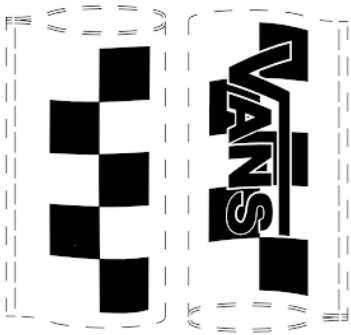


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Vans, Inc.
Application Serial No.: 90326832
Filing Date: November 18, 2020

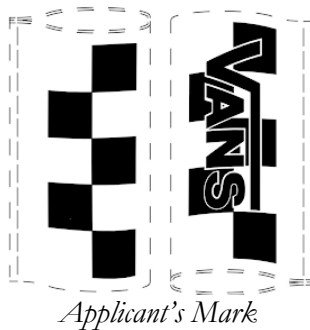


Mark:

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. 90326832 (the "Application") for the below-depicted trademark ("Applicant's Mark"). Applicant is responding to the Office Action dated March 22, 2021 (the "Office Action").



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

I. Prosecution History

On March 22, 2021, the Office issued an Office Action ("Office Action") refusing registration of the 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 "consists of a non-distinctive product design or non-distinctive

features of a product design that is not registrable on the Principal Register without sufficient proof of acquired distinctiveness.” In response, Vans hereby respectfully submits that Applicant’s Mark is not non-distinctive product design, but rather inherently distinctive product packaging, and therefore registrable on the Principal Register without a claim or proof of acquired distinctiveness.

II. Amendment to the Mark Description

Applicant herewith amends the description of its mark to more accurately correspond with the nature of the mark and the mark drawing. The amended description reads:

“The mark consists of the stylized mark “VANS” overlaid upon five shaded squares arranged in a checkerboard formation on one side of a label; on the opposing side of the label appear five shaded squares arranged in a checkerboard formation. The dotted outline of the label is not claimed as part of the mark and is intended only to show the position of the mark.”

Applicant respectfully requests that the Office take note of this amended mark description for the purposes of evaluating this response and further examining the Application.

III. Remarks in Support of Registration

a. Summary of Applicable Law

Although the role of trademark law has traditionally been to protect distinctive words and symbols, trademark law principles have gradually been extended to protect a product’s design, packaging, color, flavor, and more. TMEP 1202.02; *see also Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 209-210, 54 USPQ2d 1065, 1065-66 (2000). Trade dress is an expansive concept, held to include a vast array of non-traditional source-identifiers, including, *e.g.*, the design of a sport shoe, the motif of a western cowboy smoking cigarettes, and the design of a water meter. *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 12 U.S.P.Q.2d 1001, 1989 WL 282850 (S.D.N.Y. 1989), *rev’d*, 988 F.2d 1117, 25 USPQ2d 1913 (Fed. Cir. 1993); *Philip Morris, Inc. v. Star Tobacco Corp.*, 879 F. Supp 379, 35 U.S.P.Q.2d 1178 (S.D.N.Y. 1995); *Badger Meter v. Grinnell Corp.*, 13 F.3d 1145, 29 U.S.P.Q.2d 1507, 1513 (7th Cir. 1994); *see also* 1 McCarthy on Trademarks and Unfair Competition § 8:4.50 (5th ed.).

Today, the universe of trade dress has been refined into two separate and discrete categories. The first of these is “product-packaging” trade dress, which is composed of the overall combination and arrangement of the design elements that make up the product’s packaging, including graphics, layout, and/or color. *See Wal-Mart Stores, Inc.*, 529 U.S. 205 (2000). The second type of protectable trade dress is “product design,” which covers a product’s shape or configuration. *See Id.*

In contrast to product design, which consumers generally do not automatically perceive as identifying the source of a product, product-packaging trade dress is recognized by consumers as source-identifying. *Id.* at 205–09. As the Third Circuit has had occasion to observe, “product configuration. . . differs dramatically from trademark and from product packaging, since the success of a particular product—especially if similar competing products exist—does not readily lead to the inference of source identification. *Duraco Products, Inc. v. Joy Plastic Enterprises, Ltd.*, 40 F.3d 1431, 1453 (3d Cir. 1994). Indeed, “the very purpose of attaching a particular word to a product, or encasing it in a distinctive packaging, is most often to identify the source of the product. *Wal-Mart Stores, Inc.*, 529 U.S. at 212. As such, product-packaging trade dress may be inherently distinctive – and therefore both protectable

and registrable – even in the absence of proof of secondary meaning or acquired distinctiveness. *Id.*, see also 1 McCarthy on Trademarks and Unfair Competition § 8:13 (5th ed.).

