

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: May 9, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Banana Republic (Apparel), LLC

Serial Nos. 77375273 and 77375380

J. Allison Strickland of Fross Zelnick Lehrman & Zissu PC for Banana Republic (Apparel), LLC.

Leigh A. Lowry, Trademark Examining Attorney, Law Office 115 (John Lincoski, Managing Attorney).

Before Bucher, Kuhlke and Adlin, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Banana Republic (Apparel), LLC (“applicant”) seeks registration of the mark shown below



M O N O G R A M

for “a line of higher end handbags, purses, wallets, duffel bags, credit card cases, briefcases, shaving bags sold empty, and tote bags, excluding products personalized with the intended user's initials” in International Class 18 (the “Class 18 Application”);¹ and “a line of higher end clothing, namely, belts; tops; blouses; jeans; pants; shirts; shorts; sweaters; t-shirts; vests; blazers; coats; jackets; skirts; suits; dresses; loungewear; gloves; headwear; scarves; ties, excluding products personalized with the intended user's initials” in International Class 25 (the “Class 25 Application”).² As described in each application, “[t]he mark consists of stylized letters ‘BR’ above the word ‘MONOGRAM.’” In each application, applicant claims ownership of three registrations for the stylized portion of its involved mark only, i.e. the stylized letters “BR.”³

In each application, the examining attorney refused registration absent a disclaimer of the word MONOGRAM, finding that that the term is merely descriptive of applicant's goods in both classes under Section 2(e)(1) of the Act, and that applicant's evidence of acquired distinctiveness under Section 2(f) of the Act is insufficient. After the refusals were made final, applicant appealed and requested reconsideration. In its requests for reconsideration, applicant amended its identifications of goods. Specifically, applicant's original identifications of goods included only the products in question, but applicant amended both identifications

¹ Application Serial No. 77375273, filed January 18, 2008, and amended to allege first use dates of May 31, 2008.

² Application Serial No. 77375380, filed January 18, 2008, and amended to allege first use dates of April 8, 2008.

³ Registration Nos. 3096787, 3124964 and 3248232.

to preface each with the phrase “a line of higher end” and to include at the end of each the limiting phrase “excluding products personalized with the intended user’s initials.” Applicant argued that as a result of the amendments, the mark is not merely descriptive, and also withdrew its claim of acquired distinctiveness in the Class 18 Application only. The examining attorney denied the requests for reconsideration, and in doing so added a new ground for refusal, finding that “applicant’s amendment to the identification[s] of goods to exclude ‘products personalized with the intended user’s initials’ renders the MONOGRAM portion of the mark [deceptively] misdescriptive under Section 2(e)(1).” The appeals resumed and the Board consolidated them. Applicant and the examining attorney have filed briefs.

Analysis

In her appeal brief, the examining attorney makes clear that the disclaimer requirement is based on her finding that MONOGRAM is both merely descriptive and deceptively misdescriptive of the goods, as amended. Examining Attorney’s Brief at 1-2. We address each issue separately, recognizing that under Section 6(a) of the Act, “[t]he Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable,” such as a component which is merely descriptive or deceptively misdescriptive under Section 2(e)(1). Failure to comply with a disclaimer requirement is a ground upon which registration may be refused. *See In re Slokevage*, 441 F.3d 957, 78 USPQ2d 1395, 1399-1400 (Fed. Cir. 2006); *In re Stereotaxis, Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005).

Disclaimer Requirement Based on Mere Descriptiveness⁴

A mark is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828 (Fed. Cir. 2007); and *In re Abcor Development*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A mark need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; rather, it is sufficient that the mark describes one significant attribute, function or property of the goods or services. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). Whether a mark is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with the goods or services, and the possible significance that the mark would have to the average purchaser of the goods or services because of the manner of its use. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

⁴ In its April 4, 2011 request for reconsideration after final action, applicant did not continue to argue against the refusal based on mere descriptiveness. Instead, applicant stated "in view of the Office's continuing requirement, applicant will defer to the Office's determination in order for its application to proceed. However, applicant claims that its mark has acquired distinctiveness" It is settled that where an applicant "amends its application to seek registration based on acquired distinctiveness without expressly reserving its right to argue that its mark is inherently distinctive," it is deemed to have admitted that its mark is not inherently distinctive. *See e.g. In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1713 (TTAB 2011). While applicant's apparent attempt to reserve its right to continue arguing that its mark is not merely descriptive was vague at best, we do not find that applicant waived its right to continue claiming inherent distinctiveness. In the future, however, applicant should take significantly greater care in reserving its rights.

