

TTAB

Docket No.: 2202.008
Serial No.: 78/444,562

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD



Appellant: LA LOOP, LLC

Docket No.: 2202.008

Serial No.: 78/444,562

Law Office: 115

12-27-2005

U.S. Patent & TMO's/TM Mail Rcpt Dt. #11

Filing Date: July 1, 2004

Attorney: Barbara A. Gaynor

Trademark: SPORTLOOP

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451, on December 23, 2005.

Victor A. Cardona, Esq.
Attorney for Applicant(s)
Registration No. 44,589

Date of Signature: December 23, 2005

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1450

BRIEF FOR APPELLANT

INTRODUCTION

Pursuant to a Notice of Appeal filed with the Trademark Trial and Appeal Board on November 28, 2005, the Appellant hereby appeals from the Examining Attorney's final refusal to register the above-identified mark, dated May 31, 2005, and respectfully requests the Trademark Trial and Appeal Board to reverse the Examining Attorney's decision on the grounds that the Appellant's mark includes an acceptable identification of goods which conforms to the specimen submitted.

STATEMENT OF FACTS

Appellant filed a trademark application seeking registration on the principal register of its mark "SPORTLOOP" for necklaces. The trademark application was filed on July 1, 2004, and was assigned application number 78/444,562.

The Examining Attorney initially refused registration of Appellant's mark "SPORTLOOP" in an Office Action dated February 7, 2005 citing that the specimen (included as **Appendix A**) submitted did not match the identification of goods. Instead, the Office Action alleged that the specimen was for a "lanyard" which was argued to be "a cord worn around the neck for carrying something, such as a knife or whistle" per the definition included from the American Heritage Dictionary of the English Language (4th Ed. 2000). Lanyards were alleged to be in International Class 22. Appellant was instructed to submit a substitute specimen, or substitute a different basis for filing of the trademark application.

Appellant responded to the Office Action in a response dated April 12, 2005. Appellant amended the identification of goods to read "necklaces having orifices from which items, namely, eyeglasses, may be hung". Appellant also included a definition of necklace which is defined as "an ornament worn around the neck". Appellant further presented arguments that the goods utilized in connection with "SPOORTLOOP" is not merely a "lanyard", and instead the necklace associated with "SPORTLOOP" is ornamental. Further, the revised identification of goods allows the ornamental necklaces to also receive eyeglasses thereby satisfying the utilitarian function argued by the office in the specification of the word "lanyard".

The Examining Attorney issued a final refusal to register the mark in an Office Action dated May 31, 2005. The Office Action continued to assert that a "lanyard" was

different than the “necklace” argued by Appellant. The Examining Attorney continued to request a substitute specimen or a change in the filing basis for the application.

ARGUMENT

The Examining Attorney refused registration under 37 C.F.R. § 2.56 because the specimen was alleged to not show use of the mark for the specified goods. Appellant respectfully requests reversal of this refusal based on the remarks set forth below.

Appellant’s amended identification of goods recites:

“Necklaces having orifices from which items, namely, eyeglasses, may be hung.” In International Class 14.

As shown in **Appendix B** attached, the goods associated with the present application are a necklace having a loop attached thereto, which may be utilized to hang eyeglasses, for example. The goods may be ordered in a variety of colors or patterns as desired by a purchaser. Also attached hereto as **Appendix C** is a entry from Merriam-Webster’s on-line dictionary, which defines a necklace as “an ornament worn around the neck”.

Appellant asserts that this a “basic and widely available dictionary which may be used to determine the definition or understanding of a commonly used word.” TMEP § 1402.03.

As described above, the Examining Attorney has alleged that the goods associated with the present application are a “lanyard” and not a “necklace”. The Examining Attorney cites a definition from the American Heritage Dictionary of the English language which defines a lanyard as “a cord worn around the neck for carrying something, such as a knife or whistle”. Thus, the Examiner appears to allege that a lanyard is a cord which is used in a utilitarian manner to carry something, such as the knife or whistle cited in this definition.

