

On February 10, 2019, the Office issued an Office Action initially refusing registration under Sections 1, 2 & 45 of the Lanham Act, 15 U.S.C. § 10510-1052, 1127, based on the conclusory determination that the applied-for mark “as used on the specimen of record is merely a decorative or ornamental feature of applicant’s clothing” and therefore “does not function as a trademark to indicate the source of applicant’s clothing.” The Office also erred in finding that Applicant’s claim of acquired distinctiveness based on over five years of use in U.S. commerce to be insufficient.



VANS & Checkerboard Design
(Serial No. 88206479)

Applicant hereby respectfully submits that the applied-for mark is not mere ornamentation and indeed the VANS & Checkerboard Design mark quite aptly identifies the source of Applicant’s apparel. More specifically, consumers will view the applied-for mark as a trademark because (1) the mark makes a unitary commercial impression and consists of the well-known VANS house mark, an established source identifier; and (2) applying oversized composite trademarks to apparel has become customary in the industry and consumers have been conditioned to viewing such marks as source identifiers. Moreover, Vans reserves its rights to present actual evidence of acquired distinctiveness in support of the 2(f) claim, if necessary.

REMARKS

I. Applicant's Mark is a Strong Source Identifier and not Merely Ornamental

When determining whether a proposed mark is merely ornamental as used on the goods, the Office must consider: “(1) the commercial impression of the proposed mark; (2) the relevant practices of the trade; (3) secondary source, if applicable; and (4) evidence of distinctiveness.” TMEP § 1202.03. Moreover, it is well settled that even designs that serve as part of the aesthetic ornamentation of goods, such as t-shirts, may nevertheless be registered as a trademark for such goods, if it also serves a source-indicating function. *In re Pro-Line Corp.*, 28 USPQ2d 1141 (TTAB 1993); *In re Dimitri's Inc.*, 9 USPQ2d 1666 (TTAB 1988). Here, because the Applicant's well-known house mark is inseparable from the design component, the composite mark makes a unified commercial impression, and because consumers have been conditioned to viewing oversized brands on apparel as source identifiers, Applicant respectfully requests that the Examining Attorney withdraw the ornamentation refusal.

a. **The Composite Mark Makes a Distinct and Unified Commercial Impression of a Trademark**

The VANS & Checkerboard Design trademark makes a source identifying commercial impression, especially among Vans' brand aware consumers. As cited in the action, determining the overall commercial impression of a mark includes such factors as “...the size, location, and dominance of the proposed mark, as applied to the goods, to determine whether ornamental matter serves a trademark function.” *In re Lululemon Athletica Can. Inc.*, 105 USPQ2d 1684 (TTAB 2013). Moreover, to test whether a mark is unitary, the Office must consider whether the elements of the mark are so “merged together that they cannot be regarded as separable.” *In re Ebs Data Processing, Inc.*, 212 U.S.P.Q. 964 (T.T.A.B. 1981). The test primarily focuses on “how the average purchaser would encounter the mark under normal marketing of such goods and also . . . what the reaction of the average purchaser would be to this display of the mark.” *Dena Corp. v. Belvedere Int'l, Inc.*, 950 F.2d

1555, 1561, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991). The examining attorney must consider a number of factors in determining whether matter is part of a single or unitary mark, including the relative location of the respective elements, and the meaning of the terminology as used on or in connection with the goods or services. *Id.*, at 1561.

Applicant's mark consists of two rows of checkerboard pattern, a line that runs through the design in a "z" formation, and the well-known VANS trademark centered in the checkerboard. The VANS house mark has been in use since at least as early as 1969 and is the subject of over thirty-five U.S. federal registrations. The prominent inclusion of VANS dominates the commercial impression created by the applied-for mark. The fact that the house mark is encased in the overall design merges the components in an inseparable and unitary manner. There can be no doubt that when the average consumer encounters the composite mark on the front of a shirt, they will view it as source identifying branding.

The size and location of the mark demonstrated in the specimen of use favors a finding that it functions as a trademark. Applicant's mark is applied to the front of a garment and is clearly visible when worn. As discussed in more detail below, the oversized mark is applied to a prime branding area for casual tops, and is similar in size to source identifiers used by Applicant's competitors. The applied-for mark has been used in a consistent manner over time to ensure that consumers view it as a source identifier when used in connection with Applicant's goods and services. When viewed through the eyes of the Vans' casual and streetwear apparel consumers, there is no doubt that the size, location, and significance of the VANS & Checkerboard Design mark ensures that it will be identified as a trademark.

b. The Relevant Practice in the Apparel Industry is to Apply Oversized Trademark in the Precise Location that Applicant Applies its Mark

The Office must also consider the relevant practice in the trade when determining whether Applicant's mark is merely ornamentation or a source identifier. In *In re Lululemon*, the Board clearly determined that there is no "per se rule regarding registrability based on the size of a mark on clothing." *In re Lululemon Athletica Can. Inc.*, 105 USPQ2d 1684. The Board concluded that "it may have once been the practice in the clothing industry to limit logos to small sizes in discrete areas rather than to have them 'emblazoned' across a garment...[b]ased on the evidence reproduced above, however, we find that such is no longer the industry practice, or at least no longer the only one." *Id.* That is, if consumers are already conditioned to looking for brand information in the manner or location as demonstrated in the specimen, it is more likely that the matter will be viewed as a mark. The casual and streetwear apparel segment is replete with examples of companies using oversized trademarks on the front of shirts. Most notably, Applicant's mark is conceptually indistinguishable from the use of other well-know brands depicted below. In fact, parallels to the placement of the applied-for mark are evident among almost all of Applicant's major competitors. Below is a representative sampling of third parties using oversized marks on tops.





Gucci & Design



Adidas & Design



Puma & Design



New Balance & Design



Nike Swoosh Design Mark



Supreme & Design



Dickies & Design Mark



The North Face & Design

Undoubtedly, consumers have been conditioned to view oversized marks and designs on the front of tops as source identifiers. Accordingly, Vans' consumers will, and in fact already do, readily perceive the applied-for mark as a source identifier. Accordingly, based on the commercial impression created by the VANS & Checkerboard Design mark and the relevant practice in the trade to apply oversized marks and designs to the front of shirts, the Office erred in finding Applicant's mark merely ornamental.

Conclusion

Through the remarks and information submitted herewith, Applicant has fully complied with the Office's requests and has presented adequate evidence to remove any concern over the ornamental refusal. Applicant therefore respectfully requests that the Office withdraw the refusal and allow the application to proceed to publication.