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

Proceeding	86670074
Applicant	QVC, Inc.
Applied for Mark	DENIM & CO.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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In re Application of QVC, Inc. :  
Mark: **DENIM & CO.** :  
Class: **25** :  
Serial No. 86/670,074 :  
Filed: June 22, 2015  
Examining Attorney: David I, L.O. 114  
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UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

**APPEAL BRIEF OF APPLICANT**

QVC, Inc. (“Applicant”) by and through its undersigned counsel, hereby submits the following Appeal Brief in support of Applicant’s U.S. Application Serial No. 86/670,074 (the “Application”) to register the mark DENIM & CO., (sometimes referred to herein as “Applicant’s Mark”).

**STATEMENT OF FACTS**

Applicant appeals from a Final Refusal of registration issued by the Examining Attorney pursuant to 15 U.S.C. § 1052(a) rejecting Applicant’s Application to register the mark DENIM & CO. as deceptive for “women's clothing, namely, shirts, dresses, skirts, tops, bottoms, sweaters, shorts, pants, jackets, leggings, t-shirts made of materials other than denim all sold through interactive television and interactive online media wherein the clothing products offered for sale are modeled and whereby detailed information regarding such clothing products is

provided including information as to the fabrics and materials from which such clothing products are made” (“Applicant’s Non-Denim Goods”).<sup>1</sup> Applicant has submitted a timely Notice of Appeal and respectfully requests that the Trademark Trial and Appeal Board (“the Board”) reverse the Examining Attorney’s final refusal.

### **ISSUE ON APPEAL FOR DECISION**

Whether, in light of the Examining Attorney’s burden to prove deceptiveness, Applicant’s consumers encountering the DENIM & CO. mark in connection with women’s non-denim clothes “sold through interactive television and interactive online media wherein the clothes are modeled and whereby detailed information regarding fabrics and materials used in making the clothing is provided” will nonetheless believe that such clothes are made of denim and, if so, whether such mistaken belief will influence a significant portion of such consumers to purchase the goods.

### **BACKGROUND**

#### **A. The History and Extent of Applicant’s Use of DENIM & CO.**

DENIM & CO. is one of QVC’s oldest and most famous casual lines of apparel and accessories. (See March 24, 2016 Response to Office Action, Exhibits 2-34). QVC’s consumers have enthusiastically purchased millions of units of DENIM & CO. clothing for the past 25 years. (Id. Exhibit 1; July 10, 2017 Response to Office Action Exhibit A ¶4). From 1994 through 2013, sales of DENIM & CO. products exceeded \$2.2 Billion. (See March 24, 2016 Response to Office Action, Exhibit 1). DENIM & CO. became QVC’s most popular and best-selling proprietary brand of clothing by satisfying consumer expectations and providing them

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<sup>1</sup> The Office Action does not apply to the remaining goods listed in the Application, i.e., “women’s clothing, namely, shirts, dresses, skirts, tops, bottoms, sweaters, shorts, pants, jackets, leggings, t-shirts made in whole or substantial part of denim.”

high quality goods, (Id. at ¶12.), not by deceiving customers into thinking that knit sweaters, and cotton t-shirts are made of denim. (Id. at ¶4).

**B. The Test for Deceptiveness**

In order for Applicant's mark, as applied to Applicant's Non-Denim Goods, to be rejected as "deceptive", the Examining Attorney bears the burden of presenting evidence sufficient for all three of the following questions to be answered in the affirmative:

- (1) Is the mark misdescriptive of the character, quality, function, composition or use of Applicant's Non-Denim Goods?
- (2) If so, are prospective purchasers likely to believe that the misdescription actually describes Applicant's Non-Denim Goods?
- (3) If so, is the misdescription likely to influence a significant portion of the relevant consumers' decision to purchase Applicant's Non-Denim Goods?

See, August 13, 2018 Final Office Action; In re Spirits Int'l, N.V., 563 F.3d 1347, 90 USPQ2d 1589 (Fed. Cir. 2009); In re Budge Mfg. Co., 857 F.2d 773, 775, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988), aff'g 8 USPQ2d 1790 (TTAB 1987).

Applicant will address these three questions in the order most relevant to the facts before the Board, starting with the most obviously dispositive question.

**ARGUMENT**

**A. Are prospective purchasers likely to believe that the purported misdescription actually describes Applicant's Non-Denim Goods?**

**(i) The Very Language of the Description Precludes a Finding of Misdescription**

The registrability of the mark DENIM & CO. must be determined not based on its relationship to non-denim clothing generally, but rather based on its relationship to Applicant's Non-Denim Goods as specifically identified in the Application. "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 in connection with those goods or services, 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.” Perfect Mem'ls. LLC v. United Priority Distribs., 2016 TTAB LEXIS 95, \*29 (TTAB February 29, 2016); In re J.T. Posey Co., 2015 TTAB LEXIS 278, \*31 (TTAB August 18, 2015) (“Whether a mark or a component of a mark is merely descriptive is determined in relation to the goods for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork.”); In re N.F. Smith & Assocs., LP, 2018 TTAB LEXIS 305, \*3 (TTAB August 17, 2018) (same); In re Abcor Dev. Corp., 588 F.2d 811, 814 (C.C.P.A. 1978) (Board noted statutory requirement that mark be examined as-applied to the specific goods in question).

