

RESPONSE TO OFFICE ACTION

In an Office Action dated May 10, 2019, the Examining Attorney refused registration under Trademark Act Sections 1, 2 and 45 on the grounds that Applicant's mark is allegedly merely an ornamental feature of Applicant's goods and that the specimen submitted by Applicant is not an acceptable display associated with the goods and is mere advertising material.

To overcome this objection, an applicant may submit evidence that the applied-for mark is an indicator of a secondary source for the goods listed in the application. TMEP § 1202.03(c). Evidence that a mark is an indicator of secondary source can include non-ornamental use of the mark in commerce on other goods or services. *Id.* Here, Applicant's mark is used on other goods and services, such as condoms and educational and awareness campaign and therefore serves as a source identifier. **Exhibit A.**

Furthermore, Applicant's mark can *incidentally* serve an ornamental function while *principally* serving a source-identifying function. *In re Dimitri's, Inc.*, 9 USPQ2d 1666, 1667 (TTAB 1988). "Merely because a symbol may be pleasing to the eye, and is a decorative feature, does not necessarily mean that that symbol cannot also serve a trademark purpose." 1 *McCarthy on Trademarks and Unfair Competition* § 7:24 (4th ed.) (2004). The automatic preclusion of a mark's registration based on its ornamental or decorative features would produce an "absurd result." *Id.* It is common practice for corporations to emblazon the name of a campaign, a source indicator, on various clothing items. For example, the Livestrong Foundation uses the phrase LIVESTRONG in connection with clothing. **Exhibit B.** The LIVESTRONG mark, like the PROTECT YOUR WANG mark, is displayed in large font on the front of the t-shirt. As the evidence attached at Exhibit A demonstrates, Applicant consistently and uniformly uses its word mark across other goods and services. This illustrates that the mark for which Applicant is seeking registration is used to indicate the source of Applicant's goods. Consumers seeing Applicant's mark will immediately identify Applicant's mark as an indicator of source. Thus, it is clear that the primary purpose of Applicant's mark is to indicate the source of its goods.

In addition, the Examining Attorney has refused registration because allegedly the specimen submitted by Applicant is not an acceptable display associated with the goods and is mere advertising material. Applicant respectfully submits that the specimen submitted by Applicant is an acceptable display associated with the goods and is not advertising material. A web page that displays a product can constitute a "display associated with the goods" if it: (1) contains a picture or textual description of the identified goods; (2) shows the mark in association with the goods; and (3) provides a means for ordering the identified goods. *See*, TMEP 904.03(i); *In re Sones*, 590 F.3d 1282, 1288, 93 USPQ2d 1118, 1123 (Fed Cir. 2009); *In re Azteca Sys., Inc.*, 102 USPQ2d 1955, 1957-58 (TTAB 2012) ; *In re Dell Inc.*, 71 USPQ2d 1725, 1727 (TTAB 2004) ; *Lands' End v. Manbeck*, 797 F. Supp. 511, 514, 24 USPQ2d 1314, 1316 (E.D. Va. 1992). A web page from a third-party website may be acceptable as a display if the mark is sufficiently associated with the applicant's goods. *See In re Osterberg*, 83 USPQ2d at 1221, 1223-24. There must be a means of ordering the goods directly from the applicant's web page, such as an online ordering process. *In re Quantum Foods, Inc.*, 94 USPQ2d at 1380; *In re Osterberg*, 83 USPQ2d at 1224. In the present case, the specimen submitted describes the

product as a t-shirt, the mark is depicted on the goods; and the specimen contains a link called “SHOP NOW,” which redirects consumers to Applicant’s website for purchasing. In other words, the specimen clearly provides a means of ordering the goods from Applicant’s website even though the link is located at a third-party webpage.

Accordingly, Applicant respectfully requests that the Office withdraw the refusal and approve the application for publication.

EXHIBIT A



#protectyourwang

399 posts


Top posts



https://www.out.com/fashion/2018/6/18/alexander-wang-his-new-pride-capsule-collection

Alexander Wang on His New Pride Capsule Collection, 'Protect Your Wang'

By Out.com Editors



Alexander Wang on His New Pride Capsule Collection, 'Protect Your Wang'

Alexander Wang today announces the launch of his 'Protect Your Wang' capsule collection of T-shirts, hats, socks, bandanas, and branded condoms as part of his Pride initiative with Trojan.

