This Opinion is Not a
Precedent of the TTAB

Oral Hearing: December 12, 2019 Mailed: April 15, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Valentino S.P.A.

Serial No. 79228160

Leo M. Loughlin of Rothwell Figg Ernst & Manbeck PC,
for Valentino S.P.A.

Karen S. Derby, Trademark Examining Attorney, Law Office 123,
Susan Hayash, Managing Attorney.

Before Zervas, Taylor and Kuczma,
Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Valentino S.P.A. ("Applicant") seeks registration on the Principal Register of the standard character mark ROCKSTUD SPIKE for the following goods, as amended:

> Leather and imitations of leather; purses; school bags; school satchels; credit card wallets being leatherware; traveling trunks; duffel bags for travel; rucksacks; wallets; reusable shopping bags, grocery tote bags; attaché cases; beach bags; leather casual bags, namely, tote bags, all-purpose bags; handbags; travel bags; handbag frames; waist pouches; briefcases; cases of leather, namely, attaché cases; vanity cases not fitted; leather key-cases of leather; suitcases; bags for sports; hat boxes of leather; garment bags for travel; leather shoulder straps; leather straps; fur

> pelt; faux fur and raw skins; dog collars; clothing for pets; umbrellas; walking sticks; whips, and saddlery; harness fittings

in International Class 18; and

> Clothing, namely, t-shirts, dresses, blouses, pants, gowns; overalls; underwear; sweaters; shirts; jumpers; suits; ready-made clothing, namely, t-shirts, dresses, blouses, pants, gowns; ready-made lining being parts of clothing trousers; outer clothing, namely, coats, jackets, overalls, pants, gowns, t-shirts, camisoles; knitwear, namely, coats, jackets, overalls, pants, gowns, t-shirts, camisoles; coats; skirts; petticoats; pullovers; overcoats; jackets; stuff jackets; ski jackets; ski pants; parkas; clothing of leather, namely, gowns, pants, camisoles, coats, overcoats; t-shirts; blouses; pants; dressing gowns; formal dresses; vests; jerseys; pajamas; bathrobes; brassieres; camisoles; corselets; slips being underclothing; children's clothing, namely, pajamas, coats, jackets, overalls, pants, gowns, t-shirts, camisoles; coats; skirts; petticoats; pullovers; overcoats; clothing layettes; bathing caps; bathing suits; clothing for gymnastics, namely, biketards, leotards, maillots, pants, sport shorts, shirts, t-shirts, tops; waterproof clothing, namely, rain trousers, rain overalls, rain hats, rain boots, rain suits; raincoats; masquerade costumes; footwear; slippers; bath slippers; boots; sport boots; horse-riding boots; galoshes; shoes; beach shoes; sandals; sport shoes; gymnastic shoes; overshoes; headgear, namely, sport caps, hats; knitted caps; cap peaks; socks; sock suspenders; stockings; garters; gloves; mittens; muffs; shawls; ties as clothing; neckties; scarves and foulards as clothing; veils; bandanas; furs being clothing; fur stoles; belts; wedding dresses

in International Class 25.[1]

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[1] Application Serial No. 79228160 was transmitted to the USPTO on December 27, 2017, pursuant to Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a), based on International Registration No. 1392296, registered December 27, 2017, and claiming priority as of May 6, 2016.

The Trademark Examining Attorney has finally refused registration pursuant to Section 6(a) of the Trademark Act, 15 U.S.C. § 1056(a), based on Applicant's failure to comply with the requirement to disclaim the word SPIKE on the ground that it is merely descriptive of a feature or characteristic of Applicant's goods within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1).

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm the refusal to register.

I. Applicable law

Under Section 6(a) of the Trademark Act, "[t]he Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable." Merely descriptive terms are unregistrable, under Trademark Act Section 2(e)(1), and therefore, are subject to disclaimer if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is grounds for refusal of registration. *See In re Stereotaxis Inc.,* 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005); *In re Omaha Nat'l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Ginc UK Ltd.*, 90 USPQ2d 1472 (TTAB 2007); *In re Nat'l Presto Indus., Inc.*, 197 USPQ 188 (TTAB 1977).