At issue here is the registrability of DENIM & CO. for non-denim clothing items “sold through interactive television and interactive online media wherein the clothing products offered for sale are modeled and whereby detailed information regarding such clothing products is provided including information as to the fabrics and materials from which such clothing products are made.” How could a consumer who has just watched a host not only display, but also explain the fabric composition of a sweater, be left with the impression that the sweater is made of denim? It is simply not reasonable to believe that such a misunderstanding is likely, and likelihood, after all, is the test.

It appears that the Examining Attorney did not even consider Applicant’s July 19, 2018 amendment whereby Applicant narrowed the non-denim goods to those sold in a context in which deception is not only unlikely, but nearly impossible.

According to the Examining Attorney, the prospective purchasers of Applicant's Non-Denim Goods would likely believe that such goods are made of denim because "the previously sent evidence shows that it is common in Applicant's industry *for such goods* be made from denim." (See, August 13, 2018 Final Office Action). What is the Examining Attorney referring to when he refers to "such goods?" Clothing generally? Casual clothing? It is not clear. What is clear, however, is that he could not be referring to non-denim clothing sold by a host who has just explained to viewers that the DENIM & CO. sweater that is being modeled on the screen is made of merino wool, or to goods sold online in a context in which the material from which the garments are made is clearly spelled out. (See June 10, 2017 Response to Office Action, Exhibit A ¶8 with screenshots of, inter alia, "Denim & Co. Gingham Check Button Front Shirt" , "Denim & Co. Embroidered Gauze Dress" and "Denim & Co. Button Front Seersucker Sleeveless Collared Tunic"). All risk of misapprehension has been eliminated by the narrowing of Applicant's applied-for non-denim goods to include only such non-denim goods that will be "sold through interactive television and interactive online media wherein the clothing products offered for sale are modeled and whereby detailed information regarding such clothing products is provided including information as to the fabrics and materials from which such clothing products are made." A consumer who has not only seen the non-denim products modeled, but also been given "detailed information regarding . . . the fabrics and materials from which such clothing products are made" could not possibly come away with the mistaken belief that Applicant's non-denim clothing is made from denim. Applicant's amended description<sup>2</sup> of its

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<sup>2</sup> The Examining Attorney offers a red herring when he writes "prospective consumers will have no idea that the limitation introduced by the Applicant exists." (See August 13, 2018 Final Office Action). While it is certainly true that the typical QVC consumer will not consult TSDR prior to tuning in to QVC programming, that fact is irrelevant. What matters is not what consumers know about a brand owner's trademark portfolio. What matters is the scope of

non-denim goods makes such mistakes impossible. Applicant has so specified the nature of its non-denim goods as to overcome any realistic concerns the Examining Attorney may once have had. Accordingly, the refusal to register should be reversed.

**(ii) The Language of the Description Reflects Reality**

As attested to by Applicant's then-Vice President, David O'Connor, “[b]oth on air and online, QVC identifies the material from which its DENIM & CO. garments are made. These include jersey, cotton, gauze, gingham, seersucker, linen, terry, stretch lace, mesh lace, and leather, to name a few.”<sup>3</sup> (See June 10, 2017 Response to Office Action, Exhibit A ¶8). “Thus, the overall commercial context in which QVC sells its DENIM & CO. line of apparel makes abundantly clear to consumers that the term ‘denim’ in the mark DENIM & CO. does not solely and literally refer to the material from which some of the goods are made . . . .” (Id. ¶10).

The Examining Attorney offered no testimony to contradict or in any way undermine Mr. O'Connor’s sworn testimony.<sup>4</sup> Therefore, the record clearly and undeniably establishes that insofar as Applicant’s description of goods states that “detailed information regarding such clothing products is provided including information as to the fabrics and materials from which such clothing products are made,” that description accurately reflects reality.

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protection an applicant seeks from the USPTO. And when the goods for which protection is sought by their very nature preclude consumer deception, a deceptiveness refusal is improper.

<sup>3</sup> This testimony was given *before* Applicant amended to the current description of goods. Applicant notes this lest there be any impression that Mr. O'Connor was offering such testimony to justify the July 19, 2018 amendment. On the contrary, that amendment was made to most precisely reflect the reality sworn to by Mr. O'Connor.

<sup>4</sup> There is no evidence in the instant case that Applicant is using its mark DENIM & CO. in a deceptive manner. In fact, Applicant has provided an abundance of advertising and other evidence that it is made clear to consumers what they are buying (i.e. denim goods v. non-denim goods). *In re Abcor Dev. Corp.*, 588 F.2d 811, 814 (C.C.P.A. 1978) (Board examined mark and advertisements using mark in order to properly evaluate descriptiveness of the mark). In light of this and given the longstanding and extensive use of the DENIM & CO. mark, consumers are quite familiar with the clothing line branded with the mark. Therefore, they are not deceived.

