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

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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

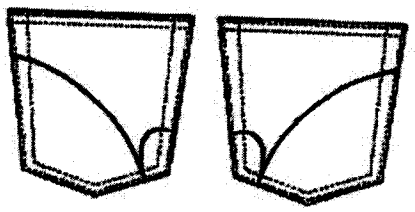
Trademark Trial and Appeal Board
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

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. <u>Practices of the Trade</u>

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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