The Examining Attorney also has cited pages of Appellant's website relating to this product, including **Appendix B**, referenced above, which depicts the colors and patterns which a user may choose from when ordering this product. In the Office Action dated May 31, 2005, the Examining Attorney also included a page (**Appendix D**) from Appellant's website, which describes the success of Appellant's business. More particularly, this page describes the "SPORTLOOP" product as being an "over-the-head, stretch-cord and molded-plastic, colorful, washable, and fun version of LA LOOP [that] was the hit of the summer with the trendy, active crowd". This page also describes setting "the tone for stylish and elegant seasonal collections of La Loop necklaces". La Loop is described as attracting the attention of the international press, including Vogue, Elle, In Style, The New York Times, London Time, and Le Figaro, to name a few. The products from La Loop are described as being of "high quality and sophisticated styling". The "lanyard" described by the Examining Attorney" is a mere utilitarian article that would not attract the attention of the indicated publications nor would it be considered stylish. As noted above, the definition of "necklace" merely indicates that it is an "ornament worn around the neck." The SPORTLOOP product is clearly an ornament, and Appellant has achieved international recognition from creating such stylish products.

Further, **Appendix B** describes the "SPORTLOOP" product as being a "... fun, washable, activewear model of LA LOOP" which comes in various colors. In the header for the SPORTLOOP website (e.g., **Appendix E**), LaLoop.com is described as being a "collection of luxurious necklaces designed to keep eyewear in place." The "SPORTLOOP" product is sold on this website under this header and is therefore advertised by Appellant to be a necklace. A further review of the LA LOOP.com website

depicts various other necklaces. Such elegant versions can cost several hundreds of dollars. The “lanyard” referred to by the Examining Attorney and which the dictionary cited describes as carrying a knife or whistle would not likely command such a price, unless its main purpose and appeal was style rather than simply function. More particularly, the cost of the products on Appellant’s website would make it clear to a purchaser that they are paying for the ornamental aspects of the product and not merely another means for transporting a whistle or knife. Further, attached hereto as **Appendix F** is an image from the New York Times which describe one of Appellant’s products as being an eyewear necklace which is “a rare bauble that also has utility.” Such descriptions make clear that the La Loop products are prized for their ornamental aspects in addition to their utility for holding eyewear.

Thus, the SPORTLOOP product is a necklace and is clearly associated with other necklaces by Appellant on its website. Further, as described above, the SPORTLOOP product may be ordered in various ornamental colors and patterns.

Therefore, Appellant respectfully submits that the revised identification of goods (i.e., “necklaces having orifices from which items, namely, eyeglasses, may be hung”) is acceptable and conforms with the specimen (**Appendix A**). The specimen is clearly for an ornamental product worn around the neck, thereby making it a “necklace”.

Appellant also acknowledges that the Examining Attorney has searched the office records and found no similar registered or pending marks which would bar registration under the Trademark Act. Accordingly, Appellant respectfully requests that Appellant’s “SPORTLOOP” mark be allowed to proceed to publication.

CONCLUSION

For the reasons set forth hereinabove, Appellant submits that the identification of goods conforms to the specimen submitted and that the mark is entitled to registration. The Board is therefore respectfully requested to reverse the Examiner's decision refusing registration of Appellant's Mark.