It is settled that “[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them.” *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002).

Here, the examining attorney relies in part on the following dictionary definitions of “monogram”: (1) “[a] design composed of one or more letters, typically the initials of a name, used as an identifying mark”;⁵ and (2) “a design of one or more letters, usually the initials of a name, used to decorate or identify an object.”⁶ Office Action Feb. 11, 2008. Based on these definitions, the examining attorney argues that MONOGRAM describes a feature of applicant’s goods, specifically that they sometimes include “the initials of the designer, sometimes in a repetitive or wallpaper pattern, but also in a single instance like a conventional monogram.” Examining Attorney’s Brief at 5.

For example, the examining attorney relies on, *inter alia*, the following evidence:

- a printout of a Style File blog entry entitled “Letter Men” from the “style.com” website which states: “On Wednesday, Phillip Lim embroidered a sweater with the ‘Laverne & Shirley’-style PL monogram. Then, last night, Zac Posen trotted out a top emblazoned with his own moniker. The third designer to get in on the act? None other than Ralph Lauren, who studded the pocket of a red plaid shirt with a rhinestone RL. Three makes a trend;

⁵ *American Heritage Dictionary of the English Language* (4th ed. 2000).

⁶ *Encarta World English Dictionary* (North American Edition 2002).

monogrammers should be doing a booming business come fall.” Office Action Nov. 15, 2011;

- printouts from the “purseuing.com” website which describe and picture: (1) a Michael Kors Jet Set Monogram Milo Large Shoulder Tote, which bears the initials MK; (2) a Coach Pop C Large Spotlight Handbag, which bears “graphic Coach monogram decals” that appear as the letter “C;” and (3) a Louis Vuitton Monogram Canvas Etoile Shopper which bears the letters “LV;” *id.*;

- printouts from the “michaelkors.com” website which offers a wide variety of totes, bags, wristlets, satchels and wallets bearing the initials “MK;” *id.*;

- a printout from the “stylehive.com” website promoting *applicant’s* BR Monogram logo pocket square which bears applicant’s involved mark. *id.*;

- printouts from the “piperlime.gap.com” website which offers the Juicy Couture JC Monogram Ms. Daydreamer shoulder bag bearing the initials “JC” and the Michael Kors Grayson Large Jet Set Monogram satchel bag bearing the initials MK, Office Action June 11, 2012; *id.*;

- a printout from the “luxedesignerhandbags.com” website offering a pre-owned Gucci Black Monogram Large Tote bag bearing Gucci’s “G” monogram; *id.*;

- printouts from the “louisvuitton.com” website offering various clothing items and bags bearing the Louis Vuitton monogram “LV;” *id.*; and

- a printout from the “macys.com” website offering a Calvin Klein Handbag, Brasil Monogram Signature Tote bearing the Calvin Klein monogram “CK;” *Id.*

The examining attorney also argues that MONOGRAM “merely describes that the identified goods feature or can feature monograms” in the form of the user’s

initials. For example, the examining attorney relies on, *inter alia*, the following evidence:

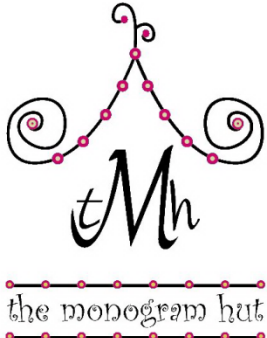

- printouts from the “Monogramming and Engraving” section of the “brooksbrothers.com” website which allows users to add initials to their clothing or tote bag purchases and offers a variety of “monogram styles,” “monogram colors” and “monogram locations” for the chosen initials; Office Action Feb. 11, 2008;
- printouts from the “Create Your Own Skinny Polo” section of the “ralphlauren.com” website which allows users to add initials in a variety of colors to their purchased shirts; *id.*;
- printouts from the “Monogramming” section of the “landsend.com” website which allows users to add initials to their clothing, tote bag, toiletry kit and duffle bag purchases, in a variety of styles; *id.*;
- printouts from “The Monogram Shop” section of the “jcrew.com” website which allows users to add initials to their purchased clothing and tote (beach) bags, in various colors and styles; Office Action Oct. 4, 2010;
- printouts from the “talbots.com” website which offer the option to add initials to purchased clothing; *id.*;
- printouts from the “garnethill.com” website which offer the option to add initials to purchased clothing; *id.*;
- printouts from the “Monogramming” section of the “hartmann.com” website which states that “Monogram personalization is a great way to make a Hartmann item truly your own” and provides prices for adding initials to “business cases,” “personal leather goods” and “luggage tags” in a variety of styles; *id.*;
- printouts from the “Monogramming” section of the “llbean.com” website which offers the option to add initials to purchased clothing, duffle bags and other luggage; *id.*;

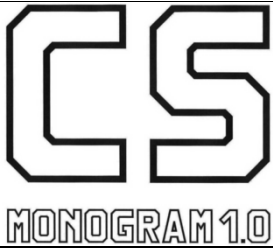
- printouts from the “Personalize” section of the “orvis.com” website which offers the option of adding initials to purchased items; *id.*;
- a printout of an article from the “style.com” website which states “What’s better than a Louis Vuitton monogram bag? A Louis Vuitton bag with your own monogram on it. That’s the thinking behind the house’s Mon Monogram service. The company has been allowing customers to personalize luggage and smaller items like wallets for a while ...,” Office Action Nov. 15, 2011;
- a printout of a Style File blog entry entitled “Letter Men, Prada’s Calling,” from the “style.com” website which states: “But for the guys, [Miuccia Prada] threw in an additional detail – bags and belt-slung sacs embroidered with oversized, varsity-jacket-style lettering ... Starting January 15, backpacks, trolleys, and shopping bags in saffiano leather or camouflage print can be customized with made-to-order multicolored saffiano leather letters. The service will be available on prada.com and at twelve Prada stores worldwide,” *id.*;⁷
- a printout of the “Custom Bags” section of the “longchamp.com” website which offers customization of purchased handbags and purses. *id.*;
- a printout from the “Custom Monogram Shop” section of the “juicycouture.com” website which offers the option to add initials to purchased clothing items; Office Action June 11, 2012;
- printouts from the Little Monogram Shop’s “thelittlemonogramshop.net” website which offers “personalized gifts for every occasion, including clothing; *id.*; and
- printouts from The Monogram Shop’s website “cvillemonogramshop.com” which offers “unique,

⁷ The examining attorney relies on a substantively similar “tweet” by @thepop referencing personalization and monogramming services available at Gucci’s London store. Because this evidence concerns services offered outside of the United States, it has been given no consideration.

personalized gifts for all occasions” including cosmetic and tote bags and clothing. *Id.*

Finally, the examining attorney relies on a number of “live” trademark registrations which include the word MONOGRAM and which are either registered on the Supplemental Register or in which the word MONOGRAM is disclaimed, including the following:

Mark	Owner	Register/No.	Disclaimer	Goods/Services
Monogram Market	Monogram Market, Inc.	Supplemental /3559289	MARKET	Retail store services featuring personalized goods and gifts
EMB EMBROIDERY/ MONOGRAM BUSINESS	VNU Business Media, Inc.	Principal/ 2623117	EMBROIDERY /MONOGRAM BUSINESS	Publications, namely, magazines in the field of screen printers, embroidery, monogram and decorated apparel
	Dodie Robertson	Principal/ 3284575	MONOGRAM	Monogramming of clothing
	Notcina Corp.	Principal/ 3190909	MONOGRAMS and DIGITIZING SOFTWARE	Computer software for automatically digitizing and converting monogram patterns to stiches, for use in home and industrial type embroidery machines
MRS. MONOGRAM	Johnston Design	Principal/	MONOGRAM	Embroidery and