The test for determining whether a term is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *See In re Chamber of Commerce of the U.S.*, 675 F.3d

1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012). The determination of whether a term is merely descriptive must be made in relation to the goods for which registration is sought. *Id*. It is not necessary, in order to find a term merely descriptive, that it describe each feature of the goods, only that it describe a single, significant ingredient, quality, characteristic, function, feature, purpose or use of the goods. *Id.*; *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987). It is also not necessary to find the term merely descriptive for each and every good listed in each class of the recited goods. If a term is held descriptive for any of the goods identified in a class of the involved application, registration is properly refused as to the entire class. *See In re Sterotaxis Inc.*, 77 USPQ2d at 1089 (quoting *In re Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46, 47 (CCPA 1975) ("Our predecessor court … has stated that 'registration should be refused if the mark is descriptive of any of the goods for which registration is sought'")); *In re Quik-Print Copy Shop, Inc.*, 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980).

II. Arguments and Evidence

The Examining Attorney maintains that the word "Spike," as defined below, merely describes a feature of Applicant's goods.[2]

[2] 9 TTABVUE 8. References to the briefs refer to the Board's TTABVUE docket system. The number preceding "TTABVUE" corresponds to the docket entry number(s), and any number(s) following "TTABVUE" refer to the page number(s) of the docket entry where the cited materials appear. Page references herein to the application record refer to the .pdf version of the United States Patent and Trademark Office (USPTO) Trademark Status & Document Retrieval (TSDR) system.

To establish descriptiveness, the Examining Attorney made of record the following:

A. Definition of "spike":

- "Any long pointed object can be referred to as a spike."[3]

B. Internet materials from various third-party websites, including Neiman Marcus, Rockstar Puppy, Pinterest, Google, Gucci, and Farfetch, showing that third parties use the word SPIKE[4] to describe embellishments or features on some of the types of goods identified in Applicant's application:[5]

- NeimanMarcus advertises a Louboutin Loubiposh Spikes Clutch Bag.

(https://www.neimanmarcus.com/Christian-Louboutin-Loubiposh-Spikes-Clutch-Bag-Metallic-Blue/prod178150246/p.prod)

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[3] March 20, 2018 Office Action, TSDR at 5, taken from COLLINS ENGLISH DICTIONARY accessed on March 20, 2018. (https://www.collinsdictionary.english/spike). The Examining Attorney also submitted a definition of "spike heel," i.e., "very high tapering heel used on women's shoes." *Id*. at TSDR 6, taken from MERRIAM-WEBSTER online dictionary, accessed March 20, 2018 (https://www.merriam-webster.com/dictionary/spike%20heel). We note Applicant's objection to our consideration of the definition of "spike heel." We need not, and did not, base our finding of descriptiveness on this definition.

[4] We have considered evidence showing use of the plural and adjectival forms of "spike" in this decision. *See In re Oscar Mayer & Co. Inc.*, 170 USPQ 296, 297 (TTAB 1971) ("WIENER SINGLES" for wieners held merely descriptive where "singles" is the plural form of the noun "single"); *see also*, e.g., *In re Gray Inc.*, 3 USPQ 1558, 1559 (TTAB 1987) (finding PROTECTIVE EQUIPMENT merely descriptive of burglar and fire alarms notwithstanding that the evidence only showed uses of variants of the term, "protect" and "protection," the Board stated, "These terms all have the same meaning, differing only in their form."); *In re Lativ Sys., Inc.*, 223 USPQ 1037, 1039 (TTAB 1984) (converting the term "vinyl" to its adjectival form "VINYLIZING" did not impart trademark or service mark distinctiveness to the term in relation to the goods or services).

[5] March 20, 2018 Office Action; TSDR 7-13.

Christian Louboutin
Loubiposh Spikes Clutch Bag, Metallic Blue
Free Shipping | Return fees apply
Online Inquiries: OC316_V2GPX | Store Inquiries: #135337

