 1006 (citing *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161 (1995)). Applicant’s insistence that these opinions did not address aesthetic functionality as a dispositive issue fails to diminish their precedential value in both confirming that functional matter may be non-utilitarian and clarifying the appropriate inquiry in such instances. In fact, the focus on competitive advantage described in *TrafFix* has emerged as the accepted approach where actual functionality is at issue but the

⁵ Response of January 13, 2009, at page 32.

nature of the proposed mark makes it difficult to evaluate functionality from a purely utilitarian standpoint. See generally TMEP Sec. 1202.02(a)(vi).

This circumstance arises with color marks and product features, such as the proposed mark, that enhance the attractiveness of the product. In such cases, the color or feature does not normally give the product a truly utilitarian advantage (in terms of making the product actually perform better), but may still be found to be functional because it provides other real and significant competitive advantages and, thus, should remain in the public domain. See *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 165, 34 USPQ2d 1161, 1163-1164 (1995) (stating that a product color might be considered functional if its exclusive use “would put competitors at a significant non-reputation-related disadvantage,” even where the color was not functional in the utilitarian sense).

Application of this doctrine prior to *TrafFix* can be found in *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994), cert. denied, 514 U.S. 1050 (1995), in which the Federal Circuit affirmed the Board’s determination that the color black for outboard motors was functional because, while it had no utilitarian effect on the mechanical working of the engines, it nevertheless provided other identifiable competitive advantages, *i.e.*, ease of coordination with a variety of boat colors and reduction in the apparent size of the engines. Applicant’s assertion that the Federal Circuit in *Brunswick* “declined to apply aesthetic functionality, holding that the purported aesthetic advantages of the color outboard motors were of a utilitarian, not aesthetic nature”⁶ plainly misses the central distinction made by the court between matter which serves “purely aesthetic functions” with no anti-competitive effect, and matter which is non-utilitarian/aesthetic yet also functional. *Id.* at 1124.

Indeed, applicant’s entire legal objection relies on an outdated understanding of aesthetic functionality as a discredited theory which wrongly denies trademark protection to matter merely because it is visually appealing, popular or commercial successful. For instance, applicant cites

⁶ Applicant’s Appeal Brief, page 15.

In re DC Comics, Inc., 689 F.2d 1042, 215 USPQ 394 (C.C.P.A. 1982), as rejecting the idea that aesthetic matter can be functional. In reality, this opinion is now understood as simply rejecting the misapplication of “aesthetic functionality” concepts to ornamental features without consideration of competitive advantage. See *Brunswick Corp.*, 32 USPQ2d at 1124. Semantic confusion over the different past and current uses of the term “aesthetic functionality” is a pitfall specifically cautioned against in TMEP Section 1202.02(a)(vi). Yet applicant misquotes this very section to support its argument. However, the referenced TMEP passage does not, as applicant states, advise that “[u]se of the term ‘aesthetic functionality’ may be appropriate [only] in limited circumstances . . . where the issue is one of true [utilitarian] functionality under §2(e)(5).”⁷ To the contrary, this section makes clear that aesthetic functionality *is* “true functionality,” even though it concerns competitive advantages that may not be utilitarian in nature.⁸

Applicant argues further that aesthetic functionality as a legal doctrine continues to be rejected as irrational or confusing, observing that the Ninth Circuit recently was “unable to make sense of the discussion of aesthetic functionality in *TrafFix* and *Qualitex*”. In fact, the Court noted that the Supreme Court opinions outline “the general contours of functionality and aesthetic functionality” and expressly restated its test for functionality in light of the *TrafFix* opinion, concluding that “[i]n the case of a claim of aesthetic functionality, an alternative test inquires whether protection of the feature as a trademark would impose a significant non-reputation-related competitive disadvantage.” *Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F. 3d. 1062, 80 U.S.P.Q.2d 1293, 1299-1300 (9th Cir. 2006).

In short, applicant’s condemnation of aesthetic functionality as a valid basis for refusal is unpersuasive and fails to address the doctrine as it is actually applied in this case. It is well established that non-utilitarian aesthetic matter may be refused trademark registration on functionality grounds, provided that “traditional trademark principals govern the registrability”.

⁷ Applicant’s Appeal Brief, page 16, at footnote 14.

⁸ Applicant’s Appeal Brief, page 15, at footnote 12.

M-5 Steel Mfg., Inc. v. O'Hagin's Inc., 61 USPQ2d 1086, 1097 (TTAB 2001). It is under this standard of competitive advantage that registration of applicant's weave configuration is refused.