	Associates, LLC	3218931		stitching services
Monarch Monograms	Ellen Luckett Baker	Principal/ 3225059	MONOGRAMS	Embroidering; Embroidery services
	Car Shoe SA	Principal/ 3910338	MONOGRAM	Footwear
MONOGRAM EMPREINTE	Louis Vuitton Malletier Société Anonyme	Principal/ 3924902	MONOGRAM	... traveling bags ... handbags ...
DELIGHTFUL MONOGRAM	Louis Vuitton Malletier Société Anonyme	Principal/ 4021248	MONOGRAM	... traveling bags ... handbags ...

This evidence establishes that the word MONOGRAM is merely descriptive because it identifies a common feature of bags and clothing. In fact, it is clear from the evidence of record that tote bags, wallets, shirts, jackets and other products identical or similar to those applicant offers under the involved mark commonly bear the initials, or “monogram,” of their designers. Applicant’s argument that its goods are not likely to be monogrammed because those offered under the involved mark are “high end” is belied by the evidence that designers of high end products such as Phillip Lim and Louis Vuitton affix their initials to products included in applicant’s identifications of goods. Similarly, applicant’s specific exclusion of “products personalized with the intended user’s initials” does not change the result because the examining attorney has established that designers’ initials, as opposed to those of intended users, often appear on applicant’s products.⁸

⁸ Notwithstanding applicant’s assertions to the contrary during prosecution of the applications, the examining attorney has also introduced evidence that applicant offers a BR MONOGRAM (Stylized) logo pocket square. Office Action Nov. 15, 2011 (printout from

Furthermore, even though applicant does not seek registration for “products personalized with the intended user’s initials,” the evidence of record leaves no doubt that applicant’s goods are commonly personalized with their user’s initials by other sellers of clothing and bags, and thus MONOGRAM describes a feature of clothing and bags. The assertion that applicant itself does not monogram its products does not impact the mere descriptiveness of MONOGRAM because applicant’s products may still be monogrammed by a third party, after their purchase from applicant.

Finally, the third-party registrations in which MONOGRAM is disclaimed or registered on the Supplemental Register provide further evidence that the term is merely descriptive of applicant’s goods. *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793, 1797 & n.1 (Fed. Cir. 1987).

Applicant’s arguments against the disclaimer requirement are unavailing. Applicant first argues that “[t]he primary significance of the term MONOGRAM in the Applicant’s Mark is that the Applicant’s goods are the Applicant’s high-end, high-quality line. A typical consumer will interpret MONOGRAM in the Mark exactly like the similar word SIGNATURE in other marks as indicating that the goods are the trademark owner’s best, most fashionable and most prestigious.” Applicant’s Brief at 8. There is absolutely no evidence, however, that the word

“stylehive.com”). And one of the articles upon which applicant relies reports that one of applicant’s employees told a reporter that applicant was “working on” offering its own monogramming services. Manley Dec. Ex. D (“Banana Republic, Monogram and the Compromise of ‘Affordable Luxury’,” *Men’s Flair*, April 12, 2008).

“monogram” conveys this meaning to “typical consumers,” and the alleged meaning is belied by the only dictionary definitions of record.