In discussing the practical implications of the Supreme Court’s seminal decision in *Wal-Mart*, McCarthy notes that “[t]he Supreme Court made it clear that the prior rules still [apply] to [product] packaging trade dress” and that, as a result, “certain types of product packaging can be classified as inherently distinctive.” 1 McCarthy on Trademarks and Unfair Competition § 8:13 (5th ed.). McCarthy further notes that, while the Court neither accepted nor rejected any test to determine when product packaging trade dress was inherently distinctive, the implication of the Court’s reasoning in that case is that, “where it is reasonable to assume consumer predisposition to take packaging as an indication of source, then inherent distinctiveness *will* be found.” *Id.* (emphasis in original).

Today, in order to determine when trade dress is inherently distinctive, courts nearly uniformly apply the *Seabrook* test. *Id.* Under the *Seabrook* test, the inquiry is:

- (1) whether the design or shape is a common, basic shape or design;
- (2) whether it was not unique or unusual in a particular field; and
- (3) whether it was a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods which consumers would view as mere ornamentation.

Id.; see *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 1344, 196 U.S.P.Q. 289, 291 (C.C.P.A. 1977). If the trade dress fails any one of the factors, then it is not inherently distinctive and there must be sufficient evidence of the design having acquired a secondary meaning. 1 McCarthy on Trademarks and Unfair Competition § 8:13 (5th ed.); see also *In re Chippendales USA, Inc.*, 622 F.3d 1346, 1355, 96 U.S.P.Q.2d 1681 (Fed. Cir. 2010).

b. Applicant’s Mark is Registrable Without Proof of Acquired Distinctiveness

i. Applicant’s Mark is product packaging trade dress

Applicant’s Mark in this case, which consists of configuration of a label bearing others of Applicant’s registered and unregistered trademarks, is a classic example of product-packaging trade dress and not – as the Office erroneously concluded – “part of the product design.”

In keeping with the Supreme Court’s decision and logic in deciding *Wal-Mart*, courts examining the at times ambiguous distinction between product packaging and product design trade dress have placed great weight on: (i) the nature of mark (*i.e.*, whether or not the trade dress is identifiably a package or label); and (ii) whether the trade dress primarily serves a source-identifying purpose. See *Sazerac Company, LLC v. Fetzer Vineyards, Inc.*, 251 F.Supp.3d 1288, 1302 (N.D. Cal. 2017) (concluding that the pleaded trade dress, which consisted of a label, applied to a bourbon bottle, was product packaging because “[t]he very purpose of attaching [the label] to the product is to identify the source of the product.”); *Yankee Candle Co. v. Bridgewater Candle Co., LLC*, 259 F.3d 25, 41 (1st Cir. 2001) (“Detachable labels are a classic case of product packaging, and therefore may be inherently distinctive.”); *cf. Deere & Company v. MTD Holdings, Inc.*, 2003 WL 22439778 3 (S.D.N.Y. Oct. 28, 2003) (defining plaintiff’s trade dress, the colors green and yellow applied to lawn care equipment, as product design, rather than product packaging, in part because “there is no argument made that the color scheme and design Plaintiff seeks to protect is a package or a label.”).

