ESTTA Tracking number: **ESTTA152532**
Filing date: **07/23/2007**

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

Proceeding	79014936
Applicant	RIGHT-ON CO., LTD.
Correspondence Address	James A. Oliff OLIFF & BERRIDGE, PLC Suite 500, 277 South Washington Street Alexandria, VA 22314 UNITED STATES email@oliff.com
Submission	Applicant's Request to Extend
Attachments	_Mot to exd time 936.pdf (51 pages)(1621034 bytes)
Filer's Name	William P. Berridge
Filer's e-mail	email@oliff.com
Signature	/William P. Berridge/
Date	07/23/2007

TRADEMARK

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

In re the Applications of

RIGHT-ON CO., LTD.

Serial Nos.: 79/014,936 and 79/014,939

Filed: July 8, 2005

Mark: Design

Examining Attorney: Gina Fink

Law Office 109

Docket No.: 128692 and 128689

MOTION TO EXTEND TIME

Applicant Right-On Co., Ltd., by and through counsel, hereby moves to extend time pursuant to Fed. R. Civ. P. 6(b), made applicable to Board proceedings by 37 C.F.R. §2.116(a). Specifically, Applicant requests a one month extension of time to prepare and file a reply to the Examining Attorney's Appeal Brief. The good cause for such relief is discussed below.

The USPTO failed to direct correspondence to Applicant's counsel, as previously requested, and thereby subjected Applicant to an unreasonably shortened time period for response to the Examining Attorney's Appeal Brief. Indeed, despite Applicant's express request that PTO correspondence be directed to Applicant's counsel in Alexandria, Virginia, and the fact that the correspondence address was so-changed in the USPTO records, the Examining Attorney's Appeal Brief, mailed July 11, 2007, was instead mailed to the former correspondent in Japan.

As early as February 14, 2007, Applicant provided the Trademark Office with new correspondence information in connection with both of the above-referenced applications. Specifically, Applicant indicated that correspondence should be directed to James A. Oliff of Oliff & Berridge, PLC in Alexandria, Virginia. *See* February 14, 2007 Change of Address forms which are attached as Exhibit A. In fact, Applicant understood that this change was accepted in light of the

Receipt for the Notice of Appeal in connection with both the above-referenced applications dated February 16, 2007. Exhibit B. The Notice of Appeal indicates the address of Applicant's counsel.

The USPTO accepted the request that correspondence be directed to James A. Oliff at Oliff & Berridge, PLC. For example, the Request for Reconsideration Denied actions mailed on March 7, 2007, were mailed to James A. Oliff. The correct correspondent address is expressly indicated thereon. See Exhibit C. Similarly, the May 21, 2007 Applicant's Appeal Briefs and Motion to Consolidate list James A. Oliff at Oliff & Berridge in Alexandria, Virginia as the Correspondent. See Exhibits D and E.

Applicant's counsel first received a copy of the PTO appeal brief on July 18 only by checking the USPTO database. Due to no malfeasance on the part of Applicant, Applicant would be unduly prejudiced by the time constraints imposed on Applicant and its counsel by the misdirected correspondence. In addition, Applicant's counsel needs to correspond with a foreign applicant, through foreign counsel, in order to prepare a reply. Thus, Applicant respectfully requests a one month extension of time in which to prepare Applicant's reply and afford Applicant the opportunity to correspond with Applicant's counsel in preparation of the reply.

In accordance with the foregoing, Applicant moves to extend the time for reply to Examining Attorney's Appeal Brief by one month to August 31, 2007.

Respectfully submitted,

James A. Oliff
William P. Berridge
Attorneys for Applicant

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone No.: (703) 836-6400

EXHIBIT A

Document Description: **Change of Address**
Mail / Create Date: **14-Feb-2007**

PTO Form 1553 (Rev 4/2000)
OMB Control #0651-0009 (Exp. 06/30/2005)

Change Of Correspondence Address

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	79014936
LAW OFFICE ASSIGNED	LAW OFFICE 109
MARK SECTION	
MARK	Design only
CORRESPONDENCE SECTION (current)	
ORIGINAL ADDRESS	KINOSHITA Jitsuzo 3rd Floor, Ogikubo TM Building 26-13, Ogikubo 5-chome Suginami-ku Tokyo 167-0051 JAPAN
NEW CORRESPONDENCE ADDRESS	
NEW ADDRESS	James A. Oliff OLIFF & BERRIDGE, PLC Suite 500 277 South Washington Street Alexandria Virginia United States 22314 703-836-6400 703-836-2787 email@oliff.com
SIGNATURE SECTION	
SIGNATURE	/William P. Berridge/
SIGNATORY NAME	William P. Berridge
SIGNATORY DATE	02/14/2007

SIGNATORY POSITION	U.S. Attorney for Applicant
FILING INFORMATION SECTION	
SUBMIT DATE	Wed Feb 14 10:47:01 EST 2007
TEAS STAMP	USPTO/CCA-151.200.228.163 -20070214104701328417-790 14936-360ef9eba331312473a 3d154d344b7abc2-N/A-N/A-2 0070214104315306487

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- ***Technical help**: For instructions on how to use TDR, or help in resolving **technical** glitches, please e-mail TDR@uspto.gov. If outside of the normal business hours of the USPTO, please e-mail Electronic Business Support, or call 1-800-786-9199.*
- ***Questions about USPTO programs**: Please e-mail USPTO Contact Center (UCC).*

***NOTE**: Within any e-mail, please include your telephone number so we can talk to you directly, if necessary. Also, include the relevant serial number or registration number, if existing.*

Document Description: **Change of Address**
Mail / Create Date: **14-Feb-2007**

PTO Form 1553 (Rev 4/2000)
OMB Control #0651-0009 (Exp. 06/30/2005)

Change Of Correspondence Address

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	79014939
LAW OFFICE ASSIGNED	LAW OFFICE 109
MARK SECTION	
MARK	Design only
CORRESPONDENCE SECTION (current)	
ORIGINAL ADDRESS	KINOSHITA Jitsuzo 3rd Floor, Ogikubo TM Building 26-13, Ogikubo 5-chome Suginami-ku Tokyo 167-0051 JAPAN
NEW CORRESPONDENCE ADDRESS	
NEW ADDRESS	James A. Oliff OLIFF & BERRIDGE, PLC Suite 500 277 South Washington Street Alexandria Virginia United States 22314 703-836-6400 703-836-2787 email@oliff.com
SIGNATURE SECTION	
SIGNATURE	/William P. Berridge/
SIGNATORY NAME	William P. Berridge
SIGNATORY DATE	02/14/2007

SIGNATORY POSITION	U.S. Attorney for Applicant
FILING INFORMATION SECTION	
SUBMIT DATE	Wed Feb 14 10:47:01 EST 2007
TEAS STAMP	USPTO/CCA-151.200.228.163 -20070214104701328417-790 14936-360ef9eba331312473a 3d154d344b7abc2-N/A-N/A-2 0070214104315306487

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***NOTE**: Within any e-mail, please include your telephone number so we can talk to you directly, if necessary. Also, include the relevant serial number or registration number, if existing.*

EXHIBIT B

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

MAILED:	February 16, 2007
IN RE:	RIGHT-ON CO., LTD.
SERIAL NO.	79014939
APPEAL RECEIVED:	02/16/2007
BRIEF DUE:	n/a

James A. Oliff
OLIFF & BERRIDGE, PLC
Suite 500277 South Washington Street
Alexandria VA 22314

ESTTA125460

The appeal and appeal fee in the above-entitled application were received on the date indicated above. Applicant indicated that it has filed or is filing today a request for reconsideration of the final refusal to register.[1]

[1] A timely request for reconsideration must be filed with the Trademark Examining Operation, and may be filed via TEAS, using the Response to Office Action form. (To maintain their status, TEAS Plus applicants must use TEAS for filing a request for reconsideration.) Applicant should notify the Board immediately if it has not filed a timely request for reconsideration and does not intend to do so.

