

**This Opinion is Not a
Precedent of the TTAB**

Oral Hearing:
December 4, 2018

Mailed: June 4, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

—
Marc Fisher LLC

v.

Bottega Veneta

—
Opposition No. 91214253

—
Darren W. Saunders and Cassandra M. Tam of Peroff Saunders PC,
for Marc Fisher LLC.

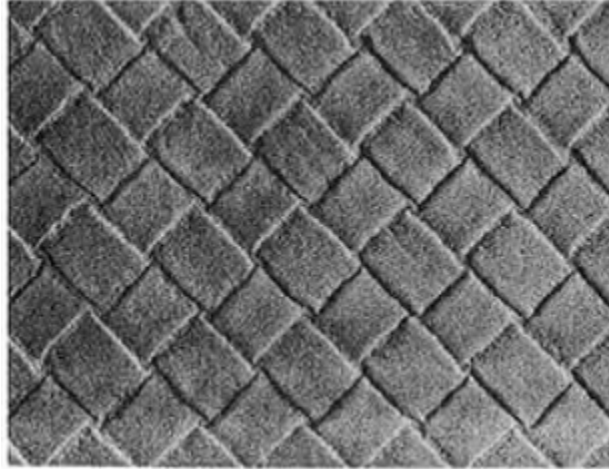
Louis S. Ederer, Matthew T. Salzmann and Benjamin C. Wolverton of Arnold &
Porter Kaye Scholler LLP, for Bottega Veneta.

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Before Wellington, Kuczma and Greenbaum,
Administrative Trademark Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

Bottega Veneta (“Applicant”) seeks registration on the Principal Register under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f), of the design displayed below for “footwear” in International Class 25:¹

¹ Application Serial No. 77219184 was filed on June 29, 2007, under Section 44(e) of the Trademark Act, 11 U.S.C. § 1126(e), based on Italian Reg. No. 1011026. Applicant submitted a certificate of renewal with an English translation on July 5, 2016. 31 TTABVUE.



The proposed mark is described in the application as follows:

The mark consists of a configuration of slim, uniformly-sized strips of leather, ranging from 8 to 12 millimeters in width, interlaced to form a repeating plain or basket weave pattern placed at a 45-degree angle over all or substantially all of the goods.

Color is not claimed as a feature of the proposed mark.

Marc Fisher LLC (“Opposer”) opposes registration on the following two bases: under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052 and 1145, on the ground that the applied-for design does not function as a trademark because it is merely ornamental, and the design has not become distinctive under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f); and under Section 2(e)(5) of the Trademark Act, 15 U.S.C. § 1052(e)(5), on the ground that the proposed mark is aesthetically functional. Amend. Not. Of Opp., 1 TTABVUE.

Applicant, in its answer, denied the salient allegations in the Amended Notice of Opposition.² Answer to Amend. Not. of Opp., 11 TTABVUE.

² Applicant’s sole “affirmative defense” of failure to state a claim was not pursued at trial, and therefore is deemed waived. *See Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*

I. Prosecution History

The application originally identified “handbags” and other bags, cases, wallets and purses made all or substantially all of leather in International Class 18, and the now opposed “footwear” in International Class 25. The ex parte prosecution history of the application is lengthy, and involves voluminous evidence submitted by both Applicant and the Examining Attorney concerning refusals to register the proposed mark in both classes on several grounds, including those now at issue and for which the Examining Attorney issued a Final Office Action, i.e., aesthetic functionality, and that the proposed mark is merely ornamental, or alternatively, a non-distinctive product design that is not registrable absent sufficient proof of acquired distinctiveness. Applicant appealed the final refusals, and the Board reversed, finding that there is no competitive need for Applicant’s competitors to use a weave design falling within the strict parameters of the proposed mark and therefore the proposed mark is not aesthetically functional, that Applicant submitted sufficient proof of acquired distinctiveness for both handbags and footwear, and that consumers recognize the design as an indicator of Applicant as the source of the products on which it appears (“2013 Decision”).

In reversing the functionality refusal, the Board explained that the record created doubt about the need for competitors to use a design with the precise characteristics

dba Watermark Cruises, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013), *aff’d mem.*, 565 F. App’x 900 (Fed. Cir. 2014).

of Applicant's proposed mark, and resolved that doubt in favor of publication of the mark for public policy reasons:

In a case involving the issue of aesthetic functionality, where the question to be resolved is competitive need, we think adopting this principle is particularly appropriate, since publishing the mark will allow competitors to come forward to assert and prove that they do have a competitive need to use the proposed mark if, indeed, they have such a need. 2013 Decision, TSDR p. 23.

The Board took an extremely narrow view of the proposed mark and the scope of protection to which it is entitled, and considered evidence of third-party use only of essentially identical designs:

Our finding that the design is not aesthetically functional is based on a very narrow reading of the proposed mark, and the scope of protection to which it is entitled. The examining attorney has raised the concern that, armed with a registration, applicant would attempt to prevent third parties from using various forms of a plain weave design. It does not appear that applicant has any intention of doing so; applicant specifically says that it 'appreciates that its rights in the Bottega Weave Design may be relatively narrow.' [citation omitted] However, to specifically address the examining attorney's concerns, we reiterate that we are finding only that the specific design for which applicant seeks registration is not aesthetically functional. We are not finding that the protection to be accorded this mark would extend to allow applicant to prevent the use, for example, of similar designs with different size leather strips, or to goods having a plain weave set at an angle but also having noticeable plain leather portions. If applicant were claiming rights to such other designs, the analysis would change, and designs having these other features would have to be considered in assessing competitive need. In effect, the reason that we have found no competitive need for applicant's proposed mark is because we are considering as probative only competitive uses of the essentially identical design. 2013 Decision, TSDR pp. 23-24.