Respectfully submitted,



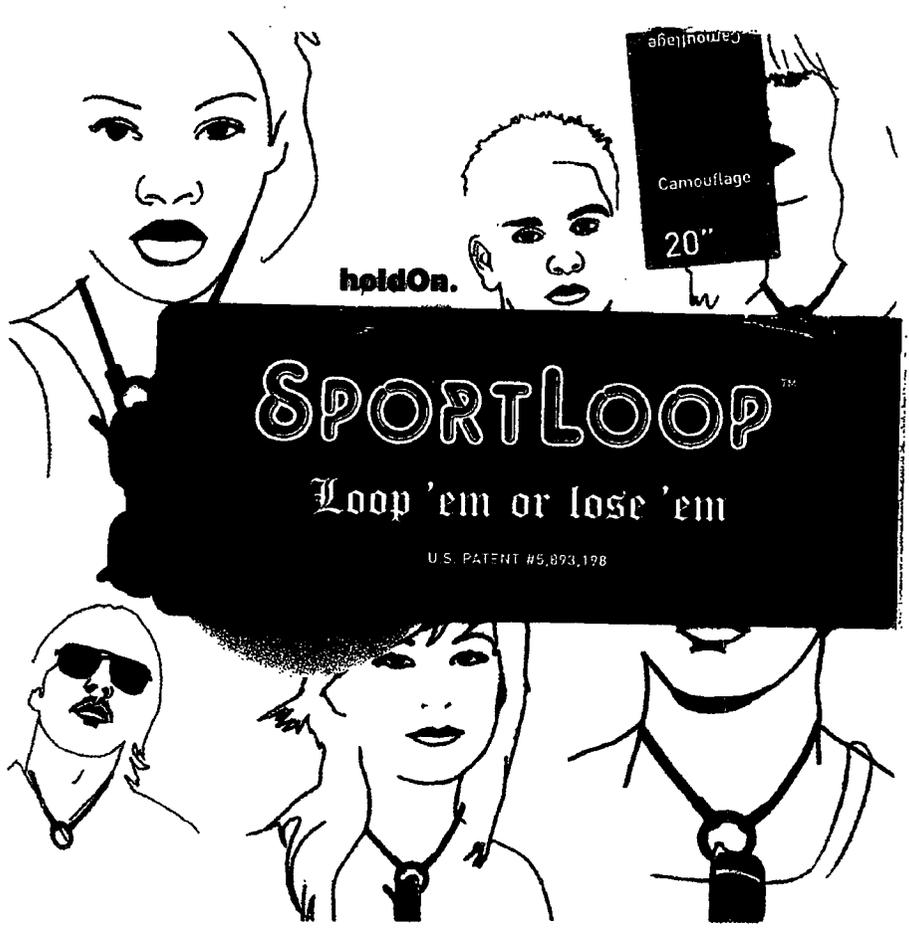
Susan E. Farley, Esq.
Registration No. 31,833

Victor A. Cardona, Esq.
Registration No. 44,589
Attorneys for Appellant

Dated: December 23, 2005

HESLIN ROTHENBERG FARLEY & MESITI P.C.

5 Columbia Circle
Albany, New York 12203
Telephone: (518) 452-5600
Facsimile: (518) 452-5579



holdOn.

SPORTLOOP™
Loop 'em or lose 'em
U.S. PATENT #5,893,198

SPORTLOOP

SHOP

ABOUT US

PRESS

CUSTOMER SERVICE

MY ACCOUNT

CHECKOUT

SPORTLOOP IS A STRETCHED OVER-THE-HEAD, FUN, WASHABLE, ACTIVEWEAR MODEL OF LALOOP

COMES IN THESE ASSORTED COLORS

- | SOLIDS | ULTRA BRITES | CHECKED |
|---|---|--|
|  BLACK |  ACID YELLOW |  CAMO |
|  KHAKI |  HOT PINK |  REGGAE |
|  WHITE |  GLO ORANGE |  FLAG |
|  RED | CAMPUS |  LATTE |
|  ORANGE |  BLUE / WHITE | |
|  BLUE |  BLUE / GOLD | |
|  TURQUOISE |  MAROON / GOLD | |
|  NAVY | | |



TO FIND A SPORTLOOP RETAILER NEAR YOU, CALL 1-877-505-1500

laloop **LOOP**



Merriam-Webster OnLine

Merriam-Webster FOR KIDS

Encyclopædia BRITANNICA

Merriam-Webster ONLINE

Merriam-Webster COLLEGIATE[®]

Merriam-Webster

Pearl Necklace

Get wholesale prices on flawless pearls. Money back guarantee!

Fine Turquoise Necklaces

All Necklaces are Handcrafted. Several Designs & Styles in Stock.

Huge Selection Of Jewelry

ships within 24 hrs. Huge selection and savings on 14k

Sterling Silver

Custom Name Qu Classic Script Styl

HOME

PREMIUM SERVICES

- M-WCollegiate.com
- M-WUnabridged.com
- Britannica.com
- Multi-User Licenses

DOWNLOADS

- WORD OF THE DAY
- WORD GAMES
- WORD FOR THE WISE
- ONLINE STORE
- HELP

Merriam-Webster Inc. Company Information

Merriam-Webster Online Dictionary

One entry found for **necklace**.