C. CHARACTERISTICS OF THE PROPOSED CONFIGURATION

A finding of functionality “does not rest on a total elimination of competition in the goods”. *Brunswick Corp.*, 32 USPQ2d at 1122 (citing *In re Bose Corp.*, 772 F.2d 866, 872, 227 USPQ 1, 6 (Fed. Cir. 1985)). As such, applicant's assertion that the refusal interprets the proposed mark as woven leather in general is both mistaken and unnecessary. Nonetheless, determination of registrability must consider the impact of denying competitors use both of 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. Toward this end, it is helpful to review the individual characteristics of the configuration:

1. The Implications of Leather as a Construction Material

Although applicant makes no claim of exclusive rights to leather in general, its presence as an element of the proposed mark affects the functionality analysis. Applicant's discussion of the reduced strength and greater costs/effort associated with slicing strips and hand weaving them back together relates solely to its own use of soft leather. However, consideration of functionality must contemplate other woven materials that produce the same commercial impression. There can be little doubt that rights of registration of the proposed mark would extend to artificial leather. But what of ribbon, straw, reed, grass, wood, paper, bark, plastics or other strip materials? As noted below, the plain weave embodied by the proposed mark offers specific utilitarian advantages to brittle, weak or less pliable materials.

The application record offers some hint of the implications for competitors employing other materials. In addition to leather, applicant confirms that it produces the same goods in the same weave using non-leather materials such as silk, satin, denim and linen.⁹ Applicant identifies

⁹ Response of October 6, 2009, page 17.

such embodiments as examples of the “Bottega Veneta Weave Design,”¹⁰ suggesting that, apart from the subject application, leather is not considered a requisite aspect of the configuration. Applicant also produces leather goods in the subject weave that are crafted in such a way as to mimic woven straw.¹¹ Moreover, applicant confirms that it would consider an actual straw bag employing the same diagonal plain weave as an infringement of its own use of the configuration.¹² As such, any consideration of functionality must be mindful that the potential for competitive disadvantage is not limited to makers of leather goods.

2. Functional Advantages of Woven Leather In General

The fundamental distinction between the proposed configuration and solid leather is its woven nature. Despite public claims that woven leather represents its own “exclusive domain,”¹³ applicant assures in its brief that it does not claim exclusive rights to woven leather in general. Nonetheless, applicant identifies solid leather among suitable alternative designs available to competitors.¹⁴ This broad view of competitive need lacks the focus required in this case. Woven leather of any configuration can offer identifiable advantages over unwoven leather. In addition to adding texture and visual appeal, woven leather is said to provide enhanced utilitarian benefits of breathability and comfort more suitable than solid leather for certain clothing applications.¹⁵ Moreover, evidence indicates an aesthetic functionality of woven leather which makes it particularly suited for some fashion purposes, such as evoking a lighter or more relaxed mood associated with Spring and Summer wardrobes.¹⁶ As such, unwoven solid leather is not properly regarded as a functionally equivalent alternative to the proposed configuration. Any consideration of available alternative designs must, at a minimum, contemplate configurations

¹⁰ Id.

¹¹ Final Office action of November 24, 2009, pages 326-331, 421.

¹² Office action of March 4, 2009, pages 323-325 and Response of October 6, 2009, page 41.

¹³ See Response of October 6, 2009, page 7; Final Office action of November 24, 2009, p. 390.

¹⁴ See, e.g., Response of January 13, 2009, page 13.

¹⁵ Final Office action of November 24, 2009, Exhibit D, pages 397-403.

¹⁶ Id. at pages 392, 404, 410, 412. See also Exhibit L, beginning p. 895 regarding consumer appeal of woven leather.

that benefit from the advantages inherent in woven material.

3. Functional Advantages of a Plain Weave Configuration

The proposed mark comprises a configuration of woven strips identifiable as a “plain weave,” *i.e.*, a simple weave in which the threads or strips interlace alternately.¹⁷ The uncomplicated arrangement of a plain weave makes it the simplest of woven forms and arguably the most basic step between solid and woven leather. Although certain traits of a plain weave are nullified by the larger scale of the proposed configuration, other advantages are present and even enhanced by the size of the woven strips.

Since plain weave merely interlaces the warp and weft strips in an alternating pattern, the weave gives the maximum number of interlacings, and is capable of producing a stronger woven material at a lower cost.¹⁸ It is this quality, along with the minimal bending and twisting required, that makes plain weave particularly suited for transforming strips of straw, reed, paper, ribbon, and other weak or brittle strips into a woven material stronger and more useful than the sum of its parts. Surface texture also may be minimized through the use of a plain weave, enabling a more flat, smooth, tight and fabric-like surface “conducive to printing and other finishes”.¹⁹ Moreover, if the weave has no added design or finish, “it has no right and wrong side, making either side usable”.²⁰ The grid-like nature of a plain weave made with uniform strips also maximizes the ability to incorporate stripes, checks and other patterns directly into the weave.²¹ The popularity and versatility of plain weave leather is illustrated by its ready availability in bulk and sheet form for further manufacture of shoes, bags, upholstery, wall coverings, and other goods.²²

Such advantages also are apparent in applicant’s woven goods, which are praised by

¹⁷ Office action dated April 4, 2009, p. 328; Final Office action dated November 24, 2009, p. 438, 453.

¹⁸ Final Office action of November 24, 2009, pages 565-568, quoting online text “*Costume Construction*,” by Leslie Robison-Green and Scott R. Robinson (2000-2005).

¹⁹ Final Office action dated November 24, 2009, p. 436, quoting “*Different Types of Weaves*” by Rahul Garg and Shivendra Parmar.