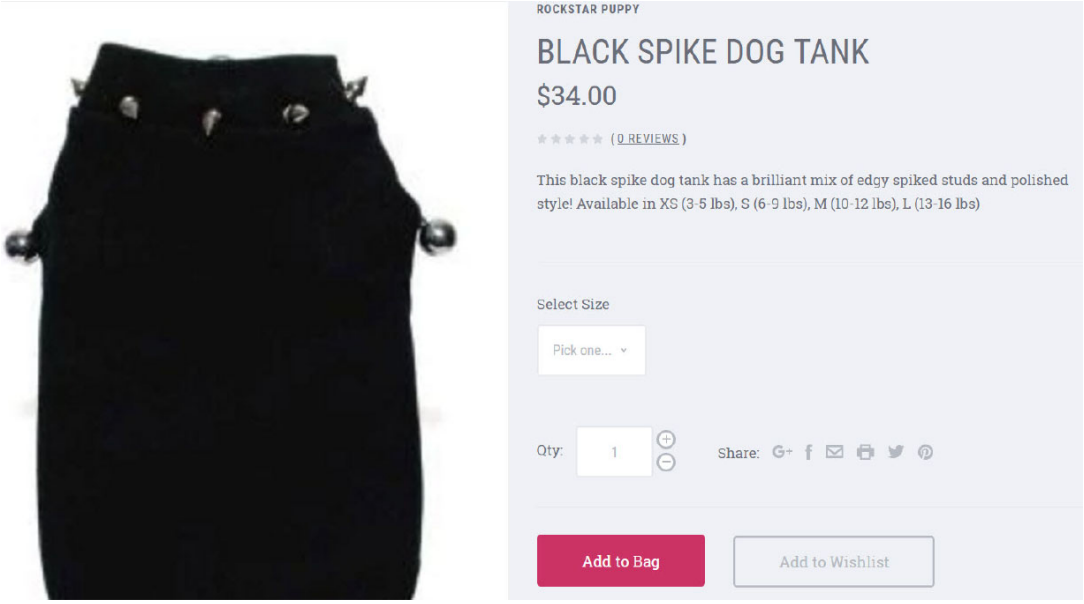
- Christian Louboutin patent leather clutch with spike studs, featuring iridescent finish.
- Removable chain shoulder strap, 21" drop.
- Zip top seals slim profile.
- Leather-reinforced corners.

More

This item is not available.
OC316_V2GPX
SHOPRUNNER free 2-day shipping & free returns

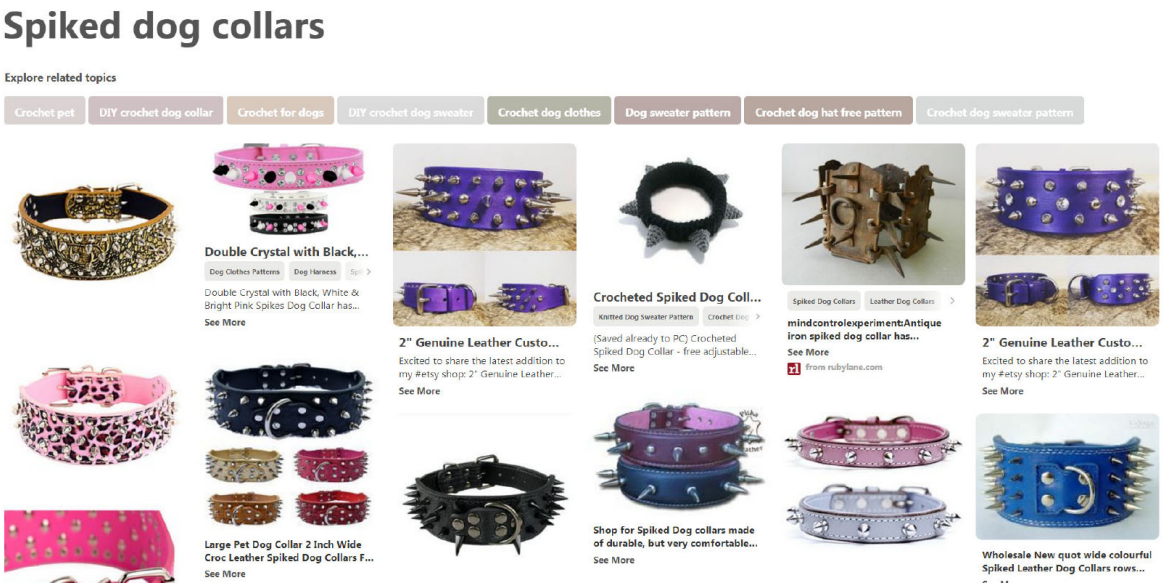
- Rockstar Puppy advertises a Black Spike Dog Tank.

