

ESTTA Tracking number: **ESTTA1465235**  
Filing date: **09/24/2025**

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

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer information

Name	Penney OpCo LLC
Granted to date of previous extension	10/01/2025
Address	6501 LEGACY DRIVE SUITE B100 PLANO, TX 75024 UNITED STATES
Attorney information	CHANDLER DANAE STEPHENS JACKSON WALKER LLP 2323 ROSS AVENUE SUITE 600 DALLAS, TX 75201 UNITED STATES Primary email: cstephens@jw.com Secondary email(s): gmccormack@jw.com 2149535642
Docket no.	103910.00058

### Applicant information

Application no.	98060917	Publication date	06/03/2025
Opposition filing date	09/24/2025	Opposition period ends	10/01/2025
Applicant	Birkenstock US BidCo, Inc. 100 WOOD HOLLOW DRIVE, SUITE 100 NOVATO, CA 95945 UNITED STATES OF AMERICA		

### Goods/services affected by opposition

Class 025. First Use: 1973 First Use In Commerce: 1973  
All goods and services in the class are opposed, namely: Sandals

### Grounds for opposition

The mark is generic	Trademark Act Sections 1, 2 and 45
The mark comprises matter that, as a whole, is functional	Trademark Act Section 2(e)(5)
Failure to function as a mark	Trademark Act Sections 1, 2 and 45
The mark is not inherently distinctive and has not acquired distinctiveness	Trademark Act Sections 1, 2 and 45; and Section 2(f)

Attachments	Notice of Opposition - 98060917.pdf(152065 bytes )
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Signature	/Chandler Stephens/
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Name	Chandler Stephens
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Date	09/24/2025
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
TRADEMARK TRIAL AND APPEAL BOARD**

In re U.S. Trademark Application Serial No. 98060917  
Filed: June 27, 2023  
Published in the *Official Gazette*: June 3, 2025



For the Mark:

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PENNEY OPCO LLC,

Opposer,

v.

BIRKENSTOCK US BIDCO INC.,


Applicant.

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Opposition No. \_\_\_\_\_

**NOTICE OF OPPOSITION**

Pursuant to 37 C.F.R. § 2.101(b), Penney OpCo LLC, a Virginia limited liability company, having its mailing address at 6501 Legacy Drive, Plano, Texas 75024 (“Opposer”), believes it will

be damaged by the registration of the trademark “” as shown in Application Serial No. 98060917 in International Class 025 and so opposes same, in whole. As grounds for its opposition, Opposer alleges as follows:

1. Applicant is Birkenstock US BidCo, Inc., a Delaware corporation, with an address of 100 Wood Hollow Drive, Suite 100 Novato, CA 95945 (“Applicant”).

2. On June 27, 2023, Applicant filed a trademark application, Serial No. 98060917 (the “Application”) in the United States Patent and Trademark Office (“USPTO”) for the mark

shown below (the “Opposed Mark”) for use in connection with “Sandals” in International Class 025 (the “Claimed Goods”):



3. The Opposed Mark is described as follows:

The mark consists of a sandal featuring a footbed with an exaggerated defined rim, that appears wider and more sunken at the heel and tapers so that the front portion appears thinner; with outsoles having sides with a rutted, irregular appearance; a raised wishbone-shaped strip in the front portion of the footbed; and an upper composed of a medial and a lateral pattern piece, each pattern piece sandwiched between the outsole and the footbed on each side of the footbed, covering the midsole, with a sharp angle in each piece from the middle of the heel to the top of the instep, where the pattern pieces collectively form two robust straps, one strap across the instep and one strap across the forefoot, where the strap portions of the medial pattern piece are longer, having punched holes and rounded, angled edges, and the strap portions of the lateral pattern piece each having a flat buckle, such that when the straps are fastened, the upper forms a substantially rounded-rectangle cutout in the middle of the forefoot. The raised wishbone-shaped strip, the punched holes, and the prongs of the buckles are all shown in broken lines, which show the position of the mark and are not claimed as part of the mark.