²⁰ Final Office action of November 24, 2009, pages 566, quoting “*Costume Construction*,” *supra*.

²¹ *Id.*; See also Final action, page 421.

²² Final Office action of November 24, 2009, Exhibit F, beginning p. 461.

consumers and fashion observers for their durability, smoothness, and light, understated elegance attributable in whole or part to the use of the most minimalist and smoothest weave.²³ Applicant also takes advantage of the flat, pixel-like surface provided by a plain weave to overlay printed graphics and to produce patterns of checks, stripes and other designs within the weave.²⁴

4. Advantages of Plain Weave Placed at an Angle

Given the obvious functional benefits of woven leather in general and plain woven leather in particular, the crux of applicant's argument in favor of registration ultimately rests on the angled appearance of the proposed mark. However, this common orientation is readily recognized within the fashion industry simply as a weave presented or placed "on the bias".²⁵ In addition to providing added visual interest to larger weaves, the placement of a plain weave on the bias can improve the ability of stiffer woven materials to mold to curved surfaces and can alter and enhance a weave's characteristics of drape and stretch.²⁶ The aesthetic effect of drape is relevant since an unstructured bag created from soft plain woven leather may be understood to look and behave much like one made from woven fabric.

If crafted properly, "a fabric that drapes well will hang in nice, even folds with no peaks or points."²⁷ A bag constructed of such soft woven leather set on a bias will necessarily have a distinguishable drape, *i.e.*, will droop or slouch in folds differently than one produced using a straight weave.²⁸ These functional qualities may be discerned both within applicant's unstructured bags and its own explanation as to the origins of the proposed mark. Applicant's online promotional materials explain its initial quest to find a "new way of using fine leathers" so as to stand out from its competitors. The evident solution was woven leather which "allowed the creation of bags completely different from the bags of that time: destructured, soft and in which

²³ See, e.g., Final Office action of November 24, 2009, pages 550, 557.

²⁴ Response of October 6, 2009, page 16.

²⁵ See generally Exhibit G of Final Office Action of November 24, 2009, beginning on page 503, including examples of plain woven leather goods described as bias cut or woven.

²⁶ See, e.g., Final Office Action of November 24, 2009, page 527, 574.

²⁷ Final Office action of November 24, 2009, page 569.

²⁸ *Id.*

the design and the quality of the materials were the most important elements”.²⁹ Notably, the quality identified by applicant as distinguishing its goods from others at the time was a soft and unstructured construction, and not specifically the use of woven leather. However, one need only glimpse such a bag to appreciate the contribution of soft, plain woven leather to this aesthetic goal. Moreover, 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.³⁰ Thus, consideration of registrability of the proposed mark must take into account the dynamic properties of an angled weave beyond its two-dimensional appearance on the drawing page.

D. DISCUSSION - COMPETITIVE ADVANTAGES OF THE PROPOSED MARK

The Federal Circuit has made clear that traditional trademark principles govern the registrability of a proposed mark's aesthetic features. The test for functionality hinges on whether registration of a particular feature hinders competition and not merely on whether the feature contributes to the product's commercial success. *M-5 Steel Mfg.*, 61 USPQ2d at 1097.

Applicant's configuration is functional because it embodies the best, or at least one, of a few superior weaves with which to transform strips into bags and footwear.³¹ Its removal from the public domain would necessarily hinder competition.

Applicant argues that registration of the proposed mark would not impair competition because other woven leather configurations distinguishable in size or design would remain available. With respect to the measurements of the configuration, however, it is noted that the uniform strips comprising the proposed mark are not limited to a particular dimension. As such, issues of strip width or dimensions of the resulting grid of squares/diamonds have limited bearing on a consideration of functionality.

Moreover, designation of a particular size element would only highlight the functional nature of the proposed mark. Applicant describes use of the configuration in either of two sizes

²⁹ Response of October 6, 2009, page 7.

³⁰ See, e.g., Final action page 549.

³¹ See *Brunswick Corp.* 32 USPQ2d at 1122.

depending on the underlying goods and states that the sizes and their particular applications were selected for “aesthetic reasons”.³² The reasons for applicant’s choices are easily deduced. A suitable weave presumably would be large enough to display the subtle geometry of the weave itself but sufficiently understated and balanced as to not overwhelm the overall design of the item on which it is used. Certain utilitarian factors dictating the optimal weave size also may be discerned. A weave of more narrow strands would take longer to create, would require more strips and would introduce breakage, strength and quality control concerns arising from the cutting and weaving of thinner strips. Likewise, a weave of a distinguishably larger dimension would create aesthetic challenges for smaller items and may render use for certain product designs impractical or less appealing. This potential is hinted at by applicant’s acknowledged use of a larger dimension weave for larger items, and a smaller dimension for smaller goods.³³

Accordingly, arguments in support of registration turn on the single issue of whether the 45-degree angle of an otherwise functional weave is sufficient to render it registrable as a trademark. It is the examining attorney’s position that the angled configuration provides real and significant competitive advantages to the goods on which it is applied. Moreover, its removal from the public domain inevitably would hinder the ability of competitors to freely use plain woven leather in general, notwithstanding applicant’s assurances to the contrary. Aspects of this competitive need include the following:

1. The Competitive Need To Access A Classic Fashion Motif

The fashion purpose of the proposed mark engages a layer of competitive need not encountered in many products. Whereas the color or appearance of a dry cleaning pad or similar product may have little purpose beyond ornamentation or source identification, the look of a fashion item serves to make the wearer look or feel more attractive or stylish. Although fashions constantly change, certain enduring motifs may be regarded as particularly useful in achieving

³² Response of October 6, 2009, page 6.