(https://www.rockstarpuppyboutique.com/black-spike-dog-tank/)



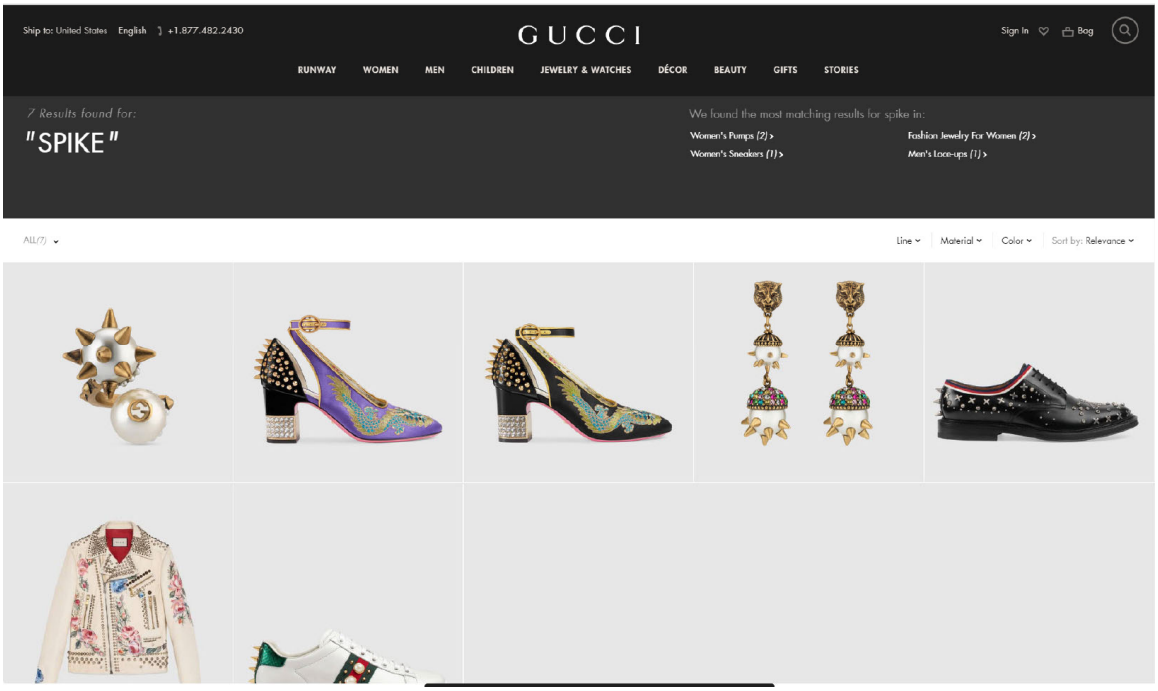
- The word “spiked” is used to describe a feature of dog collars.

(https://www.pinterest.com/explore/spiked-dog- collars/)



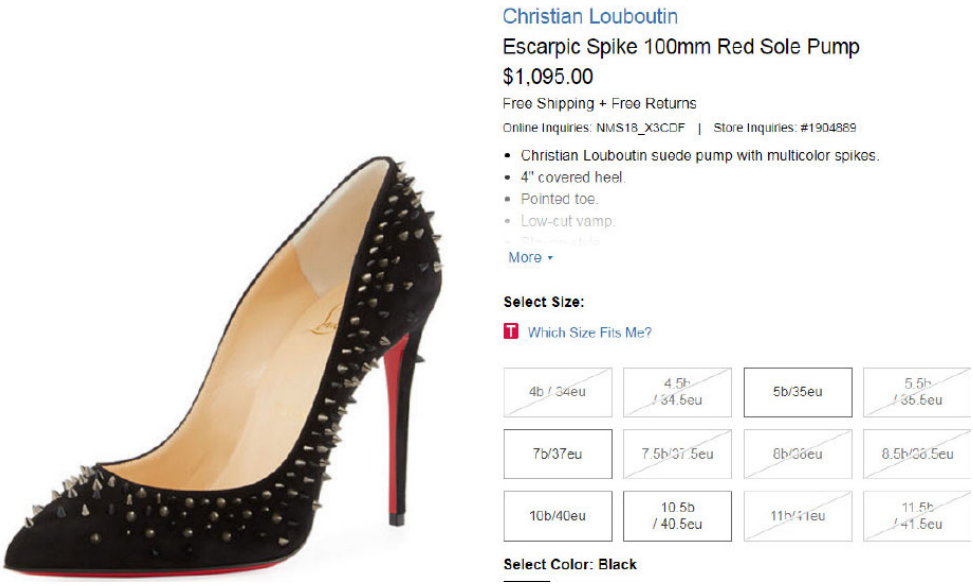
- The word “spike” is used to describe embellishments on shoes, clothing and accessories.

