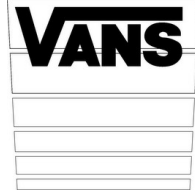


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No.: 88202504

Examining Attorney: Heather Schubert



Trademark: (the "VANS Trapezoid Mark")

Law Office: 103

Applicant: Vans, Inc.

Office Action Date: September 23, 2019

Filing Date: November 21, 2018

Attorney Ref. No.: 990.409.11

**Request for Reconsideration
Remarks**

On February 7, 2019, the Trademark Office (the "Office") issued an Office Action refusing registration with respect to U.S. Application Serial No. 88202504 (the "Application") under Sections 1, 2 & 45 of the Lanham Act, 15 U.S.C. § 1051-1052, 1127, based on the conclusory determination that the VANS Trapezoid Mark is "merely a decorative or ornamental feature of applicant's clothing" and "does not function as a trademark to indicate the source of applicant's clothing and distinguish applicant's clothing from others." Applicant, Vans, Inc. ("Vans") filed a Response to Office Action on August 7, 2019 arguing that the VANS Trapezoid Mark is not ornamentation but rather a trademark that identifies the source of Vans' clothing. The Office maintained the ornamentation refusal in a September 23, 2019 Final Office Action, under reply. Vans maintains that use of the VANS Trapezoid Mark on the specimen of record is not ornamental. However, in the alternative, Vans asserts a claim under Section 2(f) of the Lanham Act, 15 U.S.C. § 1052 ("Section 2(f)") *in part*, as well as additional evidence in support of its Section 2(f) claim.¹ TMEP § 1212.02(c).

In support of Vans' claims of acquired distinctiveness, Vans presents the Declaration of Vicki Redding (the "Redding Decl."), Vice President Product Management (Apparel) of Vans at **Exhibit A**.



Vans' Request for Reconsideration under TMEP § 715.03 presents a new issue, namely, a claim of acquired distinctiveness not previously asserted. Consequently, Vans respectfully notes that should the Office not agree that the declaration, evidence, and remarks presented herein are persuasive, a non-final Office Action should issue. *See* TMEP § 714.05(a) (delineating the circumstances for issuing

¹ Vans respectfully asserts in this Request for Reconsideration that the VANS Trapezoid Mark is entitled to registration on the Principal Register under Section 2(f) based *in part* on its prior active registrations for VANS, as well as its use of the registered VANS marks for more than five years before the date Vans asserts its claim under Section 2(f) with respect to the VANS Trapezoid Mark. TMEP §§ 1212.02(f), 1212.04. In addition, Vans submits in this Request for Reconsideration that the VANS Trapezoid Mark is entitled to registration on the Principal Register under Section 2(f) because this mark as a whole has acquired distinctive based on the length of time that Vans has used the VANS Trapezoid Mark and Vans' exclusivity in the marketplace related to this mark. TMEP § 1212.06.

a new non-final office action, including a claim of acquired distinctiveness). Nevertheless, Vans has filed contemporaneously herewith a Notice of Appeal.

I. The VANS Trapezoid Mark has acquired distinctiveness in part based on prior active registrations for VANS

Acquired distinctiveness in a mark under Section 2(f) can be established based on a “claim of ownership of one or more active prior registrations on the Principal Register of the *relevant portion of the mark* for goods and services that are sufficiently similar to those identified in the pending application.” TMEP § 1212.02(f); *see also* TMEP § 1212.04. In this case, Vans’ owns more than forty active federal trademark and service mark registrations for the VANS house mark, including the following registrations for the stylized word VANS found in the VANS Trapezoid Mark, for the same or substantially similar goods as listed in the Application, namely, “apparel, namely, tops (“Goods”). (Redding Decl. at ¶¶ 4-5.) Copies of the certificates for these registrations are annexed hereto as **Exhibit B**:

Mark	Goods	Registration Number
	Clothing and footwear; namely, sport shirts, T-shirts, hats, shorts, jogging suits, socks and shoes for men, women and children	1861882
	Wearing apparel, namely, sport shirts, t-shirts, hats, short, jogging suits, socks, swimsuits and shoes	1353939

Accordingly, the VANS Trapezoid Mark has acquired distinctiveness *in part* based on the Vans’ ownership of the foregoing active prior registrations.

II. The VANS Trapezoid Mark has acquired distinctiveness based on more than five years of use of the VANS marks.

Acquired distinctiveness in a mark can also be established under Section 2(f) with a “verified statement that the *relevant portion of the mark* has become distinctive of the applicant’s goods or services by reason of the applicant’s substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made.” TMEP § 1212.02(f). An applicant claiming acquired distinctiveness under Section 2(f) *in part* “may submit one or any combination of” evidence of prior registrations, substantially exclusive and continuous use in commerce for five years or more of the relevant portion of the mark, and other appropriate evidence of acquired distinctiveness. TMEP § 1212.02(f).