4. The Application was based on Applicant’s alleged use of the Opposed Mark in commerce for the Claimed Goods under Trademark Act Section 1(a), 15 U.S.C. § 1051(a).

5. On November 14, 2023, the USPTO issued an Office Action refusing registration of the Opposed Mark on the grounds that the mark is: (a) functional under Trademark Act Section 2(e)(5), 15 U.S.C. §1052(e)(5); and (b) nondistinctive product design requiring evidence of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), to be eligible for registration on the Principal Register.

6. The November 14, 2023 Office Action also requested information regarding whether the Opposed Mark has been the subject of a design or utility patent.

7. Applicant disclosed the following utility patent in its response to the Office Action: U.S. Utility Patent No. US 6,681,502 B1. Applicant stated in its response to the Office Action that U.S. Utility Patent No. US 6,681,502 B1 “covers alternative sandal construction techniques that are not used in the applied-for trade dress.”

8. U.S. Utility Patent No. US 6,681,502 B1 is entitled “Sandal.” The claims of U.S. Utility Patent No. US 6,681,502 B1 are directed to a “sandal” or a “shoe bottom.” There are no method claims in U.S. Utility Patent No. 6,681,502 B1.

9. Applicant disclosed the following design patents in its response to the Office Action: U.S. Design Patent Nos. D513,838 S, US D855,950 S, US D880,116 S, US D955,705 S, US D963,303 S, US D969,465 S, US D978,489 S, US D984,099 S, US D1,000,055 S, US D1,006,411 S, US D1,023,524 S, and US RE49,694 E, and E.U. Design Nos. 000169420-0002, 007788716-0001, 007788716-0002, 007788716-0003, 007788716-0004, 007788716-0005, 015036449-0001, and 015036449-0003. Applicant stated in its response to the Office Action that the “majority of the product design Applicant seeks to register is identified in its design patents, which protect non-functional, ornamental features.”

10. U.S. Design Patent Nos. D955,705 S, D969,465 S, and D1,006,411 S include “broken lines depicting portions of the shoe sole” showing “portions of the sandal that form no part of the claimed design.” U.S. Design Patent No. D963,303 S includes “dotted lines on the bottom edge of the shoe sole” that are “intended to show that the bottom part of the shoe shall not be part of the design.” U.S. Design Patent No. D978,489 S includes “broken lines in the shoe sole” depicting “portions of the sandal that form no part of the claimed design.” U.S. Design Patent Nos.

D1,000,055 S and D1,023,524 S include “broken lines depicting portions of the sandal sole” showing “portions of the sandal that form no part of the claimed design.”

11. Three different Letters of Protest were forwarded to the Examining Attorney for the Application, consisting of evidence that the Opposed Mark is functional, nondistinctive, and fails to function as a mark.

12. Applicant submitted multiple responses to Office Actions during prosecution of the Application, and eventually all refusals were withdrawn by the USPTO. The Application was published for opposition in the *Official Gazette* on June 3, 2025.

13. Opposer is engaged in the development, marketing, advertising, and retail sale of footwear, including sandals, to the general public, through brick-and-mortar stores nationwide and the ecommerce operations as the licensee of its affiliate Penney IP LLC.

14. The Opposed Mark as depicted and described in the Application consists largely of features which are commonly used throughout the footwear industry.

15. Many of the features of the Opposed Mark appear in other coexisting product configurations for sandals manufactured by others, are generic and not unique to Applicant, and therefore do not indicate source in Applicant.

16. The features of the Opposed Mark are naturally used by others in the footwear industry because they are functional for a sandal design.

17. Opposer believes it will be damaged by the registration of the Opposed Mark because it will confer upon Applicant exclusive rights to which it is not entitled, as set forth in Counts I-III below. Specifically, the registration of the Opposed Mark will protect generic, nondistinctive and functional features of sandals and thereby embolden Applicant’s attempts to restrict others from incorporating similar features in their product designs or restrict others from

continuing to use such features in their goods, all to the detriment of Applicant's competitors, including Opposer.