(http://www.gucci.com/us/en/serarch?search-cat=header-search&text=spike)



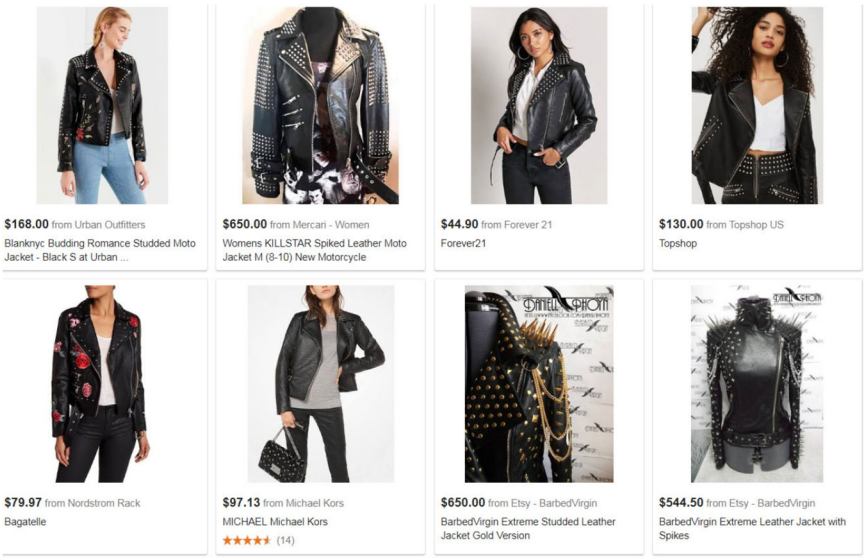
- NeimanMarcus advertises an Escarpic Spike … Pump.

(https://www.neimanmarcus.com/Christian-Louboutin-Escarpic-Spike-100mm-Red-Sole-Pump/prod 192450126/p.prod? ecid=NMCS__GooglePLA& utm_medium=CSE&utm_source=NMCS__ GooglePLA&utm_campaign=ChristianLouboutin#&)



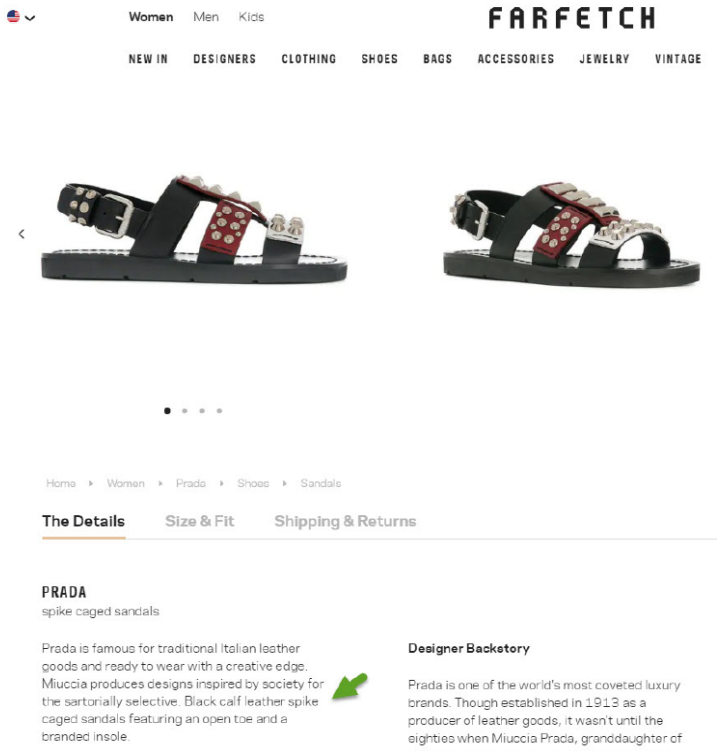
- A Google search shows that various entities use the word "spike" to describe decorative features of jackets.

(https://www.google.com/search?q=spike+leather=jacket& rlz=1C1GGrv …)



- Farfetch uses "spike" to describe Prada sandals.

