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

Proceeding	91185498
Party	Plaintiff The TJX Companies, Inc.
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THE TJX COMPANIES, INC.,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. 91185498
	)	
DENISE MARIE BARR,	)	
	)	
Applicant	)	

BRIEF ON BEHALF OF OPPOSER

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TABLE OF CONTENTS

I. BRIEF STATEMENT OF THE CASE AND THE ISSUE TO BE DETERMINED 1

II. THE RECORD 2

A. The Evidence Submitted by Opposer TJX 2

B. The Evidence Submitted by Applicant Barr 2

III. ARGUMENT 3

A. Opposer TJX Has Established Standing 3

B. The Evidence Demonstrates That the Term "IT BAG" Is a Widely Used Descriptor of Purses 4

C. There Is No Evidence That Applicant's Designation Has Attained Secondary Meaning 6

IV. CONCLUSION 6

INDEX OF AUTHORITIES

Cases

Books on Tape, Inc. v. The Booktape Corp., 836 F.2d 519, 5 USPQ2d 1301 (Fed. Cir. 1987) 4

Gyulay, In re, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) 5

H.U.D.D.L.E., In re, 216 USPQ 358 (TTAB 1982) 5

National Shooting Sports Foundation, Inc., In re, 219 USPQ 1018 (TTAB 1983) 5

Ritchie v. Simpson, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999) 3

Tower Tech Inc., In re, 64 USPQ2d 1314 (TTAB 2002) 5

Statutes and Rules

15 U.S.C. §1052(e) 2

15 U.S.C. §1052(f) 2, 6

37 C.F.R. § 2.122(b) 2

37 C.F.R. § 2.123(b) 2

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BRIEF ON BEHALF OF OPPOSER

I. BRIEF STATEMENT OF THE CASE AND THE ISSUE TO BE DETERMINED

Opposer, The TJX Companies, Inc. ("TJX" or "Opposer"), believes it will be damaged by the registration of the designation IT BAG (Stylized) as a trademark by Applicant, Denise Marie Barr ("Barr" or "Applicant"). The IT BAG (Stylized) designation is the subject of Application No. 77/301,887, filed October 11, 2007, for use on "travel bags, multi-purpose purses; and purses." TJX's opposition is based on the fact that the designation IT BAG, when used on some or all of the listed goods, is merely descriptive of those goods and has not attained secondary meaning as a source-identifier for Applicant's goods.

Thus, the issues to be determined in this proceeding are:

(i) Whether the registration of the designation IT BAG (Stylized), used on travel bags, multi-purpose purses, or purses, would be contrary to the

provisions of Section 2(e)(1) of the Lanham Act (15 U.S.C. §1052(e)(1)) in view of its merely descriptive nature; and

(ii) If so, whether that designation nevertheless has attained secondary meaning with respect to Applicant's goods so as to be registrable under Section 2(f) of the Lanham Act (15 U.S.C. §1052(f)).

II. THE RECORD

A. The Evidence Submitted by Opposer TJX

On August 3, 2009, TJX filed *Opposer's Notice of Filing of Transcript and Exhibits of Its Testimony Period Deposition of Theresa Conduah* whereby the transcript of the June 22, 2009, deposition of Ms. Conduah and its exhibits (Conduah Exhibit Nos. 1-20) were made of record in this proceeding.

B. The Evidence Submitted by Applicant Barr

Pursuant to 37 C.F.R. § 2.122(b), the PTO file of Barr's opposed application (No. 77/301,887) is part of the record in this proceeding.

On or about August 18, 2009, Applicant filed *Applicant's Trial Testimony Affidavit* in which Applicant purported to submit evidence via that affidavit notwithstanding the fact that there was no agreement of the parties (as is required under 37 CFR §2.123(b)) for the submission of either party's testimony by affidavit. Moreover, the putative evidence was not properly submitted under any available alternative. In response to *Opposer's Motion to Strike Applicant's Trial Testimony Affidavit*, the Board entered its order mailed September 23, 2009, pursuant to which order the Board has accepted only the following materials as evidence submitted by Applicant:

(1) Applicant Exhibit 2: A TESS printout pertaining to Opposer's Application No. 77/323,233 whereby Opposer seeks registration of the designation THE NEW IT BAG (Stylized) as a trademark, not for handbags or purses, but instead for "reusable non-woven polypropylene shopping bags";

(2) Applicant Exhibit 3: A TDR printout of the *Notice of Suspension* pertaining to the application referenced in Applicant Exhibit 2;

(3) Applicant Exhibit 5: A TESS printout pertaining to the application made the subject of this proceeding;

(4) Applicant Exhibit 8: A TARR printout pertaining to a third-party application (No. 77/346,847) whereby a third-party (not identified in the exhibits of record) sought to register the designation IT COSMETICS as a trademark or service mark (for goods or services also not identified in the exhibits of record); and

(5) Applicant Exhibit 9: A copy of the *Notice of Publication* pertaining to the application made the subject of this proceeding.

