

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mark:	FLAWLESS TWILL)	Law Office 124
)	Examining Attorney
Serial No.:	88/414,659)	Chandel Boozer
)	
Filed:	May 3, 2019)	
)	

RESPONSE TO OFFICE ACTION

On May 3, 2019, HSN Holding, LLC (“Applicant”) filed an application to register the mark FLAWLESS TWILL (“Applicant’s Mark”) for use in connection with “*Fabrics for the manufacture of apparel*” in Class 24 (“Applicant’s Goods”). On July 23, 2019, the Examining Attorney issued an Office Action refusing registration of Applicant’s Mark on the ground that the mark merely describes the ingredient and characteristic of Applicant’s Goods. More specifically, the Examining Attorney claims that the term FLAWLESS is laudatory.

While Applicant herein disclaims the term TWILL in Applicant’s Mark, the Trademark Office’s long standing treatment of the term FLAWLESS strongly indicates the term is not merely descriptive or laudatory. The evidence submitted with this Response shows that for a least 72 years and through today, the Trademark Office has consistently deemed the term FLAWLESS, whether alone or with a descriptive term, not merely descriptive. Accordingly, Applicant’s Mark FLAWLESS TWILL should also be deemed not merely descriptive and registerable on the Principal Register without a disclaimer or claim of acquired distinctiveness. Similarly, the evidence submitted by the Examining Attorney to support the claim that Applicant’s Mark is merely descriptive does not show descriptive use of Applicant’s Mark. As such, Applicant respectfully requests that the Examining Attorney amend the Application to disclaim TWILL, withdraw the refusal and approve the Application for publication.

AMENDMENT

Applicant hereby requests that the Examining Attorney enter the following statement in the record:

“No claim is made to the exclusive right to use "TWILL" apart from the mark as shown”

ARGUMENT

The Examining Attorney bears the burden of establishing a *prima facie* case that a term is merely descriptive. *In re Box Sols. Corp.*, 79 U.S.P.Q.2d (BNA) 1953, 1955 (T.T.A.B. 2006). Any doubt as to whether a term is merely descriptive must be resolved in the Applicant’s favor. *Id.*, *In re Morton-Norwich Products, Inc.*, 209 USPQ 791, 791 (TTAB 1981) (The Board's practice is "to resolve doubts in applicant's favor and publish the mark for opposition"); *see also Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002).

I. The term FLAWLESS is not merely descriptive because the Trademark Office has consistently, both historically and recently, not treated it as such.

While third-party registrations are not conclusive on the question of descriptiveness, the long and consistent treatment of the term FLAWLESS by the Trademark Office strongly indicates that the term is not merely descriptive or laudatory. TMEP 1209.03(a). There are 218 registrations on the Principal Register for marks containing the term FLAWLESS without a disclaimer or claim of acquired distinctiveness, of which 151 are currently live. Exhibit A. If applications which are allowed or refused on grounds other than descriptiveness were included in the count, the number of marks containing the term FLAWLESS which do not treat the term as descriptive greatly increases. By contrast, there are only 4 live registrations on the Principal Register for marks containing the term FLAWLESS with a disclaimer of FLAWLESS. Exhibit


B. The registrations on the Principal Register for marks containing the term FLAWLESS without a disclaimer or claim of acquired distinctiveness span 72 years. The first being the 1948 registration for the mark FLAWLESS for “*cake makeup*,” in Class 3 that is now expired. The live registrations include the 35 year old registration for the mark FLAWLESS FINISH for “*cream makeup of the skin*” in Class 3 and the newly registered mark FLAWLESS EYEWEAR for “*Eyewear; eyewear, namely, eyeglasses, eyeglass frames, protective eyeglasses; Optical lenses; optical lenses, namely, eyeglass lenses and sunglass lenses; Cases for eyeglasses and sunglasses*,” in Class 9 registered on January 7, 2020. Exhibit C for the TSDR records of all three registrations. Additionally, there are 13 live registrations for the mark FLAWLESS on the Principal Register without a claim of acquired distinctiveness. Exhibit D. This demonstrates that the term FLAWLESS has been consistently treated by the Trademark Office over the last 72 years as not merely descriptive.