Accordingly, the appeal is hereby instituted, but action on the appeal is suspended pending the Examining Attorney's consideration of the request for reconsideration.

In the event the refusal of registration is maintained, proceedings will be resumed and applicant will be allowed time in which to file a brief on its appeal.

New Developments at the Trademark Trial and Appeal Board

TTAB forms for electronic filing of extensions of time to oppose, notices of opposition, petition for cancellation, notice of ex parte appeal, and inter partes filings are now available at http://estta.uspto.gov. Images of TTAB proceeding files can be viewed using TTABVue at http://ttabvue.uspto.gov.

Parties should also be aware of changes in the rules affecting trademark matters, including rules of practice before the TTAB. *See* Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. R. 55,748 (September 26, 2003) (effective November 2, 2003) Reorganization of Correspondence and Other Provisions, 68 Fed. Reg. 48,286 (August 13, 2003) (effective September 12, 2003). Notices concerning the rules changes are available at www.uspto.gov.

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

MAILED:	February 16, 2007
IN RE:	RIGHT-ON CO., LTD.
SERIAL NO.	79014936
APPEAL RECEIVED:	02/16/2007
BRIEF DUE:	n/a

James A. Oliff
OLIFF & BERRIDGE, PLC
Suite 500277 South Washington Street
Alexandria VA 22314

ESTTA125467

The appeal and appeal fee in the above-entitled application were received on the date indicated above. Applicant indicated that it has filed or is filing today a request for reconsideration of the final refusal to register.[1]

[1] A timely request for reconsideration must be filed with the Trademark Examining Operation, and may be filed via TEAS, using the Response to Office Action form. (To maintain their status, TEAS Plus applicants must use TEAS for filing a request for reconsideration.) Applicant should notify the Board immediately if it has not filed a timely request for reconsideration and does not intend to do so.

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EXHIBIT C

Document Description: **Reconsideration Letter**
Mail / Create Date: **07-Mar-2007**

To: RIGHT-ON CO., LTD. (email@oliff.com)

Subject: TRADEMARK APPLICATION NO. 79014939 - N/A

Sent: 3/7/2007 7:39:14 PM

Sent As: ECOM109@USPTO.GOV

Attachments:
Attachment - 1
Attachment - 2
Attachment - 3
Attachment - 4
Attachment - 5
Attachment - 6
Attachment - 7
Attachment - 8
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Attachment - 40
Attachment - 41

[Important Email Information]
UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 79/014939

APPLICANT: RIGHT-ON CO., LTD.

79014939

CORRESPONDENT ADDRESS:
James A. Oliff
OLIFF & BERRIDGE, PLC
Suite 500
277 South Washington Street
Alexandria VA 22314

RETURN ADDRESS:
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

If no fees are enclosed, the address should include the words "Box Responses - No Fee."

MARK:

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

CORRESPONDENT EMAIL ADDRESS:
email@oliff.com

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address..

Serial Number 79/014939

This letter responds to the applicant's communication filed on February 9, 2007. The amended drawing page and amended description of the mark are acceptable and made of record. The refusal to register under Sections 1, 2 and 45 as the mark is merely ornamental and the applicant has not claimed acquired distinctiveness under Section 2(f) is maintained and continued.

The trademark examining attorney has carefully reviewed the request for reconsideration as to the ornamentation refusal and is not persuaded by applicant's arguments. No new issue has been raised and no new compelling evidence has been presented with regard to the ornamentation point at issue in the final action. TMEP §715.03(a). Therefore, the request for reconsideration is **denied** and the final refusal under Sections 1, 2 and 45 as the mark is ornamental is continued. 37 C.F.R. §2.64(b); TMEP §715.04.

The filing of a request for reconsideration does *not* extend the time for filing a proper response to the final action, which runs from the date the final action was mailed. 37 C.F.R. §2.64(b); TMEP §§715.03 and 715.03(c). It is noted that the applicant has filed its Notice of Appeal. Accordingly, the application is being returned to the Trademark Trial and Appeal Board for resumption of the Appeal process.

Ornamental Refusal, but Capable

The refusal to register under Sections 1, 2 and 45 was continued and made FINAL. Registration is refused on the Principal Register because the proposed mark, as displayed on the drawing page and described in the description of the mark of record, is a decorative or ornamental feature of the goods and would not be perceived as a mark by the purchasing public. Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051, 1052 and 1127; *See In re Owens-Corning Fiberglass Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985); *In re David Crystal, Inc.*, 296 F.2d 771, 132 USPQ 1 (C.C.P.A. 1961); *In re Villeroy & Boch S.A.R.L.*, 5 USPQ2d 1451 (TTAB 1987); TMEP §§1202.03 *et seq.*

The mark consists of stitching on pockets. The stitching is not particularly unique or unusual. The design looks like a random design of stitching and does not incorporate any elements that look any different than any other stitching on jeans pockets than would be added to create a different fashionable or ornamental look/style.

The description of the marks is as follows: "The mark consists of a stitching design on side-by-side pockets. The solid lines represent stitching. The shape of the pockets in not claimed as part of the mark. The dotted lines are not claimed as a feature of the mark, but rather to show the mark's position on the goods."

The Examining Attorney supplements her prior evidence with additional evidence of use of stitching on jeans pockets. The stitching on famous/designer brands is recognized as a trademark because of the long use, emphasized advertisements such as "look for" advertising, or in other words because this stitching has acquired distinctiveness as a mark. Corresponding registrations have been attached (for many examples) that have been registered on the Supplemental Register or under Principal-2(f) after having acquired distinctiveness. It is noted that even famous clothing makers, such as Abercrombie and Armani/Exchange, had to register their stitching marks under 2(f) or on the Supplemental Register. All this evidence is relevant in that stitching on jeans pockets is not viewed an inherently distinctive.

Additional website and Nexis® evidence have been attached which discuss stitching on jeans pockets.

Prior decisions and actions of other trademark examining attorneys in registering different marks are without evidentiary value and are not binding upon the Office. Each case is decided on its own facts, and each mark stands on its own merits. *AMF Inc. v. American Leisure Products, Inc.*, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re International Taste, Inc.*, 53 USPQ2d 1604 (TTAB 2000); *In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994); *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 641 (TTAB 1984); *In re Consolidated Foods Corp.*, 200 USPQ 477 (TTAB 1978).

The practices of the trade lead to the conclusion that the applicant's mark is ornamental, but capable of acquiring distinctiveness. Mere stitching on jeans pockets is not inherently viewed as a trademark. But, designer stitching that is used for lengthy periods of time or emphasized in a company's advertising (or defended in litigation such as the Levi's example – see attached) are recognized as trademarks based on their acquired trademark status (through acquired distinctiveness).