(https://www.farfetch.com/shoesbox/Black-Spiked-Stilettos/)[6]



- ShoesPies features as items for sale black "spiked stilettos."

(https://www.shoespie.com/shoebox/Black-Spiked-Stilletos/)[7]

C. Articles discussing "spikes" as a fashion trend:

- An article from VOGUE online titled "11 Top Accessory Trends of Spring 2018," touts the "Super-Sneaker" and states that on the Spring runways, sneakers got some truly wild updates" Loewe's came with curled toes, … Junya Watanabe's were studded with spikes … ."

[6] September 4, 2018 Office Action; TSDR 11.

[7] March 20, 2018 Office Action; TSDR 11.

(https://www.vogue.com/article/spring-2018-accessory-trend-report)[8]

- An article from Houston Lifestyles & Homes titled "Fashion – What's in Stores Now – January 2018" notes, in part: "Christian Louboutin – 'Escarpic' pumps in velvety plum suede are adorned with scores of the label's signature spikes."

(http://houstonlifesyles.com/fashion-whats-in-stores-now-january-2018).[9]

D. Articles using the word "spike" to describe a feature of Applicant's goods:[10]

- An article from Wallpaper titled "Fashion Week discussing Valentino A/W 2018" states, in part, "Best in Show: … MAI Bombers, wool shirt jackets and long coats were scattered with metal spikes."

(https://www.wallpaper.com/fashion/fashionweeks/menswear-aw-2018/paris/valentino-aw-2018)[11];

- Valentino's Rockstud Spike … Bag is advertised as being "punctuated with the Italian label's signature spikes."

[8] September 4, 2018 Office Action; TSDR 8.

[9] *Id*. at TSDR 12-13.

[10] We have not considered the webpage from The Sole Supplier (*id*. at TSDR 17) because the website has a .uk web address and there is no indication that US consumers view the page in the absence of an offer of international shipping.

[11] *Id*. at TSDR 15.

Valentino - Valentino Garavani The Rockstud Spike Medium Quilted Leather Shoulder Bag - Black

$2795.00
at NET-A-PORTER Limited

See it Now

Valentino Garavani's 'Rockstud' bag demonstrates Creative Director Pierpaolo Piccioli's love of rewriting the rules. Crafted from supple leather, it's punctuated with the Italian label's signature spikes - each individually placed in the diamond quilting. It opens to a smooth interior fitted with three pockets for easy organization.

(https://www.parenting.com/shop/valentino-valentino-valentino-garavani-the-rockstud-spike-medium-quilted-leather-shoulder-bag-blackpfcbdad67790540e82aa40239bbe9561a)[12];

- The "Editor's Note" on a Valentino Free Rockstud Spike Slides advertisement stating: "In a sporty rendition of Valentino's signature quilted leather and rockstud spikes, these Rockstud Spike slides are designed for optimal comfort and style."

(https://editorialist.com/product/free-rockstud-spike-slides-in-navy)[13];

- An article titled "It's Valentino's Name, but Their Vision" states, in part: "Valentino's sales, $510 million in 2012, have improved, and lucrative accessories, like sandals studded with small spikes, now account for nearly half of sales in some stores."

(https://www.nytimes.com/2013/03/10/fashion/valentinos-name-their-vision.html)[14];

- An article in WWD titled "Mark Ruffalo, Glen Powell, Dave France Talk Shop at Valentino, Mark

[12] *Id*. at TSDR 16.

[13] *Id*. at TSDR 18.

[14] *Id*. at TSDR 21.

> Ruffalo" stating, in part: "I loved the spikes, the embroidered stuff was really cool … ."

(https://wwd.com/fashion-news/fashion-scoops/mark-ruffalo-glen-powell-dave-franco-talk-shop-at-valentino-11107371/)[15]; and

- A posting on the My Theresa website titled "FALL IN LOVE WITH VALENTINO GARAVANI BAGS" noting: "Valentino bags are a veritable vision, flaunting biker spikes … ."

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  "Marvel at an edgy array of black studded bags, inspired by retro rock bands and biker chicks or admire the simple structure of a Valentino Garavani purse with its gorgeous plush quilting and gothic spike detailing."