³³ Response of October 6, 2009, page 146.

this function, *e.g.*, patent leather, houndstooth, herringbone, faded denim, leopard print, wide wale corduroy, etc. Such raw materials of fashion must remain available so as to not deprive manufacturers of the competitive advantage of their proven appeal.

For makers of bags and shoes, plain woven leather in either orientation represents such an essential aesthetic commodity and may be reasonably compared to a color in an artist's palette. Registration of the proposed mark would remove from the public domain a ubiquitous motif required by competitors to effectively respond to consumer demands and expectations. *Abercrombie & Fitch Stores, Inc. v. American Eagle Outfitters, Inc.*, 280 F.3d 619, 61 U.S.P.Q.2d 1769, 1781 (2002) ("no designer should have a monopoly on designs regarded by the public as the basic form of a particular item").

As explained by the Seventh Circuit, "[g]ranting a producer the exclusive use of a basic element of design (shape, material, color, and so forth) impoverishes other designers' palettes." *Jay Franco & Sons, Inc. v. Franek*, 615 F.3d 855, 96 USPQ2d 1404 (7th Circuit 2010) (citing *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527 (Fed. Cir. 1994)). The *Jay Franco* opinion concerned a claim of trademark rights in the circular shape of a beach towel. The court began its aesthetic functionality analysis by noting that "[f]ashion is a form of function" while acknowledging "the chief difficulty is distinguishing between designs that are fashionable enough to be functional and those that are merely pleasing." *Id.* at 1408. As in the Federal Circuit, the Seventh Circuit focused on the competitive/economic impact to other manufacturers from a grant of exclusive rights in so basic a configuration, observing that the more rudimentary and general the element, "the more likely it is that restricting its use will significantly impair competition." *Id.* The court concluded that "[a] circle is the kind of basic design that a producer [...] adopts because alternatives are scarce and some consumers want the shape regardless of who manufactures it. There are only so many geometric shapes; few are both attractive and simple enough to fabricate cheaply." *Id.* comparing to *Qualitex*, 514 U.S. at 168-69 (functionality doctrine invalidates marks that would create color scarcity in a particular market). Since a

producer barred from selling such towels “would lose a profitable portion of the market,” the circular shape was refused trademark protection on the basis of functionality. *Id.* at 1409.

The same approach to competitive need is called for in this case. Nevertheless, applicant argues that a diagonal plain weave is not a basic configuration because it was unknown in connection with the identified goods prior to its introduction by the applicant in 1975.³⁴ Applicant contends further that third party examples of similar diagonal weaves should be disregarded as deliberate and recent attempts to capitalize on consumer desire for its own goods. Such claims are unpersuasive to the extent applicant cannot demonstrate during any of its 35 years of use the exclusive use necessary to claim a diagonal weave orientation as its own. The examining attorney 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.³⁵ Such perennial presence as a generic motif distinguishes the proposed mark from the several registered configurations cited by the applicant in support of registration, each of which also involves integration of proprietary logos or other singular decorative patterns or embellishments absent in this case.

As indicated, uniform plain weave exists in only two basic orientations – straight and angled. Applicant acknowledges one as in the public domain but the other as its exclusive intellectual property. Given the nearly identical nature of the two orientations, such divergent views are unsupportable. Although applicant points to comments comparing some third party examples of plain weave to its own more famous use, applicant provides no credible reason to conclude that these other manufacturers have not chosen a diagonal orientation for the same aesthetic reasons which motivated applicant’s own adoption and use. The mere fact that a blogger dubs a competing product “Bottega-esque” arguably says more about the writer’s abilities than it does the competitor’s motivations.

³⁴ See, e.g., Response of January 13, 2009, page 17.

³⁵ See examples of vintage and recent use of the proposed mark on third party shoes and bags. Attachments to Office action of April 4, 2009; Final action of November 24, 2009, Exhibits A, page 2 (vintage) and B, page 141 (recent).

Indeed, applicant's central claim to have pioneered use of diagonal plain weave for shoes and bags would no doubt come as a surprise to cultures and crafters that have used identical angled configurations with various materials for decades, centuries or perhaps millennia. In this regard, the examining attorney has provided numerous examples of native weaving, traditional crafts and folk art producing an identical appearance to the proposed mark.³⁶ Notably, these include examples of traditional woven bags and shoes to which applicant's own use of the proposed mark has been compared.³⁷

2. The Competitive Need For Plain Woven Leather

As indicated, plain woven leather composed of uniform strips offers inherent utilitarian and aesthetically functional benefits including strength, tightness of weave, simplicity of manufacture and a minimum of strip bending. Such a symmetrical woven fabric is usable in two basic orientations: one with the strips running in a straight horizontal/vertical manner and a second rotated one-eighth turn so that the strips run diagonally. Another one-eighth turn and the weave returns to its original appearance.