**B. Is the mark misdescriptive of the character, quality, function, composition or use of Applicant’s Non-Denim Goods?**

**(i) The term “Denim” in the Mark Describes a Lifestyle**

Mr. O’Connor also testified that the term “denim” in Applicant’s Mark does not refer to the material content of Applicant’s garments, but rather to a comfortable, casual and relaxed lifestyle, i.e., the “Denim Lifestyle”. (Id. at ¶7). Thus, as Mr. O’Connor makes clear in his Declaration, while some items in the line are, in fact, made of denim, other items are not. Indeed, the preponderance of goods in the line are not made of denim, but rather of such varied materials as jersey knit, cotton, gauze, gingham, seersucker, linen, terry, lace (both stretch and mesh), and leather, to name a few. (Id. at ¶8).<sup>5</sup> As the pictures in Paragraph 8 of Mr. O’Connor’s Declaration make abundantly clear, it strains credulity to think that consumers would be deceived into believing that the non-denim items in Applicant’s line – whether it be a lace top, a gauze dress or a cable knit sweater – are made of denim.

The invocation of “denim” to convey a lifestyle, as opposed to a fabric, is common and has not been limited to Applicant. Consumers, familiar with all the trappings of the “Denim Lifestyle,” are used to seeing all types of consumer products, including both denim and non-denim clothing, branded with a mark including the word “denim” or “jeans”. Examples of clothing lines including both denim and non-denim products include RALPH LAUREN’S DENIM & SUPPLY, THE ROCAWEAR DENIM COMPANY, BLUE JEANS JAM, SOUTHPOLE DENIM COMPANY, and GUESS DENIM COMPANY. (See, March 24, 2016 Response to Office Action, Exhibit A). Other examples include BLUE HILL AMERICAN

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<sup>5</sup> Applicant’s Director of Buying Bridget Caitlon Love testified similarly in her October 27, 2016 Affidavit. Ms. Love testified that only 15-30% of the clothing sold under the DENIM & CO. brand is actually made from denim. (See the October 27, 2016 Affidavit of Bridget Caitlin Love attached to Applicant’s October 27, 2016 Response to Office Action.)

DENIM CO., TOMMY JEANS, BROOKLYN DENIM CO., ARMANI JEANS, CALVIN KLEIN JEANS, PEPE JEANS and DKNY JEANS. (See, January 31, 2018 Response to Office Action, Exhibits D and E). As a result, consumers appreciate that the appearance of the term “denim” in marks such as Applicant’s Mark is suggestive of a relaxed lifestyle, not a direct reference to a specific material fabrication. As such, the term “denim” in Applicant’s Mark does not describe – let alone misdescribe – the material content of Applicant’s Non-Denim Goods.

The Examining Attorney’s recitation of dictionary definitions and assertion that prospective purchasers of Applicant’s goods will naturally believe the non-denim goods in Applicant’s DENIM & CO. line are made of denim hardly qualifies as proof, let alone the substantial proof that is required to find a mark “deceptive.”

**(ii) USPTO Practice**

The USPTO has a long and substantial history of acknowledging that “denim” refers to more than just a specific fabric and thus registering denim-formative marks for items not explicitly made from denim. For example, the USPTO granted Ralph Lauren a Principal Register registration (No. 4430796) for the mark DENIM & SUPPLY RALPH LAUREN for “belts; blouses; coats; dresses; hats; jackets; pants; scarves; shirts; shorts; skirts; t-shirts; tops” and did so without any requirement to limit the goods to those made in whole or substantial part of denim. (See, July 10, 2017 Office Action Response, as Exhibit B). By what logic is DENIM & SUPPLY registrable for items not explicitly made from denim while DENIM & CO. is rejected?

All of the marks in the chart below include the term DENIM or JEANS and were registered without any of the clothing items or accessories being limited to goods “made in whole or in substantial part of denim.” More notably, several of the registrations cover goods


that are explicitly made from leather, (e.g. leather handbags, leather cases) or were the types of goods that were almost certainly not made from denim (e.g. sweaters, jumpers, cardigans, pullovers, dressing gowns, bathrobes) yet matured to registration without being limited to goods made in whole or in substantial part of denim” and without being denied based on deceptiveness.<sup>6</sup>

Mark/Name	Reg. No. and Date	Goods	Owner
AJ ARMANI JEANS	2742849 7/29/03	<p><b><u>Class 18</u></b></p> <p><b>Leather and imitations of leather sold in bulk; leather goods</b>, namely, handbags, purses, wallets, brief cases, toiletry cases sold empty, cosmetic cases sold empty; <b>animal skins, animal hides</b>; and traveling bags.</p> <p><b><u>Class 25</u></b></p> <p>Clothing, namely, pullovers, <i>cardigans</i>, <i>sweaters</i>, trousers, skirts, jackets, blouses, shirts, jeans, <i>sweatpants</i>, shorts, <i>sweatshirts</i>, suits, dresses, <i>overcoats</i>, coats, <i>raincoats</i>, belts, jerseys, neckwear, <i>socks</i> and stockings, vests, waistcoats, <i>jumpers</i>, <i>tracksuits</i>, blousons, T-shirts, <i>anoraks</i>, suspenders, <i>loungewear</i>, headwear, overalls, hats and caps, gloves, shoes, sandals, <i>boots and slippers</i>.</p> <p><b><u>Class 35</u></b></p> <p>Retail store services featuring <i>optical goods</i>,</p>	GIORGIO ARMANI S.P.A

<sup>6</sup> Items that are explicitly non-denim are in **bold**, (e.g., leather jackets (LIFE AFTER DENIM and LA DENIM), wool hats (HIFIGGER DENIM), fur coats and shearling (CK CALVIN KLEIN JEANS), and leather belts (WRANGLER JEANS)) and items that would almost certainly not be made from denim are in **bold and italics** (e.g., swimsuits, wet suits, socks, hosiery, underwear, brassieres, lingerie, pajamas, bath robes, sweaters, cardigans, knit tops, woven tops, sweatshirts, sweatpants, khakis, ear muffs).