(https://www.mytheresa.com/en-us/designers/valentino/bags.html).[16]

E. A Wikipedia excerpt discussing the State College Spikes:

> "The State College Spikes are a minor league baseball team based in State College, Pennsylvania."
>
> (https://en.wikipedia.org/wiki/State_College_Spikes).[17]

In urging reversal of the refusal, Applicant argues that SPIKE is suggestive and does not convey an immediate idea of Applicant's identified goods. Applicant also asserts that the Examining Attorney did not meet her burden of proof and that doubts as to descriptiveness must be resolved in its favor. Applicant relies on the following to support its position:

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[15] *Id*. at TSDR 24.

[16] *Id*. at TSDR 26.

[17] *Id*. at TSDR 27-30.

A. A second definition of the word "spike," included in the same source mentioned above, i.e., "a *long* piece of metal with a sharp point."[18]

B. Copies of 19 third-party Principal Register registrations for SPIKE-formative marks for various clothing items, headwear, and footwear which do not include a disclaimer of SPIKE, to show that the term previously has not been found merely descriptive for related goods.[19] These registrations include:

Registration No.	Mark
5310027	SPIKESMIND
5341465	BOWS & SPIKES
5207166	SPIKE ISLAND
5167214	KICKSPICE
4597180	JUSTSPIKES
4739414	SPIKE
4704255	PAMPASPIKE
4499292	SPIKEASE
4428020	PAMPASPIKE
4401348	SPIKE AND LARRY'S

[18] (Originally submitted) March 20, 2018 Office Action, TSDR at 5 and retrieved from the online COLLINS ENGLISH DICTIONARY on March 20, 2018. (https://www.collinsdictionary.english/spike).

[19] July 20, 2018 Response to Office Action, TSDR 10-32. We have not considered Registration No. 1869720 because it has been cancelled. *See Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1819 n.4 (TTAB 2016) ("An expired or cancelled registration is evidence of nothing but the fact that it once issued.").

Registration No.	Mark
3293776	
3290625	STATE COLLEGE SPIKES
3828924	CINCINNATI SPIKES
3624495	
3519103	MICROSPIKES
2793499	SCORPIONSPIKES
4255607	SOFTSPIKES
2278540	SOFTSPIKES

III. Discussion

Contrary to Applicant's contention that the Examining Attorney did not meet her evidentiary burden, we find that the advertising materials, and third-party website and publication evidence made of record clearly demonstrate that the word SPIKE describes, without any mental leap or imagination, a detail of Applicant's identified clothing, footwear and purses.

We acknowledge, but are not persuaded by Applicant's arguments and evidence to the contrary, which we address in turn. First, Applicant questions the probative value of the definition of "spike" relied upon by the Examining Attorney ("[a]ny long pointed object") because it includes the word "long," and emphasizes the additional definition referenced above, i.e., "a *long* piece of metal with a sharp point." As noted,

mere descriptiveness is determined in relation to the identified goods; "[t]hat a term may have other meanings in different contexts is not controlling." *In re Franklin Cnty. Historical Soc'y*, 104 USPQ2d 1085, 1087 (TTAB 2012) (citing *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979)). So long as any single meanings of a term is descriptive, the term may be considered to be merely descriptive." *In re Mueller Sports Med., Inc.*, 126 USPQ2d 1584, 1590 (TTAB 2018) (quoting *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984)). Notably, the word "long" is defined, in part, as "having a greater length than breadth: ELONGATED,"[20] and the word "sharp" is defined, in part, as "[t]apering to a point or edge."[21] As referenced and illustrated in the excerpted articles discussed above, Applicant's purses and shoes, as well as those of third parties, contain pointed metal pieces and those pieces taper to a point or edge and have an elongated shape in relation to the flat surface on which they are attached. We thus find that both definitions demonstrate that "spike" immediately describes a feature of Applicant's goods.

Applicant also argues that "[t]he analysis in this case is whether the mark 'ROCKSTUD SPIKE' *as a whole* would *immediately* convey information as to the nature, feature or characteristic of Applicant's goods." Applicant's brief p. 4, emphasis

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[20] MERRIAM-WEBSTER online dictionary, (https://www.merriam-webster.com/dictionary/long), accessed April 15, 2020. The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014)*, aff'd,* 823 F.3d 594, 118 USPQ2d 1632 *(Fed. Cir. 2016)*; *Threshold.TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1038 n.14 (TTAB 2010); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

[21] The OXFORD DICTIONARY, (https://www.lexico.com/en/definition/sharp), accessed April 25, 2020.

supplied.[22] By this argument, Applicant essentially is asserting that its mark is a unitary phrase and therefore no disclaimer is required.