As to the ornamentation refusal and Applicant's showing of acquired distinctiveness, the Board found that the record demonstrated frequent use of woven leather designs, "and particularly designs in plain weave," for handbags and shoes. "As a result, customers are not likely to view such designs as a source-identifier unless there has been significant promotion that the design is a trademark. In other words, applicant has a heavy burden to demonstrate that its applied-for weave design would be recognized as a trademark." 2013 Decision, TSDR pp. 26-27. The Board reviewed Applicant's "significant amount of evidence in support of its claim of acquired distinctiveness," and found that the evidence "amply demonstrates that applicant's weave design is recognized by consumers as a trademark for applicant's goods." 2013 Decision, TSDR pp. 27, 31-32.

In conclusion, the Board reiterated its "previous statement that our finding that the design is not aesthetically functional is based on a very narrow reading of the proposed mark, and the scope of protection to which it is entitled." 2013 Decision, TSDR p. 32.

Following publication, the mark registered for the Class 18 goods with a Section 2(f) claim, and this opposition was instituted against the proposed mark for the Class 25 goods.

II. Evidentiary Issues

A. Opposer's Objection

Opposer objects to and moves to strike the Trial Declaration and Cross-Examination Deposition Testimony of Giuseppe Giovannetti, former President of

Bottega Veneta, Inc. and head of Applicant's U.S.-based operations, later employed by Applicant's sister company, Tomas Maier, LLC, on grounds of bias because he was a paid fact witness. The Board ordinarily does not strike testimony taken in accordance with the applicable rules on the basis of substantive objections; rather, such objections are considered by the Board in its evaluation of the probative value of the testimony. *Alcatraz Media*, 107 USPQ2d at 1755 (citing *Krause v. Krause Publ'ns Inc.*, 76 USPQ2d 1904, 1907 (TTAB 2005) and *Marshall Field & Co., v. Mrs. Fields Cookies*, 15 USPQ2d 1321, 1326 (TTAB 1992)); *see also Bd. of Regents, Univ. of Tex. Sys. V. S. Ill. Miners, LLC*, 110 USPQ2d 1182, 1194 n.19 (TTAB 2014). In accordance with our practice, we have not stricken Mr. Giovannetti's testimony. Rather, we have considered the probative value of his testimony in light of Opposer's specific objections. *See Alcatraz Media*, 107 USPQ2d at 1755.

B. Applicant's Objections

1. Improper Lay Opinion

Applicant objects to, and seeks to exclude, portions of Mr. Fisher's testimony concerning the origin, quality and structure of third-party footwear products, purported optimal methods to construct woven leather footwear, the history of third-party use of some woven leather designs, and the buying habits and perceptions of footwear purchasers, "because it is improper lay opinion about technical and specialized matters for which he has not been noticed or qualified as an expert." 90 TTABVUE 51.

Opposer has not presented Mr. Fisher as an expert. However, there is no question that he is extremely knowledgeable in the field of footwear. In addition to founding Opposer, Mr. Fisher testified that he has worked in the shoe industry since 1980, and he has designed several thousand shoe styles including shoes with leather basket weave designs that were the same as or similar to Applicant's proposed mark. *See, e.g.*, 46 TTABVUE 20-30. Based on his long tenure in the shoe business, Mr. Fisher has become very familiar with different styles of footwear and footwear manufacture. 46 TTABVUE 21. As CEO of Opposer, Mr. Fisher oversees the day to day operations and all aspects of the business, including visiting stores regularly to see what brands and styles of shoes are for sale, and to keep current on fashion trends. 46 TTABVUE 9. As Mr. Fisher states: "That's my job is to know what everyone has. All of our – my competitors, my job is to know what they have and what they are selling and what prices they are selling and where they make them, and how they make them, et cetera, et cetera." 46 TTABVUE 20.

We view Mr. Fisher's testimony in the objected-to paragraphs as that of a fact witness, and account for the possible bias of his testimony due to his position as founder (among other things) of Opposer. That Opposer presented Mr. Fisher as a lay witness does not categorically disqualify his opinions. Fed. R. Evid. 701 (conditions for allowing the opinion testimony of lay witnesses). Moreover, as stated above, the Board generally does not strike testimony taken in accordance with the applicable rules on the basis of substantive objections. Rather, the Board considers such objections when evaluating the probative value of the testimony at final hearing. *See*

Alcatraz Media, 107 USPQ2d at 1755. Accordingly, we do not strike any of the objected-to testimony, but consider it in light of Applicant's objections. For example, we have disregarded any opinion testimony about the ultimate disposition of the claims asserted herein. *Id.*

2. Lack of Foundation, Authentication and Personal Knowledge

Applicant also objects to the admission of third-party footwear submitted as exhibits to Mr. Fisher's testimony deposition and his associated testimony during Opposer's case-in-chief and on rebuttal, on grounds of lack of foundation, authentication and lack of personal knowledge. The objections are overruled. Although Mr. Fisher did not personally purchase any of the footwear, he testified that his assistant, Lori Becker, purchased them at his direction, he is familiar with the brands, and the shoes are examples of shoes that have been sold for many years and are currently being sold in the marketplace.³ 83 TTABVUE 12-14, 15-38 (testimony about each of the seven shoes), and 55-58.

3. Improper Rebuttal Testimony and Exhibits

On direct examination, Stefano Brazzale (Applicant's former Technical Director) testified that "[t]here are third parties who have made, and continue to make, woven leather footwear products However, other than knockoffs of Bottega Veneta footwear, I have seen few third-party footwear products that fall within the strict parameters for the Bottega Veneta weave design" and that "[t]his is particularly the

³ The better practice is to introduce this type of evidence through the testimony of the individual who actually made the purchase, but Opposer's failure to do so is not fatal, given Mr. Fisher's testimony.

case since 2001....” 62 TTABVUE 8, ¶ 16. As rebuttal, Opposer submitted seven third-party shoes that Mr. Fisher testified were purchased in 2018, are not knock-offs, and fall within the description of the applied-for mark.

During Mr. Fisher’s deposition, Applicant objected to this testimony and the exhibits as improper, claiming that they go beyond the scope of Mr. Brazzale’s direct testimony. Applicant reiterates the objection in its brief.