Of the live registrations for marks containing the term FLAWLESS which are currently registered on the Principal Register without a disclaimer or claim of acquired distinctiveness, there are 15 for use with clothing or fabric, demonstrating that the term FLAWLESS is treated the same way for fabric and clothing as other goods or services. Exhibit E. Specifically, note the registration for the mark FLAWLESS LINGERIE for “*Lingerie, bras, panties, bustiers, long line bralettes, camisole, body suits, slips, chemise, babydoll pajamas, garter belt, garter panties, waist cinchers, kimono, hosiery*,” in Class 25. The term LINGERIE in the mark FLAWLESS LINGERIE is disclaimed. The TSDR record for Registration Number 5,757,927 at Exhibit F. Just like Applicant’s Mark, this mark consists of the term FLAWLESS with a disclaimed term.

It is registered on the Principal Register without a disclaimer or claim of acquired distinctiveness as should Applicant's Mark.

Similarly, there are several live registrations on the Principal Register for marks containing the term FLAWLESS without a disclaimer or claim of acquired distinctiveness which are analogous to Applicant's Mark in that they containing the term FLAWLESS and a disclaimed term. In addition to FLAWLESS LINGERIE noted above, following is a non-exhaustive list of 18 registrations for marks containing the term FLAWLESS plus a disclaimed term which demonstrates Applicant's Mark is registerable:

Trademark/Disclaimer	App. No./Reg. No.	Status/Key Dates	Goods/Services
FLAWLESS EYEWEAR Disclaimer: "EYEWEAR"	RN: 5953450 SN: 88363824	Registered January 7, 2020 Int'l Class: 09 First Use: August 1, 2018 Filed: March 29, 2019	(Int'l Class: 09) Eyewear; eyewear, namely, eyeglasses, eyeglass frames, protective eyeglasses; Optical lenses; optical lenses, namely, eyeglass lenses and sunglass lenses; Cases for eyeglasses and sunglasses
FLAWLESS DENTISTRY Disclaimer: "DENTISTRY"	RN: 5596881 SN: 87562968	Registered October 30, 2018 Int'l Class: 44 First Use: February 19, 2018 Filed: August 9, 2017	(Int'l Class: 44) Dentistry services
FLAWLESS SKIN LOTIONS AND CREAMS Disclaimer: "SKIN LOTIONS AND CREAMS"	RN: 5330748 SN: 87114902	Registered November 7, 2017 Int'l Class: 03 First Use: January 1, 2017 Filed: July 25, 2016	(Int'l Class: 03) cosmetics

Trademark /Disclaimer	App. No./Reg. No.	Status/Key Dates	Goods/Services
FLAWLESS LASHES Disclaimer: "LASHES"	RN: 4292247 SN: 85671209	Registered 8 & 15 March 23, 2019 Int'l Class: 44 First Use: November 1, 2010 Filed: July 8, 2012 Registered: February 19, 2013	(Int'l Class: 44) providing on-site beauty salon services, namely, eyelash extensions, waxing services, and makeup application services
FLAWLESS FOUNDATION Disclaimer: "FOUNDATION"	RN: 3501656 SN: 77397562	Renewed September 16, 2018 Int'l Class: 03 First Use: September 24, 2007 Filed: February 14, 2008 Registered: September 16, 2008	(Int'l Class: 03) cosmetics, namely, non-medicated skin care preparations, makeup, liquid makeup, foundation, blush, mascara, face and body moisturizers and lotions, face and body cleansers, sun screens, and nail polish
FLAWLESS LIP Disclaimer: "LIP"	RN: 2782834 SN: 76380574	Renewed November 11, 2013 Int'l Class: 03 First Use: June 1, 2002 Filed: March 11, 2002 Registered: November 11, 2003	(Int'l Class: 03) cosmetic products, namely, lipsticks, lip balm and lip color
FLAWLESS NETWORK Disclaimer: "NETWORK"	RN: 5320113 SN: 86960015	Registered October 31, 2017 Filed: March 31, 2016	(Int'l Class: 38) providing user access to a global computer network
MAKELLOS CABINETRY (Stylized) 	RN: 4567321 SN: 86117777	Registered 8 & 15 September 30, 2019 Int'l Class: 20 First Use: December 1, 2012 Filed: November 13, 2013	(Int'l Class: 20) kitchen cabinetry