Although applicant seeks exclusive access to one of the two types of uniform plain weave it argues that the proposed mark is not functional because competitors would retain access to the other orientation. Such reasoning is unpersuasive. The two plain weave orientations are confusingly similar such that registration of one would affect the availability of both. Although applicant rejects this analysis, it is noted that applicant's evidence of registrability consists largely of excerpts in which angled plain weave goods of other manufacturers are deemed reminiscent of those of the applicant. However, further evidence indicates that such comparisons arise even when the third party plain weave is not angled.³⁸ As such, to the extent applicant regards comparison of third party goods to its own as evidence of infringing similarity, the orientation of the plain weave on the goods appears to be irrelevant.

³⁶ Exhibit H of the Final Office Action dated November 24, 2009, pages 584-730.

³⁷ See, e.g., Final action of November 24, 2009, pages 670, 675, 701, 716.

³⁸ See, e.g., Id., at Exhibit K, beginning at page 850.

The applicant's plain weave presents an issue comparable to the consideration of a circular towel configuration in *Jay Franco & Sons, Inc. v. Franek*, supra. There, the appellant's configuration was regarded as potentially barring circular shapes as well as any other design similar enough that consumers are likely to confuse it with a circular shape. In the *Jay Franco* opinion, this zone of hindrance was said to encompass "most regular polygons." *Id.* at 1408. In applicant's case, it may reasonably be said to encompass non-angled uniform plain weave.

Moreover, as discussed below, maintaining a specific weave orientation over a curved surface such as a shoe presents challenges avoidable only by the applicant should registration be granted. Given the possibility of inadvertent infringement on three-dimensional goods, or the likelihood that applicant's views on coexistence would fray upon registration, manufacturers may simply avoid plain weave altogether. Significantly, the registration of one orientation of plain woven leather would open the door to a claim of trademark rights to the other, perhaps by the applicant itself. Such a result, even applicant would agree, would work to the competitive disadvantage of other designers.

Thus, registration of the proposed configuration ultimately would place other manufacturers at a significant non-reputational competitive advantage by denying access to functional qualities offered by no other type of weave. With respect to manufacturers working with less pliable materials, including woven native grasses, reeds or wood strips, such an exclusion would create a burden as much utilitarian as aesthetic since the weave best suited for their available raw materials would be rendered off-limits.

3. The Competitive Need To Coordinate Patterns

The examining attorney has provided numerous examples of third party use of angled plain woven leather for goods other than shoes and bags, including other fashion accessories and belts.³⁹ This evidence also indicates consumer desire to match both the color and texture of

³⁹ Final action of November 24, 2009, at Exhibit I, beginning at page 731.

personal goods including belts, shoes and handbags. Applicant's exclusive rights in the proposed mark would deny leather goods manufacturers the ability to expand their product lines in a logical manner or to provide their customers with matching shoes and/or bags. As such, the proposed mark may be regarded as functional in that a grant of exclusive rights to the applicant for footwear and bags would deprive competitors employing a similar weave on other goods the ability to expand and coordinate their products. See *Deere & Co. v. Farmhand, Inc.*, 560 F.Supp. 85, 217 USPQ 252 (S.D.Iowa 1982), *aff'd*, 721 F.2d 253 (8th Cir.1983).

Registration also would deprive consumers who may be able to afford only one of applicant's luxury goods the ability to coordinate a matching bag or shoes from a different manufacturer. On the other hand, registration would grant applicant an unfair advantage in the ability to produce shoes or bags to coordinate with the multitude of third party shoes and bags in the same material already in circulation.

4. The Competitive Need To Cover Three Dimensional Surfaces

Central to applicant's argument is the notion that registration of its diagonal configuration would not deny competitors the benefits of a plain weave presented in a straight orientation. However, given the three dimensional nature of the goods to which it is applied, maintaining the orientation of an unbroken weave over the curved surface of goods such as footwear is demonstrably impractical in many instances. A weave which begins as horizontal on the toe of a shoe may appear angled on the side (and vice versa) and will appear in a different orientation when viewed at different angles.⁴⁰

Assuming for a moment that a straight plain weave is not confusingly similar to the same weave set at an angle, a grant to the applicant of exclusive rights to the angled form nonetheless would place competitors in an impossible position. In order to ensure a non-infringing orientation, competitors would be forced to employ awkward breaks to reposition their woven fabric, to limit use of the weave to smaller, flatter areas of a product's surface, or to simply forego

⁴⁰ Id. at Exhibit J, beginning on page 784.

plain weave altogether. Such limitations would not affect the applicant, which would enjoy the ability to cover the entire surface of its goods with an appealing expanse of unbroken woven leather without regard to shifting orientation.