The Examining Attorney reiterates, the Applicant may overcome the stated ornamental refusal by doing the following, as appropriate:

(1) claiming ***acquired distinctiveness*** under Trademark Act Section 2(f) by submitting ***evidence*** that the proposed mark has become distinctive of applicant's goods in commerce. 15 U.S.C. §1052(f). Evidence may consist of examples of advertising and promotional materials that specifically promote, as a trademark, the subject matter for which registration is sought, dollar figures for advertising devoted to such promotion, dealer and consumer statements of recognition of the proposed mark as a trademark and any other evidence that establishes recognition of the proposed mark as a trademark for the goods. *See* TMEP §1202.03(d).

Noting that the Supplemental Register is not an option for the applicant as a 66(a) applicant. TMEP §1202.02(f) supports this refusal, by analogy, as the applicant's mark on its face and using its description of the mark is ornamental.

TMEP §1904.02(a) states: Under Section 68(a) of the Trademark Act, 15 U.S.C. §1141h, a request for extension of protection will be examined under the same standards as any other application for registration on the Principal Register.

In conclusion, the refusal to register under Section 1, 2, and 45 are maintained and continued and the applicant is returned to the Board for further processing of the appeal.

/Gina M. Fink/
Trademark Attorney - Law Office 109
Phone: (571) 272-9275
Law Office 109 Fax: (571) 273-9109

Time of Request: Wednesday, March 07, 2007 18:47:12 EST
Client ID/Project Name:
Number of Lines: 106
Job Number: 1841:16151896

Research Information

Service: Terms and Connectors Search
Print Request: Selected Document(s): 1
Source: US Newspapers and Wires
Search Terms: ornamental w/p jean w/p stitch!

1 of 7 DOCUMENTS

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The Capital Times (Madison, Wisconsin)

October 11, 2005 Tuesday
ALL EDITION

SECTION: LIFESTYLE; Pg. 1B

LENGTH: 1354 words

HEADLINE: PERFECT JEAN-ETICS;
PRICES ARE PUSHING $250 FOR TRENDY DENIM BRANDS

BYLINE: By Amy MertzThe Capital Times

BODY:

Call it jean-etic engineering.

Denim manufacturers are on a quest for creating the perfect pair of jeans, with improved fit due to the addition of Lycra and other materials for stretch, shape and softness; special washes that result in varying degrees of darkness; more realistic distressing, such as holes and tattering; and embellishments and embroidery on pockets and elsewhere.

But the improvements come at a cost, of course. And while many express outrage at $3-a-gallon gasoline, women in the fashion "know" aren't sticker-shocked to find denim pushing $250 on store shelves.

Ironically, the proletariat's icon has become a status symbol for the middle and upper class.

To be fair, expensive denim brands aren't a new thing. We all remember names like Jordache, Gloria Vanderbilt and Guess that ruled the '80s and early '90s. But the prices never seemed to break $80 - even when taking inflation into account.

Some local retailers have built their businesses around premium jeans sales and offer an assortment of well-known labels for the fashion-conscious.

The area's largest premium denim retailer is Bop, 222 W. Gorham St., which also sells merchandise online at shopbop.com. Manager and buyer Mollie Milano says her employees are trained for a whole day on denim and try on every brand so they can find the best pair of jeans to suit a particular customer's body type and style.

"I think it's kind of evolved," Milano says of the move toward women spending more on denim. This evolution started about five years ago.

"Two years ago Seven for All Mankind was our No. 1 jean in our store," she says, and they cost about $130 then.

Bop's biggest sellers right now are Citizens of Humanity ($132 to $220), Paige ($165 to $176) and True Religion ($172-$275). Some jeans like Seven feature Swarovski crystals and rhinestones on the front and back pockets, jacking the price up to as much as $395.

"A lot of the manufacturing is being done over in Japan, where they use spun denim on fancier machines. I think a lot of (the rising price) has to do with the actual quality of the jean," Milano says.

Many high-end labels are made in the U.S., too, where workers often are paid more than they earn overseas.

Antik denim, which Bop carries, averages around $250 and is commonly seen on celebrities. It began hitting the mainstream six to eight months ago and is known for elaborate, sometimes colorful embroidery on the back pockets.

"If a celebrity is seen in a certain pair of jeans, those are what the girls want," Milano says. "If a certain brand is mentioned in magazines, like People, we hang up pictures, and that sells jeans," Milano says.

About 75 percent of Bop's clientele is college age; the other 25 percent is women between 25 and

60.

Childless women in their mid-30s with a disposable income "don't bat an eye on spending $250 on jeans," Milano says, and are the ones who tend to accumulate designer denim.

This year True Religion jeans with back pocket flaps were the big trend, Milano says. "All the others copied that and copied their embroidery."

The number of pairs of jeans a customer buys or owns varies, Milano says.

"Half the girls come in here and get a couple great pairs of jeans for the season and that's it," she says. "The other half come in here a lot and have every brand." The latter tend to be from big cities, where fashion sense is important and part of the culture, she adds.

Bop does sell jeans that cost less than $100 that are popular. "Big Star ($86-$101) is a great basic, and we do sell those to some high school girls, too," Milano says. "I think the younger girls stay more toward the mall and brands that are a little lower-end."

* * *

Jenny Condon, owner of Allure, an accessories-heavy boutique that opened last year in Middleton's Greenway Station, says denim is one of her store's mainstays. Allure carries the much-sought-after labels Citizens of Humanity, Hudson, True Religion, and Union and will be getting Joe's Jeans soon.

Premium denim is an easy sell to those who spend a lot on high fashion, she says, but women who don't live by labels are opening their wallets, too.

"People who buy the designer denim buy designer everything," Condon says. "The people who aren't into all designer stuff but buy designer denim are impressed with the fit, get more compliments on them and like them because they don't stretch out as much."

Much of the higher price goes toward the denim sustaining different washes and being made of higher-quality material, which makes them hold up better and retain their shape, Condon says.

Allure's client base is wide; it attracts high school girls, college students and women in their 50s, Condon says. Merchandise targets women in their 20s and 30s, and Allure carries trendy items, like designer handbags and the popular, sparkly Michael Stars T-shirts.

"We started with novelty jeans because we're an accessories store - with jeans with triangle pockets like Hudson that you might not wear every day," Condon says.

* * *

Jeans continue to sell quite well at Allure, Condon says, despite stores that sell average-priced denim reporting an abundance of jeans this fall.

If you look around most department stores and mall-type chains like Gap, they are flooded with denim. Prices of **jeans** that typically run $65 or less have been slashed by as much as 50 percent in most stores, judging from an informal local inventory. And the ones that aren't on sale are those imitating the premium labels - with an emphasis on more **ornamental** back pockets, contrast **stitching,** softer material, Lycra for a snug fit, and most importantly, a heftier price tag.

Meanwhile, labels that don't typically produce denim, such as discount merchant H&M, are entering the market to catch up with the denim craze.

Sheryl Batten, owner of Bodacious, 1719 Monroe St., says of the four suppliers from which she bought in New York last month, one was almost completely dedicated to jeans.