Trademark /Disclaimer	App. No./Reg. No.	Status/Key Dates	Goods/Services
Disclaimer: "CABINETRY"		Registered: July 15, 2014	
FLAWLESS BELLY Disclaimer: "BELLY"	RN: 4767240 SN: 86298646	Registered July 7, 2015 Int'l Class: 25 First Use: September 24, 2013 Filed: June 3, 2014	(Int'l Class: 25) clothing, namely, maternity bands; girdles; maternity clothing, namely, bands, wraps, undergarments; maternity lingerie; shapewear, namely, bands, wraps, and undergarments
FLAWLESS BODY Disclaimer: "BODY"	RN: 5928185 SN: 88140209	Registered December 3, 2019 Int'l Class: 08 First Use: January 14, 2019 Filed: October 2, 2018	(Int'l Class: 08) Appliances for beauty care purposes, namely, electric shavers, hair trimmers and depilatory appliances; electric and battery-powered hair trimmers
FLAWLESS BROWS Disclaimer: "BROWS"	RN: 5567003 SN: 87563412	Registered September 18, 2018 Int'l Class: 08 First Use: May 28, 2018 Filed: August 10, 2017	(Int'l Class: 08) Appliances for beauty care purposes, namely, electric shavers, hair trimmers and depilatory appliances; Electric and battery-powered hair trimmers
FLAWLESS CONSULTING Disclaimer: "CONSULTING"	RN: 3499105 SN: 78717292	Renewed September 9, 2018 Int'l Class: 41 First Use: June 30, 1980 Filed: September 21, 2005 Registered: September 9, 2008	(Int'l Class: 41) workshops and seminars in the field of building partnerships, negotiating contracts, training how to provide feedback, and organizational management and distributing written course materials in connection therewith
FLAWLESS DERMAPLANE Disclaimer: "DERMAPLANE"	RN: 5956071 SN: 87563684	Registered January 7, 2020 Int'l Class: 08,21 First Use: January 15,	(Int'l Class: 08) Appliances for beauty care purposes, namely, hair trimmers and depilatory appliances; appliances for beauty care purposes, namely, non-electric

Trademark /Disclaimer	App. No./Reg. No.	Status/Key Dates	Goods/Services
		2018 Filed: August 10, 2017	hand implements used to clean and exfoliate the skin; battery-powered hair trimmers; razors (Int'l Class: 21) Appliances for beauty care purposes, namely, non-electric hand implements for hair and skin removal
FLAWLESS FOAM ENCASEMENT Disclaimer: "FOAM ENCASEMENT"	RN: 2739033 SN: 78081199	Renewed July 15, 2013 Int'l Class: 20 First Use: August, 2001 Filed: August 27, 2001 Registered: July 15, 2003	(Int'l Class: 20) mattresses and boxsprings
FLAWLESS HOMES Disclaimer: "HOMES"	RN: 5742368 SN: 86928122	Registered May 7, 2019 Int'l Class: 36 First Use: February 23, 2016 Filed: March 3, 2016	(Int'l Class: 36) real estate agency services
FLAWLESS KINKS Disclaimer: "KINKS"	RN: 5926961 SN: 87348369	Registered December 3, 2019 Int'l Class: 26 First Use: February 1, 2019 Filed: February 24, 2017	(Int'l Class: 26) Hair extensions; hair pieces and wigs
FLAWLESS THREADS Disclaimer: "THREADS"	RN: 4636676 SN: 86234861	Registered November 11, 2014 Int'l Class: 25 First Use: January 1, 2010 Filed: March 28, 2014	(Int'l Class: 25) baseball caps and hats; graphic t-shirts; hats; hooded sweat shirts; long-sleeved shirts; shirts; shirts and short-sleeved shirts; short-sleeved or long-sleeved t-shirts; short-sleeved shirts; sweat shirts; t-shirts; tee shirts; wearable garments and clothing, namely, shirts

Trademark /Disclaimer	App. No./Reg. No.	Status/Key Dates	Goods/Services
THE FLAWLESS FACIAL SYSTEM Disclaimer: "FACIAL SYSTEM"	RN: 5725051 SN: 87842693	Registered April 16, 2019 Int'l Class: 03 First Use: May 9, 2015 Filed: March 20, 2018	(Int'l Class: 03) facial masks; facial moisturizers; facial scrubs; facial washes; facial beauty masks; facial cleansers; facial cleansing milk; facial cream; facial lotion; facial oils; fragranced face care preparations, namely, facial creams, facial lotions, facial gels, facial toners, facial cleaners and facial peels; non-medicated facial and eye serum containing antioxidants; non-medicated skin toners; non-medicated skin care preparations, namely, creams, lotions, gels, toners, cleaners and peels; non-medicated skin care preparations, namely, facial creams, facial lotions, facial gels, facial toners, facial cleaners and facial peels; skin toners; tea tree oil

See Exhibit G for TSDR records for the above marks. The fact that all of these similarly situated marks are registered on the Principal Register without a claim of acquired distinctiveness or disclaimer of FLAWLESS is strong evidence of the registerability of Applicant's Mark.