As is demonstrated by the above representative sampling of cases examining the matter, where the trade dress in which rights are asserted consists of a label or product labeling, as in this case, courts are heavily inclined toward classifying such trade dress as product packaging, rather than product design. This pattern of decisions reflects the realities of how consumers today recognize or fail to recognize elements of trade dress as indications of source; in contrast to product design trade dress, which, the Court noted in *Wal-Mart*, is almost invariably “intended not to identify the source, but to render the product itself more useful or more appealing,” 529 U.S. at 213, product labels are understood and designed to be understood as identifying the source of the product. Indeed, the very definition of a label – “a material, marked or inscribed, for attachment to something *to indicate its manufacturer, nature, ownership, destination, etc.*” – confirms that its primary purpose is in indicating source. A webpage printout from online dictionary Dictionary.com is attached hereto as Exhibit A to make this evidence of record.

Applicant’s Mark is just such a label, and it was an error for the Office to conclude otherwise. It is clear both from the description of the mark and the mark image itself, both submitted in connection with the Application, that Applicant’s Mark is a label *which will be affixed* to Applicant’s products with the sole and primary purpose of identifying Applicant as the source of Applicant’s identified products. Applicant’s incorporation of Vans’ famous VANS and VANS & Flying V Extended Design trademarks, identified with greater particularity below, can leave no doubt that Applicant’s Mark is pure product packaging which serves an unambiguously source-identifying purpose.



The VANS Flying V Extended Mark

ii. Applicant’s famous trademarks

For decades now, Applicant has used its VANS trademark on its own and in combination with a variety of stylizations and design elements (the “Vans Marks”) as trademarks for Applicant’s clothing, footwear, and bag products. Applicant has expended substantial time, money, and other resources in the developing, advertising, and otherwise promoting the Vans Marks and, 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 Applicant. Applicant’s Vans Marks, including those incorporated into Applicant’s Mark, have become famous among consumers and afforded tremendous strength.

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, Foot Locker, Journeys, PacSun, DSW, WalMart, and JCPenney. Applicant 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.

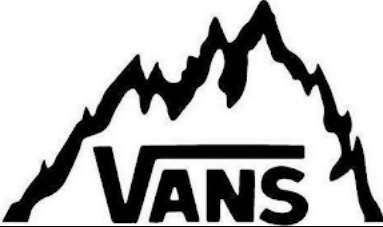





Sponsorships and individual athlete and celebrity agreements represent another significant form of advertising and promotion by Vans. Applicant’s Vans Marks have been promoted through high-profile athletes, musicians, and artists. Indeed, Vans has collaborated with numerous world-famous musicians and 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 as incorporated into Applicant’s Mark, have become beloved and iconic indicators of Applicant’s brand.

Applicant 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 B). 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 boots; Socks; Sweat jackets; Sweat pants; Sweat shirts; Sweaters; Tank tops; Tops as clothing; Vests” in Class 25.	6136350
VANS	“Shoes” in Class 25.	1267262
VANS	“Clothing and footwear; namely, sport shirts, T-shirts, hats, shorts, jogging suits, socks and shoes for men, women and children” in Class 25.	1861013

<p>VANS</p>	<p>“Souvenir merchandise related to a skateboarding, extreme sports, punk rock festival and tour, namely, t-shirts, caps and hats” in Class 25.</p>	<p>3742510</p>
	<p>“Wearing apparel, namely, sport shirts, t-shirts, hats, short, jogging suits, socks, swimsuits and shoes” in Class 25.</p>	<p>1353939</p>
	<p>“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.</p>	<p>6136351</p>
	<p>“Clothing and footwear; namely, sport shirts, T-shirts, hats, shorts, jogging suits, socks and shoes for men, women and children” in Class 25.</p>	<p>1861882</p>
	<p>“Belts; Footwear; Headwear; Shirts” in Class 25.</p>	<p>5891110</p>
	<p>“Men’s, women’s and children’s clothing, namely, shirts, T-shirts, shorts, underwear, swim trunks, trousers, sweaters, jackets, coats, caps, hats, bandannas, vests and socks; footwear” in Class 25.</p>	<p>2174502</p>
	<p>“Footwear; Jackets; Shirts; Sweat shirts; Tops as clothing” in Class 25.</p>	<p>6464835</p>
	<p>“Footwear” in Class 25.</p>	<p>6168135</p>