We chatted with the designer about creating the special collab, as well as asking about his decision to move his brand out of Fashion Week for the first time this year. Get your new merch [here](#), with a portion of proceeds benefitting the LGBT Center of New York, and read our interview below.

How did this collaboration come to be?

AW: It started last year—I had known I wanted to do something for Pride. We'd reached out to Trojan to work on an initiative, and we were able to take a float together during the parade, and we had T-shirts. But last year we weren't able to produce the T-shirts for the mass audience that we wanted to. So this year, Trojan was so generous in partnering with us again and helping us create a capsule collection that we can then sell and donate a portion of proceeds to the LGBT center in New York. We'll be on the float again this Sunday, the 24th.

There's T-shirts, baseball caps, and bandanas all with the 'Protect Your Wang' logo.

Obviously Pride means a lot to you—can you vocalize what makes Pride so significant in your eyes and why you wanted to do this collection?

Pride has always been a celebration that's very close to me—being born in San Francisco, it's been such a privilege to be a part of that gay community. In New York, it's such a big celebration as well, and that's something I wanted to be a part of. Especially with Trojan, who's such an incredible brand with amazing values, coming together during this important time where it's not just about celebration, but about how this message of inclusivity and sex positivity in the world right now is really important. Having the platform to share this message is something I'm really grateful for.

You mentioned the world is falling apart—do you have any words of encouragement for queers out there who feel an overwhelming doom?

I think with all the bad, there's still good, and Pride brings together so many people. To have people being vocal is so important.

Can you speak more about choosing to show your latest runway collection outside of traditional fashion week this year?

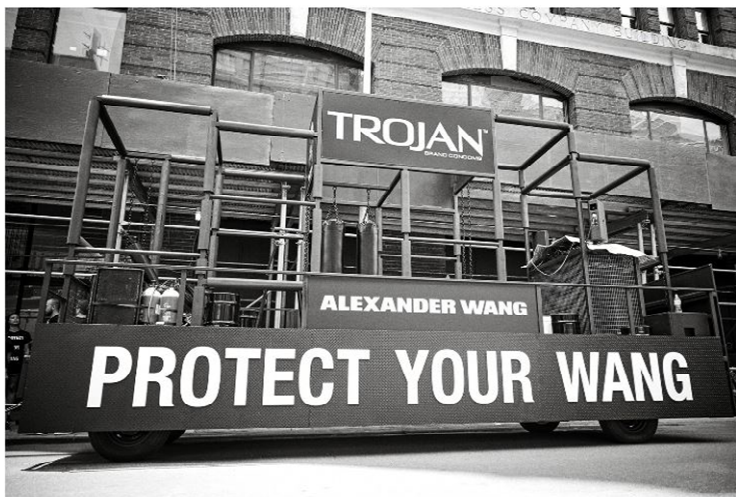
For us, it didn't make sense to design pieces by season anymore. We wanted to take that all away, and see what happens when you do the show how you want to. It didn't make sense for us to be a part of Fashion Week anymore.

Photos Courtesy of Alexander Wang

FASHION

Alexander Wang Hosts His Biggest, Boldest Pride Float Ever

BY JANELLE OKWODU
June 28, 2018



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Photo: Courtesy of Alexander Wang

My first look at this year's "Protect Your Wang" float.

Alexander Wang wants you to protect your wang. A year after bringing out his entire posse for a star-studded bash at the [Pride](#) parade, the designer was ready for round two this weekend. Wang delivered a bigger, bolder celebration, continuing his partnership with Trojan via a Stefan Beckman-designed float and a newly launched capsule collection supporting the LGBT Center of New York. "We wanted to take the collaboration a step further," shared Wang, who took to the streets of New York with friends like models Catherine McNeil and Hanne Gaby Odiele. "Last year we received such a huge response after creating the T-shirts for the NYC Pride march, but we didn't get the chance to produce them for everyone celebrating." Wang rectified the situation this time around: "We started with the T-shirt and added additional accessories including a hat, bandana, and socks that were accessible, so that people could show their support for inclusive sexual health."