Thus, the totality of the evidence demonstrates that for a least 72 years and through today, the Trademark Office has consistently deemed the term FLAWLESS, whether alone or with a descriptive term, not merely descriptive. Accordingly, Applicant's Mark FLAWLESS TWILL should also be deemed not merely descriptive and registerable on the Principal Register without a disclaimer or claim of acquired distinctiveness. At the very least, this extensive history of

registering marks with the term FLAWLESS on the Principal Register without a disclaimer or claim to acquired distinctiveness provides significant doubt about the descriptiveness of the term. This doubt must be resolved in the Applicant's favor with a finding that the mark is not merely descriptive. *In re Box Sols. Corp.*, 79 U.S.P.Q.2d (BNA) 1953, 1955 (T.T.A.B. 2006). *In re Morton-Norwich Products, Inc.*, 209 USPQ 791, 791 (TTAB 1981) (The Board's practice is "to resolve doubts in applicant's favor and publish the mark for opposition"); see also *Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002).

II. The evidence submitted by the Examining Attorney is insufficient to establish that the Applicant's Mark is used descriptively in the industry.

Applicant respectfully asserts that there is no evidence to support a conclusion that the mark FLAWLESS TWILL is used descriptively in the industry and thus is merely descriptive. If an Examining Attorney refuses registration, the refusal must be supported by appropriate evidence. See TMEP § 1209.02. The Examining Attorney bears the burden of setting forth a *prima facie* case in support of a descriptiveness refusal by establishing a reasonable basis for the refusal. *In re Pacer Tech.*, 338 F.3d 1348, 1350 (Fed. Cir. 2003). The Examining Attorney introduced the following evidence in support of the conclusion that the mark FLAWLESS TWILL is "used in the relevant industries that use fabric to describe clothing":

1. Screenshot of Applicant's website advertising and selling pants called LEMON WAY FLAWLESS TWILL PULL-ON ANKLE PANTS stating "Made from Flawless Twill, a soft, stretch cotton-blend knit, these pull-on pants feature a ..."
2. Screenshot of website advertising and selling pants called PALO HIGH RISE CROP FLARE JEANS stating under "Details:" "Flawless Twill: Soft and Perfect Stretch"

3. Screenshot of website advertising and selling a shirt called CLASSIC SOFT LAVERNDER TWILL stating in part "...Made of 100% cotton, comfort and longevity add some extra points to an otherwise flawless shirt."

Based on this the Examining Attorney concludes that the mark FLAWLESS TWILL is commonly used to describe clothing. It should be noted that Applicant's Goods are not *clothing*. Applicant's Goods are *fabric for use in the manufacture of clothing*. Thus, the evidence necessary to support the Examining Attorney's conclusion that the mark FLAWLESS TWILL is descriptive of Applicant's Goods would be evidence of use of FLAWLESS TWILL to describe fabric rather "...to describe clothing".

In any event, the evidence provided by the Examining Attorney does not show descriptive use of the mark FLAWLESS TWILL. In the first two examples of use submitted by the Examining Attorney the mark is being used as a trademark as indicated by the mark FLAWLESS TWILL being set apart in capital letters and then the branded fabric being described as "a soft, stretch cotton-blend knit" or "soft and perfect stretch." This is in stark contrast to a descriptive use, for instance, "our clothing is made of the most flawless twill."

The second example of use submitted by the Examining Attorney is not only using FLAWLESS TWILL as a trademark, but there is no evidence that it is a third party use. One other use of FLAWLESS TWILL is insufficient to support a claim that the mark is "used in the relevant industries that use fabric to describe clothing" and thus it is merely descriptive. The first two pages of online search results for "flawless twill" refer to Applicant. Exhibit H.

The third screenshot submitted by the Examining Attorney to support that Applicant's Mark is used in the industry to describe clothing doesn't actually use Applicant's Mark

FLAWLESS TWILL. The shirt is noted as having a twill structure. The only use of the term “flawless” is in the description of the shirt. The shirt is described “...an otherwise flawless shirt.” There is no use of FLAWLESS TWILL anywhere in the submitted screenshot. Accordingly, it cannot be used to support that FLAWLESS TWILL is used descriptively in the industry. The Examining Attorney has not provided evidence that the mark FLAWLESS TWILL is used descriptively in the industry or established a reasonable basis for the refusal.

CONCLUSION

Applicant has established in this Response that Applicant's Mark is entitled to registration. Accordingly, Applicant respectfully requests that the Examining Attorney amend the Application to disclaim TWILL, withdraw the refusal and approve the Application for publication.

Dated: January 23, 2020

Respectfully submitted,

/s/ Lynn Rzonca

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