	“Footwear” in Class 25.	6164024
	“Footwear” in Class 25.	3922443
	“Pants; bottoms as clothing” in Class 25.	6472953
	“Belts; Footwear; Headwear; Jackets; Pants; Shirts; Shorts; Socks; Sweatshirts; T-shirts” in Class 25.	6135640
	“Men’s, women’s, and children’s footwear” in Class 25.	1927910
	“Apparel, namely, tops” in Class 25.	6248317
VANS CHECKERBOARD DAY	“Footwear; Shirts; Tops as clothing” in Class 25.	6398097
VANS PARK SERIES	“Clothing, namely, jackets, shirts, and t-shirts; Headwear; Caps being headwear” in Class 25.	6279803
LA MAISON VANS	“Shirts; Tops as clothing” in Class 25.	6240896
STURDY STRETCH BY VANS	“Footwear; Clothing, namely, shirts, t-shirts, tank tops, sweaters, jackets, pants, jeans, leggings, shorts, board shorts, skirts, dresses, swimwear, socks, belts, scarves, gloves and underwear; Headwear” in Class 25.	5071701

	<p>“Footwear; Clothing, namely, shirts, t-shirts, tank tops, sweaters, jackets, pants, jeans, leggings, shorts, board shorts, skirts, dresses, swimwear, socks, belts, scarves, gloves and underwear; Headwear” in Class 25.</p>	<p>5071643</p>
	<p>“Apparel, namely, tops” in Class 25.</p>	<p>6109518</p>
	<p>“Men’s, women’s and children’s clothing, namely, shirts, t-shirts” in Class 25.</p>	<p>2277833</p>
	<p>“Footwear” in Class 25.</p>	<p>3204987</p>
	<p>“Footwear; sneakers; high-top shoes; sandals; flip flops; skateboarding shoes; surf shoes; moccasins; Apparel, namely, T-shirts, shirts, dresses, tank tops, sweatshirts, pants, shorts, denim pants, denim shorts, sweaters, hooded sweaters, jackets, hats, caps, beanies, belts, boxers, socks, scarves, underwear, swimwear and board shorts” in Class 25.</p>	<p>4932799</p>
	<p>“Footwear” in Class 25.</p>	<p>6007688</p>

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 Vans Marks, including those incorporated into Applicant's Mark, are undeniably strong and inherently distinctive marks. As such consumers will immediately perceive Applicant's Mark as a source indicator when encountered in virtually any size or location when used in connection with the identified goods.

iii. Applicant's Mark is inherently distinctive

As is discussed in greater detail *supra*, the proper test for analyzing whether product packaging trade dress is inherently distinctive is the *Seabrook* test, which asks three questions, all of which must be answered in the negative to find inherent distinctiveness.

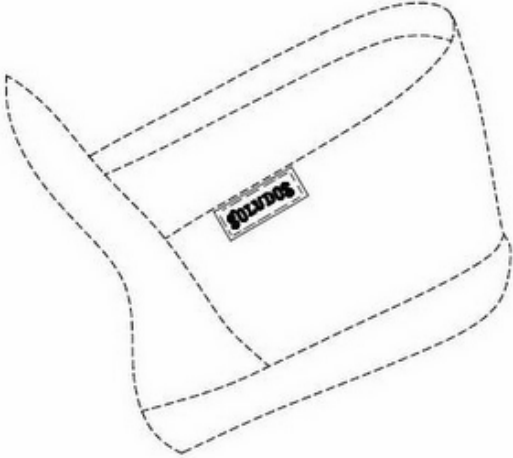
To the first question, whether the design or shape is a common, basic shape or design, the answer is clearly no. Applicant's Mark consists of a three-dimensional configuration of a label with the stylized mark "VANS" overlaid upon five shaded squares arranged in a checkerboard formation; on the opposing side of the label appear five shaded squares arranged in a checkerboard formation. Applicant is the owner of both the VANS and VANS Flying V Extended marks, which comprise the dominant visual and source-identifying element of Applicant's Mark. Neither these famous trademarks – which customers have been uniquely associating with Applicant for more than five decades – nor Applicant's proprietary double-sided label of checkerboard squares, are "common" and there is no evidence in the record to suggest otherwise.