Thesaurus

Main Entry: **neck·lace**

Pronunciation: 'ne-k1&s

Function: *noun*

: an ornament worn around the neck

For More Information on "necklace" go to Britannica.com

Get the Top 10 Search Results for "necklace"



Pronunciation Symbols

Ac

Merriam-We

© Diction

○ Thesaur



necklace

Palm & P

Browse and d Merriam-Web e-books and (Palm and Poc and Mobile P Merriam-V Online Sto

Handheld Collegiate

Now you can Eleventh Editi anywhere as new Speaking Handheld! Franklin.cc

Merriam Colleg 14-day F

Products

Premium Services

Company Info

Contact Us

Advertising Info

Privac

© 2005 Merriam-Webster, Incorporated



SHOP ABOUT US PRESS CUSTOMER SERVICE MY ACCOUNT CHECKOUT

LA LEASH
LA LOOP

> BIOS

ABOUT US

FUNCTIONS

Next Zoullas created a partnership with Elizabeth Faraut, whose background in product development and marketing (Guerlain, Guess Jeans) help set the tone for stylish and elegant seasonal collections of la LOOP necklaces that integrated the highest quality materials with international fashion trends.

In a remarkably short period of time, not only did la LOOP become the premier accessory in the eyewear industry, but it also attained cult status among the thousands of devoted customers, collectors and celebrities who discovered la LOOP around the world. Now available in over 500 high-end stores throughout Europe, Asia, Australia and the United States, la LOOP also attracted the attention of the international press, including Vogue, Elle, InStyle, The New York Times, London Times, Le Figaro, to name a few.

With the extraordinary, rapid success of la LOOP, the design, manufacturing and distribution partnership of Zoullas and Faraut became firmly established which intensified their mission to provide creative solutions to everyday problems with products of high quality and sophisticated styling. From the outset, they believed that a vast marketplace of overextended and style-conscious professionals, parents, students and homemakers, was not being addressed with modern accessories that both served a function and looked great on. Into this mix, two other product launches in the past year have attracted great attention and extended sales further.

SportLOOP, an over-the-head, stretch-cord and molded-plastic, colorful, washable and fun version of la LOOP was the hit of the summer with the trendy, active crowd.

La LEASH was created to keep the obvious list of other necessities always within reach, most notably the cell phone, but also IPOD, pen, keys, ID, MetroCard and more. Designed with Italian leather cord and a Sterling Silver clasp, la LEASH is also available with attachable pochettes, IPOD holders with more attachments to come...

Everything about us is really about providing you with just the right tools for the modern-day life of ease and style.

HOME

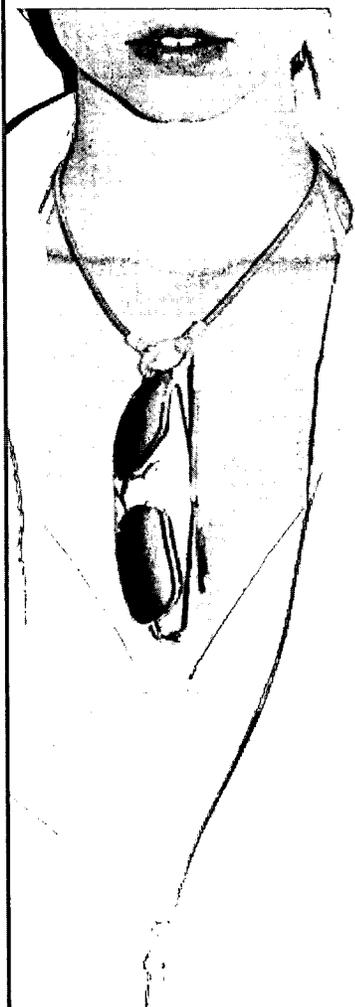
SHOP

ABOUT US

PRESS

CUSTOMER SERVICE

MY ACCOUNT



SPORTLO

Loop 'em or lose 'em

The perfect way to keep track of your sunglasses
you're on the move - from skateboarding
to biking, to everyday running around

[WATCH VIDEO](#)

[THE PRODUCT](#)

THE NEW YORK TIMES, SUNDAY, MAY 5, 2002

PULSE: MOTHER'S DAY

Ellen Tien



**All Eyes Front
And Center**

Instead of jewelry give her a rare bauble that also has utility. La Loop's eyewear necklace holds eyeglasses with style. Seen on celebrities like Julia Roberts and Steven Meisel, the chains come in links of silver, leather or tortoise shell (\$85 to \$175 at Robert Marc, 212-737-6000).