Mark/Name	Reg. No. and Date	Goods	Owner
		<p><i>watches, jewelry, costume jewelry, leather goods, textiles and textile goods, clothing articles and footwear, <b>games, playthings, sporting articles, foodstuffs, smoking articles</b>; business management of shops of <b>perfumery and cosmetics, articles for house cleaning, cutlery, optical goods, watches, jewelry, costume jewelry, stationery, leather goods, furniture articles, house articles</b>, textiles and textile goods, clothing articles and footwear.</i></p>	
<p><b>DENIM &amp; SUPPLY RALPH LAUREN</b></p>	<p>4438197 11/26/13</p>	<p><b><u>Class 18</u></b>  Handbags</p>	<p>PRL USA Holdings, Inc.</p>
<p><b>DENIM &amp; SUPPLY RALPH LAUREN</b></p>	<p>4430736 11/12/13</p>	<p><b><u>Class 25</u></b>  Belts; Blouses; Coats; Dresses; Hats; Jackets; Pants; <i>Scarves</i>; Shirts; Shorts; Skirts; T-shirts; Tops</p>	<p>PRL USA Holdings, Inc.</p>
<p><b>PEPE JEANS</b></p>	<p>5276893 8/29/17</p>	<p><b><u>Class 18</u></b> <b>Leather</b>, unworked or semi-worked; <b>imitation leather</b>; handbags, backpacks, satchels, haversack, knapsacks, rucksacks, valises, cases, suitcases, luggage, briefcases, <b>key cases made of leather</b>; travelling bags, purses, pocket wallets and pouches, <i>umbrellas, parasols and walking sticks</i>; holdalls; <b>leather straps; leather cases, leather-board boxes</b></p> <p><b><u>Class 25</u></b> Clothing, namely, shirts; blouses; polo shirts; tops; jumpsuits; sports jerseys; shorts, trousers, jeans, skirts, culottes, dresses,</p>	<p>Pj Hungary Kft</p>

Mark/Name	Reg. No. and Date	Goods	Owner
		<p>suits, waistcoats, t-shirts, <i>sweatshirts</i>, <i>sweat pants</i>, tracksuits, <i>scarves</i>, <i>shawls</i>, belts, <i>socks</i>, tights, <i>underwear</i>, vests, bodices, <i>dressing gowns</i>, <i>bathrobes</i>, smocks, <i>beachwear</i>, <i>swimwear</i>, <i>ties</i>, braces, bandanas, <i>cravats</i>, gloves, mittens and wristbands; footwear, namely, ladies, men's and children's shoes, beach shoes, <i>boots</i>, <i>football boots</i>, <i>gymnastic and sports shoes</i>, casual shoes, overshoes, <b>leather shoes</b>, canvas shoes, sandals and <i>slippers</i>;</p> <p>headgear, namely, hats, sun hats, sun visors, <i>rain hats</i>, berets, caps, headscarves, beanies, <i>earmuffs</i>; articles of outer clothing, namely, jackets, coats, <i>overcoats</i>, <i>rainwear</i>, <i>mackintoshes</i>, <i>parkas</i>, <i>ponchos</i>, vests, gilets, blazers, <i>down coats</i>, waistcoats; knitwear, namely, <i>sweaters</i>, <i>jumpers</i>, <i>cardigans</i>, pullovers, sleeveless pullovers, jackets, <i>sweatshirts</i>, dresses, tops</p> <p><b><u>Class 35</u></b>  The bringing together, for the benefit of others the following goods clothing, footwear, headgear, clothing accessories, <i>jewelry</i>, luggage, bags, handbags, cases, suitcases, briefcases, <b>leather handbags</b>, <b>leather cases</b>, <b>leather briefcases</b>, <b>leather wallets</b>, <b>leather bags</b>, <b>leather pouches</b>, <b>leather purses</b>, <b>leather and imitation leather</b>, <b>leather key cases</b>, <b>leather shoulder straps</b>, <b>credit card holders made of leather</b>, <b>umbrellas</b>, <b>parasols</b>, wallets and pouches, purses, travelling sets, travelling cases, <i>walking sticks</i>, <i>shooting sticks</i>, <i>perfumery</i>, <i>watches</i>, <b>earrings of precious metal</b>, <b>bracelets of precious metal</b>, <b>jewelry of precious metal</b>, <b>key fobs made of precious metal</b>, belt buckles, key rings, key cases, towels, hot water bottle covers, handkerchiefs, bed linen, travelling rugs, textiles and textile goods, cases and</p>	

