

THIS OPINION IS  
NOT A PRECEDENT  
OF THE T.T.A.B.

Mailed:  
May 20, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Opposition No. 91185498

The TJX Companies, Inc.

v.

Denise Marie Barr

**CORRECTIVE ORDER**

Larry C. Jones and Jason M. Sneed of Alston & Bird LLP for  
The TJX Companies, Inc.

Denise M. Barr (pro se).

Before Holtzman, Zervas and Ritchie, Administrative  
Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

On April 30, 2010, we sustained the opposition to the  
registration of the following mark on the ground of mere  
descriptiveness:



At the end of our decision, we indicated that we would set aside our decision "and applicant's mark will be forwarded for registration" if applicant enters a disclaimer of the words "IT BAG." Because the present application is an intent-to-use application, and, of course, applicant has not yet filed a statement of use, the last sentence in our April 30, 2010 decision is amended to: "Nevertheless, in accordance with Trademark Rule 2.133(b), this decision will be set aside if applicant, no later than **thirty** days from the mailing date hereof, submits an appropriate disclaimer of the words 'IT BAG.'"<sup>1</sup>

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<sup>1</sup> The time period for filing an appeal or motion for reconsideration, as well as the disclaimer, remain unchanged by this corrective order.

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Before Holtzman, Zervas and Ritchie, Administrative  
Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

On October 11, 2007, Denise Marie Barr ("applicant")  
filed an application (Serial No. 77301887) for registration  
on the Principal Register of the following mark for "travel  
bags; multi-purpose purses; purses."<sup>2</sup>

<sup>2</sup> Applicant has entered the following description of the mark  
into the record: "The mark consists of Capital 'I' with lower



Applicant claims a bona fide intent to use the mark in commerce under the provisions of Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), and has disclaimed the word BAG.

Opposer, The TJX Companies, Inc., filed a notice of opposition to the registration of applicant's mark. In the notice of opposition, opposer pleaded, inter alia, that long prior to applicant's filing date, "Opposer, its predecessors, subsidiaries, related companies and licensees ... have been in the retail store business offering for sale a wide array of goods"; that registration of applicant's mark "without a disclaimer of each of the terms therein, would interfere with Opposer's right to the lawful descriptive use of the terms 'it' and 'bag' to refer to Opposer's goods, particularly Opposer's bags and purses that are currently trendy, fashionable and/or in style"; that applicant's mark, when used in connection with her goods, "immediately conveys to consumers and potential consumers that Applicant's goods

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case 't' on first line, and 'BAG' in all caps on second line. The 'I' and 'BAG' are in black and the 't' is in gray."

are bags or purses that are trendy, fashionable and/or currently in style"; and that "Applicant's application for registration should be refused on the basis that the stylized mark made the subject of this application consists of or comprises a merely descriptive term which has not become distinctive of Applicant's goods without a disclaimer thereof and a minimal stylization that does not elevate the IT BAG (Stylized) mark as a whole to being distinctive."

Applicant has denied the salient allegations of the notice of opposition, but has admitted that opposer has "been in the retail store business offering for sale a wide array of goods since long before" the filing date of applicant's application. The Board has received a brief only from opposer.

*The Record*

In addition to the pleadings, the file of the opposed application is part of the record without any action by the parties. Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b). Opposer introduced the testimonial deposition of Theresa Conduah, an associate attorney with opposer's law firm, with exhibits consisting of material taken from the Internet. Applicant in turn introduced evidence pursuant to her personal affidavit, which was the subject of a motion to strike filed by opposer. The Board, in its order dated September 23, 2009, construed applicant's affidavit in part

as a notice of reliance and denied opposer's motion to the extent that applicant submitted documents that were official records of the United States Patent and Trademark Office. (Opposer's motion to strike was otherwise granted.) Thus, pursuant to the Board's order, Exhibits 2, 3, 5, 8 and 9 to applicant's affidavit are part of the trial record.

*Standing/Priority*

To establish standing, a petitioner must have a real interest in the proceeding. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999). Generally, where a claim of mere descriptiveness is asserted, it is sufficient for the plaintiff to establish that it is a competitor. *Plyboo America, Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633 (TTAB 1999); and *No Nonsense Fashions, Inc. v. Consolidated Foods Corp.*, 226 USPQ 502 (TTAB 1985). In addition, standing may be found when the plaintiff has been advised that it will be refused registration when applicant's application matures into a registration. See TBMP § 309.03(b) (2d ed. rev. 2004) and cases cited therein.