To the second question, which asks if the proposed trade dress is not unique or unusual in a particular field, the answer is again no, and for precisely the same reasons. While it may very well be that others in the apparel, accessories, and bag space use labels to identify their products, Applicant seeks registration in this case for the configuration of a double-sided label *bearing its own famous trademarks*. Indeed, Applicant took care in filing the Application to explicitly disclaim the dotted outline of the label, clarifying that the depiction of the label itself was intended only to show the position of Applicant's Mark.


Likewise, the third prong of the *Seabrook* test, which asks whether the design is a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods which consumers would view as mere ornamentation, must also be answered in the negative. Applicant's Mark is not simply a common label, but a unique double-sided label depicting Applicant's famous trademarks, which it has used for decades and registered with the Office in numerous graphic variants and in connection with a wide variety of goods and services, including as listed above. No consumer would, upon encountering Applicant's Mark, dismiss it as mere ornamentation; the very purpose of labels is to identify the source of those goods, a reality which even the most disinterested or casual of consumers could not fail to appreciate.

Applicant acknowledges that one difficulty in analyzing cases such as these is the infrequency with which they come up for consideration, leaving relatively few guideposts, as it is only in recent years that brand owners have begun to fully appreciate the value in protecting and enforcing their rights in "non-traditional" source-identifiers, such as product packaging trade dress. Applicant is not, however, the first to seek registration for a mark consisting of a label bearing another of its trademarks for apparel. For the sake of brevity, however, Applicant will limit its discussion of past Office decisions to the most germane, obtained after a quick search using the Office's TESS database. Applicant therefore respectfully draws the Office's attention to the below list of highly analogous trademarks registered on the Office's Principal Register without a claim of acquired distinctiveness. Extracts from

the USPTO TSDR database for the above registrations, including assignment information, are attached as Exhibit C to make these registrations of record.

<p>Mark</p>	
<p>Mark Description</p>	<p>The mark consists of a stylized "SOLUDOS" on a label secured to the footwear near the topline of the quarter.</p>
<p>Reg. No.</p>	<p>4,104,509</p>
<p>Goods</p>	<p>"Footwear" in Class 25.</p>

<p>Mark</p>	
<p>Mark Description</p>	<p>The mark consists of the design of the name "KATE SPADE" printed on a small rectangular label positioned and sewn into the middle exterior portion of the bag. The dotted lines appearing on the drawing is not a part of the mark and only serves to show the position of the mark.</p>
<p>Reg. No.</p>	<p>2,073,406</p>

Goods	“Handbags, all-purpose carrying bags, tote bags, travelling bags, shoulder bags, clutch purses, all-purpose athletic bags, backpacks, wallets, coin purses and cosmetic bags (sold empty)” in Class 18.
Mark	
Mark Description	The mark consists of a rectangular patch featuring the stylized word “JANSPORT” placed on the front in the upper middle portion of a backpack. The dotted lines in the drawing serve to indicate the positioning of the mark in relation to the backpack and do not form part of the mark.
Reg. No.	5,432,012
Goods	“Backpacks, mesh backpacks, wheeled backpacks” in Class 18.

Applicant is mindful that the Office is not bound by prior decisions, and that the above registered marks may somewhat differ from Applicant’s Mark in that they are limited to a particular placement, but Applicant nonetheless respectfully submits that these registrations offer guidance helpful in examining Applicant’s Mark and reflect the reality that labels and tags bearing the rightsowner’s own marks are inherently distinctive source-identifiers. In fact, as Applicant’s Mark is not limited to a particular placement, but is a true branding label, its status as inherently distinctive product packaging is even clearer. Applicant respectfully requests, therefore, that its own Application be examined in keeping with this reality and submits that Applicant’s mark is inherently distinctive and registrable on the Office’s Principle Register without a showing of acquired distinctiveness.

III. Conclusion

As established by the foregoing arguments and evidence, Applicant respectfully submits that Applicant’s Mark is inherently distinctive product packaging trade dress and that Applicant is not required to demonstrate that the mark has acquired distinctiveness. Applicant 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.

Respectfully submitted,

/Seth A. Walters/

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