E. APPLICANT FAILS TO REBUT THE PRIMA FACIE CASE OF FUNCTIONALITY

A determination of functionality is a question of fact, and depends on the totality of the evidence presented in each particular case. *Valu Eng'g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1273, 61 USPQ2d 1422, 1424 (Fed. Cir. 2002); *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1339 (TTAB 1997); TMEP §1202.02(a)(iv). The Office must establish a prima facie case that the configuration mark sought to be registered is functional. The burden then shifts to the applicant to present sufficient evidence to rebut the prima facie case. *In re R.M. Smith, Inc.*, 734 F.2d 1482, 1484, 222 USPQ 1, 3 (Fed. Cir. 1984); *In re Bio-Medicus Inc.*, 31 USPQ2d 1254, 1257 n.5 (TTAB 1993); TMEP §1202.02(a)(iv).

The Examining Attorney has established a prima facie case of functionality based on competitive need that the applicant has failed to rebut. Aside from challenging the legal validity of the refusal, applicant's primary response is simply that others may use a different configuration. However, applicant can identify no alternative which possesses the same level of simple appeal, strength and versatility of a classic plain weave. Indeed, alternate weaves proposed by the applicant generally involve added raised texture, open areas, or conspicuous patterns which unavoidably produce a very different aesthetic tone.

Applicant also places undue importance on its response to the examining attorney's inquiries regarding the perceived nature of the proposed mark. As indicated, the examples of third party shoes and bags included in the third Office action were put forth to help clarify ambiguities in applicant's own characterization of the configuration. Applicant's failure to regard every example as an infringement was an anticipated result of the inquiry and has little bearing on the consideration of equivalent alternative configurations. By contrast, applicant's discussion of

functionality is silent with respect to the numerous examples of vintage, traditional and contemporary shoes and bags constructed from an identical weave attached to the final Office action and earlier actions. Such widespread use offers but a glimpse of the potential for sweeping competitive disadvantage and loss of consumer choice if the proposed configuration is placed off limits to all but the applicant's luxury leather goods.

In this regard, applicant also has provided no support for its claim that referenced third party uses of the same or confusingly similar weaves for bags and shoes may be dismissed as recent infringements adopted solely for reputational reasons, i.e., to capitalize on applicant's own success or consumer desire for applicant's goods. Indeed, with respect to non-competing handmade, traditional or eco-friendly goods woven from low-cost native or recycled materials, consumer appeal and motivation may be fairly regarded as the complete opposite of that associated with applicant's high-end fashions. Accordingly, the final refusal of registration under Trademark Act Section 2(e)(5), should be affirmed on the ground that registration of the proposed mark would place competitors at a significant non-reputational disadvantage.

II. THE PROPOSED MARK IS ORNAMENTAL UNDER TRADEMARK ACT SEC. 2(E)(5)

In the alternative, registration was refused as final because the applied-for configuration mark, as used by the applicant, is solely decorative or ornamental in nature and does not function as a trademark to identify and distinguish applicant's goods from those of others or to indicate the source of applicant's goods. Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051-1052, 1127; *see* TMEP §904.07(b). Moreover, the nature of the proposed mark is such that it is incapable of functioning as a source-identifier for applicant's goods. *See In re Petersen Mfg. Co.*, 2 USPQ2d 2032 (TTAB 1987) (holding design of the rear panel of a container for hand tools unregistrable because it is mere ornamentation); *In re The Original Red Plate Co.*, 223 USPQ 836 (TTAB 1984) (holding the wording YOU ARE SPECIAL TODAY used on ceramic plates to have no

source-indicating significance for the plates); *Damn I'm Good Inc. v. Sakowitz, Inc.*, 514 F. Supp. 1357, 212 USPQ 684 (S.D.N.Y. 1981) (holding the wording DAMN I'M GOOD used in large letters inscribed on bracelets and printed on hang tags is ornamental and has no source-indicating significance); TMEP §§1202.03 *et seq.*

The proposed mark is ornamental because it merely comprises the pattern of the material from which applicant's goods are made in whole or part. Although described by applicant as "a distinctive repeating pattern," applicant's configuration simply presents the commonplace appearance of the simplest form of woven leather. The configuration contains no ornamental embossing, printing or interruptions in warp or weft capable of being considered distinctive. Instead, the proposed mark is the unavoidable texture which results when leather strips are woven in a plain weave.

The ornamental or decorative nature of a given pattern or design is enhanced where the design is repeated over the entire surface of the product or packaging. *In re Soccer Sport Supply Co.*, 184 USPQ 345, 347 (C.C.P.A. 1975). "The deadening repetition of even a distinctive design may create a 'wallpaper' effect on the buyer who sees the pattern as mere 'background ornamentation.'" *Major Pool Equip. Corp. v. Ideal Pool Corp.*, 203 USPQ 577, 582 (N.D. Ga. 1979) (quoting J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §7:11, at 172). In this case, applicant's mark is intended to cover the entire surface of its product to create such a "wallpaper" effect, and would be perceived as ornamental and not source-identifying for applicant's goods. *See* TMEP §§1202.03 *et seq.*

In response, applicant argues that the practices of the trade, as reflected by a number of existing U.S. trademark registrations, supports an interpretation of its proposed mark as a type of repeating background which, even if ornamental, is nonetheless capable of registration under a Sec. 2(f). Such arguments are unpersuasive. Unlike the referenced registered marks, the proposed mark does not comprise a particular pattern of colored blocks or stripes or an array of distinctive insignia or initials repeated over a product's surface. Instead, applicant indicates that

such decorative finishes or designs are painted, printed or embossed atop its proposed mark or woven directly into the configuration. Unlike an arbitrary but ornamental arrangement of repeating designs, the proposed mark is repetitive by its very nature. In this capacity, applicant's mark is more comparable to a single color background than a deliberate pattern of repeating designs.