Each item came with a co-branded condom, and the collection's proceeds went toward a serious cause, but Wang kept things light on the float. With shirtless male models dancing on a structure Wang dubbed "an industrial, brutalist Venice Beach gym" and the party extending into the streets, the event captured the joyous spirit Pride is all about. "Last year was the first time that I marched the entire route, and you really got to experience the energy from a different perspective," said Wang. "Seeing people from all over the world come to New York to celebrate Pride was really inspiring. What I love is that it brings people together to celebrate not only what we have in common but how we are different." Here, the designer shares an exclusive behind-the-scenes look at his weekend and all the raucous fun.

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ALEXANDER WANG CELEBRATES PRIDE WITH "PROTECT YOUR WANG" CONDOMS

The designer teamed up with Trojan for a cheeky capsule collection.

JUN 19, 2018 9:21PM BY LAUREN ALEXIS FISHER



In honor of Pride Month, **Alexander Wang** is teaming up with Trojan Condoms for a "Protect Your Wang" capsule collection benefiting the **LGBT Center of New York**.



Alexander Wang And Trojan Have Teamed For A Pride Collaboration

Radar



BY JENNA IGNERI /
JUNE 18, 2018

"Protect Your Wang" with designer condoms and merch

With NYC Pride celebration just around the corner, [Alexander Wang](#) is launching the collaboration to top all collaborations. The designer teamed up with condom and lubricant brand Trojan for the second time for what might be the cheekiest of capsule collections ever: Protect Your Wang. Pretty good, right?

The limited-edition capsule collection includes a t-shirt, hat, socks, a bandana, and, of course, condoms, all emblazoned with the Protect Your Wang slogan. While it serves to emphasize the importance of using condoms to protect your health, it also gives back. A portion of proceeds, as well as a large overall donation from the brands, will go to the [LGBT Center of New York](#) to support its sexual health programs.

"Pride has always been one of my favorite moments of the year, and it's even more amazing when you can engage with your friends and fans to share an important message that promotes wellness within the LGBTQ community," Wang said in a press release. "Partnering with Trojan to bring the 'Protect Your Wang' collection to life has been an inspiring way to create products that have further purpose in supporting initiatives we are both passionate about."

If you'll be in NYC for the Pride March on June 24, look for the designer's Protect Your Wang float. Condoms and other goods will be handed out along the way, while Wang himself and 200 members of his squad will participate in the celebrations.

You can start shopping the apparel today [online](#), as well as in the Alexander Wang SoHo location. Each item purchased will come with a condom. Take a closer look at the new merch, below.


















EXHIBIT B

- CATEGORIES**
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 \$25.93 White Tank Top 'LIVESTRONG'	 \$25.93 Black Tank Top 'LIVESTRONG'	 \$27.80 Adidas White Logo T Shirt 'LIVESTRONG'	 \$27.80 Adidas Purple Logo T Shirt 'LIVESTRONG'
 \$28.74 White/Black Raglan Baseball T Shirt 'LIVESTRONG'	 \$33.42 White Long Sleeve T Shirt 'LIVESTRONG'	 \$33.42 Black Long Sleeve T Shirt 'LIVESTRONG'	 \$33.42 Grey Long Sleeve T Shirt 'LIVESTRONG'
 \$33.42 Charcoal Long Sleeve T Shirt 'LIVESTRONG'			

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White T Shirt
'LIVESTRONG'
Item# 6-33-JW1191A

This practical, basic t shirt can be layered or worn alone. You can never have too many of these versatile shirts in your closet. Just toss one on and go.

- 5 oz, 100% Preshrunk HD Cotton
- Screen printed logo
- Seamless collar
- Double needle stitching throughout
- Taped shoulder to shoulder

Enter Desired Quantities

<input type="text" value="0"/>	\$20.31	Small
<input type="text" value="0"/>	\$20.31	Medium
<input type="text" value="0"/>	\$20.31	Large
<input type="text" value="0"/>	\$20.31	X-Large
<input type="text" value="0"/>	\$24.06	XX-Large (+\$3.75)
<input type="text" value="0"/>	\$27.80	XXX-Large (+\$7.49)
<input type="text" value="0"/>	\$0.00	Total


1	25	50	100	250	500
-24	-49	-99	-249	-499	+
\$20.31	\$19.38	\$18.44	\$17.50	\$16.57	\$15.63

Gift Wrapping \$3.75 ea.

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