18. In fact, Applicant has already attempted to restrict such competition by sending a cease-and-desist letter to Opposer on October 16, 2023, alleging trademark infringement and/or dilution of the Opposed Mark and threatening to file a lawsuit against Opposer in federal court. Therefore, Opposer will be further damaged if Applicant is permitted to obtain a registration for the Opposed Mark.

**COUNT I**  
**Failure to Function as a Mark / Genericness**  
**(Trademark Act Sections 1, 2, and 45)**

19. Opposer repeats and re-alleges the allegations of the preceding paragraphs as if fully set forth herein.

20. The Opposed Mark fails to function as a source identifier for the Claimed Goods and is therefore ineligible for registration pursuant to Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127.

21. Consumers do not associate the Opposed Mark with a particular source. Rather, the Opposed Mark and its features are so commonly used in the footwear industry that consumers are accustomed to seeing the same or substantially similar product design emanating from multiple sources.

22. The Opposed Mark is such a basic design of a sandal that it is generic for the Claimed Goods. On information and belief, Applicant has failed to police the use of identical or similar sandal designs by others, resulting in widespread generic uses by others and making the Opposed Mark incapable of identifying the source of the Claimed Goods.

23. Considering the utilitarian nature of the features claimed in the Opposed Mark, it

necessarily fails to function as a mark for the Claimed Goods. The combination of features such as the footbed, straps, and buckle shown in the Opposed Mark are incapable of identifying the source of the Claimed Goods because they are merely functional aspects of a sandal design.

**COUNT II**  
**Lack of Acquired Distinctiveness**  
**(Trademark Act Section 2(f))**

24. Opposer repeats and re-alleges the allegations of the preceding paragraphs as if fully set forth herein.

25. In the alternative, and to the extent that the Opposed Mark could ever be capable of functioning as a source identifier, the Opposed Mark is ineligible for registration on the Principal Register under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), because there is insufficient evidence of acquired distinctiveness.

26. As a product design for the Claimed Goods, the Opposed Mark cannot be inherently distinctive. Therefore, the Opposed Mark is not registrable on the Principal Register without sufficient proof of acquired distinctiveness under Section 2(f).

27. The evidence of acquired distinctiveness submitted by Applicant during prosecution of the Application is insufficient because Applicant has not made substantially exclusive use of the Opposed Mark.

28. Third parties commonly use the features of the Opposed Mark in their own sandal designs due to their utilitarian advantages, such that the Opposed Mark does not uniquely indicate source in Applicant.

**COUNT III**  
**Functionality**  
**(Trademark Act Section 2(e)(5))**

29. Opposer repeats and re-alleges the allegations of the preceding paragraphs as if

fully set forth herein.

30. The Opposed Mark is a functional product design for the Claimed Goods and is ineligible for registration pursuant to Trademark Act Section 2(e)(5), 15 U.S.C. § 1052(e)(5).

31. On information and belief, the Opposed Mark, at least in part, consists of features of a sandal configuration that have been the subject of a utility patent.

32. The Opposed Mark consists of features that provide a utilitarian advantage to the user, including the design of the footbed, straps, and buckle of the Claimed Goods.

33. Applicant's advertising materials tout the function and utilitarian advantages of the features in the Opposed Mark.

34. The Opposed Mark has no unique or distinctive elements; it is nothing more than its function and therefore not protectable as a trademark.

#### **PRAYER**

WHEREFORE, on the foregoing grounds, Opposer believes that it will be damaged by the registration of the Opposed Mark shown in Application Serial No. 98060917 in International Class 025 and opposes registration thereof on the grounds set forth above.

Opposer further prays that this Opposition be sustained, Applicant's Application Serial No. 98060917 be rejected in whole, and that the registration of the Opposed Mark be refused in whole.

The \$600 fee for a single class required under 37 C.F.R. § 2.6(a)(17)(ii) is submitted herewith.

Date: September 24, 2025

Respectfully submitted,

JACKSON WALKER L.L.P.

By: /Chandler Stephens/\_\_\_\_\_

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