Not surprisingly, like a single color, evidence of fashion industry practice indicates widespread use of the proposed configuration in the same ornamental manner employed by the applicant. Evidence provided in connection with the Sec. 2(e)(5) refusal confirms that the proposed mark is in no way unique or unusual in the clothing and fashion accessories fields. If anything, the actual aspects for which applicant is best known, *i.e.*, the use of highest quality leather, craftsmanship and product design, are simply luxury refinements of a commonly-adopted and well-known form of ornamentation for a particular class of goods that would be viewed by the public as mere ornamentation for the goods.

Established practices of the trade may be relevant to the amount of evidence needed to show acquired distinctiveness with respect to a mark that is merely ornamental or decorative. TMEP §1202.03(b). Generally, more evidence is needed if the applied-for mark is matter used so frequently as ornamentation or decoration in the relevant industry that consumers would be less apt to discern source-indicating significance based on its use. *See In re Villeroy & Boch S.A.R.L.*, 5 USPQ2d 1451 (TTAB 1987) (holding design of vines with morning glories used on tableware to be mere ornamentation where applicant concedes that "it is common practice to decorate tableware with floral patterns;" thus the three declarations, advertising and promotional evidence, and sales and advertising figures were found insufficient to show trademark significance because such evidence did not refer to or promote the design as a trademark and the advertising and promotional figures failed to distinguish between applicant's various floral patterns).

Accordingly, the final refusal of registration under Trademark Act Sections 1, 2 and 45 on the ground that the mark is of an ornamental nature incapable of registration should be

affirmed.

III EVIDENCE OF ACQUIRED DISTINCTIVENESS IS INSUFFICIENT

A determination that the proposed mark is functional or purely ornamental constitutes an absolute bar to registration on the Principal Register, regardless of any evidence of acquired distinctiveness. If matter is generic, functional, or purely ornamental, or otherwise fails to function as a mark, the matter is unregistrable. Trademark Act Sections 2(e)(5) and 23(c), 15 U.S.C. §§1052(e)(5), 1091(c); *see TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29, 58 USPQ2d 1001, 1006 (2001); *In re Controls Corp. of Am.*, 46 USPQ2d 1308, 1311 (TTAB 1998); TMEP §1202.02(a)(iii)(A); 1202.03(a).

In the event the proposed mark may be held non-functional and not purely ornamental, registration also was refused because the applied-for mark consists of a nondistinctive product feature that is not registrable on the Principal Register without sufficient proof of acquired distinctiveness. Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051-1052, 1127; *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210, 213-14, 54 USPQ2d 1065, 1068-69 (2000). Applicant has responded by asserting acquired distinctiveness based on long use of the proposed mark and an assortment of evidence. Applicant's response is insufficient to demonstrate of acquired distinctiveness as a single source indicator.

The burden of proving acquired distinctiveness is on the applicant. *Yamaha Int'l Corp. v. Yoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988); *In re Meyer & Wenthe, Inc.*, 267 F.2d 945, 122 USPQ 372 (C.C.P.A. 1959); TMEP §1212.01. The ultimate test in determining acquisition of distinctiveness under Section 2(f) is not applicant's efforts, but applicant's success in educating the public to associate the claimed mark with a single source. TMEP §1212.06(b). Evidence such as advertising material must be reviewed to determine how the matter is used, the commercial impression created by such use, and what the use would mean to purchasers. *Nextel Communications, Inc. v. Motorola, Inc.*, 91 USPQ2d 1393 (TTAB 2009) (sound mark had not acquired distinctiveness in part because applicant failed to provide evidence

corroborating that the mark was used in advertisements in such a way that it would be recognized as a source identifier for cellular telephones); *In re Redken Laboratories, Inc.*, 170 USPQ 526, 529 (TTAB 1971).

The bulk of applicant's Sec. 2(f) evidence consists of hundreds of pages depicting its woven leather and other goods in its own catalogs, in fashion magazines or being worn or carried by celebrities. Such evidence merely confirms the unquestioned fact that the proposed mark is in use. However, it does not demonstrate that consumers necessarily regard applicant as the sole source for bags and shoes made from the woven configuration. In fact, applicant provides no persuasive evidence that it specifically promotes the configuration as a trademark. Applicant's suggestion that its promotional images "always focus[] on the unique look of the Bottega Veneta Weave Design"⁴¹ fails in this task since the same could be said of any advertisement depicting products offered for sale.