Otherwise, Applicant Barr submitted no evidence of record in this proceeding.

III. ARGUMENT

A. Opposer TJX Has Established Standing

No legitimate issue exists as to TJX's standing in this proceeding. To establish its standing, TJX must show a real interest in the outcome of the proceeding and a reasonable basis for its belief of damage. *See, e.g., Ritchie v. Simpson*, 170 F.3d 1092, 1095, 50 USPQ2d 1023 (Fed. Cir. 1999). However, it is not necessary that TJX allege or

establish prior rights in IT BAG or any other designation. *Books on Tape, Inc. v. The Booktape Corp.*, 836 F.2d 519, 520, 5 USPQ2d 1301, 1302 (Fed. Cir. 1987).

Applicant's own evidence, namely, Applicant Exhibits 2 and 3, is probably sufficient to establish Opposer's standing, inasmuch as those documents reflect the pendency of Opposer's application to register THE NEW IT BAG (Stylized) as a trademark for shopping bags and the suspension of that application pending the disposition of the opposed IT BAG (Stylized) purses trademark application. Additionally, in Paragraph 1 of Applicant's *Answer* to the *Notice of Opposition* in this proceeding, Applicant admits that Opposer is and has been "in the retail store business offering for sale a wide array of goods since long before October 11, 2007," the date on which the opposed application was filed by Applicant. (*See also*, Conduah Depos., pp. 25-27; Conduah Exhs. 19-20.) Thus, Opposer's standing to bring this opposition is adequately established.

B. The Evidence Demonstrates That The Term "IT BAG" Is a Widely Used Descriptor of Purses

Although the body of evidence submitted by Opposer consists solely of the transcript of the deposition of Ms. Conduah, that oral testimony and the exhibits authenticated therein demonstrate that the term "IT BAG" is used commonly by the public in this country to describe purses, particularly purses having appeal because of their stylish, trendy or fashionable nature. The oral testimony and documentary exhibits of record reflect the common usage of the term "IT BAG" by the public as a laudatory reference to a purse, particularly a purse having, in the opinion of the person using that term, one or more of the following characteristics:

- A "must have" status (Conduah Exh. 1);
- "Popular" (Conduah Exhs. 2,4);
- A "status symbol" (Conduah Exhs. 3,6);
- "Iconic" (Conduah Exh. 5);
- "Hot" (Conduah Exhs. 6,12);
- The "season's sensation" (Conduah Exh. 7); and
- "Trendy" (Conduah Exh. 18).[1]

A term is deemed to be "merely descriptive" of goods if it forthwith conveys to the relevant public an immediate idea about, *inter alia*, a quality, characteristic or feature of those goods. *See, In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). To be considered descriptive, it is sufficient if the term describes any significant attribute, property or function of the goods. *See, In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982). It matters not that there may also be other apt descriptors. Id. Moreover, the question is not whether someone presented with only the designation could guess therefrom what the goods are. Rather, the question is whether someone who knows what the goods are is likely to understand the designation to convey information about those goods. *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002). Still further, while it is not necessary that a designation be in common use in conjunction with any of the listed goods (*In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983)), such common use, of course, is highly relevant, if not dispositive.

[1] The website materials submitted as evidence by Opposer are of record because they were introduced properly into evidence through testimony.

The undisputed evidence of record shows clearly that the term "IT BAG", when used in connection with purses, is widely perceived as a laudatory term that describes a purse that is, or which its marketers aspire that it be, stylish, trendy or fashionable. Thus, Opposer respectfully submits that the Board should find the term "IT BAG", as used in connection with the purses listed in the opposed application, immediately informs a prospective purchaser or other member of the public of a salient feature which the source of that product incorporates in, or intends to be associated with, that product. As such, the term "IT BAG", as applied to purses, is "merely descriptive" of such products in today's marketplace.

C. There Is No Evidence That Applicant's Designation Has Attained Secondary Meaning

Opposer recognizes that (assuming that the term "IT BAG" is not also generic for purses), the merely descriptive term "IT BAG" might nevertheless become registrable if it has attained secondary meaning. (15 U.S.C. §1052(f)) However, there is no evidence of record to support such a contention, if Applicant even assets such a contention.

IV. CONCLUSION

Thus, consideration of the body of evidence and the controlling legal principles clearly leads to the conclusion that the term "IT BAG", as it may be used on and in conjunction with purses, is merely descriptive and has not attained secondary meaning. With that term being the predominant and only verbal feature of the opposed mark, and with that term not being disclaimed in its entirety by Applicant, TJX's opposition should

be sustained, and Barr's application for registration of the subject mark should be refused.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I certify that the foregoing "Brief on Behalf of Opposer" was served on Applicant by mailing a copy of same by U.S. first class mail, postage prepaid, on the 11th day of December 2009, to Applicant, addressed as follows:

Denise Marie Barr
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Las Vegas, NV 89138

Larry C. Jones