We recognize that applicant promotes BR MONOGRAM as its “higher end” line, including on social networks where applicant has many followers, and by sending an “advertising mailer” to customers in the Fall of 2008 which described BR MONOGRAM as a “limited edition collection, defined by exquisite fabrics, distinctive details and modern silhouettes. Monogram is our most eloquent expression of style.” Declaration of Kristen Manley, applicant’s Corporate Counsel for Brand Services, submitted with Office Action response of October 21, 2011 (“Manley Dec.”) Ex. B.⁹ Similarly, New York City’s tourism website included a listing for applicant’s BR MONOGRAM “pop up,” i.e. temporary, Manhattan store which opened in 2008, and the listing describes the BR MONOGRAM line as “similar to the company’s tried-and-true classic style, but ... less ‘everyday,’ with slightly higher prices and even better quality fabrics than Banana Republic’s already high-caliber clothing.” *Id.* Ex. C; *see also, id.* Exs. D-F (articles from, *inter alia*, Women’s Wear Daily, “portfolio.com,” DNR, Luxist, “msnbc.com,” and New York Post describing the pop up store as “upmarket,” “upscale,” and “higher-priced,” and BR MONOGRAM as a “signature label”). However, much of this evidence is from the first half of 2008, when the temporary store was in operation, and even if certain of applicant’s customers have come to associate the term “monogram” with

⁹ Ms. Manley submitted two declarations, one for the Class 18 Application and another for the Class 25 Application. They are extremely similar, and unless otherwise indicated, citations are to the declaration submitted with the Class 18 Application.

applicant's “higher end” line, the other evidence of record, including the only dictionary definitions, establishes that “monogram” is most commonly used to signify a user’s or designer’s initials, rather than applicant’s or another party’s “higher end” collection. Perhaps more importantly, because applicant seeks registration of a composite mark, comprised of applicant’s own monogram BR and the word MONOGRAM, consumers will be more likely to associate the word MONOGRAM with applicant’s BR monogram, placed in close proximity thereto, than with an upscale collection, especially where the references to the intended “upscale” connotation are online, in certain articles or in promotional materials presumably not at consumers’ fingertips, whereas consumers will be directly presented with applicant’s mark containing its BR monogram in close proximity to the word MONOGRAM. Moreover, most of the references to the intended “upscale” connotation do not display applicant’s involved mark. In short, applicant’s promotion of and the unsolicited media attention accorded to BR MONOGRAM is simply not enough to overcome the commonly understood meaning of “monogram,” especially where a large number of third party sellers and ultimate users of bags and clothing, not to mention applicant itself, use the term “monogram” as the record shows it to be commonly understood.¹⁰

¹⁰ Applicant’s argument that MONOGRAM is not descriptive because it has multiple meanings, including those cited by the examining attorney and the connotation of the “best and highest quality,” as urged by applicant, is unavailing. *In re IP Carrier Consulting Group*, 84 USPQ2d 1028, 1034 (TTAB 2007) (“The fact that ‘pipe’ has multiple meanings, some of which are not descriptive, is not controlling or relevant to the descriptiveness analysis. So long as any one of the meanings of a word is descriptive, the word may be merely descriptive.”).

Applicant next argues that the examining attorney erred “in equating the word ‘monogram’ (a noun) with the word ‘monogrammed’ (an adjective) ... A shirt bearing a purchaser’s initials as a monogram is a ‘monogrammed shirt,’ not a ‘monogram shirt,’ in common speech.” Applicant’s Brief at 11-12 (emphasis in original). We are not persuaded. The dictionary definitions and other evidence of record make clear that “monogram” means a user’s or designer’s initials placed on objects, even if those objects may also be described as “monogrammed.”¹¹ Applicant’s reliance on *In re Gentex Corp.*, 150 USPQ 828 (TTAB 1966) is misplaced, because in that case there was no evidence that the mark RIOTER merely described “protective helmets”; in this case, by contrast, there is a great deal of evidence that MONOGRAM merely describes a feature of applicant’s goods.