Likewise, applicant's described practice of not including conspicuous logos on its goods cannot reasonably be regarded as a "key visual cue"⁴² suggesting trademark significance. The numerous examples provided by the examining attorney make clear that there is nothing unique or unusual about inconspicuous or interior placement of marks on fashion goods. Applicant also makes no suggestion that it limits this practice to goods made with the subject configuration. As such, there is no reason to conclude that a lack of conspicuous logos in anyway encourages recognition of the product configuration as a trademark. If anything, such arguments illustrate the ease with which both the applicant and others may communicate to consumers that goods constructed with the same type of woven leather come from different sources. As explained by the Seventh Circuit in connection with an attempt to exclude others from a particular shape of beach towel: "If Franek is worried that consumers will confuse Jay Franco's round beach towels with his, he can imprint a distinctive verbal or pictorial mark on his towels. That will enable him

⁴¹ Response of October 6, 2009, page 21.

⁴² Applicant's Brief, page 5.

to reap the benefits of his brand while still permitting healthy competition in the beach towel market.” *Jay Franco & Sons, Inc.*, 96 USPQ2d at 1409.

Notably, while applicant’s brief describes its use of the proposed mark as “uninterrupted and widespread use for 35 years,” it does not describe it as exclusive.⁴³ Given the extensive use of the same configuration by others throughout applicant’s time of use, evidence offered by the applicant indicates at most a strong association between applicant and the proposed configuration. See *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 1403, 222 USPQ 939, 940-41 (Fed. Cir. 1984) (“When the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term or device, an application for registration under Section 2(f) cannot be successful, for distinctiveness on which purchasers may rely is lacking under such circumstances.”); *Nextel Communications, Inc. v. Motorola, Inc.*, 91 USPQ2d 1393 (TTAB 2009) (opposer’s contemporaneous use of the mark in connection with services closely related to applicant’s goods was sufficient to rebut applicant’s contention of substantially exclusive use); *Target Brands, Inc. v. Hughes*, 85 USPQ2d 1676, 1682-83 (TTAB 2007) (Substantial use of mark by opposer’s parent company and additional use of mark by numerous third parties “seriously undercuts if not nullifies applicant’s claim of acquired distinctiveness.”); *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355, 1357-58 (TTAB 1989) (“[T]he existence of numerous third party users of a mark, even if junior, might well have a material impact on the Examiner’s decision to accept a party’s claim of distinctiveness.”); *Flowers Industries Inc. v. Interstate Brands Corp.*, 5 USPQ2d 1580, 1588-89 (TTAB 1987) (“[L]ong and continuous use alone is insufficient to show secondary meaning where the use is not substantially exclusive.”).

As the examiner has demonstrated, applicant is far from the first or only producer of bags and shoes with the same look of angled plain woven leather. The fact that applicant is widely known for its dedication to this specific construction material is alone insufficient to transform the mark into a single source indicator. Moreover, the provided examples of unsolicited

⁴³ Applicant’s Brief, page 18.

references to the proposed mark as a “signature” or “trademark” of the applicant are clearly intended in a non-legal sense. As indicated in the numerous similar excerpts cited by the examining attorney, virtually anything can be deemed a “trademark” or “signature” as a way to highlight a close association between a person or entity and a particular trait or characteristic (*e.g.*, trademark cupcakes, trademark denim, signature patent leather).⁴⁴

Similarly, evidence of third party goods compared visually to the applicant’s does not support a finding that the proposed mark serves as a single source indicator, particularly given the fashionable nature of the goods. Applicant’s conclusion that such offhand references render competing goods “conceded imitations” is without merit since the statements obviously are not made by the producers of the goods. Applicant also fails to consider that such comparisons may refer to overall product design and not just to a use of plain woven leather. At most, such excerpts merely acknowledge applicant as a well-known reference point by which to compare other examples of a freely available configuration.

Applicant fails further in establishing that consumers/commentators who associate a plain woven leather configuration with the applicant, even primarily so, are not fully aware that others also employ the configuration to different degrees and that applicant’s use is but a well-known brand of a classic fashion motif. Indeed, the examining attorney easily discovered similar examples of applicant’s own products judged as imitations of motifs primarily associated with other manufacturers. These include descriptions of applicant’s goods as “a total Chanel Portobello rip-off!!!”, as “Fendi Spy-esque” and as “the exact color of the Hermes orange”.⁴⁵ It also is noted that a quilted design by the applicant “still looks like Chanel to me!”.⁴⁶ The applicant presumably would disagree that such comments constitute either evidence of its own infringement or validation of third party trademark rights.

⁴⁴ See Final Office Action of November 24, 2009, Exhibit M beginning on page 979. The include reference to a virtually identical “signature woven leather” of another design (page 1049).

⁴⁵ See Final Office Action of November 24, 2009, Exhibit N beginning on page 1061.

⁴⁶ *Id.*

In view of the foregoing, refusal under Trademark Act Sections 1, 2 and 45, and rejection of the claim of acquired distinctiveness under Trademark Act Sec. 2(f) should be affirmed.

Respectfully submitted,

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