A Boston Globe article from late August cited a 2004 report that the average consumer age 13 and

older buys nine pairs of jeans a year. It also attributed the 10 percent rise in the jeans market this year partially to the popularity of premium denim and a growing acceptance of jeans as workplace attire.

Batten says she carries denim mainly because she feels she has to; she tries to focus on non-denim apparel, though. She stocks J & Co., Blue Cult/2Blu, Sergio Valente, French Connection and Blujeanious, with prices ranging from $78 to $170. J & Co. is the top seller there.

* * *

If the price of premium jeans doesn't leave you flabbergasted, or if you still aren't satisfied with your jeans, how about a pair boasting fibers conditioned with a cocktail of cellulite-fighting retinol, squalene and menthol? Or vitamin E, to moisturize your legs?

Also now available at Earnest Cut & Sew in Manhattan are custom-made jeans, starting at $300. The customer chooses the cut (boot cut or straight leg), the shade and fabric, the thread color, the rivet and button metals, and the pocket lining material. Shopbop.com and Nordstrom.com offer shoppers a jeans guide that allows you to search for jeans by choosing the leg cut (boot, flare, straight), waist style (low or medium rise) and brand, plus provides tips on how to achieve the perfect fit.

Expect the prices to stay up for a while, as all the makers duke it out for business. Cotton Inc. publication Lifestyle Monitor predicts that in a few years, the best brands will knock out their competitors and bring prices down a bit.

Milano says she thinks the price of denim will top out at $200 and start to come back down. "I think it's got to stop sometime soon," she says. "I don't think it can get much higher. I think back to basics is likely; the distressed wash and embroidery will pass."

Batten doesn't expect the prices to drop, though. "I don't think jeans will ever fizzle," she says. "They've been around forever - they're such a staple.

"Ultimately, young girls are brandwise, and when something is very popular, they have to have that brand. The jeans are a statement and the focus of the look. But the brands can go back and forth."

E-mail: amertz@madison.com

GRAPHIC: LOUIS LANZANO/ASSOCIATED PRESS Ralph Lauren faded denim beaded jeans accent an outfit last month at Fashion Week in New York city. PHOTOS BY MICHELLE STOCKER/THE CAPITAL TIMES For a straight or boyish figure: Paperdenim&cloth's Super Low Flare in "1 Year" wash. $176. Trendy: True Religion Breast Cancer Awareness Jeans. $240. Shown here: Joey fit in Medium Miner wash. Bargain: Big Star five-pocket bootleg stretch, dark wash. $86. Splurge: Antik Denim, Monroe fit, Copper wash. $260. Shopbop.com sells True Religion Breast Cancer Awareness Jeans for $240 a pair. The Web site donated 100 percent of its profit to the Y-Me National Breast Cancer Organization.

LOAD-DATE: October 12, 2005

Note:

In order to avoid size limitation constraints on large e-mail messages, this Office Action has been split into 4 smaller e-mail messages. The Office Action in its entirety consists of this message as well as the following attachments that you will receive in separate messages:

Email 1 includes the following 8 attachments
1. web1-1
2. web1-2
3. abercrombie
4. armani-1
5. armani-2
6. calvinklein
7. gap-1
8. gap-2

Email 2 includes the following 7 attachments
1. guess
2. levis
3. luckybrand
4. seven-1
5. seven-2
6. seven-3
7. web2-1

Email 3 includes the following 23 attachments
1. web2-2
2. web2-3
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9. 73321116P001OF003
10. 73321116P002OF003
11. 73321116P003OF003
12. 73770338P001OF003
13. 73770338P002OF003
14. 73770338P003OF003
15. 75124717P001OF003
16. 75124717P002OF003
17. 75124717P003OF003
18. 76354256P001OF002
19. 76354256P002OF002
20. 76354257P001OF002
21. 76354257P002OF002
22. 76636332P001OF002
23. 76636332P002OF002

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Mail / Create Date: **07-Mar-2007**

To: RIGHT-ON CO., LTD. (email@oliff.com)

Subject: TRADEMARK APPLICATION NO. 79014936 - N/A

Sent: 3/7/2007 7:35:40 PM

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[Important Email Information]
UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 79/014936

APPLICANT: RIGHT-ON CO., LTD.

79014936

CORRESPONDENT ADDRESS:
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RETURN ADDRESS:
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

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2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address..

Serial Number 79/014936

This letter responds to the applicant's communication filed on February 9, 2007. The amended drawing page and amended description of the mark are acceptable and made of record. The refusal to register under Sections 1, 2 and 45 as the mark is merely ornamental and the applicant has not claimed acquired distinctiveness under Section 2(f) is maintained and continued.

The trademark examining attorney has carefully reviewed the request for reconsideration as to the ornamentation refusal and is not persuaded by applicant's arguments. No new issue has been raised and no new compelling evidence has been presented with regard to the ornamentation point at issue in the final action. TMEP §715.03(a). Therefore, the request for reconsideration is **denied** and the final refusal under Sections 1, 2 and 45 as the mark is ornamental is continued. 37 C.F.R. §2.64(b); TMEP §715.04.

The filing of a request for reconsideration does *not* extend the time for filing a proper response to the final action, which runs from the date the final action was mailed. 37 C.F.R. §2.64(b); TMEP §§715.03 and 715.03(c). It is noted that the applicant has filed its Notice of Appeal. Accordingly, the application is being returned to the Trademark Trial and Appeal Board for resumption of the Appeal process.

Ornamental Refusal, but Capable

The refusal to register under Sections 1, 2 and 45 was continued and made FINAL. Registration is refused on the Principal Register because the proposed mark, as displayed on the drawing page and described in the description of the mark of record, is a decorative or ornamental feature of the goods and would not be perceived as a mark by the purchasing public. Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051, 1052 and 1127; *See In re Owens-Corning Fiberglass Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985); *In re David Crystal, Inc.*, 296 F.2d 771, 132 USPQ 1 (C.C.P.A. 1961); *In re Villeroy & Boch S.A.R.L.*, 5 USPQ2d 1451 (TTAB 1987); TMEP §§1202.03 *et seq.*

The mark consists of stitching on pockets. The stitching is not particularly unique or unusual. The design looks like a random design of stitching and does not incorporate any elements that look any different than any other stitching on jeans pockets than would be added to create a different fashionable or ornamental look/style.

The description of the marks is as follows: "The mark consists of a stitching design on side-by-side pockets. The solid lines represent stitching. The shape of the pockets in not claimed as part of the mark. The dotted lines are not claimed as a feature of the mark, but rather to show the mark's position on the goods."

The Examining Attorney supplements her prior evidence with additional evidence of use of stitching on jeans pockets. The stitching on famous/designer brands is recognized as a trademark because of the long use, emphasized advertisements such as "look for" advertising, or in other words because this stitching has acquired distinctiveness as a mark. Corresponding registrations have been attached (for many examples) that have been registered on the Supplemental Register or under Principal-2(f) after having acquired distinctiveness. It is noted that even famous clothing makers, such as Abercrombie and Armani/Exchange, had to register their stitching marks under 2(f) or on the Supplemental Register. All this evidence is relevant in that stitching on jeans pockets is not viewed an inherently distinctive.

Additional website and Nexis® evidence have been attached which discuss stitching on jeans pockets.