The function of rebuttal evidence is “to explain, repel, counteract, or disprove the evidence of the adverse party.” *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 116 USPQ2d 1869, 1883 (Fed. Cir. 2015) (citation omitted). We find that the objected-to testimony and associated exhibits rebut Mr. Brazzale’s aforementioned testimony. *See Data Packaging Corp. v. Morning Star, Inc.*, 212 USPQ 109, 113 (TTAB 1981) (“The fact that evidence might have been offered in chief does not preclude its admission as rebuttal.”). It is not uncommon to have a witness noticed for both case-in-chief and rebuttal testimony, as Opposer did here. Accordingly, Mr. Fisher’s testimony and exhibits constitute proper rebuttal and Applicant’s objection is overruled. We have considered the rebuttal testimony and exhibits in our determination of the merits of the opposition.⁴

⁴ Even if we had concluded that Mr. Fisher’s testimony constituted more than rebuttal, we point out that the Board may exercise its discretion to consider improper rebuttal evidence, particularly when an objecting party fails to demonstrate that the evidence raises new or surprising issues or any prejudice resulting from the failure. *Cf. Snyder v. Dep’t of the Navy*, 854 F.3d 1336 (Fed. Cir. 2017) (admission of allegedly improper rebuttal evidence falls within the sound discretion of the Merit Systems Board when objecting party fails to demonstrate prejudice). *Apollo Medical Extrusion Techs., Inc. v. Medical Extrusion Techs., Inc.*, 123 USPQ2d 1844, 1848 (TTAB 2017).

4. Hearsay

Next, we overrule Applicant's hearsay objection to a dictionary entry defining "weave" as "to make (as a basket) by intertwining," submitted as an exhibit to Mr. Fisher's testimony deposition. The Board routinely takes judicial notice of dictionary definitions, and sees no reason to exclude the definition made of record by Opposer during Mr. Fisher's testimony deposition. *See, e.g., Univ. of Notre Dame du Lac v. J. C. Gourmet Food Imps. Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

Applicant also raises hearsay objections to Opposer's Rebuttal Notice of Reliance Exhibits 10-16. These exhibits consist of printouts from commercial websites submitted by Opposer to show that the corresponding seven third-party shoes Opposer made of record during Mr. Fisher's rebuttal testimony (as Exhibits 2-8) are currently being sold in the U.S. Although admissible for what they show on their face, *see* Trademark Rule 2.122(e)(2), 37 C.F.R. § 2.122(e)(2), statements contained in the printouts constitute hearsay, and absent corroborating testimony, may not be relied upon for the truth of the matters asserted. *WeaponX Performance Prods. Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1038 (TTAB 2018).

5. Improper Notice of Reliance Exhibits

Last, we sustain Applicant's objection to Opposer's Notice of Reliance Exhibits 8 and 9 because they are Internet printouts that do not identify the complete source URLs and dates on which they were published or accessed and printed. *See* Trademark Rule 2.122(e).

III. The Record

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b)(1), the file of Applicant's application. Evidence submitted during prosecution, including evidence regarding acquired distinctiveness of the proposed mark under Section 2(f) of the Trademark Act, is automatically of record in this proceeding, subject to any objections. Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b). *See also Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1628-29 (Fed. Cir. 2009).

A. Opposer's Testimony and Evidence

Opposer filed the Testimony Deposition and Rebuttal Testimony Deposition of Marc Fisher (46-47, 83 TTABVUE), and the Cross-Examination Testimony by Written Questions of Stefano Brazzale (75 TTABVUE 2-40) and Carlotta Corazza, Applicant's Senior Intellectual Property Manager (75 TTABVUE 41-67), all with associated exhibits.

Opposer filed a Notice of Reliance on the Discovery Deposition of Ms. Corazza and portions of and exhibits to the Discovery Depositions of Mr. Brazzale, Mr. Giovannetti, and Patricia Pinkernell, Applicant's General Merchandising Manager, and Applicant's Responses to Opposer's Interrogatories and Requests for Admission. 44 TTABVUE and 45 TTABVUE (confidential portions of the discovery depositions and exhibits).

Opposer also filed a Rebuttal Notice of Reliance on Internet printouts from websites offering for sale the third-party footwear submitted as Opposer's Rebuttal Exhibits 2-8. 82 TTABVUE.

B. Applicant's Testimony and Evidence

Applicant filed the Testimony Declarations of Stefano Brazzale (59 and 62 TTABVUE), Carlotta Corazza (60, 61 and 73 TTABVUE), Giuseppe Giovannetti (62 and 64 TTABVUE) and Patricia Pinkernell (65-68 TTABVUE), the Cross-Examination by Written Questions of Mr. Brazzale and Ms. Corazza, and the Cross-Examination Depositions of Mr. Giovannetti (76 and 77 TTABVUE) and Ms. Pinkernell (76 and 77 TTABVUE), with associated exhibits.

Applicant also filed a Notice of Reliance on Reg. No. 4527371 for the applied-for mark registered under Section 2(f) in Class 18, portions of the Discovery Deposition of Mr. Fisher, Opposer's Responses to Interrogatories, and Internet printouts from Applicant's website and various online news outlets. 56-57 TTABVUE (confidential portions located at 58 TTABVUE).

IV. Standing

Standing is a threshold issue that must be proven by the plaintiff in every inter partes case. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). Opposer's witness, Marc Fisher, testified that Opposer has designed and sold fashion footwear since 2005. 46 TTABVUE 88. As a competitor to Applicant in the footwear industry, Opposer presumptively has an interest in the outcome of this proceeding beyond that of the public in general. *See*

Books on Tape Inc. v. Booktape Corp., 836 F.2d 519, 5 USPQ2d 1301, 1302 (Fed. Cir. 1987). According to Mr. Fisher, “I believe I have a competitive need. If my competitors are all using the design and I want to make a simple shoe with a generic basket weave, I should be able to use whatever design I want to use.” 83 TTABVUE 43-44. We find that Opposer has established its standing to bring this opposition. Applicant does not dispute Opposer’s standing.