In this case, the VANS house mark, including the stylized version depicted in the chart above, has been in exclusive and continuous use in commerce for goods identical or substantially similar to the Goods for more than five years from the date of Vans’ claim of distinctiveness with respect to the VANS Trapezoid Mark. (Redding Decl., ¶¶ 4-5.) The mark in U.S. Registration Nos. 1861882 and 1353939, listed above, has been in use in commerce since 1969. *Id.* In addition, Vans has been using

numerous other registered marks consisting of its VANS house mark for footwear, apparel, accessories, and related services since 1969. *Id.* at ¶ 4. The VANS house mark is immediately recognizable to consumers for its trademark significance when presented in any size or placement on garments due to its extensive and exclusive use for more than fifty years and Vans' extensive branding efforts. *Id.* at ¶¶ 3-5. Indeed, Vans submits that the VANS house mark is a famous and well-known mark. *Id.* at ¶ 4. Because of the intense fame of the VANS house mark, it is virtually impossible for the mark, alone or in combination with a design element, to be perceived as ornamental by the relevant consumers.

In view of the foregoing, the VANS Trapezoid Mark is registrable on the Principal Register under Section 2(f) grounded in part on the exclusive and continuous use in commerce of the prior registered VANS stylized marks in the chart above since 1969, and the exclusive and continuous use in commerce of the registered VANS house mark since that same year.

III. The composite VANS Trapezoid Mark has acquired distinctiveness

In addition to the claim of acquired distinctiveness *in part* above, the composite VANS Trapezoid Mark itself has acquired distinctiveness based on Vans' longstanding and prominent use of this mark for more than thirty years and its exclusivity in the marketplace (Redding Decl., ¶ 6.) The VANS Trapezoid Mark is thus registrable on the Principal Register on this basis under Section 2(f).

To establish that a design has acquired distinctiveness as a trademark, an applicant must present proof "sufficient to establish purchaser recognition of the . . . design as an indicia of origin for goods originating exclusively with applicant." *Anchor Hocking Glass Corp. v. Corning Glass Works*, 162 USPQ 288, 292 (TTAB 1969); see *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417, 422 (Fed. Cir. 1985) (approving USPTO practice of permitting registration of designs that appear principally to be ornamental upon proof of acquired distinctiveness). In determining the sufficiency of an applicant's evidence of acquired distinctiveness, it is not necessary for each and every consumer to associate the mark with a single source or that even a majority of consumers make the association, rather it is only necessary that a "substantial part" or "appreciable number" of relevant consumers make the association. 2 J. Thomas McCarthy, *McCarthy On Trademarks and Unfair Competition* § 15:45 (5th ed. 2020). Factors relevant to the determination of acquired distinctiveness include: (1) exclusivity, length, and manner of use of the trademark, and (2) Applicant's efforts to associate the mark with its goods. TMEP § 1212.06; McCarthy at § 15:30.

A. Longstanding use of the VANS Trapezoid Mark supports finding acquired distinctiveness

The VANS Trapezoid Mark has been in continuous and exclusive use in the United States for more than 30 years, a duration that signifies that a mark is well-known and effectively indicates the source of goods. (Redding Decl. ¶ 6.) Indeed, Vans' use far surpasses the five years of use typically accepted as *prima facie* evidence of acquired distinctiveness. See 15 U.S.C. ¶ 1052(f) (acknowledging five years of use as ground for establishing acquired distinctiveness); TMEP §§ 1212.05, 1212.06(a); McCarthy at § 15:54 ("The five-year presumption is certainly not a minimum, for a secondary meaning can clearly be created in less than five years."). Thus, consumers have been exposed to Vans' products bearing the VANS Trapezoid Mark for a significant amount of time, more than enough time for consumers to immediately associate this trade dress with Vans.

B. Use of the VANS Trapezoid Mark is exclusive to Vans

Since introducing the VANS Trapezoid Mark more than 30 years ago, Vans' use of this mark has remained exclusive and accordingly has become very apt at identifying the source of Vans products. (Redding Decl. ¶ 6.) *See also* TMEP § 1212.05(b). Vans notes that the Office has not produced any evidence to the contrary.

C. Summary

As a result of the length of time that Vans has used the VANS Trapezoid Mark and Vans' exclusivity in the marketplace related to this mark, Vans asserts that the VANS Trapezoid Mark has acquired distinctiveness in the minds of consumers and is thus entitled to registration on the Principal Register under Section 2(f).

IV. Conclusion

Vans has made more than a sufficient showing herein that the VANS Trapezoid Mark has become distinctive. It therefore respectfully requests that the Examining Attorney allow registration of this mark on the Principal Register under Section 2(f) and approve the Application for publication. The Examining Attorney must resolve any doubts as to the sufficiency of Vans' acquired distinctiveness claim in Vans' favor. *See In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 4 USPQ2d 1141 (Fed Cir. 1987). Should the Office not agree that these remarks are persuasive, a further non-final action should issue. *See* TMEP §§ 714.05(a)(i), 715.03(b).

The Examining Attorney is invited to contact the undersigned with any questions or concerns.

Respectfully submitted,
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