Applicant has admitted that opposer has "been in the retail store business offering for sale a wide array of goods since long before" the filing date of applicant's application. In addition, Exhibit 2 to applicant's affidavit is a TESS printout of opposer's application for THE NEW IT BAG (stylized), which was filed on November 7,

2007 (application Serial No. 77323233), and exhibit 3 to applicant's affidavit is a Notice of Suspension issued in opposer's application in view of applicant's application.<sup>3</sup>

The Notice of Suspension states that applicant's application "if and when it registers, may be cited against this application in a refusal to register under Section 2(d) of the Trademark Act ...." In view of the above, petitioner has established its standing.

*Mere Descriptiveness*

A term 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. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). Whether a term 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 those goods or services,

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<sup>3</sup> Although opposer did not plead the potential refusal of its application as a basis for its standing, applicant stated at paragraph 4 of her affidavit that opposer's application "proves that the sole reason for opposing my trademark application ... was to disqualify my application .... The Opposer's application was suspended by the USPTO pending the disposition of my application." Also, it was she, and not opposer, who introduced evidence of the potential refusal. We consider the pleadings to have been amended to assert the potential refusal of opposer's

and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. That a term may have other meanings in different contexts is not controlling. In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). Moreover, 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). See also In re Patent & Trademark Services Inc., 49 USPQ2d 1537 (TTAB 1998); In re Home Builders Association of Greenville, 18 USPQ2d 1313 (TTAB 1990); and In re American Greetings Corporation, 226 USPQ 365 (TTAB 1985).

Opposer has introduced the following evidence in support of its assertion that applicant's mark is merely descriptive of "purses having appeal because of their stylish, trendy or fashionable nature." Brief at 4.

"An 'It-Bag' is a designer handbag that is deemed the 'must-have' item of the moment as a result of a combination of celebrity usage, clever marketing techniques, superior quality and their ability to represent the mood of the season. They are generally produced in limited edition quantities."  
*about.com*

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application as a basis for opposer's standing. See Fed. R. Civ. P. 15(b); and TBMP § 314 (2d ed. rev. 2004).

### **It Bag**

"'It Bag' is a colloquial term from the fashion industry used in the 1990s and 2000s to describe a brand or type of high-priced designer handbag by makers such as Hermes or Fendi that becomes a popular best-seller. \*\*\* The term was coined in the 1990s with the explosive growth of the handbag market in fashion. Designers vied to produce one bag that would sell hundreds of thousands of units by becoming the bag 'of the moment' - a single handbag style that would spread like wildfire in popularity through the intertwined worlds of fashion and celebrity, aided by clever or just plain lucky marketing. Another way to define them is to say what other bags are not: 'They are most definitely not *it bags* in the sense that they become *isn't bags* the next season.'" (Italics in original.)

*wikipedia.com* entry for "It Bag"

"For serious shoppers seeking the ultimate status symbol, nothing compares with the white alligator and diamond Chanel bags, which costs a disarming \$260,150. \*\*\* 'The very wealthy, the people for whom these bags were always intended, will continue to buy their 'it' bags.' Atkins says. 'For these women, no price is too high.'" *forbes.com* - *The New 'It' Bags*; February 29, 2008

### **The next it bag**

"Every season produces a new 'it bag.' And some seasons produce way too many it bags to count. Other it bags linger for seasons, staying as popular as when they first premiered." *madberries.com*

"'The bag has become the iconic 'it' bag, the symbol of ultimate luxury, because of its inaccessibility to the general public. People really want what they can't have,' said Tonello, an American who lives in Barcelona." *reuters.com* - *Birkin buyer says cracked code for Hermes 'it' bag*; April 14, 2008

### **Is This It for the It Bag?**

"Status handbags, you see, are a lot like housing. After the rise of the \$1,000 purse, fashion's equivalent of the \$1 million studio, there

inevitably comes talk of a backlash. Are we now living in a handbag bubble?"  
*nytimes.com*; November 1, 2007

**Why "It" Bags Are Out**

"Irene Weisburd used to buy 20 handbags a year, dutifully getting on waiting lists for the season's designated 'it' bag and filling her 'bag wardrobe' with Fendi Baguettes, A Louis Vuitton Murakami bag and Prada nylon backpacks.