Prior decisions and actions of other trademark examining attorneys in registering different marks are without evidentiary value and are not binding upon the Office. Each case is decided on its own facts, and each mark stands on its own merits. *AMF Inc. v. American Leisure Products, Inc.*, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re International Taste, Inc.*, 53 USPQ2d 1604 (TTAB 2000); *In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994); *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 641 (TTAB 1984); *In re Consolidated Foods Corp.*, 200 USPQ 477 (TTAB 1978).

The practices of the trade lead to the conclusion that the applicant's mark is ornamental, but capable of acquiring distinctiveness. Mere stitching on jeans pockets is not inherently viewed as a trademark. But, designer stitching that is used for lengthy periods of time or emphasized in a company's advertising (or defended in litigation such as the Levi's example – see attached) are recognized as trademarks based on their acquired trademark status (through acquired distinctiveness).

The Examining Attorney reiterates, the Applicant may overcome the stated ornamental refusal by doing the following, as appropriate:

(1) claiming ***acquired distinctiveness*** under Trademark Act Section 2(f) by submitting ***evidence*** that the proposed mark has become distinctive of applicant's goods in commerce. 15 U.S.C. §1052(f). Evidence may consist of examples of advertising and promotional materials that specifically promote, as a trademark, the subject matter for which registration is sought, dollar figures for advertising devoted to such promotion, dealer and consumer statements of recognition of the proposed mark as a trademark and any other evidence that establishes recognition of the proposed mark as a trademark for the goods. *See* TMEP §1202.03(d).

Noting that the Supplemental Register is not an option for the applicant as a 66(a) applicant. TMEP §1202.02(f) supports this refusal, by analogy, as the applicant's mark on its face and using its description of the mark is ornamental.

TMEP §1904.02(a) states: Under Section 68(a) of the Trademark Act, 15 U.S.C. §1141h, a request for extension of protection will be examined under the same standards as any other application for registration on the Principal Register.

In conclusion, the refusal to register under Section 1, 2, and 45 are maintained and continued and the applicant is returned to the Board for further processing of the appeal.

/Gina M. Fink/
Trademark Attorney - Law Office 109
Phone: (571) 272-9275
Law Office 109 Fax: (571) 273-9109

Time of Request: Wednesday, March 07, 2007 18:47:12 EST
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Research Information

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Search Terms: ornamental w/p jean w/p stitch!

1 of 7 DOCUMENTS

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The Capital Times (Madison, Wisconsin)

October 11, 2005 Tuesday
ALL EDITION

SECTION: LIFESTYLE; Pg. 1B

LENGTH: 1354 words

HEADLINE: PERFECT JEAN-ETICS;
PRICES ARE PUSHING $250 FOR TRENDY DENIM BRANDS

BYLINE: By Amy MertzThe Capital Times

BODY:

Call it jean-etic engineering.

Denim manufacturers are on a quest for creating the perfect pair of jeans, with improved fit due to the addition of Lycra and other materials for stretch, shape and softness; special washes that result in varying degrees of darkness; more realistic distressing, such as holes and tattering; and embellishments and embroidery on pockets and elsewhere.

But the improvements come at a cost, of course. And while many express outrage at $3-a-gallon gasoline, women in the fashion "know" aren't sticker-shocked to find denim pushing $250 on store shelves.

Ironically, the proletariat's icon has become a status symbol for the middle and upper class.

To be fair, expensive denim brands aren't a new thing. We all remember names like Jordache, Gloria Vanderbilt and Guess that ruled the '80s and early '90s. But the prices never seemed to break $80 - even when taking inflation into account.

Some local retailers have built their businesses around premium jeans sales and offer an assortment of well-known labels for the fashion-conscious.

The area's largest premium denim retailer is Bop, 222 W. Gorham St., which also sells merchandise online at shopbop.com. Manager and buyer Mollie Milano says her employees are trained for a whole day on denim and try on every brand so they can find the best pair of jeans to suit a particular customer's body type and style.

"I think it's kind of evolved," Milano says of the move toward women spending more on denim. This evolution started about five years ago.

"Two years ago Seven for All Mankind was our No. 1 jean in our store," she says, and they cost about $130 then.

Bop's biggest sellers right now are Citizens of Humanity ($132 to $220), Paige ($165 to $176) and True Religion ($172-$275). Some jeans like Seven feature Swarovski crystals and rhinestones on the front and back pockets, jacking the price up to as much as $395.

"A lot of the manufacturing is being done over in Japan, where they use spun denim on fancier machines. I think a lot of (the rising price) has to do with the actual quality of the jean," Milano says.

Many high-end labels are made in the U.S., too, where workers often are paid more than they earn overseas.

Antik denim, which Bop carries, averages around $250 and is commonly seen on celebrities. It began hitting the mainstream six to eight months ago and is known for elaborate, sometimes colorful embroidery on the back pockets.

"If a celebrity is seen in a certain pair of jeans, those are what the girls want," Milano says. "If a certain brand is mentioned in magazines, like People, we hang up pictures, and that sells jeans," Milano says.

About 75 percent of Bop's clientele is college age; the other 25 percent is women between 25 and

60.

Childless women in their mid-30s with a disposable income "don't bat an eye on spending $250 on jeans," Milano says, and are the ones who tend to accumulate designer denim.

This year True Religion jeans with back pocket flaps were the big trend, Milano says. "All the others copied that and copied their embroidery."

The number of pairs of jeans a customer buys or owns varies, Milano says.

"Half the girls come in here and get a couple great pairs of jeans for the season and that's it," she says. "The other half come in here a lot and have every brand." The latter tend to be from big cities, where fashion sense is important and part of the culture, she adds.

Bop does sell jeans that cost less than $100 that are popular. "Big Star ($86-$101) is a great basic, and we do sell those to some high school girls, too," Milano says. "I think the younger girls stay more toward the mall and brands that are a little lower-end."

* * *

Jenny Condon, owner of Allure, an accessories-heavy boutique that opened last year in Middleton's Greenway Station, says denim is one of her store's mainstays. Allure carries the much-sought-after labels Citizens of Humanity, Hudson, True Religion, and Union and will be getting Joe's Jeans soon.

Premium denim is an easy sell to those who spend a lot on high fashion, she says, but women who don't live by labels are opening their wallets, too.

"People who buy the designer denim buy designer everything," Condon says. "The people who aren't into all designer stuff but buy designer denim are impressed with the fit, get more compliments on them and like them because they don't stretch out as much."

Much of the higher price goes toward the denim sustaining different washes and being made of higher-quality material, which makes them hold up better and retain their shape, Condon says.

Allure's client base is wide; it attracts high school girls, college students and women in their 50s, Condon says. Merchandise targets women in their 20s and 30s, and Allure carries trendy items, like designer handbags and the popular, sparkly Michael Stars T-shirts.

"We started with novelty jeans because we're an accessories store - with jeans with triangle pockets like Hudson that you might not wear every day," Condon says.

* * *

Jeans continue to sell quite well at Allure, Condon says, despite stores that sell average-priced denim reporting an abundance of jeans this fall.

If you look around most department stores and mall-type chains like Gap, they are flooded with denim. Prices of **jeans** that typically run $65 or less have been slashed by as much as 50 percent in most stores, judging from an informal local inventory. And the ones that aren't on sale are those imitating the premium labels - with an emphasis on more **ornamental** back pockets, contrast **stitching,** softer material, Lycra for a snug fit, and most importantly, a heftier price tag.