V. Acquired Distinctiveness

A. Applicable Law

Because the proposed mark is a product design, it is not inherently distinctive, and it can be registered as a mark only on a showing of acquired distinctiveness. *Wal-Mart Stores Inc. v. Samara Bros. Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1069 (2000) (“Consumers are aware of the reality that, almost invariably, even the most unusual of product designs – such as a cocktail shaker shaped like a penguin – is intended not to identify the source, but to render the product itself more useful or more appealing.”); *AS Holdings, Inc. v. H & C Milcor, Inc.*, 107 USPQ2d 1829, 1837 (TTAB 2013). Applicant acknowledged as much by seeking registration of the proposed mark under Section 2(f). *See Yamaha Int’l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) (“Where, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the statute accepts a lack of acquired distinctiveness as an established fact.”). Accordingly, Applicant must show that its proposed mark has acquired distinctiveness, i.e., secondary

meaning. *Converse, Inc. v. ITC*, 909 F.3d 1110, 128 USPQ2d 1538, 1543 (Fed. Cir. 2018).

A mark has acquired distinctiveness “if it has developed a secondary meaning, which occurs when, ‘in the minds of the public, the primary significance of a [mark] is to identify the source of the product rather than the product itself.’” *Wal-Mart*, 54 USPQ2d at 1068 (quoting *Inwood Labs, Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 214 USPT 1, 4 n.11 (1982)); *see also Stuart Spector Designs Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 1554 (TTAB 2009) (“An applicant must show that the primary significance of the product configuration in the minds of consumers is not the product but the source of that product in order to establish acquired distinctiveness.”). There is no fixed rule for the amount of proof necessary to demonstrate acquired distinctiveness, but the burden is heavier for product configurations than for word marks. *Stuart Spector Designs*, 94 USPQ2d at 1554; *see also EFS Mktg. Inc. v. Russ Berrie & Co.*, 76 F.3d 487, 37 USPQ2d 1646, 1649 (2d Cir. 1996) (“[C]onsumers do not associate the design of a product with a particular manufacturer as readily as they do a trademark or a product-packaging trade dress.”).

Because this case has been completely tried, the only issue relevant to the outcome is whether, on the entire record, Applicant has established the requisite acquired distinctiveness to support registration of its mark. *Yamaha*, 6 USPQ2d at 1004, 1010; *Target Brands Inc. v. Hughes*, 85 USPQ2d 1676, 1680 (TTAB 2007). “Registrability of a mark must be determined on the basis of facts as they exist at the time when the

issue of registrability is under consideration.” *McCormick & Co. v. Summers*, 354 F.2d 668, 148 USPQ 272, 276 (CCPA 1966); *Kaiser Aluminum & Chem. Corp. v. Am. Meter Co.*, 153 USPQ 419, 410 n.2 (TTAB 1967) We therefore review all evidence made of record during prosecution of the application and all testimony and evidence properly submitted at trial. *Cold War*, 6 USPQ2d at 1630.

As we conduct this review, we acknowledge the Board’s finding in the 2013 Decision that “applicant has a heavy burden to demonstrate that its applied-for weave design would be recognized as a trademark” because the record demonstrated frequent use of woven leather designs, “and particularly designs in plain weave,” for handbags and shoes, such that consumers likely would not “view such designs as a source-identifier unless there has been significant promotion that the design is a trademark.” We also keep in mind that Applicant has the “ultimate burden of persuasion” as to acquired distinctiveness, which it must meet by a preponderance of the evidence. *Yamaha*, 6 USPQ2d at 1010. Based on Mr. Fisher’s testimony and Opposer’s evidence, discussed below, concerning the history of weave designs for shoes, Mr. Fisher’s personal experience with using weave designs for shoes that he designed and manufactured in the 1980s and 1990s, and the third-party uses to which he testified, including the 21 third-party shoes Opposer made of record, we find that Applicant’s burden is heavy, indeed.

B. Evidence From Application File Pertaining to Acquired Distinctiveness

As the Board explained in the 2013 Decision, Applicant provided sufficient Section 2(f) evidence of acquired distinctiveness during prosecution to persuade the Board to

reverse the Examining Attorney's refusal to register the mark on the ground that it is merely ornamentation, and to approve the application for publication for opposition. In summary, this evidence consists of:

1. Two declarations from Vanni Volpi, an officer of Applicant, attesting to Applicant's long use, promotion and sales of the applied-for weave design (mostly focused on handbags), unsolicited media coverage referencing consumer association of the proposed mark with Applicant (again, mostly focused on handbags), and that the Examining Attorney's evidence of third-party use of the same or similar weave designs (mostly on handbags) were copies of or inspired by the applied-for design;
2. Declarations from many individuals in the fashion industry who testified that they consider the applied-for design to be "iconic" and that consumers who see the design on handbags immediately recognize that Applicant is the source of the handbags; and
3. Consumer comments and reviews on blogs referencing the design or describing third-party bags as looking like the applied-for weave design and specifically mentioning Applicant as the source of the design.

Although all of this evidence is of record, we do not consider the declarations as testimony because they were not executed during the assigned testimony period, as Trademark Rule 2.121(a) requires. *Robinson v. Hot Grabba Leaf, LLC*, ___ USPQ2d ___ (TTAB 2019). The exhibits attached thereto, all of which are at least 10 years old and in many cases date to the 1980s and 1990s, have little, if any, bearing on more recent customer perception. "Trademark rights are not static," and eligibility for registration must be determined on the basis of the facts and evidence of record that exist at the time registration is sought. *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (citations omitted).⁵ They also are hearsay,

⁵ This principle would apply equally to the declarations, were we to consider them.

and many not be relied upon for the truth of the matters asserted therein. Fed. R. Evid. 801(c); *Safer, Inc. v. OMS Invs., Inc.*, 94 USPQ2d 1031, 1040 (TTAB 2010).

The prosecution file of the application also includes voluminous evidence of third-party uses of woven leather designs submitted by the Examining Attorney. Although this evidence is hearsay, it demonstrates on its face, as the Board previously found, that such designs, “and particularly designs in plain weave, are often used for handbags and shoes.” 2013 Decision, TSDR p. 26. *Cf. WeaponX Performance Prods.*, 126 USPQ2d at 1040.