Mark/Name	Reg. No. and Date	Goods	Owner
		holders for handheld consumer electronic and telecommunication devices, <i>spectacles, sunglasses</i> , cases and <i>frames for spectacles and sunglasses</i> , chains and cords <b>for spectacles and sunglasses</b> , cleaning cloths, portable telephone fascias, cases and holders, computer cases, cd and dvd holders and cases, holders and cases for portable music players, eyewear goods, <i>printed matter, photographs, stationery, pens</i> and pen holders, and office requisites, parts and fittings for all the aforesaid goods, enabling customers to conveniently view and purchase those goods; business management services; business administration; business advisory services; franchise services, namely, offering business management assistance in the establishment and operation of retail stores featuring all the aforementioned goods; concession stands featuring all of the aforementioned goods; commercial administration of the licensing of the goods and services of others; retail store and wholesale store services featuring all of the aforementioned goods	
<p><b>ARMANI JEANS</b> <b>EST 1981 and</b> <b>Design</b></p> 	4557883 7/1/14	Clothing, namely, pullovers, <i>cardigans, sweaters</i> , trousers, skirts, jackets, blouses, shirts, jeans, pants, <i>sweatpants</i> , shorts, <i>sweatshirts</i> , suits, dresses, <i>overcoats</i> , coats, <i>raincoats</i> , belts, wrist bands, jerseys, neckwear, <i>scarves, socks and stockings, hosiery, tights</i> , vests, waistcoats, <i>jumpers</i> , tracksuits, blousons, gym suits, knickers, t-shirts, <i>anoraks</i> , suspenders, <i>loungewear, underwear</i> , tank tops, <i>underpants</i> , brassieres, corsets, <i>petticoats, nightgowns, dressing gowns, bath robes, beachwear, swimsuits, sleepwear</i> , headwear, overalls, gloves; headgear, namely, hats and caps, bandanas, head sweat bands, <i>head scarves</i> ;	Giorgio Armani S.P.A.

Mark/Name	Reg. No. and Date	Goods	Owner
		shoes, sandals, <i>boots</i> and <i>slippers</i>	
<b>CANAL JEAN CO</b>	1279046 5/22/84	Men's and women's wearing apparel-namely, pants, jeans, jackets, blouses, shirts, <i>sweaters</i> , outer jackets, coats, t-shirts, <i>sweatshirts</i> and <i>sweatsuits</i>	Canal Jean Co., Inc.
<b>CK CALVIN KLEIN JEANS</b>	2069292 6/10/97	Women's, men's, boys and girls wearing apparel, namely, shirts, t-shirts, tank tops, blouses, jackets, sport coats, pants, dresses, shorts, walking shorts, skirts, jeans, gloves, suits, blazers, clothing belts, <i>socks</i> , <i>tights</i> , hats; outerwear, namely, jackets, coats, vests, <i>sweaters</i> , <i>shearling jackets</i> , <i>rain wear</i> , <i>rain coats</i> , <i>capas</i> , <i>ponchos</i> , warm-up suits, <i>scarves</i> , <i>shawls</i> , <i>clothing ties</i>	Calvin Klein Trademark Trust
<b>DENIM &amp; SUPPLY RALPH LAUREN</b>	4430736 11/12/13	Belts; blouses; coats; dresses; hats; jackets; pants; <i>scarves</i> ; shirts; shorts; skirts; t-shirts; tops	Prl Usa Holdings, Inc.
<b>DKNY JEANS</b>	2992294 9/6/05	Pants, jeans, shorts, <i>jumpers</i> , dresses, skirts, t-shirts, shirts, blouses, jackets, blazers, <i>cardigans</i> , <i>trench coats</i> , dusters, vests, <i>anoraks</i> , overalls, <i>sweatshirts</i> , skorts, and <i>sweaters</i>	Gabrielle Studio, Inc.
<b>DR. DENIM</b>	2772303 10/7/03	pants, shirts, hats, t-shirts, caps, <i>underwear</i>	Dr. Denim, Inc.
<b>FOSTER JEANS CO.</b>	3889063 12/14/10	Baseball caps; <i>bathing suits</i> ; belts; blouses; <i>boots</i> ; caps; <i>cardigans</i> ; dresses; gloves; hats; jackets; <i>leather jackets</i> ; <i>neckties</i> ; <i>night gowns</i> ; <i>pajamas</i> ; pants; shirts; shoes; short-sleeved or long-sleeved t-shirts; shorts; <i>ski jackets</i> ; <i>ski pants</i> ; skirts; <i>socks</i> ; suspenders; <i>sweat pants</i> ; <i>sweat shirts</i> ; <i>sweaters</i> ; t-shirts; tank tops; <i>underwear</i> ;	California Lake Capital