Meanwhile, labels that don't typically produce denim, such as discount merchant H&M, are entering the market to catch up with the denim craze.

Sheryl Batten, owner of Bodacious, 1719 Monroe St., says of the four suppliers from which she bought in New York last month, one was almost completely dedicated to jeans.

A Boston Globe article from late August cited a 2004 report that the average consumer age 13 and

older buys nine pairs of jeans a year. It also attributed the 10 percent rise in the jeans market this year partially to the popularity of premium denim and a growing acceptance of jeans as workplace attire.

Batten says she carries denim mainly because she feels she has to; she tries to focus on non-denim apparel, though. She stocks J & Co., Blue Cult/2Blu, Sergio Valente, French Connection and Blujeanious, with prices ranging from $78 to $170. J & Co. is the top seller there.

* * *

If the price of premium jeans doesn't leave you flabbergasted, or if you still aren't satisfied with your jeans, how about a pair boasting fibers conditioned with a cocktail of cellulite-fighting retinol, squalene and menthol? Or vitamin E, to moisturize your legs?

Also now available at Earnest Cut & Sew in Manhattan are custom-made jeans, starting at $300. The customer chooses the cut (boot cut or straight leg), the shade and fabric, the thread color, the rivet and button metals, and the pocket lining material. Shopbop.com and Nordstrom.com offer shoppers a jeans guide that allows you to search for jeans by choosing the leg cut (boot, flare, straight), waist style (low or medium rise) and brand, plus provides tips on how to achieve the perfect fit.

Expect the prices to stay up for a while, as all the makers duke it out for business. Cotton Inc. publication Lifestyle Monitor predicts that in a few years, the best brands will knock out their competitors and bring prices down a bit.

Milano says she thinks the price of denim will top out at $200 and start to come back down. "I think it's got to stop sometime soon," she says. "I don't think it can get much higher. I think back to basics is likely; the distressed wash and embroidery will pass."

Batten doesn't expect the prices to drop, though. "I don't think jeans will ever fizzle," she says. "They've been around forever - they're such a staple.

"Ultimately, young girls are brandwise, and when something is very popular, they have to have that brand. The jeans are a statement and the focus of the look. But the brands can go back and forth."

E-mail: amertz@madison.com

GRAPHIC: LOUIS LANZANO/ASSOCIATED PRESS Ralph Lauren faded denim beaded jeans accent an outfit last month at Fashion Week in New York city. PHOTOS BY MICHELLE STOCKER/THE CAPITAL TIMES For a straight or boyish figure: Paperdenim&cloth's Super Low Flare in "1 Year" wash. $176. Trendy: True Religion Breast Cancer Awareness Jeans. $240. Shown here: Joey fit in Medium Miner wash. Bargain: Big Star five-pocket bootleg stretch, dark wash. $86. Splurge: Antik Denim, Monroe fit, Copper wash. $260. Shopbop.com sells True Religion Breast Cancer Awareness Jeans for $240 a pair. The Web site donated 100 percent of its profit to the Y-Me National Breast Cancer Organization.

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

Proceeding	79014939
Applicant	RIGHT-ON CO., LTD.
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Submission	Appeal Brief
Attachments	Ex Parte Appeal Brief.pdf (12 pages)(483311 bytes)
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Signature	/William P. Berridge/
Date	05/21/2007

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

In re the Application of: Right-On Co., Ltd.

Trademark Attorney: Gina Fink

Application No.: 79/014,939

Law Office: 109

Filed: July 8, 2005

Docket No.: 128689

Mark: Design

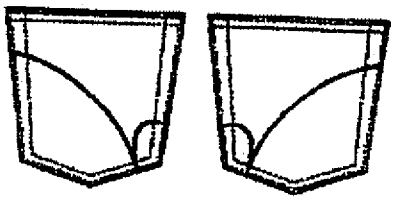
Trademark Trial and Appeal Board
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

EX PARTE APPEAL BRIEF

Applicant, Right-On Co., Ltd. (hereinafter "Right-On"), through its attorneys, hereby appeals to the Trademark Trial and Appeal Board the decision of the Examining Attorney refusing registration of Applicant's mark, which is a small, neat and discrete-yet-distinctive stitching design on side-by-side pockets.

Background

Applicant's mark is an arbitrary, distinctive pattern stitched across side-by-side pockets as depicted below:



Specifically, the mark consists of a stitching design on the side-by-side pockets. The solid lines represent stitching. The shape of the pockets is not claimed as part of the mark. The dotted lines are not claimed as a feature of the mark, but rather show the mark's position on the goods. The goods identified in the application are clothing, namely, jeans, T-shirts, polo shirts, sweat shirts, sweaters, gloves and socks; belts for clothing; footwear, namely, sports shoes, mountaineering boots and sandals; head gear for wear, namely, caps and hats.

Applicant filed an application for International Registration of the subject mark claiming priority based on its home country application and designating the United States, under the Madrid Protocol, as a country in which an extension of protection was desired. The Examining Attorney refused registration of the mark under §§ 1, 2 and 45 of the Trademark Act, as being a decorative or ornamental feature of the goods that would not be perceived as a mark by the purchasing public. The Examining Attorney based the refusal on the statement that "consumers would view pockets with stitching on them as decorative or ornamental and not as a trademark without further supporting evidence."

Applicant responded that the Examining Attorney should consider several factors to determine whether the subject mark can be registered, including (1) the commercial impression of the proposed mark; and (2) the relevant practices of the trade, pointing to a number of prior registrations by applicant and third parties on the Principal Register of pockets with stitching on them. TMEP §1202.03. The Examining Attorney again refused registration, and issued a Final Office Action. The Examining Attorney refused to consider the cited registrations because copies had not been entered into the file, and cited Supplemental Register registrations of pockets with stitching on them and Google and website evidence referring to pocket stitching designs.

Applicant filed a Request for Reconsideration on February 9, 2007, providing further arguments and entering copies of the previously cited registrations into the record. Reconsideration was subsequently denied on March 7, 2007, in an Office Action citing additional websites and Supplemental Register registrations. Applicant's Appeal, which was filed on February 16, 2007 (and suspended pending the outcome of the Request for Reconsideration), was resumed on March 20, 2007.

Argument

A design that has ornamental value may nevertheless be registered if it also functions as a trademark. *In re Corning Glass Works,* 6 USPQ2d 1032 (TTAB 1988). Indeed, if incidental ornamentality were a bar to trademark protection, the result would be that the more appealing the design, the less protection it would receive. *Keene Corp. v Paraflex Industries, Inc.*, 653F.2d 822, 211 USPQ201 (3d Cir. 1981) (the court further stating that "it would be unfortunate were we to discourage use of a spark of originality which could transform an ordinary product into one of grace."). When determining whether ornamental matter can be registered, (1) the commercial impression of the proposed mark; and (2) the relevant practices of the trade should be considered. TMEP §1202.03.

As discussed below, Applicant's distinctive pocket stitching, which includes smoothly curved lines of varying thickness and abrupt points, is an easily recognizable mark. It is common practice in the trade to use stylized stitching on hip pockets to distinguish manufacturers, and Applicant's arbitrary mark serves this source-identifying function notwithstanding any ornamental nature.

