

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Vans, Inc.
Application Serial No.: 90379391
Filing Date: December 14, 2020



Mark:

Class: 25
Examining Attorney: Matthew Patter Howell
Law Office: 123

APPLICANT'S RESPONSE TO OFFICE ACTION

Applicant Vans, Inc. ("Vans" or "Applicant"), by and through its attorneys, respectfully submits this Response to Office Action regarding Application Serial No. 90379391 (the "Application") for the VANS & Design mark, depicted below ("Applicant's Mark"). Applicant is responding to the Office Action dated March 18, 2021 (the "Office Action").



Applicant responds to the issues raised in the Office Action as follows:

I. Prosecution History

On March 18, 2021, the Office issued an Office Action ("Office Action") refusing registration of Application Serial No. 90379391 ("Application") under Sections 1, 2 & 45 of the Lanham Act, 15 U.S.C. § 1051-1052, 1127, based on the determination that Applicant's Mark is "merely a decorative or ornamental feature of applicant's clothing and, thus, does not function as a trademark to indicate the source of applicant's clothing and to identify and distinguish applicant's clothing from others."¹ In response, Vans asserts that Applicant's Mark conveys a distinct commercial impression by reference to similar trademarks from third parties, and that consumers would immediately perceive it as a source identifier (rather as an ornamental design) on account of the mark's specific placement and the mark's fame and iconic pop culture status.

¹ It should be observed that the "Merely Ornamental" refusal is the only ground for refusal raised by the Office.

II. Applicant's Mark is a strong source identifier and is not merely ornamental as it is presented in Applicant's specimen of use.

When determining whether a proposed mark is merely ornamental as used on the goods, the Office must consider the following four factors:

- The Commercial Impression of the Proposed Mark;
- The Relevant Practices of the Trade;
- The Distinctiveness of the Proposed Mark; and
- Indications of Secondary Source.

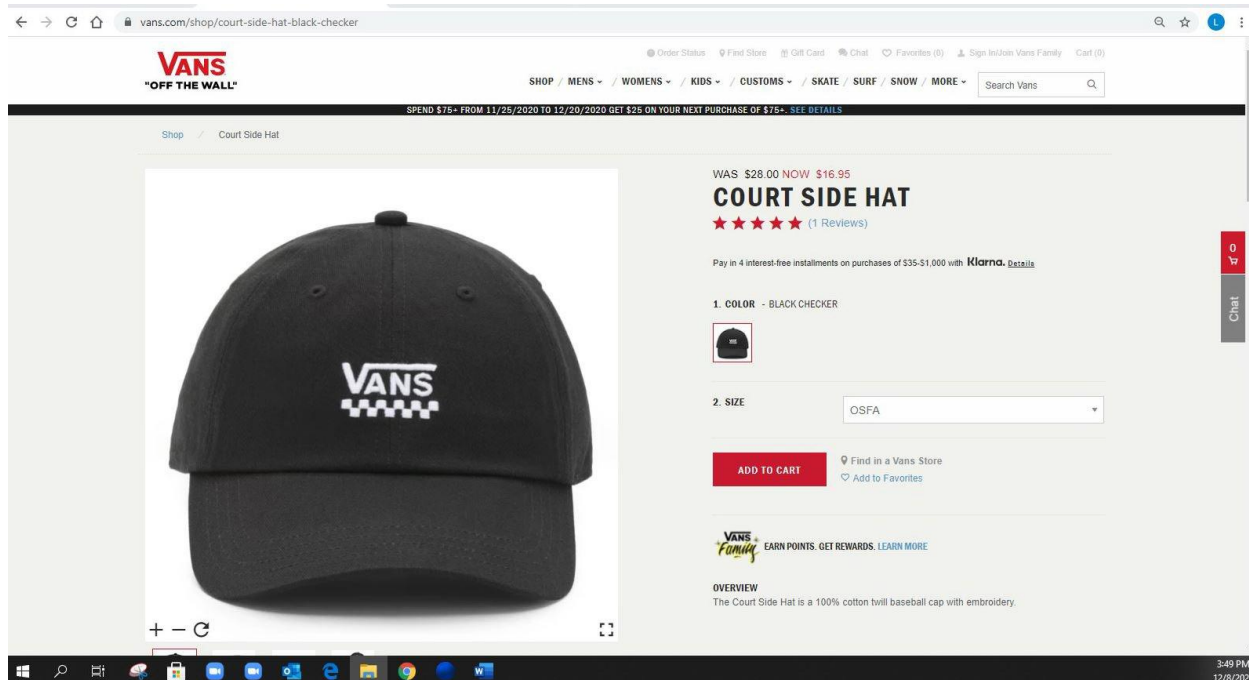
TMEP § 1202.03.