Finally, applicant introduced printouts from Office records regarding 38 third-party Principal Register trademark registrations including the word MONOGRAM which is not disclaimed, and argues that they establish that MONOGRAM is a source identifier and that consumers will perceive it as such. This evidence is not persuasive, however, because none of the registrations are for clothing or bags. Instead, applicant relies on registrations for products such as “chocolate coating,” “cleaning preparations for toilets,” “mops,” “student loan services” and a wide range of other products and services which do not generally bear the initials of their user

¹¹ Applicant’s suggestion that the distinction between nouns and adjectives is necessarily relevant to the question of mere descriptiveness is inaccurate. See *In re Central Sprinkler Co.*, 49 USPQ2d 1194, 1199 (TTAB 1998).

or designer. In this case, by contrast, we are concerned with clothes and bags, and the evidence establishes that these are goods that commonly bear a monogram.

In short, the evidence of record leaves no doubt that MONOGRAM is merely descriptive of applicant's high-end clothing, handbags, purses and other products, even though none of those products are "personalized with the intended user's initials" by applicant itself. Accordingly, the disclaimer requirement on the basis of mere descriptiveness is affirmed.

Disclaimer Requirement Based On Deceptive Misdescriptiveness

Under Section 2(e)(1) of the Act, terms that are deceptively misdescriptive of the goods to which they are applied are unregistrable. "The test for determining whether a term is deceptively misdescriptive involves a determination of (1) whether the matter sought to be registered misdescribes the goods and, if so, (2) whether anyone is likely to believe the misrepresentation." *In re White Jasmine LLC*, 106 USPQ2d 1385, 1394 (TTAB 2013).

Here, the dictionary definitions and other evidence of record make clear that MONOGRAM misdescribes applicant's goods. Indeed, MONOGRAM is defined as a design, "typically" or "usually" the "initials of a name," which is used to "decorate" or "identify" an object. But applicant's goods specifically exclude "products personalized with the intended user's initials," and thus the use of MONOGRAM is misdescriptive.¹²

¹² Neither of applicant's specimens of use show use of the involved mark directly on applicant's goods. Rather, applicant's specimens consist of a sign on the wall of one of applicant's stores, a detachable hangtag affixed to clothing and a hanger bearing the mark on which applicant's clothes are hung. To the extent that any of applicant's goods bear the

The evidence of record also establishes that consumers are likely to believe the misrepresentation. In fact, the evidence establishes that companies which offer clothing, tote bags, purses and related products often offer monogramming services, specifically the ability to personalize these goods with the intended user's initials. Here, however, applicant's mark includes MONOGRAM but applicant will not offer this type of monogramming service, as many of its competitors do and consumers have therefore come to expect.

In short, the evidence of record leaves no doubt that MONOGRAM is deceptively misdescriptive of applicant's high-end clothing, handbags, purses and other products, precisely because none of those products are "personalized with the intended user's initials," as consumers have come to expect that such goods may be monogrammed, by applicant or another entity. Accordingly, the disclaimer requirement on the basis of deceptive misdescriptiveness is affirmed.

Acquired Distinctiveness

Applicant bears the burden of establishing that its mark has acquired distinctiveness under Section 2(f) of the Act. *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005). In determining whether applicant has met this burden, "the Board may examine copying, advertising expenditures, sales success, length and exclusivity of use, unsolicited media coverage, and

involved mark, consumers will interpret the word MONOGRAM as describing the stylized initials BR appearing directly above it.

consumer studies (linking the name to a source),” though “no single factor is determinative.” *Id.*

It is settled that “the applicant’s burden of showing acquired distinctiveness increases with the level of descriptiveness; a more descriptive term requires more evidence of secondary meaning.” *Id.* (citing *In re Bongrain Intern. (Am.) Corp.*, 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990)). Here, for the reasons set forth above, we find that applicant’s mark is highly descriptive, and that applicant’s burden is “concomitantly high.” *Id.*