\* \* \*

For the past 10 years or so, fashion houses have churned out expensive bags with distinctive shapes and logos in the hopes that they'd catch on as that season's sensation.

\* \* \*

The 'it' bag isn't important any more,' says Stephanie Solomon, women's fashion director at Bloomingdales. 'It's all about looking different from your neighbor.'" *online.swj.com*; January 26, 2008

**The latest It bag**

"The latest It bag to get a handle on the market is the revamped Roberta Di Camerino Bigne bag ..., part of the Venetian fashion empire started in the '40s by Guiliana Coen and favored by the likes of Grace Kelly, Elizabeth Taylor and Elsa Maxwell. *time.com*; December 2, 2008

**THE IT BAG**

If I invest in one handbag for the season, what should it be?  
*Elle.com*;

The evidence in the record, including the evidence set forth above, some of which appears in articles in national publications such as *The New York Times*, establishes that the term "It Bag" is used to describe a handbag which is trendy, fashionable or stylish in nature. We therefore conclude that IT BAG is merely descriptive of a feature or characteristic of certain purses, i.e., those that are trendy, fashionable or stylish in nature. At a minimum,

therefore, a disclaimer of "it bag" in applicant's stylized mark, not just "bag," is needed before applicant's mark can be registered.

We turn then to the question raised in opposer's pleading, but not in its brief, of whether IT BAG in stylized form is registrable on the Principal Register with a disclaimer of IT BAG.

When "words which are merely descriptive, and hence unregistrable, are presented in a distinctive design, the design may render the mark as a whole registrable, provided that the words are disclaimed, under Section 6." In re Clutter Control, Inc., 231 USPQ 588, 589 (TTAB 1986). See also In re Miller Brewing Co., 226 USPQ 666 (TTAB 1985) (LITE (stylized) for beer registrable on the Principal Register with a disclaimer of the word). Since applicant is seeking registration on the Principal Register, not the Supplemental Register, without relying on Section 2(f) of the Trademark Act, we must determine if the stylization of the mark is inherently distinctive; that is, the "stylization of the words or the accompanying design features of the asserted mark [must] create an impression on purchasers separate and apart from the impression made by the words themselves." In re American Academy of Facial Plastic and Reconstructive Surgery, 64 USPQ2d 1748, 1753 (TTAB 2002). See also In re Behre Indus., 203 USPQ 1030,

1032 (TTAB 1979) ("[T]he distinctive display of descriptive or otherwise unregistrable components of a mark cannot bestow registrability upon the mark as a whole unless the features are of such a nature that they undoubtedly would serve to distinguish the mark in its entirety in the applicable field or it can be shown through competent evidence that the unitary mark as a whole displayed in the asserted distinctive manner does in fact create a distinctive commercial impression separate and apart from and above the descriptive significance of its components").

The following stylized marks were held not to be inherently distinctive and thus unregistrable on the Principal Register; (a) In re Guilford Mills Inc., 33 USPQ2d 1042 (TTAB 1994);

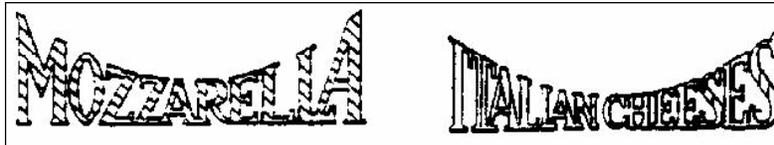


The image shows a stylized logo for the word "microdenier". The word is enclosed in a thin rectangular border. The letters are in a clean, sans-serif font. The letter 'o' is replaced by a simple circle, and the letter 'e' is replaced by a horizontal oval shape. The rest of the letters are standard lowercase letters.