C. Opposer’s Claim of Lack of Acquired Distinctiveness

1. Woven Leather Basket Weave on Footwear – History/Fashion Trend

Turning to Opposer’s testimony and evidence, Mr. Fisher consistently and repeatedly testified that the proposed-mark is a woven leather basket weave that commonly was used on footwear in the 1980s and 1990s and continues to be used on footwear although it is not as popular now as it once was. Mr. Fisher personally designed shoes with a woven leather basket weave “for many different brands and customers in the ‘80s and 90s.” 46 TTABVUE 25. According to Mr. Fisher,

The most common types of wovens where we used weaves were on what we call a slipper silhouette or an oxford for women. Many sandals we did with weaves. Many pumps we made woven. So it was a very common – it was a very common detail to put on the best-selling silhouettes that women would be wearing for the fashion trends of the period, you know, whether it was the mid ‘80s, late ‘80s, early ‘90s, mid ‘90s. You know, it would depend on the generation, and it would depend on, you know, what part of the decade it was in; but I made a lot of – woven shoes were very common 46 TTABVUE 26-27.

...

Q. When you were designing shoes with basket weave designs on them, was there a particular reason that you selected a basket weave as opposed to some other kind of weave for the shoe?

Mr. Ederer: Objection. Asked and answered.

The Witness: That was the most common weave used was the simple basket weave. You know, that was the most generic weave used in the marketplace for people making shoes. 46 TTABVUE 43.

...

Q: Now, aside from shoes that you personally designed or that Nine West designed while you were at Nine West during that time, are you aware of any other designers or manufacturers of shoes that sold footwear in the United States of the same basket weave pattern or a similar basket weave pattern?

Mr. Ederer: Objection to form.

The Witness: Yes. There were many.

Mr. Ederer: Move to strike as nonresponsive.

Q. Could you elaborate, please?

A. Well, you know, that is, as I mentioned earlier, the most common weave used on woven shoes for ladies and men. So since I can recall, which is back when I started, you know, really being in shoe stores, you know, as much as possible, weekly, daily, monthly, that weave has been used by countless brands, not one or two. I mean, you know, obviously, it's been used by Cole Haan in ladies' shoes for many, many years or men's shoes or Bally or Ferragamo or Nine West or Enzo Angiolini or Calico or Sesto Meucci or Floresheim or, you know, I can go on and on because back in the '80s, this was a fashion trend and even into the '90s, and we – we made many, and just any shoe store you would walk into in New York, California, Florida, you would see shoes with this weave. You would see countless woven shoes that had that weave at places like Sears, J.C. Penny,

Thom McCann, Kinney, Payless, you know, you could go to Walmart and find the weave. So it was a very commonly used, again, generic. It's kind of like going to an ice cream store and seeing vanilla ice cream. Every ice cream store tends to have vanilla ice cream. Although, you know, and that – that's the way this weave is. It's the most classic, generic basket weave ...

Back in the '80s Joan & David made hundreds of styles with that weave. 46 TTABVUE 47-48.

...

I am talking about '83, '84 into '99, 2000, 2001. That was – it's still used today by many brands. It's – you know, it's still used. It's still used now. 46 TTABVUE 49.

...

As for the basis for his testimony, Mr. Fisher stated “Because I was out in the stores doing my job, looking at shoes, shopping for shoes; and you know, my job is to be in shoe stores every day as much as possible. So I sold many of them. I sold millions of shoes with that weave --.” 46 TTABVUE 49.

Mr. Fisher testified that he has not designed shoes with a basket weave for several years, and he does not currently design shoes with that design. However, Mr. Fisher explained that

weaves are – in my career, have been a – they go as a trend, fashion trend. Right now, that's not really the trend for ladies' shoes, and when the trend comes back, that will be the weave that I use just like we have used it for the past 35 years. So that's the reason why I am objecting to someone's claim that it's theirs because it's not theirs. 46 TTABVUE 84-85.

...

When woven shoes are the fashion trend, and if I can't use the most classic weave that's been used for years that

women relate to when they think about a woven shoe, I think that will – that will adversely affect me.

So if wovens are in, I want to be able to use the go-to basket weave that is as simple as it gets in the dictionary, and that's why I want to do it. There is – it's no one else's right to make claim that that's theirs. It's not theirs. It's everyone's." 46 TTABVUE 85.

[I]f woven shoes are a hot commodity, and everyone – all my competition has them, and they are all using the same standard basket weave that, you know, people have been using for 30, 40, 50 years, then I certainly would want to be able to use it also. 46 TTABVUE 133.

...

It's a staple or it can be a trend. We can call it a trend, a fashion trend, a – you know, a trend.

When these shoes were made, that was a fashion look. The reason why I don't use this weave today is it's really not a fashion look. I don't know if Nicole has this at retail today. I would have to, you know, ask someone to do a search. 46 TTABVUE 178.

...

As I stated, woven shoes in the '80s were quite the trend and everyone was making them, as you can see through all of these illustrations.

Today, it's not the fashion trend, so people aren't making them the way they used to. 46 TTABVUE 183.

2. Third-Party Use

Opposer submitted 21 third-party shoes with a leather weave design that falls within the parameters of the applied-for mark, or very close to those parameters, to demonstrate that the proposed-mark is and has been commonly used on footwear by third-parties in the United States. The images are reproduced in Appendix A to this decision, and are in the same form presented in Opposer's brief. 86 TTABVUE 12.