Mark/Name	Reg. No. and Date	Goods	Owner
		<i>wet suits</i>	
<b>“HARDEST WORK’IN DENIM”</b>	3379657 2/5/08	Clothing, namely, tops, bottoms, jeans, pants, shirts, t-shirts	Haulin’ Jeans Co., Inc.
<b>HILFIGER DENIM</b>	2899046 11/2/04	Clothing, namely, shirts, t-shirts, <i>sweatshirts</i> , tank tops, <i>sweaters</i> , <i>turtleneck</i> s, shorts, <i>sweatpants</i> , blazers, pants, jeans, skirts, suits, overalls, dresses, vests, jackets, coats, <i>parkas</i> , <i>ponchos</i> , <i>swimwear</i> , <i>bikinis</i> , <i>swim trunks</i> , <i>overcoats</i> , belts, hats, <b>wool hats</b> , caps, <i>scarves</i> , gloves	Tommy Hilfiger Licensing LLC
<b>JEANS &amp; CO and Design</b>  <b>JΣANS&amp;C•</b>	5001772, 7/19/16	Clothing, namely, shirts, dresses, jackets, tops and bottoms; trousers and jeans; shirts for children; <i>underwear</i> ; shoes; hats; <i>hosiery</i> ; mittens; sashes for wear; sleep masks	Shanghai Yiyongtang Department Store Co., LTD.
<b>LA DENIM</b>	3203054  1/23/07	Men's and women's apparel, namely, belts, <i>undershirts</i> , <i>socks</i> , shirts, t-shirts, <i>knit tops</i> , skirts, pants, trousers, shorts, <i>sweaters</i> , vests, coats, jackets, blouses, and polo shirts	Guess?, Inc.
<b>LAUREN JEANS COMPANY</b>	3254299 6/19/07	Wearing apparel, namely, jeans, vests, jackets, coats, shirts, <i>sweatshirts</i> , overalls, blouses, skirts, dresses, hats, pants, <i>socks</i> , gloves and footwear	Prl Usa Holdings, Inc.
<b>LRL LAUREN JEANS CO. RALPH LAUREN</b>	4082400  1/10/12	Clothing, namely, <b>khakis</b> ; dresses; jackets; jeans; shirts; skirts; <i>sweaters</i> ; t-shirts	Prl Usa Holdings, Inc.

Mark/Name	Reg. No. and Date	Goods	Owner
<b>LIFE AFTER DENIM</b>	3606501 4/14/09	Clothing, namely, shirts, tops, <i>undershirts</i> , tank tops, cotton woven shirts, <i>knit shirts</i> , polo shirts, t-shirts, <i>sweatshirts</i> , <i>sweaters</i> , vests, <i>cardigans</i> , pants, slacks, shorts, <i>sweatpants</i> , jeans, coats, jackets, blazers, <i>rain coats</i> , <i>overcoats</i> , top coats, sports coats, <b>leather coats</b> , <b>leather jackets</b> , <i>waistcoats</i> , overalls, <i>scarves</i> , <i>thermal underwear</i> , gloves, mittens, wristbands, <i>neckties</i> , belts; headwear	Everine Fashion Ltd.
<b>NAUTICA JEANS COMPANY</b>	2523102 12/25/01	Men's, women's and children's wearing apparel, namely, <i>hosiery</i> , shoes, <i>undershirts</i> , <i>boxer shorts</i> , shirts, blouses, trousers, pants, jackets, coats, <i>bathing suits</i> , <i>bathrobes</i> , shorts, <i>scarves</i> , <i>socks</i> , hats and caps, gloves and <i>foul weather gear</i>	Nautica Apparel, Inc.
<b>PEPE JEANS LONDON</b>	1861869 11/8/94	Clothing; namely, men's, women's, and children's trousers, shorts, culottes, skirts, dresses, jackets, shirts, t-shirts, blouses, <i>knitted tops</i> , <i>jumpers</i> , <i>sweaters</i> , <i>cardigans</i> , coats, vests, jumpsuits, <b>tracksuits</b> , overalls, belts, jeans, <i>sweatshirts</i> , <i>underwear</i> , gilets, <i>socks</i> , caps and hats, and shoes	Pj Hungary Kft.
<b>PEPE JEANS LONDON (Stylized)</b>  	1951723 1/23/96	Clothing; namely, men's, women's, and children's trousers, shorts, culottes, skirts, dresses, jackets, shirts, t-shirts, blouses, <i>knitted tops</i> , <i>jumpers</i> , <i>sweaters</i> , <i>cardigans</i> , coats, vests, jumpsuits, <b>tracksuits</b> , overalls, belts, jeans, <i>sweatshirts</i> , <i>underwear</i> , <i>socks</i> , caps and hats, and shoes	Pj Hungary Kft.
<b>POLO JEANS CO.</b>	2049948 4/1/97	Wearing apparel, namely, jeans, t-shirts, <i>knit shirts</i> , <i>sweatshirts</i> , overalls, blouses, skirts, dresses and hats	Prl Usa Holdings, Inc.