Moreover, it is well settled that even designs that serve as part of the aesthetic ornamentation of goods, such as clothing, may nevertheless be registered as a trademark for such goods, if it also serves a source-indicating function. *In re Pro-Line Corp.*, 28 U.S.P.Q.2d 1141 (TTAB 1993); *In re Dimitri's Inc.*, 9 U.S.P.Q.2d 1666 (T.T.A.B. 1988). Here, Applicant's Mark (i) creates a unique commercial impression of a trademark, (ii) consumers have been conditioned to viewing trademarks affixed to the center of the front panel(s) of hats as source identifiers, and (iii) Applicant's mark incorporates several of the most distinctive and famous clothing trademarks in the world. Applicant thus asserts that indications of secondary source are not applicable to the instant case. Accordingly, Vans respectfully requests that the Office withdraw the ornamentation refusal and allow the application to proceed to publication.

A. The Applicant's Mark makes the distinct commercial impression of a trademark.

Applicant's Mark, as presented in the December 14, 2020 specimen (the "Specimen"), makes the unmistakable commercial impression of a trademark. 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 U.S.P.Q.2d 1684 (T.T.A.B. 2013). Moreover, when considering the impact a mark has on consumers, the significance of the proposed mark must be considered. TMEP § 1202.03(a).

Applicant's Mark is placed in the center and on the front panels of a baseball cap, as can be seen in the below reproduction of the Specimen.



The Specimen

The size and location of Applicant's Mark clearly favors a finding that it functions as a trademark. The placement of Applicant's Mark allows it to be prominently featured whether on a shelf in a store or being worn on the street. As discussed in more detail below, Applicant's Mark is applied to the prime branding area for headwear and is similar in size to source identifiers used by its competitors. Applicant's Mark, and Applicant's related VANS and Checkerboard trademarks, have been used in a consistent manner over time to ensure that consumers view these marks as source identifiers when used in connection with Applicant's goods and services. When viewed through the eyes of Vans' clothing consumers, there is no doubt that the size, location, and significance of Applicant's Mark ensures that it will be identified as a trademark. Indeed, it has been Vans' conscious intent to develop and use the mark in this manner.

- B. The relevant practice in the clothing and headwear industries is to place logo and design trademarks on the front and center of headwear in a manner identical to that which Vans has employed in this case.

The Office must also consider the relevant practice in the trade when determining whether Applicant's Mark is merely ornamentation or a source identifier. That is, if consumers are already conditioned to looking for brand information in the manner or location as specified in the specimen of use, it is more likely that the matter will be viewed as a mark. The clothing and headwear market is replete with examples of companies communicating brand information by prominently displaying their trademarks on the front and center of their headwear products, capitalizing on the fact that this position is the most visible and eye-catching location on headwear. Parallels to Applicant's Mark are evident among many of Vans' competitors. Below is a representative sampling establishing that it is the practice of the trade for parties to apply logo designs on the front of hats as trademarks.