Applicant has not met this burden. It introduced a copy of one advertisement in *Vogue*, Manley Dec. Ex. A, but that advertisement bears only the stylized initials BR (which as indicated is separately used and registered), without the accompanying MONOGRAM which is part of the involved mark and the part which is subject to the disclaimer requirement. And while Ms. Manley testified generally that applicant ran other advertisements of some type in other unspecified publications, it is not clear whether these advertisements included the involved mark or were like the one in *Vogue*. Applicant’s mailer, discussed above and included as Exhibit B to the Manley declaration, includes the involved mark, as does applicant’s website, if sporadically, but all told applicant’s promotional efforts are underwhelming at best, especially because applicant and others often do not use the involved mark, but instead only the words BR MONOGRAM or simply MONOGRAM, and because applicant does not provide any quantitative information on its promotional efforts. Similarly, the publications and websites which mention

BR MONOGRAM usually do not display the involved stylized mark as it appears in the drawing, and the quantity of this evidence is also insufficient, especially for a mark as highly descriptive as applicant's. Applicant has sold "hundreds of thousands of dollars worth" of goods identified in the Class 18 Application and "tens of millions of dollars worth" of goods identified in the Class 25 Application. Manley Dec. in Class 18 Application ¶ 13; Manley Dec. in Class 25 Application ¶ 14. However, this evidence is insufficient, especially given that applicant's mark is highly descriptive, as it is unclear whether applicant's sales success is a function of the products' popularity (as opposed to consumer recognition of the involved mark), or derives from the stylized BR component of applicant's mark (as opposed to the mark in the drawing at issue). *See In re Bongrain*, 894 F.2d at 1316, 13 USPQ2d at 1729.

More importantly, the quantity and quality of evidence of use of MONOGRAM by third parties establishes that applicant's mark has not acquired distinctiveness. To the contrary, the evidence that Phillip Lim, Ralph Lauren, Zac Posen, Michael Kors, Coach and Louis Vuitton, among others, monogram some of their bags and clothes with their own initials, and the evidence that Brooks Brothers, Ralph Lauren, Lands End, J. Crew, Talbots, Garnet Hill, Hartmann, L.L. Bean, Orvis and Juicy Couture offer monogramming services for clothes and bags, all establish that applicant's use of MONOGRAM is anything but "exclusive." *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 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.”); *see also*, *Racine Industries Inc. v. Bane-Clene Corp.*, 35 USPQ2d 1832, 1840 (TTAB 1994).

Applicant’s Request for Remand

In the event the disclaimer requirement is affirmed, applicant requests in the alternative, in its brief, and for the first time since the appeal resumed, that this case be remanded to the examining attorney “to consider 2(f) evidence based on five years’ continuous use,” pointing out that by the time the appeal is decided, “the fifth anniversary of Applicant’s first use date in early 2008 will likely have passed.” The examining attorney objects to remand.

We decline applicant’s alternative request. As TBMP § 1205.01 (3d ed. rev. 2012), upon which applicant relies, makes clear, the Board has the discretion to deny a request for remand, including when it “would serve no useful purpose.” Here, remand would serve no useful purpose because MONOGRAM is so highly descriptive, and so extensively used by third parties, that evidence that applicant has used its mark for more than five years would be insufficient to establish acquired distinctiveness. *In re Ennco Display Systems, Inc.*, 56 USPQ2d 1279, 1286 (TTAB 2000) (while Board may consider evidence of continuous use for more than five years, “the language of the statute is permissive, and the weight to be accorded this kind of evidence depends on the facts and circumstances of the particular case”). Applicant has already submitted what would be considered stronger

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evidence of acquired distinctiveness, and a declaration stating that its mark has now been used for five years would not add to the weight of the evidence.

Conclusion

After careful consideration of all of the evidence and argument presented, including evidence and argument not specifically discussed herein, we find that there is no doubt that MONOGRAM is merely descriptive and deceptively misdescriptive, and without acquired distinctiveness, for the goods identified in applicant's Class 18 Application and Class 25 Application.

Decision: The refusal to register in the absence of a disclaimer of MONOGRAM is affirmed. This decision will be set aside if, within thirty days of the mailing date of this order, applicant submits to the Board a proper disclaimer of MONOGRAM in each application. Trademark Rule 2.142(g). The disclaimer should be worded as follows: "No claim is made to the exclusive right to use the word MONOGRAM apart from the mark as shown."