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Paper No. 19

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THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB  
U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Lucky Brand Dungarees, Inc.

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Serial No. 75/137,067

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Thomas J. Daly and Gary J. Nelson of Christie, Parker & Hale for applicant.

Nicholas K. D. Atree, Trademark Examining Attorney, Law Office 109 (Ronald R. Sussman, Managing Attorney).

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Before Seeherman, Walters and Holtzman, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

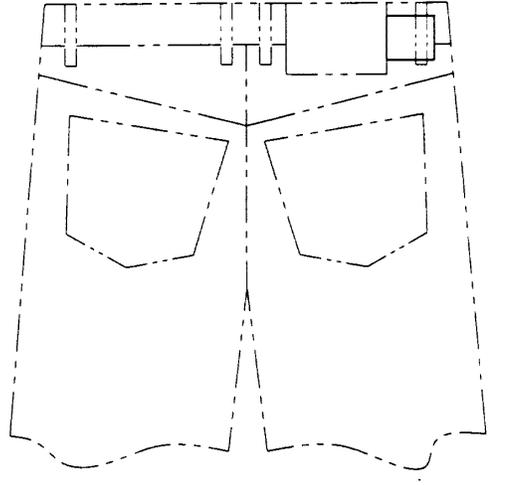
Lucky Brand Dungarees, Inc. has filed a trademark application to register the mark shown below for "clothing, namely, pants, jeans, shorts, bottoms, dresses, skirts, jumpers, jumpsuits, rompers and overalls."<sup>1</sup> The application includes the statement "[t]he matter shown by the broken

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<sup>1</sup> Serial No. 75/137,067, in International Class 25, filed July 22, 1996, based on use of the mark in commerce, alleging first use and first use in commerce as of February, 1993.

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lines is not a part of the mark and serves only to show the placement of the mark on the goods."



The specimen of record in this case is a photograph of applicant's jeans with the alleged mark thereon, as shown below:

The Trademark Examining Attorney refused registration under Sections 1, 2 and 45 of the Trademark Act on the ground that applicant's alleged mark is ornamental and does not function as a trademark to indicate the source of the identified goods. Applicant argued that the alleged mark is inherently distinctive, submitting the declaration of an officer of applicant in support of this position. Subsequently, applicant amended its application to seek registration under the provisions of Section 2(f) of the Trademark Act, asserting that the alleged mark has acquired distinctiveness as a trademark in connection with the identified goods.

Following the Examining Attorney's final refusal on the ground that the subject matter does not function as a mark because it is ornamental and applicant has not established that it has acquired distinctiveness, applicant appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

*Inherent Distinctiveness*

Because applicant amended its application to assert a claim of acquired distinctiveness under Section 2(f), applicant has essentially conceded that the alleged mark is not inherently distinctive. See, *In re Leatherman Tool Group Inc.*, 32 USPQ2d 1443 (TTAB 1994) (pertaining to issue

of descriptiveness). However, because both applicant and the Examining Attorney continued to address the issue of inherent distinctiveness after submission of the amendment under Section 2(f), both during examination and in their briefs, we will consider the issue of inherent distinctiveness as well as whether, if the alleged mark is not inherently distinctive, it is registrable on the basis of acquired distinctiveness.

Designs or symbols that are inherently distinctive are registrable without proof of secondary meaning, whereas those that do not possess inherent distinctiveness can achieve status as registrable trademarks only upon proof that they have become distinctive. *Wiley v. American Greetings Corp.*, 26 USPQ2d 101 (1<sup>st</sup> Cir. 1985). An inherently distinctive mark is one that is "by its very nature distinctive or unique enough to create a commercial impression as an indication of origin..." *In re Raytheon Co.*, 202 USPQ 317 (TTAB 1979). While a design may in fact be unique, *i.e.*, it may be the only such design being used by anyone, to be registrable as a trademark, it also must possess an "original, distinctive and peculiar appearance." *In re McIlhenny Co.*, 278 F.2d 953, 126 USPQ 138, 140 (CCPA 1960), quoting with approval from *Ex parte Haig & Haig, Ltd.*, 18 USPQ 229, 230 (Asst. Commr. 1958). The fact that

other similar products use or incorporate designs which differ in only insignificant respects leads to the conclusion that such designs lack inherent distinctiveness, and thus, to be entitled to registration, they must have acquired secondary meaning as indications of the sources of the goods. *In re E. S. Robbins Corp.*, 30 USPQ2d 1540 (TTAB 1992). “[A] design which is a mere refinement of a commonly adopted and well known form of ornamentation for a class of goods would presumably be viewed by the public as a dress or ornamentation for the goods.” *In re Soccer Sport Supply Company, Inc.*, 507 F.2d 1400, 184 USPQ 354, 347 (CCPA 1975), citing *In re General Tire & Rubber Co.*, 56 CCPA 867, 404 F.2d 1396, 160 USPQ 415 (CCPA 1969).

The Examining Attorney has submitted numerous third-party registrations indicating that it is not uncommon for manufacturers of clothing to register as marks labels and decorations for their clothing, particularly those appearing on the pockets, zipper covers and waistbands of jeans. However, all of these third-party designs are registered on the Supplemental Register or on the Principal Register with a showing of acquired distinctiveness, under Section 2(f) of the Trademark Act. There is certainly no reason why a particular label or design particularly located on particular goods cannot indicate origin.