I. Commercial Impression

To determine what commercial impression is or can be created by the mark, the Examining Attorney must consider the size, location and prominence of the proposed mark, as applied to the goods, to determine whether ornamental matter serves a source-identifying function. *See, e.g., In re Dimetris, Inc.*, 9 USPQ2d 1666, 1667 (TTAB 1988); *In re Astro-God's Inc.*, 223 USPQ 621, 623 (TTAB 1984). A small, neat and discrete design feature may be just as likely to create the commercial impression of a trademark as a larger rendition of the same matter emblazoned across the front of a garment may be likely to be perceived merely as a decorative or ornamental feature of the goods. TMEP §1202.03(a).

The Examining Attorney criticizes Applicant's design as "random" and lacking creative value in comparison to other fashionable looks. The Examining Attorney dismissed Applicant's arguments based on the improper syllogy that because other famous brands including Abercrombie and Armani/Exchange "had to" register their stitching marks under §2(f) or on the Supplemental Register, Applicant must follow suit.

However, the Examining Attorney has stipulated that consumers look to the stitching designs on jean pockets to distinguish sources of jeans and consider such designs as "designer labels." Final Office Action, August 17, 2006, at page * 3, paragraph 2. The Examining Attorney incorrectly deduces that "a consumer recognizes a 'designer label' of certain stitching on a jeans pocket … because that stitching design has acquired distinctiveness as is associated with the maker/designer." The fact that one stitching design is more famous than another stitching design used in the same location in the same way does not make the less famous design merely

ornamental. Rather, as indicated by the Examining Attorney's stipulation, consumers will look to such designs as a source indicator, regardless of whether the source is famous.

Applicant's mark is a small, neat and discrete—yet distinctive—design feature that creates the impression that such a design feature indicates a source of the goods identified in the application. Applicant's mark, admitted to be "random" (i.e., arbitrary) by the Examining Attorney, is a curvy design with distinctive points located in a place easily seen when worn, or when displayed for sale by a retailer. Applicant's mark is not a typical ornamental feature that is commonly used, e.g., a flower, butterfly, etc. Rather, Applicant's mark is a unique, arbitrary design intended to indicate to the consuming public that the goods identified in the application originate from Applicant. Thus, Applicant's mark creates a commercial impression of a trademark and not of mere ornamentation.

II. Practices of the Trade

To determine that the mark is inherently distinctive, the Examining Attorney must consider whether the subject matter is unique or unusual in a particular field or whether it is a mere refinement of a commonly-adopted form of ornamentation for a particular class of goods that would be viewed by the public only as a dress or ornamentation for the goods. *See, e.g., In re General Tire and Rubber Company*, 404 F.2d 1396, 160 USPQ 415 (C.C.P.A. 1969) (referencing registration for a mark wherein three narrow white concentric rings of approximately equal width were applied to the outer surface of a dark sidewall tire).

Unless the design mark is without even a small degree of stylization, e.g., a single stripe over the side of a shoe, consumers are accustomed to distinguishing design marks on clothing, especially when the design mark is as "random," unique and distinctive as Applicant's.

Applicant's mark, detailed, arbitrarily curved stitching on side-by-side pockets, is unique in comparison to other marks in the relevant industry. In the clothing industry, such distinctive designs are routinely used not merely for aesthetics, but also to identify a source of goods.

For example, the Examining Attorney provides with her argument an Ohio State University Extension Fact Sheet on Textiles and Clothing. In a section of this document subtitled "Styling," the authors write:

> Fashion and styling details are given more attention by designers, as reflected in market offerings with much styling variety beyond traditional jeans looks .... Other looks are achieved in pleats, tucks, special yoke insets of contrast or shape, button treatments and pocket designs. Fashion detailing is evident in pockets, especially hip pockets. Pocket shape, top-stitching pattern and other trim ideas are varied to create interesting *and distinctive* [emphasis added] garment detail; however, some companies promote plain pocket jeans.

As apparent from the evidence provided by the Examining Attorney, pocket stitching detail is intended to be distinctive and to distinguish goods in the marketplace. Further, in the trade in which Applicant offers its goods, the application of design marks on pockets as trademarks is a typical practice in the industry. Examples of this trade practice include similarly distinctive stitching designs in the pockets of Levi's jeans, as well as numerous others for which registration has been obtained on the Principal Register without any evidence of acquired distinctiveness under §2(f) of the Trademark Act (*see, e.g.,* Registrations Nos. 0404248, 0577490, 1139254, 2794649, 2791156, and 3114494, of record). Indeed, Applicant itself has secured registrations on the Principal Register of similar design marks for the same goods as those identified in the current application (*see, e.g.,* Registrations Nos. 3090433, 3104095, and 3106997, of record).

Applicants provided, as illustrative examples, a listing of registrations for stitching on clothing pockets that have been granted registration on the Principal Register to support the conclusion that stitching designs are source identifiers. In the Examining Attorney's Final Rejection, the Examining Attorney referred to a number of registrations of similar goods for "stitching" marks that were granted registration on the Principal Register after showing acquired distinctiveness, or registration on the Supplemental Register for having capability of acquiring distinctiveness (which is not available to the present Applicant as this is a Madrid application), and thus deemed by the Trademark Office to be at least capable of acquiring distinctiveness and functioning as a source identifier.

Consumers have been conditioned to recognize pocket stitching as source identifiers. Some of the marks cited by the Examiner were registered in recent years, for example, 2005 and 2006. However, many marks were registered much earlier. In fact, Levi's stitching and double arcuate design was registered as early as 1943. Consumers have had the opportunity to be conditioned to view such marks as source identifiers, and have so viewed them, for as long as 64 years.

Applicant is not alone. Levi's has successfully asserted trademark infringement actions based on the presumption that consumers are quite capable of recognizing trademarks as source identifiers and have been conditioned to view stitching marks as source identifiers. Supporting evidence provided by the Examining Attorney in her response to the Request for Reconsideration discusses the Levi's lawsuits. http://www.newyorktimes.com/2007/01/29/business/29jeans.html?ex=1327726800&en=87d256ba8ee9dcb1&ei=5088&partner=rssnvt&enc=rss (March 7, 2007). The article states that Levi's has filed nearly 100 lawsuits based on pocket design marks against

its competitors since 2001. The article further states that nearly all of the cases have settled out of court, with Levi's rivals agreeing to cease infringement of Levi's arcuate stitching design and red labels. Not only have manufacturers recognized that stitching designs on jeans pockets are capable of functioning as trademarks, they have asserted and acquiesced in rights to such marks and the goodwill embodied in the marks.

Nonetheless, the Examining Attorney used this evidence to improperly deduce a blanket rule that "stitching" marks are not inherently distinctive, and that applicants pursuing such marks must show acquired distinctiveness under Trademark Act §2(f). The Examining Attorney's reasoning, however, is based on the tautological presumption that "a consumer recognizes a designer label of certain stitching on a jeans pocket ... because that stitching design has acquired distinctiveness as associated with the maker/designer."