Opposer submitted 14 of the 21 shoes as exhibits to Mr. Fisher's trial testimony that the shoes fall within the description of the applied-for mark. 46 TTABVUE 81-

82. The 14 shoes include:

- a. A ladies half-inch heel woven ballerina by Robert Zur with leather strips approximately 7mm-9mm wide on an angle--Mr. Fisher testified that "woven ballerinas like this have been sold in the U.S., look-alike shoes like this, for as long as I have been in the shoe business full-time, certainly since 1984, and they are still being sold today." 49 TTABUE 62. Mr. Fisher testified that he knows this "[b]ecause I have seen them in stores. I have made them, and it's a classic ladies' shoe that's been running for years that when weaves are in, people take this classic ballerina. It's always a good seller, and they put a weave on it. So it's a very common style." 49 TTABVUE 63.
- b. A ladies woven, tassle moccasin by Sesto Meucci with "the same woven basket weave detail that we have been discussing today, your classic basket weave" with woven leather strips approximately 8mm wide, that always was one of the "staples" of the line and has been sold for many years that he "would see ... constantly throughout my career." 49 TTABVUE 64-65;
- c. A ladies woven flat slipper by Vince Camuto (a former partner of Mr. Fisher's father) made with a basket weave with leather strips approximately 8mm-9mm wide "on the angle" that has been sold in the last five years. 46 TTABVUE 77; and
- d. A ladies, flat, woven ballerina by Tori Burch "made with the basket weave 8 millimeters, 9 millimeters that we have been discussing today, the classic basket weave" of patent leather, that "I believe that recall seeing ... at retail in the last two, three years." 46 TTABVUE 78-79.

Opposer submitted 7 additional third-party shoes with the rebuttal testimony of Mr. Fisher. Three examples are:

- a. A “handmade” “classic men’s woven loafer” by Allen Edmonds with interlaced leather strips that appear to be between 8mm-12mm, forming a basket weave, oriented at a 45-degree angle, that Mr. Fisher testified falls within the description of the applied-for mark. 83 TTABVUE 20-21;
- b. A “ladies woven loafer” by Robert Zur with a “[g]eneric basket weave” comprising leathers strips that appear to be 8mm-12mm wide, oriented at a 45-degree angle, that Mr. Fisher testified falls within the description of the applied-for mark. 83 TTABVUE 28-30; and
- c. A ladies slip on shoe by Cole Haan with a “generic basket weave that’s placed on an angle” that Mr. Fisher testified falls within the description of the applied-for mark. 83 TTABVUE 31-34.

Although Applicant contends that many of the shoes do not fit squarely within the description of the applied-for mark (App. Br., 90 TTABVUE 20-22, 36-37), for example, the strips might be 6 or 7 millimeters instead of 8 (*see, e.g., cross-examination of Mr. Fisher, 83 TTABVUE 62-65*), as Mr. Fisher points out, the difference of a millimeter is miniscule and would not be noticeable: “A millimeter is like a thread.” 46 TTABVUE 115. “I believe that I am using 6 millimeters and some are 7 millimeters and some are 5, it’s going to have the same visual look as what’s – as 8 to 12; and I – if Bottega Veneta had a trademark, they would probably oppose it because everyone would be taking out a ruler trying to figure out is it 6 millimeters, 7 millimeters or 8 millimeters?” 46 TTABVUE 106-107. In other words, because ordinary footwear consumers do not typically bring a ruler with them when they shop for shoes, and there is no evidence that they are able to recognize the width of leather strips within millimeters, they will rely on a general impression and will likely not be able to distinguish whether a particular shoe has strips of leather that are a few millimeters within range of Applicant’s claimed width of 8-12 millimeters.

Nor would the ordinary footwear consumer be able to tell, without use of a protractor or other square edge, whether the leather strips are interlaced precisely on a 45 degree angle. As for the use of the proposed mark on “all or substantially all” of the footwear, there is no evidence that consumers uniformly understand the meaning of “substantially all.” We agree with Mr. Fisher that the definition of “substantially” and the manner in which footwear is worn leaves this parameter open to debate as to its limiting effect: “If the lady has a pair of slacks on, and you are only looking at the front of the shoe, then you would think that – you wouldn’t even notice if she had long slacks, and she was wearing that the back was not woven.” 46 TTABVUE 166.

Moreover, even if there are some small differences in appearance between the precise description of the applied-for mark and the 21 third-party shoes submitted by Opposer, “[i]n order to be relevant to the question of whether applicant’s mark has acquired distinctiveness, the third-party uses do not have to be identical to applicant’s mark.” *Saint-Gobain Corp. v. 3M Co.*, 90 USPQ2d 1425, 1440 (TTAB 2007) (color mark); *see also Goodyear Tire & Rubber Co. v. Interco Tire Cop.*, 49 USPQ2d 1705, 1720 (TTAB 1998) (differences between applicant’s tire tread designs and third-party designs not shown by applicant to be of source-identifying significance.). Based on Mr. Fisher’s testimony identifying the 21 shoes, we find them to fall within or be substantially similar to the description of the applied-for mark. *See Converse*, 128 USPQ2d at 1547 (“Although we agree with the ITC that evidence of the use of similar

but not identical trade dress may inform the secondary-meaning analysis, we think such uses must be substantially similar to the asserted mark.”).

In making this finding, we recognize that we are reaching a different conclusion than the Board did in the 2013 Decision. We do so because the record before us is different from the record previously before the Board, *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“The Board must decide each case on its own merits.”). In the 2013 Decision, the Board allowed the proposed mark to be published for opposition based on the record before it at that time, and with an extremely narrow reading of the applied-for mark and an eye toward allowing competitors of Applicant the opportunity to oppose registration, as Opposer now has done. Simply put, we are not bound by the 2013 Decision.

Also, even if, as Applicant contends, many of the 14 shoes submitted with Opposer’s case-in-chief are “vintage” or “used,” consumers are still being exposed to and are purchasing the same or substantially similar styles. *See, e.g.*, 46 TTABVUE 64-66, Sesto Meucci shoe style still sold today. *Cf. Converse*, 128 USPQ2d at 1547 (in evaluating the length, degree and exclusivity of Converse’s use, “uses older than five years should only be considered relevant if there is evidence that such uses were likely to have impacted consumers’ perceptions of the mark as of the relevant date.”).