Nike



Adidas

See, *e.g.*, U.S. Reg. Nos. 1990180 and 1284385 for the mark:



See, *e.g.*, U.S. Reg. No. 1253013 for the mark:



New Balance



Reebok

See, *e.g.*, U.S. Reg. No. 3427255 for the mark:



See, *e.g.*, U.S. Reg. No. 1848848 for the mark:



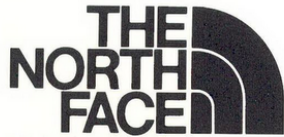


The North Face



Patagonia

See, e.g., U.S. Reg. No. 3630846 for the mark:



See, e.g., U.S. Reg. No. 1294523 for the mark:



The above examples of third-party use of federally registered trademarks by Applicant's competitors and contemporaries – each of them household names and industry leaders – makes it quite clear that it is *the prevailing practice* in Applicant's trade to place trademarks of a similar size and dominance on the front and center of headwear, including baseball caps.

As such, consumers have been undoubtedly conditioned by the clothing and headwear industry itself to view the front and center of baseball caps as *the* primary branding location, and to look to this location first for source-identifying information. Accordingly, Applicant's consumers will, and in fact already do, readily perceive Applicant's Mark, as presented in the December 14, 2020 specimen, as a source identifier.

C. The distinctiveness of Applicant's Mark far exceeds any requirement for overcoming an ornamental refusal

Applicant's Mark is not only distinctive, but is primarily comprised of one of the most iconic and highly recognizable clothing trademarks in the world. The distinctiveness of Applicant's Mark derives in part from Vans' consistent and continuous use of the VANS trademark, with or without specific checkerboard elements, on apparel for over four decades. As such, Applicant's Mark falls on the extreme end of the distinctiveness spectrum – the point reserved for only the strongest and most famous trademarks. Certainly, the mark's distinctiveness far exceeds any showing that may be required to overcome an ornamental refusal.

1. Distinctiveness of Applicants Mark²

² Vans presents the following information to demonstrate distinctiveness in connection with its arguments refuting the ornamental refusal and not as actual evidence of acquired distinctiveness. While it should be procedurally unnecessary, Vans reserves the rights to present further evidence of distinctiveness if it elects.

Since at least as early as the 1969, Vans has used its VANS trademark on its own in combination with a variety of stylizations and design elements (the “Vans Marks”) as trademarks for Applicant’s clothing and headwear products. Vans has expended substantial time, money, and other resources in the developing, advertising, and otherwise promoting the Vans Marks. As a result of these efforts, consumers readily identify merchandise bearing the Vans Marks as being high quality merchandise emanating from, sponsored by, or approved by Vans. Applicant’s Vans Marks, including Applicant’s Mark, have become well-known among consumers and accordingly is afforded tremendous strength.

Examples of Vans’ clothing and headwear products bearing the Vans Marks are depicted below:



Representative images of Applicant's use of its Vans Marks on clothing and headwear products

Applicant has sold *billions* of dollars' worth of products in connection with its Vans Marks. These products are promoted, offered, and sold nationwide through a variety of retail means, including in thousands of retail stores. These retail stores include national, regional, independent, and even specialty retailers such as Zumiez, Dick's Sporting Goods, Kohls, Foot Locker, Journeys, PacSun, DSW, WalMart, and JCPenney. Vans also maintains a global network of proprietary retail stores, including flagship locations in major metropolitan areas throughout the world.





Applicant's products are also offered and sold in connection with its Vans Marks through websites of many of its retailers, as well as through Vans' own proprietary e-commerce websites. For years, Applicant has spent tens of millions of dollars annually advertising and promoting the Vans Marks to the general public in connection with its products and services through virtually every available type of media, including print publications, out-of-home signage, and the internet. With respect to print publications, Vans has also advertised and promoted the Vans Marks in a wide variety of nationally circulated magazines. Vans additionally promotes and markets the Vans Marks on its own website, authorized websites, and social media sites, including vans.com, facebook.com/VANS, twitter.com/VANS_66, and instagram.com/vans, among others. Further, Vans' products sold in connection with the Vans Marks are advertised and promoted through many of its retail partners' websites, including sites used by Nordstrom, Walmart, Barneys, ASOS, and Famous Footwear, among others.