The Examining Attorney cites case law that supports the proposition that although there is no prescribed method or place for a fixation of a mark to goods, the location of a mark on the goods "is part of the environment in which the [mark] is perceived by the public and ... may influence how [the mark] is perceived." *In re Tilcon Warren, Inc.*, 221 USPQ 86, 88 (TTAB 1984); *see In re Paramount Pictures Corp.*, 213 USPQ 1111, 1115 (TTAB 1982). The Examining Attorney correctly paraphrases that where consumers have been conditioned to recognize trademarks in a certain location, as on the breast area of a shirt, ornamental matter placed in a different location is less likely to be perceived as an indication of source. TMEP §1202.03(b). However, the Examining Attorney again incorrectly presumes that consumers are incapable or unwilling to consider the pockets of jeans, slacks or trousers to be a common location on which to recognize the trademarks of a manufacturer. The exemplary marks both on

the Principal Register and the Supplemental Register provided above support the antithesis of this assertion.

The Examining Attorney also argues that stitching on pockets is not inherently distinctive because it is just as common for random stitching designs to be added to jean pockets for no other purpose but ornamentation. In support of this statement, the Examining Attorney provides several website printouts offering tips to individuals with sewing machines on how to sew stitching designs on pockets. The fact that individuals can modify clothing does not mean such designs are not inherently distinctive, it merely indicates individuals' ability to copy designs, or create their own. Nonetheless, the test of whether a mark is distinctive is whether the purchaser will consider the mark to indicate the source of the goods on which the mark is used. In the case of individuals making their own clothes, there are no purchasers, these goods are not offered in commerce, and the issue of source indicators is moot.

Furthermore, the evidence provided by the Examining Attorney indicates that individuals that make their own clothing want to mimic the distinctiveness of having a consistent unique stitching design in order to distinguish their design from those of others, even when those clothes are not offered for sale anywhere. That is, the stitching designs on jeans pockets has become so recognized as a "designer" trademark indication of origin that amateurs are using this same technique to have their clothes appear to be designer jeans, with the designs identifying themselves as the designer.

This strategy is not restricted to amateurs. In response to Applicant's Request for Reconsideration, the Examining Attorney provided supporting evidence to maintain her assertion that "designer stitching" must be used for lengthy periods of time or emphasized in the company's

advertising to acquire distinctiveness. Supporting documents include a newspaper article that discusses the designer denim market. See Amy Mertz, PERFECT JEAN-EDICTS; PRICES ARE PUSHING $250 FOR TRENDY DENIM BRANDS, The Capital Times, Madison, Wisconsin, (October 11, 2005). The article states that department stores and mall-type chains like Gap carry moderately expensive denim from manufacturers that are "imitating the premium labels-with an emphasis on more ornamental back pockets, contrast stitching, softer material, lycra for a snug fit, and most importantly, a heftier price tag." *Id.* Thus, stitching designs on jean pockets are so recognized as a source indicator that moderately famous labels are attempting to capitalize on the goodwill of premium labels by using similar stitching designs.

Other evidence provided by the Examining Attorney in her response to Applicant's Request for Reconsideration also indicates that there is widespread use of greatly varying stitching designs as trademarks by different jeans manufacturers. Specifically, the Examining Attorney provided web search results that included numerous jean brands and respective photographs of stitching designs on back pockets. http://jeans/pbwiki.com/JeanPocketProject (March 7, 2007). It is apparent from the brand listing and corresponding photographs provided by the Examining Attorney that each brand has its own distinctive stitching pattern. For example, Abercrombie has easily recognizable overlapping double curved stitching. http://jeans.pbwiki.com/Abercrombie "March 7, 2007". Armani Exchange has a distinctive upward sharp curve laid upon an otherwise blank background. http://jeans.pbwiki.com/Armani%20Exchange. Guess has layered multicolored V-shaped stitching. http://jeans.pbwiki.com/Guess. Lucky Brand Jeans has a simple but distinctive overlapping and opposing arcuate design, and although arcuate, is still easily distinguishable

from Levi's arcuate design. http://jeans.pbwiki.com/Lucky%20Brand. This evidence thus further proves that such pocket designs are distinctive source identifiers that are perceived as marks by the consuming public.

Applicant's design is similarly inherently distinctive. Because of the nature of the design and the context in which it is used, prospective purchasers would perceive it as a designation that identifies goods or services produced by a particular entity, whether known or anonymous. Applicant uses its design on side-by-side pockets, where the pockets are easily seen whether folded on display in a store, or worn by a consumer. Consumers have been conditioned for over half a century to recognize clothing manufacturers from such pocket stitching, and recognize that such pocket stitching identifies the source of the clothing and is a way to distinguish among clothing sources. Thus, designs in such locations are known to be source identifiers just as designs or marks located in the breast area of a shirt as known to be source identifiers, as conceded by the Examining Attorney.

Because the practice of the trade confirms that pocket designs perform the function of a trademark by signifying to purchasers and prospective purchasers the goods of a particular entity in distinguishing the goods from those of others, the subject mark is capable of distinguishing the Applicant's goods. TMEP §1202.03(b).

Conclusion

Based on the preceding arguments, in concert with the documents and materials previously entered into the record, Applicant has provided clear reasoning and evidence that Applicant's mark is inherently distinctive, and the Examining Attorney's refusal to register under

§§ 1, 2 and 45 is erroneous. Accordingly, Applicant respectfully requests that the refusal to register Applicant's mark be reversed.

No fee is believed to be due in connection with the filing of this Appeal Brief. However, any fee deemed payable is authorized to be charged to Deposit Account No. 15-0461.

Respectfully submitted,

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

Proceeding	79014939
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Attachments	Motion to Consolidate.pdf (2 pages)(57488 bytes)
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Date	05/21/2007

EXHIBIT E

TRADEMARK

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

In re the Application of: Right-On Co., Ltd. Trademark Attorney: Gina Fink

Application No.: 79/014,939 Law Office: 109

Filed: July 8, 2005 Docket No.: 128689

Mark: Design

MOTION TO CONSOLIDATE

Applicant Right-On Co., Ltd., by and through counsel, hereby requests that the Board order consolidation of appeals for Application Nos. 79/014,936 and 79/014,939. Cause to consolidate is discussed below.

The decision to consolidate cases is a matter of discretion for the Board. The Board may consolidate cases involving common questions of law or fact. *See, e.g., S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1297 (TTAB 1997) (both proceedings involved the same mark and virtually identical pleadings). Even in cases where marks vary, the Board has ordered consolidation for reasons including judicial economy. *See, e.g., Ritchie v. Simpson*, 41 USPQ2d 1859 (TTAB 1996), *rev'd on other grounds*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999) (cases consolidated despite variations in marks and goods).

The Board will save time, effort and expense by consolidating the above-mentioned appeals. The subject marks in both appeals belong to the same Applicant, as represented by the same counsel. In both cases, Applicant appeals from the same Trademark Examining Attorney's denial to register Applicant's design marks. In both cases, the Examining Attorney denied

registration of side-by-side stitching designs under §§ 1, 2, and 45 of the Trademark Act on the same grounds and the same evidence. The only difference between both applications and appeals is the particular stitching design of Applicant's mark. Aside from references to the specific design of each mark, the Examining Attorney's grounds for refusal and Applicant's factual background, legal arguments and supporting authority in both Appeal Briefs are identical.

In accordance with the foregoing, Applicant moves to consolidate the appeals for Application Nos. 79/014,936 and 79/014,939.

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