A mark or portion of a mark is considered "unitary" when it creates a commercial impression separate and apart from any unregistrable component. The test to determine whether a mark is unitary inquires whether the elements of the mark are so integrated or merged together that they cannot be regarded as separable. *See In re EBS Data Processing*, 212 USPQ 964, 966 (TTAB 1981); *In re Kraft, Inc.*, 218 USPQ 571, 573 (TTAB 1983). In this case, there is nothing in the record to show that the combination of the terms ROCKSTUD (a compound term made up the words "rock" and "stud") and SPIKE creates a phrase with a singular impression in the minds of purchasers. The term SPIKE is used descriptively in the articles excerpted above without the term ROCKSTUD in discussing detailing of some of Applicant's identified clothing and footwear items.

We also are not persuaded by the third party registration evidence made of record by Applicant. With one exception, the marks displayed have unique meanings or are unitary. More particularly, the marks in Registration Nos. 5310027, 5167214, 4597180, 4428020, 3624495, 3519103, 2793499, 4255607 and 2278540 are compound terms; the mark in Registration No. 4499292 is telescoped; the wording in the marks of Registration Nos. 3293776 and 4704255 is integrated with the design elements; the mark in Registration No. 5207166 is a geographic location; the mark in Registration No. 4401348 is a name; the mark in Registration No. 5341465 is incongruous; the

[22] 7 TTABVUE 8.

word SPIKE in the mark in Registration No. 3290625, as established by the Wikipedia article of record, alludes in part to the underdeveloped antler on the team's logo; and the mark in Registration No. 3828924 identifies a sports team – markedly, the identified clothing items covered by the registration are "uniforms, shirts, T-shirts, hats and sweatshirts for use in connection with promotion of applicant's select baseball team." The mark in Registration No. 4739414 is for the single term SPIKE and of course is not disclaimed. The registration, however, does not convince us that the USPTO has found the word "spike" to be distinctive when used in connection with any of the clothing items identified in Applicant's application.

We also find unavailing Applicant's contention that because it previously registered the mark "# I ♥ SPIKE" (Registration No. 5663681) for virtually identical Class 18 and 25 goods without a disclaimer of the word "spike," a disclaimer is not required in this case. Unlike the applied-for mark, the "# I ♥ SPIKE" mark is a unitary phrase or slogan. Specifically, the registered mark "# I ♥ SPIKE" consists of a subject (I) and an object (SPIKE) linked by the pictorial representation of the verb (LOVE) which, as the Examining Attorney points out, "creat[es] continuity of thought or expression."[23] *See generally* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) Section 1213.05(b)(ii)(B) (Oct. 2018).

Further, Applicant's reliance on prior Board decisions where the Board found a disclaimer was not required is misplaced. It is well settled that each case must be decided on its own facts and the Board is not bound by prior decisions involving

[23] 8 TTABVUE 16.

different records. *See In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). Thus, the question of whether a disclaimer is required is determined on the evidence of record at the time each registration is sought. *In re theDot Commc'ns Network LLC*, 101 USPQ2d 1062, 1064 (TTAB 2011); TMEP § 1209.03(a). The cases cited by Applicant are for different marks used in association with different goods and the issue of whether a disclaimer was required was decided on different records.

After careful consideration of all of the evidence and arguments presented, we conclude that when applied to Applicant's goods, the word SPIKE immediately describes, without any multi-step reasoning or thought process, a feature or characteristic of those goods. While we acknowledge that any doubt as to the issue of descriptiveness favors an applicant, contrary to Applicant's contention, we have no doubts that the word SPIKE in Applicant's applied-for mark ROCKSTUD SPIKE is merely descriptive and must be disclaimed.

Decision: The refusal to register based on the requirement for a disclaimer of the word SPIKE is affirmed. However, if Applicant submits the required disclaimer of SPIKE to the Board within thirty days of the mailing date of this decision, the requirement for the disclaimer will have been met and the application will proceed.[24] *See* Trademark Rule 2.142(g), 37 C.F.R. § 2.142(g); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE Section 1219 (2019).

[24] The standard format for the required disclaimer text is as follows: "No claim is made to the exclusive right to use SPIKE apart from the mark as shown." TMEP § 1213.08(a)(i).