Sponsorships and individual athlete and celebrity agreements represent another significant form of advertising and promotion by Vans. Applicant's Vans Marks have been promoted through high-profile athletes, musicians, and artists. Indeed, Vans has collaborated with numerous world-famous musicians and rock groups with millions of fans in the United States and across the globe, including Metallica, Pearl Jam, Iron Maiden, Motorhead, Bad Brains, Bad Religion, The Beatles, Kiss, Ramones, AC/DC, DEVO, Mastodon, Dinosaur Jr., Descendents, UNKLE, Deftones, Gorillaz, Tyler, The Creator, and Slayer.

As a result of Applicant's longstanding use of the Vans Marks, along with Applicant's extensive advertising, publicity, promotion, and sales on a wide variety of products, including, but not limited to footwear, apparel, and sporting goods, the Vans Marks, including Applicant's Mark, have become a beloved and iconic indicator of Applicant's brand.

Vans owns the following representative U.S. federal trademark registrations for its Vans Marks covering relevant goods (the "Vans Registrations") (extracts from the USPTO TSDR database, including assignment information, are attached as Exhibit A). These registrations are valid, subsisting, and in full force and effect.

Mark	Goods/Services (Class)	Reg. No.
VANS	"Bandanas; Belts; Boardshorts; Bodysuits; Bottoms as clothing; Capris; Coats; Coveralls; Dresses; Footwear; Headwear; Hoodies; Insoles; Jackets; Jeans; Leggings; Pants; Rain wear; Shirts; Shorts; Skirts; Snowboard	6136350

	boots; Socks; Sweat jackets; Sweat pants; Sweat shirts; Sweaters; Tank tops; Tops as clothing; Vests in Class 25.	
	“Bandanas; Belts; Boardshorts; Bodysuits; Bottoms as clothing; Capris; Coats; Coveralls; Dresses; Footwear; Headwear; Hoodies; Insoles; Jackets; Jeans; Leggings; Pants; Rain wear; Shirts; Shorts; Skirts; Snowboard boots; Socks; Sweat jackets; Sweat pants; Sweat shirts; Sweaters; Tank tops; Tops as clothing; Vests” in Class 25.	6136351
	“Wearing apparel, namely, sport shirts, t-shirts, hats, short, jogging suits, socks, swimsuits and shoes” in Class 25.	1353939
	“Apparel, namely, tops” in Class 25.	6248317
	“Men’s, women's and children's clothing, namely, shirts, t-shirts” in Class 25.	2277833

Each of the above registered Vans Marks was registered with the USPTO on its Principal Register without a claim of acquired distinctiveness, thereby establishing that the Vans Marks are inherently distinctive marks that requires no demonstration of acquired distinctiveness.

In view of the above, Applicant’s Mark is undeniably a strong and inherently distinctive mark. As such consumers will immediately perceive as a source indicator when encountered in just about any size or location, and especially as it appears in the Specimen in connection with headwear.

III. Conclusion

As established by the foregoing arguments and evidence, Applicant respectfully submits that consumers encountering Applicant’s Mark as shown in the Specimen will immediately understand it as an indication of source in Applicant because: (i) the commercial impression of Applicant’s Mark is that of a trademark, as it is not only placed in a common branding location, but incorporates Applicant’s famous VANS trademark; (ii) it is the overwhelming prevailing practice in the industry to place trademarks and other source-identifying indicia in precisely the location shown in the Specimen; and (iii) Applicant’s Mark is a strong and inherently distinctive trademark. Accordingly, it is clear that Applicant’s Mark, as presented in the Specimen, is not perceived by consumers as mere ornamentation, but is rather viewed for what it is – an inherently distinctive trademark. TMEP § 1202.03.

Vans therefore respectfully requests that the Examining Attorney approve the Application for publication.

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