(b) In re Pollio Dairy Products Corp., 8 USPQ2d 2012, 2014 (TTAB 1988) ("In the absence of any evidence to convince us otherwise and since we quite agree with the Examining Attorney that there is nothing unusual or even different in the formation of the letters which would cause this presentation of the word, LITE, to stand out from any other such presentation");



(c) In re Grande Cheese Co., 2 USPQ2d 1447, 1449 (TTAB 1986) ("We conclude, then, that the designations sought to be registered do not comprise inherently distinctive lettering styles and/or background displays such that they would create separate commercial impressions apart from the generic significance of the disclaimed words");



(d) In re Couriaire Express Int'l, Inc., 222 USPQ 365, 366 (TTAB 1984) ("the slightly slanted letters and capitalization of the letters 'C' and 'A' in applicant's mark [shown below] are insufficient to render applicant's mark as distinctive in style");



and (e) United States Lines, Inc. v. American President Lines, Ltd., 219 USPQ 1224, 1227 (TTAB 1982) ("The displays of applicant's marks [one shown below] in the instant cases are even less distinctive, we believe, than was the

applicant's mark in Project Five. We conclude that the terms sought to be registered do not create distinctive commercial impressions separate and apart from the descriptive significance of their components. Applicant's admittedly descriptive marks are not entitled to registration on the Principal Register with disclaimers").

The logo for 'ThruService' is rendered in a bold, black, serif font. The word 'Thru' is written in a slightly smaller size than 'Service'. A thick, solid black horizontal line runs beneath the entire word, extending slightly beyond the left and right edges of the text.

Other marks have been held to be registrable on the Principal Register when generic or merely descriptive words are combined with a distinctive stylization. See (a) Miller Brewing Co., 226 USPQ 666 (TTAB 1985) ("The configuration (i.e., the style of lettering, or manner of display) of the disclaimed word is not merely descriptive as applied to applicant's goods, neither Section 2(e) nor Section 2(f) is applicable");

The logo for 'Lite' is rendered in a bold, black, serif font. The letters are closely spaced. A thick, solid black horizontal line runs beneath the word, extending slightly beyond the left and right edges of the text.

(b) In re Jackson Hole Ski Corp., 190 USPQ 175, 176 (TTAB 1976) (Applicant argued, and the board agreed, that a mark consisting of a geographical designation and "the letters 'JH' displayed in a distinctive and prominent fashion so as to create a commercial impression in and of themselves ...

[and] the letters 'JH' are twice the size of the other letters; that unlike any of the other letters, they are partly joined together, creating the visual impression of a monogram; and that they are set down from the rest of the letters, which positioning has the effect of highlighting the 'JH couplet"' was distinctive);



(c) In re Grand Metropolitan Foodservice, 30 USPQ2d 1974, 1976 (TTAB 1994) ("In view of the nature of applicant's inventive and somewhat stylized mark, being an obvious play on the word 'muffin' and the word 'fun,' we believe that the meaning or commercial impression of applicant's mark will be more than that simply of the word 'muffins.' Therefore, applicant's mark is not merely descriptive");

*Muffins*

and (d) In re Clutter Control, Inc., 231 USPQ 588, 589 (TTAB 1986) ("In our opinion, the tube-like rendition of the letter 'C' in the words 'construct' and 'closet' make a striking commercial impression, separate and apart from the word portion of applicant's mark").



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C.f. *In re The Wella Corp.*, 565 F.2d 143, 196 USPQ 7 (CCPA 1977) (mark registrable on the Supplemental Register, with "Balsam" disclaimed);



and *In re Venturi, Inc.*, 197 USPQ 714 (TTAB 1977) (mark shown below with the word "pipe" and the representation of the pipe disclaimed had acquired distinctiveness).



In the case before us, the substantially vertical, overlapping upper case "I" and lower case "T" of approximately equal size and of different shading in "IT," with the base of the "I" complimenting the base of the "T," creates an impression on purchasers separate and apart from the impression made by the words themselves. Moreover, in our view, applicant's mark is far more distinctive than any of the marks cited above which were refused registration, and is more in the nature of those marks which are registered on the Principal Register. We therefore find that the mark sought to be registered herein is not, when applied to the goods of the applicant, merely descriptive of them.

However, in view of our finding that the wording IT BAG is merely descriptive of applicant's goods, the mark as a whole is not registrable absent a disclaimer of IT BAG.

**Decision:** The opposition is sustained and registration to applicant is refused. Nevertheless, in accordance with Trademark Rule 2.133(b), this decision will be set aside and applicant's mark will be forwarded for registration if applicant, no later than **thirty** days from the mailing date hereof, submits an appropriate disclaimer of the words "IT BAG."<sup>4</sup>

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<sup>4</sup> A proper disclaimer would read: "No claim is made to the exclusive right to use IT BAG apart from the mark as shown." See TMEP § 1213.08 (2d ed. rev. 2004).