Mark/Name	Reg. No. and Date	Goods	Owner
<b>V.I.P. JEANS</b>	3958385 5/10/11	Clothing, namely, men's, ladies' and children's sportswear, namely, shirts, blouses, t-shirts, <i>sweaters</i> , pullovers, jackets, blazers, coats, vests, jeans, pants, <i>sweatshirts</i> , <i>sweatpants</i> , shorts, bermuda shorts, <i>ties</i> , belts and ladies' skirts and dresses	Street Denim Holdings Inc.
<b>WRANGLER JEANS CO.</b>	4400434 9/10/13	<i>Underwear</i>	Wrangler Apparel Corp.
<b>WRANGLER JEANS CO.</b>	3558946 1/6/09	Belts, casual pants, dungarees, jeans, <i>knit/woven shirts</i> , shorts, denim clothing, namely, denim shorts, denim pants, denim shirts	Wrangler Apparel Corp.
<b>WRANGLER JEANS CO.</b>	3473459 7/27/08	(Int'l Class: 25) <b>leather belts</b>	Wrangler Apparel Corp.
<b>WRANGLER JEANS CO. ESTABLISHED 1947</b>	3759294 3/9/10	Clothing, namely, <i>woven tops</i> , jeans, pants, and shorts	Wrangler Apparel Corp.

(Printouts of the above registrations from the TSDR database are attached as Exhibit F of the January 31, 2018 Response to Office Action and as Exhibit G of the January 31, 2018 Response to Office Action.)

Significantly, the USPTO has even registered some denim- and jeans-formative marks, and allowed applications for others, with only partial disclaimers of the words “denim” or “jeans” (limiting the disclaimers of the terms “denim” or “jeans” to just the denim items in the identification of goods). The Office has also registered denim-formative marks whereby the

registrations cover two categories of goods, those explicitly made from denim and those made from other fabrications. Examples of this are:

<b>Mark</b>	<b>Owner</b>	<b>Reg./App No. and Date</b>	<b>Goods</b>	<b>Disclaimer</b>
<b>1897 DENIM</b>	The Glik Company	4139599 5/8/12	Denim clothing, namely, caps, footwear, hats, jackets, jeans, jogging suits, pants, shirts, t-shirts, tops, trousers, and underwear;  <b>Clothing not made of denim, namely, footwear, jogging suits, and underwear</b>	“DENIM” disclaimed only for denim clothing, namely, caps, footwear, hats, jackets, jeans, jogging suits, pants, shirts, t-shirts, tops, trousers and underwear
<b>AMERICAN DENIM CO.</b>	Stretch-O-Rama, Inc.	4527303, 5/6/14	<b>Clothing</b> , namely, pants, jeans, jackets, coats, shirts, sweater, sweatshirts and sweatpants, shoes, sneakers, underwear, hosiery, swimwear and headwear <b>made of denim and other fabrications</b>	“DENIM CO.”
<b>AMERICAN DENIM COMPANY</b>	Stretch-O-Rama, Inc.	4527304, 5/6/14	<b>Clothing</b> , namely, pants, jeans, jackets, coats, shirts, sweater, sweatshirts and sweatpants, shoes, sneakers, slippers, underwear, hosiery, swimwear and headwear <b>made of denim and other fabrications</b>	“DENIM COMPANY”
<b>DIFFER DENIM COMPANY</b>	Tutay Tekstil ... Sanayi Ticaret Ve Limited	5253880, 8/1/17	<b>Clothing, namely, underwear, sweatpants, sweatshirts, t-shirts, knit tops, sweaters,</b>	“DENIM COMPANY 1989”

Mark	Owner	Reg./App No. and Date	Goods	Disclaimer
1989 & Design	Sirketi		<p>beach clothes;</p> <p>and</p> <p>Denim clothing, namely, jeans, dresses, skirts, shorts, pants, overalls, jackets, shirts, blouses, vests, blazers, tops, bottoms, shirts, and outerwear, namely, jackets and coats</p>	
ISAAC MIZRAHI JEANS	Im Brands, LLC	<p>Allowed</p> <p>87161536, filed 9/6/16</p>	<p><b>Men’s and women’s clothing, namely, bathing suits, belts, coats, jacket, jeans, jumpsuits, pants, parkas, shirts, shorts, sleepwear and loungewear, suits, sweaters, t-shirts, vests, socks, sweatshirts, tops, trousers, bottoms, hooded shirts and sweatshirts; women’s clothing, namely, dresses, hosiery, leggings, shirts, tights, knee highs, panty hose; women’s intimate apparel, namely, bras, slips, camisoles, and panties; shapewear, namely, girdles, body shapers, bodysuits, lingerie, and hosiery; men’s clothing, namely, dress shirts and neckwear; men’s and women’s footwear</b></p>	<p>“JEANS” disclaimed <b>only</b> for jeans, pants, shorts, trousers, bottoms and leggings in Class 25</p>

(Printouts of the above registrations and allowed applications from the TSDR database are attached hereto as Exhibit H of the January 31, 2018 Response to Office Action.)

Thus, the USPTO has recognized that “denim”-branded and “jeans”-branded product lines often include not only apparel fabricated from denim, but also apparel fabricated from other materials. Clearly, the USPTO has understood that, in the proper circumstances — such as is the case with Applicant’s Mark — consumers will not, by the mere presence in a mark of the term “denim” or “jeans”, be duped into actually believing, contrary to what their eyes and logic are telling them, that goods, such as Applicant’s Non-Denim Goods. Presumably, this understanding arose at least in part from the fact that few if any consumers would like their bathing suits, socks, underwear or panty hose to be made of denim.