Applicant also claims that third-party footwear sold in the United States with the same or substantially similar basket weave design described in the applied-for mark are knockoffs or infringements of Applicant’s. *See Applicant’s Answers to Opposer’s Requests for Admission Nos. 40 and 41* (44 TTABVUE 344-45), and S. Brazzale Decl.,

¶ 16 (62 TTABVUE 8). The record does not support such a finding. Rather, Mr. Fisher's testimony, and the 21 third-party shoes made of record by Opposer, persuade us that: the applied-for design is a common basket weave that numerous shoe manufacturers and sellers have used on their footwear products; the third-party footwear includes shoes bearing a basket weave design that is the same as or substantially similar to the applied-for mark; the third-party shoes have been sold in the United States since at least the 1980s including some that have been sold continuously through the trial period of this proceeding; and the numerous third-party uses defy Applicant's claim that its use is, or has ever been, substantially exclusive such that Applicant's use would support a finding that Applicant has acquired distinctiveness in the applied-for mark for footwear.

While absolute exclusivity is not required, *see L.D. Kitchler Co. v Davoli, Inc.*, 192 F.3d 1349, 52 USPQ2d 1307 (Fed. Cir. 1999), the widespread use of basket weave designs on footwear by competitors is inconsistent with Applicant's claim of substantially exclusive use of the design and, ultimately, of acquired distinctiveness. Indeed, the proliferation of such uses clearly shows that Applicant's use is not "substantially exclusive." *See, e.g., Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939, 940-41 (Fed. Cir. 1984) ("When the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term or device, an application for registration under Section 2(f) cannot be successful, for distinctiveness on which purchasers may rely is lacking under such circumstances."); *Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 172 USPQ 361,

363 (CCPA 1972) (evidence insufficient to establish distinctiveness due to significant and continuous concurrent use of term by competitor such that applicant's use was not substantially exclusive); *Miller v. Miller*, 105 USPQ2d 1615, 1624-25 (TTAB 2013) (applicant's use not substantially exclusive due to opposer's use, third-party use, applicant's acknowledgement of third-party use and applicant's consent and agreement to third-party use).

3. Applicant's Lack of Enforcement

We also are mindful that according to Carlotta Corazza, Applicant's Senior Intellectual Property Manager, Applicant has taken no action to attempt to police its proposed mark to prevent others from using it on their footwear in the United States. 75 TTABVUE 47-50 (responses to cross-examination on written questions, Question Nos. 14-17). Concurrent use of the proposed mark by Applicant and at least some of the third parties represented by the 21 shoes of record and the other shoes that Applicant claims are counterfeits make it less likely that the public associates the proposed mark with Applicant alone, or recognizes the proposed mark as identifying only Applicant's footwear. *See, e.g., Ayoub, Inc. and Ayoub Supply, LLC v. ACS Ayoub Carpet Serv.*, 118 USPQ2d 1392, 1404 (TTAB 2016) (record showed some policing efforts but also showed concurrent use of surname AYOUB by third-parties during time applicant claimed substantially exclusive use, militating against finding that applicant's use was substantially exclusive).

D. Applicant's Testimony and Evidence of Acquired Distinctiveness

We now turn to Applicant's trial testimony and evidence of acquired distinctiveness.

1. Length of Use

Mr. Brazzale testified that Applicant considers the proposed mark to be Applicant's "signature design," that the applied-for mark has been uniformly applied to different product categories, starting with handbags in 1975 and expanding in about 1980 to footwear, and that in 2001, Applicant decided to focus more on this "signature" design by expanding use of the design on even more products. S. Brazzale Decl. ¶¶ 2-10, 62 TTABVUE 2-6.

Ms. Corazza testified about Applicant's history of promoting the proposed mark as a source indicator in the 1980s and 1990s, and the unsolicited media coverage Applicant received, mostly in the 1980s and 1990s, including articles about footwear and photographs of celebrities wearing products with the applied-for design,⁶ and a short promotional film by Andy Warhol T.V. Productions in 1985. 73 TTABVUE 4-7, ¶¶ 7-12, and Exhibits C-H, 73 TTABVUE 18-574 and 60 TTABVUE. She also corroborated Mr. Brazzale's testimony about the increasing importance of the proposed-mark to Applicant, especially after 2001. ¶¶ 6, 13-14.

⁶ Exhibit F-4 and F-5 contain several such photographs from 2011-2014. 73 TTABVUE 524-574, 60 TTABVUE 88-99. Screenshots of the film and associated documentation from The Andy Warhol Museum in Pittsburgh, PA were submitted as Exhibits G and H, respectively. 60 TTABVUE 198-204.

However, as Opposer points out, “long and continuous use alone is insufficient to show secondary meaning where the use is not substantially exclusive.” *Flowers Indus. v. Interstate Brands Corp.*, 5 USPQ2d 1580, 1588-89 (TTAB 1987); *see also Stuart Spector Designs*, 94 USPQ2d at 1571 (“In this case, while there has been over 50 years of continuous use for each of the configurations, the probative value of this factor is greatly diminished inasmuch as this use was not substantially exclusive given the third-party uses.”).

2. Advertising and Sales

Applicant argues that “[l]arge-scale expenditures promoting and advertising goods under a particular design mark, especially where the mark is prominently featured, are strong evidence that the mark has acquired distinctiveness. That is the case here.” App. Br., 90 TTABVUE 30 (citations omitted).

In addition to the evidence submitted with Ms. Corazza’s testimony, discussed above, Applicant submitted evidence of its more recent advertising campaigns for footwear bearing the applied-for mark on social media and various digital platforms. G. Giovannetti Decl. ¶¶ 8-9, 63 TTABVUE 4-5; Exhibit D, 63 TTABVUE 55-166. He also provided confidential figures for Opposer’s U.S. based advertising and promotional expenditures in 2008-2014, which show increases in both during that time, and he testified that “The majority of these advertisements and promotional materials also feature products bearing the Bottega Veneta Weave Design, including footwear.” 63 TTABVUE 4, ¶ 7; Exhibit A, 64 TTABVUE 9 (confidential). According to Mr. Giovannetti, some of these advertisements and promotional materials “specifically highlighted,” “focused exclusively on,” or “focused on” “footwear products

bearing the Bottega Veneta Weave Design.” 63 TTABVUE 4-5, ¶ 8; Exhibits B and C., 64 TTABVUE 11-16 (confidential).⁷