However, the alleged mark in this application is a common rectangular label and there is no evidence in the record that it has ever been used, or promoted, except as a vehicle for other trademarks and descriptive, informational matter. Thus, consistent with the decision of our primary reviewing court's predecessor in the analogous case of *In re Kotzin*, 276 F.2d 411, 125 USPQ 347 (CCPA 1960),<sup>2</sup> we conclude that applicant's alleged mark is not inherently distinctive and it is not entitled to registration on the Principal Register without a showing of acquired distinctiveness. See also *In re Levi Strauss & Co.*, 165 USPQ 348 (TTAB 1970).

*Acquired Distinctiveness*

We now consider whether applicant has established, under Section 2(f) of the Trademark Act, that the alleged mark has acquired distinctiveness in connection with the identified clothing items.

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<sup>2</sup> As in this case, the *Kotzin* case involved an application to register a rectangular label attached to trousers at a particular location. Also as in this case, the label bore a trademark and informational material. The court stated, at 350, "we do not believe that the purchasing public would regard the described location of this label as an indication of the origin of the goods, at least until its collective mind has somehow been conditioned to think that it is. ... The public is accustomed, however, to seeing printed and woven fabric labels stitched to [various items of clothing], cushions, mattresses and furniture in a variety of locations and in the absence of convincing evidence we see no reason why purchasers would think that appellant's label location has any significance."

Initially, applicant's claim of acquired distinctiveness relied solely upon a declaration by applicant's secretary/treasurer, Barry Perlman, attesting to applicant's continuous and exclusive use of the alleged mark in connection with the identified goods for slightly more than five years. Mr. Perlman also stated in his declaration<sup>3</sup> that "[s]ince 1993, Applicant has sold over \$120 million worth of clothing items bearing the STYLE LABEL."<sup>4</sup> Applicant supplemented this submission with the almost identical declaration of its executive vice president; and with three declarations, which are identical to each other, of individuals in the clothing trade. The declarants state, *inter alia*, that they purchase clothing products from applicant and from other clothing manufacturers; and that they and their customers recognize the alleged mark as indicating applicant as the source of the goods to which the label is attached.

Consideration of applicant's evidence does not convince us that the subject matter of this application has acquired distinctiveness as a trademark indicating

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<sup>3</sup> In a previously submitted declaration, Mr. Perlman stated that applicant has shown its clothing at various industry trade shows and that "[b]uyers at these trade shows have recognized and commented upon the placement and design of the STYLE LABEL trademark."

<sup>4</sup> The declaration is dated December 10, 1997.

applicant as the source of the identified goods.<sup>5</sup> Merely using an alleged mark for a number of years does not necessarily lead to the conclusion that distinctiveness has been achieved. See *In re Packaging Specialists, Inc.*, 221 USPQ 917 (TTAB 1984). In this case, given the fact that the alleged mark is merely a common rectangular label in a particular location, we find that further evidence is necessary for us to conclude that this subject matter is perceived by consumers as a source indicator.

However, applicant provides very little additional evidence. In particular, applicant has provided no evidence that it has promoted its alleged mark as a mark. Mr. Perlman's first declaration includes reference to an enclosed photograph of applicant's jeans strung together on a clothesline, with the alleged mark visible, indicating that this photograph is from an advertisement. However, the label is only barely visible and there nothing in this photograph that would indicate that the label is other than just that - a label. There is also no information regarding the use of this advertisement or the exposure of consumers to applicant's advertising.

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<sup>5</sup> Based on the drawing of record, it is the shape and location of the label that comprise the alleged mark. An issue that is not before us and we do not address, but merely note, is that neither the drawing of the mark nor any language in the application shows the placement of the label on the identified clothing items other than jeans.

Additionally, the three declarations of wholesalers or retailers is the only evidence addressing the question of whether the ultimate purchaser of applicant's clothing products recognizes the alleged mark as anything other than a label carrying applicant's name and other information. Considering the alleged mark involved, the mere statements of wholesalers or retailers that their customers recognize the subject matter as a mark is insufficient. It is well settled that the assertions of wholesalers or retailers, who know full well from whom they are buying, that they themselves recognize a particular designation as a trademark, cannot serve to establish that members of the purchasing public, who come to the marketplace without such specialized knowledge, would in fact recognize the designation as an indication of origin. See *In re Semel*, 189 USPQ 285, 288 (TTAB 1975); *In re Meyer & Wenthe, Inc.*, 267 F.2d 945, 122 USPQ 372, 376 (CCPA 1959); and *In re Pennzoil Products Co.*, 20 USPQ2d 1753, 1758 (TTAB 1991).

In conclusion, we find that the Examining Attorney has established that the alleged mark is not inherently distinctive; and that applicant has not established the acquired distinctiveness thereof in relation to the identified goods.

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*Decision:* The refusal under Sections 1, 2 and 45 of the Act is affirmed.

E. J. Seeherman

C. E. Walters

T. E. Holtzman  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board