**C. Is the “misdescription” likely to affect a significant portion of the relevant consumers’ decision to purchase Applicant’s Non-Denim Goods?**

**(i) There is No Evidence that Denim is a Desirable Material for Every Type of Clothing; Consumers Do Not Want Denim Sweaters.**

In order to establish a *prima facie* case of deceptiveness, the Examining Attorney must provide sufficient evidence that the allegedly misdescriptive quality or characteristic of the goods would be a material factor in the purchasing decision of a significant portion of the relevant consumers. See, In Re Spirits Int’l, N.V., supra; TMEP 1203.02(d). To do this, the Examining Attorney must provide evidence that the allegedly misdescriptive quality or characteristic would make the product or service more appealing or desirable because of objective standards or criteria that provide an objective inducement to purchase the goods and/or services beyond that of a mere personal preference. *Id.*

Applicant respectfully submits that the Examining Attorney has not established a *prima facie* case of “deceptiveness” here because there is no evidence to support the materiality factor. In fact, there does not appear to be any evidence of record whatsoever to support the proposition

that the applied-for mark is “deceptive.” According to the Examining Attorney, “In the present case, the previously sent evidence – [consisting of a dictionary definition of denim as a “thick cotton cloth that is usually blue and is used especially to make jeans” and some printouts from the Internet showing denim garments and purportedly showing that denim is a common and popular fabric] – shows that products with the ingredient or component denim, are more appealing or desirable because they are stronger and aesthetically appealing. Thus, the [alleged] misdescription is likely to affect a significant portion of the relevant consumers’ decision to purchase [A]pplicants’ [non-denim] goods.” (See, November 9, 2017 Office Action.)

Neither a dictionary definition of the term “denim”, nor Internet printouts provided by the Examining Attorney establish that denim is a desirable material for apparel products such as Applicant’s sweaters and t-shirts.

Instead, it appears that the Examining Attorney relies on his own allegation that apparel products made of denim are more appealing or desirable because they are “stronger and aesthetically pleasing.” But without evidence, that is just an opinion. In re Mavety Media Grp. Ltd., 33 F.3d 1367, 1372 (Fed. Cir. 1994), abrogated by In re Tam, 808 F.3d 1321 (Fed. Cir. 2015) (Board vacated and remanded decision to refuse mark that was made based solely on “personal opinion and dictionary definitions”). What expert fashion body has determined with empirical evidence that denim is more “aesthetically pleasing” to consumers than the jersey, cotton, gauze, gingham, seersucker, linen, terry, stretch lace, mesh lace, and leather that Applicant uses in its DENIM & CO. apparel line? (See O’Connor Decl. ¶8.) Moreover, the Examining Attorney’s allegation begs the question: Stronger and more aesthetically pleasing than what? Presumably, the answer to that question is “stronger and more aesthetically pleasing than apparel products made of materials other than denim.” However, in addition to not proving

that allegation with any objective evidence, the statement is not logical. Is “stronger” necessarily a better or more desirable characteristic in all circumstances? A denim sweater may be stronger than one made of wool, but does that make it more desirable? Is a denim t-shirt more appealing than a cotton t-shirt? One would imagine the answer to both questions would be “no.”

**(ii) QVC Viewers Will Not Miss the Message**

The clothing at issue here is “sold through interactive television and interactive online media wherein the clothes are modeled and whereby detailed information regarding fabrics and materials used in making the clothing is provided.” The Examining Attorney has not explained how consumers of goods sold in this context could possibly think that a wool sweater was made of denim. And he has certainly provided no evidence to even suggest that a significant number of such consumers would somehow allow the well-known DENIM & CO. trademark to eclipse the detailed fabric information provided by the QVC host and the online product display cause such an absurd misunderstanding.

In short, the Examining Attorney has not made out a *prima facie* case that Applicant’s use of the term “denim” in the mark DENIM & CO. will induce consumers to purchase non-denim items in Applicant’s DENIM & CO. line because they were duped into believing the non-denim items were, in fact, made of denim, let alone that it would be a material factor in the purchasing decisions of a significant number of the prospective purchasers of Applicant’s Non-Denim Goods. Thus, it is respectfully submitted, the Examining Attorney’s “deceptiveness” refusal should be withdrawn.<sup>7</sup>

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<sup>7</sup> The final Refusal also, somewhat inexplicably, invited Applicant to disclaim “denim” for Applicant’s Non-Denim Goods. But Applicant did not disclaim denim for such goods because it appears both unnecessary and an illogical means to overcome a “deceptiveness” refusal. However, if the Board concludes that a disclaimer will eliminate any deceptiveness

**CONCLUSION**

Because the non-denim goods for which Applicant seeks protection are only those that will be sold in a context in which consumers could not possibly be misled, because in the world of apparel “denim” has come to refer to not just a fabric and because the fabric referenced to as denim is by no means ideal for each and every type of garment, and therefore not likely to be invariably sought after by consumers, Applicant’s DENIM & CO. mark is not “deceptive” and the Board should reverse the Examining Attorney’s final refusal.

Dated: February 14, 2019  
New York, New York

Respectfully submitted,  
  
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concerns, Applicant asks that the matter be remanded to provide Applicant the opportunity to consider such a resolution.