Mr. Giovannetti also testified that Applicant’s sales of the “complete line of products bearing the Bottega Veneta Weave design have substantially increased” from 2003-2014, and “[t]he percentage of the company’s overall sales of products bearing the Bottega Veneta Weave Design has also increased significantly” during that time. 63 TTABVUE 5-6, ¶ 10-11; Exhibit E, 64 TTABVUE 17 (confidential). However, Applicant provided no context for these figures. It therefore is difficult “to accurately gauge the level of this success ... in the absence of additional information such as applicant’s market share or how the [applicant’s] product ranks in terms of sales in the trade.” *Target Brands, Inc. v. Hughes*, 85 USPQ2d 1676, 1681 (TTAB 2007). While the sales figures might demonstrate the popularity of Applicant’s footwear bearing the applied-for mark, without more, they do not show that the relevant customers associate the applied-for mark as a source identifier of footwear. *See Stuart Spector Designs*, 94 USPQ2d a 1571 (“while sales volume figures may demonstrate the growing popularity of the products, mere figures demonstrating successful product sales are not probative of purchaser recognition of a configuration as an indication of source.”).

Although the figures show an increase in both sales and advertising from 2008-2014, “it is well established that compelling sales and advertising figures do not

⁷ Exhibit D consists of a collection of printouts and screenshots showing Applicant’s promotion of products bearing the applied-for design on social media and digital platforms. 63 TTABVUE 5, ¶ 9; Exhibit D, 63 TTABVUE 55.

always amount to a finding of acquired distinctiveness.”⁸ *Stuart Spector Designs*, 94 USPQ2d at 1572. “[T]he more important question is how the alleged mark is being used, i.e., in what manner have consumers been exposed to the alleged mark so that we can impute consumer association between the configuration[] and the product producer. To determine whether a configuration has acquired distinctiveness, advertisements must show promotion of the configuration as a trademark.” *Id.* “When advertisements are submitted as evidence of acquired distinctiveness, they must demonstrate the promotion and recognition of the specific configuration embodies in the applied-for mark and not of the goods in general.” *AS Holdings*, 107 USPQ2d at 1838. Such advertisements, commonly referred to as “look for” advertising, can demonstrate that a product design has acquired distinctiveness. Other than some older advertisements, which have little bearing on current consumer perception, Applicant submitted no such advertisements at trial.

The Board has acknowledged that “[t]here are cases where the lack of ‘look for’ advertising [is] not fatal in view of industry practice to recognize certain configurations as source indicators.” *Stuart Spector Designs*, 94 USPQ2d at 1574. However, Applicant submitted no testimony or evidence to support a finding that such is the practice in the footwear industry.

On this record, the lack of “look for” advertising undermines Applicant’s claim of acquired distinctiveness based upon its advertising. *Id.* at 1573-74; *see also Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1517-18 (TTAB 2017).

⁸ On this record, we do not find Applicant’s sales and advertising figures to be “compelling.”

3. Consumer Recognition

Applicant submitted no testimony from consumers, instead primarily relying on the testimony of Ms. Pinkernell, who is responsible for managing the selection of footwear and other items to be sold at Applicant's stores in the U.S. While we accept Ms. Pinkernell's testimony concerning the popularity of Applicant's products, including footwear, that bear the applied-for design, her testimony about consumer recognition of the proposed-mark as a source identifier is merely hearsay, and cannot be considered for the truth of the matter asserted. Mr. Giovannetti also testified that "As former President of the Bottega Veneta's U.S. operations, I can speak from personal experience in saying that American customers who visited Bottega Veneta stores frequently seek out products bearing the Bottega Veneta Weave Design." G. Giovannetti Decl., ¶ 13, 63 TTABVUE 7. This testimony, however, merely supports a finding that footwear bearing the applied-for design is popular among Applicant's customers. It does not support a finding that the applied-for mark has acquired distinctiveness as a source identifier even among Applicant's customers, let alone general consumers.

4. Prior Registration

Finally, Applicant's ownership of Reg. No. 4527371 for the applied-for mark, which registered under Section 2(f) in Class 18 following the 2013 Decision, does not help persuade us that Applicant has established acquired distinctiveness for the Class 25 goods at issue here. While Trademark Rule 2.41(a)(1), 37 C.F.R. § 2.41(a)(1), allows the USPTO to accept, as prima facie evidence of acquired distinctiveness, an applicant's ownership of an active prior registration of the same mark on the

Principal Register for goods that are “sufficiently similar” to the goods identified in the application, the Rule is permissive, and also states that additional evidence of distinctiveness may be required “in appropriate cases.” Here, Applicant has submitted no evidence at trial to support a finding that handbags and footwear are “sufficiently similar” such that the prior registration would even be a factor for us to consider.⁹

VI. Conclusion

We find, on the basis of the record as a whole, that Opposer established a prima facie case that the evidence of acquired distinctiveness proffered by Applicant during prosecution was inadequate and that Applicant has failed to establish in this proceeding that the applied-for mark has acquired distinctiveness within the meaning of Section 2(f). *See Kohler*, 125 USPQ2d at 1518; *Stuart Spector Designs*, 94 USPQ2d at 1576.

Decision: The opposition is sustained on the ground that the applied-for mark is a merely ornamental product design that has not acquired distinctiveness.¹⁰

⁹ The 2013 Decision addresses the concept of “transferability” of acquired distinctiveness from handbags to other items identified in Class 18 at TSDR 23 n.23: “[T]he acquired distinctiveness of the mark in connection with handbags is so strong, and the other Class 18 items are so closely related to handbags, that the acquired distinctiveness of the mark would transfer to these goods in any case. See TMEP § 1212.09(a) and cases cited therein.” To the extent Applicant is relying on this dicta to support its argument that footwear in Class 25 is “sufficiently similar” to handbags or any other item listed in the Class 18 registration such that the finding of acquired distinctiveness for the latter transfers to the former (*see App. Br.*, 90 TTABVUE 30), the Board made no reference to “transferring” acquired distinctiveness to footwear in Class 25, and we see no basis for doing so here.

¹⁰ Accordingly, we need not decide whether the applied-for mark is aesthetically functional.

Appendix A

