

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Trademarks  
P.O. Box 1451  
Arlington, VA 22313-1451

**Re: Application Serial No.:** 77/858,216  
**Mark:**  
**Filing Date:** October 27, 2009  
**Applicant:** The David Family Group LLC  
**Class:** 33  
**Office Action Date:** February 8, 2010  
**Examining Attorney:** Toby E. Bulloff  
**Law Office:** 117

**RESPONSE TO OFFICE ACTION NO. 1**

Applicant hereby responds to Office Action No. 1 dated February 8, 2010 as follows.

**I. APPLICANT'S LEATHER LABEL IS AN INHERENTLY DISTINCTIVE TOUCH MARK THAT IS ENTITLED TO REGISTRATION ON THE PRINCIPAL REGISTER.**

The Examiner has refused registration of Applicant's leather texture mark on the ground that it "consists of a nondistinctive configuration of packaging for the goods that is not registrable on the Principal Register without sufficient proof of acquired distinctiveness." Office Action at 2. Moreover the Examiner states that Applicant's mark "is not inherently distinctive because it is a feel or texture of a wine bottle label, positioned in the usual place for a wine bottle label (wrapping around the center of the bottle)." *Id.*

Contrary to the Examiner's position, Applicant's highly unique, source-indicating leather label mark is in fact inherently distinctive and thus registrable on the Principal Register without the need to show acquired distinctiveness. PTO precedent confirms this.

**A. THE LANHAM ACT IS CLEAR THAT NON-TRADITIONAL TRADEMARKS LIKE APPLICANT’S LEATHER TEXTURE TOUCH MARK ARE ENTITLED TO REGISTRATION.**

The Lanham Act broadly defines “trademark” to include “any word, name, symbol, or device, or any combination thereof” that identifies and distinguishes the goods of one person from those of another. 15 U.S.C. § 1127. As one Court prominently stated, a trademark may be “almost anything at all that is capable of carrying meaning.” *Qualitex Co. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995); *see also Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 764 n.1 (1992) (noting that “trade dress” includes “features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques.”). Applicant’s highly distinctive touch mark is merely one more in a long line on inherently distinctive, nontraditional trademarks that deserves to and should be registered. *See* 1-2 J. Gilson, *Trademark Protection and Practice* § 2.11[5] (2010) (“Tactile sensations, if sufficiently distinctive, may function as trademarks.”).

**B. THE PTO HAS PREVIOUSLY REGISTERED A TEXTURE MARK FOR IDENTICAL GOODS WITHOUT REQUIRING PROOF OF ACQUIRED DISTINCTIVENESS.**

On October 17, 2006, the PTO issued U.S. Registration No. 3,155,702 on the Principal Register for a “sensory, touch mark” for “wines” in Class 33 owned by American Wholesale Wine & Spirits, Inc. (the “Velvet Mark Registration”). In doing so, the PTO found that the applicant’s velvety texture mark was inherently distinctive and thus did not require evidence of acquired distinctiveness. The mark in U.S. Registration No. 3,155,702 is described as follows:

**The mark consists of a velvet textured covering on the surface of a bottle of wine.** The dotted line in the drawing is not a feature of the mark but is intended to show the location of the mark on a typical container for the goods; the dark/lower part of the container drawing shows the mark. The stippling in the drawing is not a feature of the mark, but a representation of how one type of velvet covering may appear in visual form. **The mark is a sensory, touch mark.**

The mark in the Velvet Mark Registration was initially refused registration on the ground that it was not inherently distinctive. However, in the applicant’s April 17, 2006 response, it argued that “[s]ince [the mark in the Velvet Mark Registration] is a TOUCH mark, it is the sensation of the touch that is to be distinctive, not a visual inspection nor a mental semantic

inquiry into the meaning and manufacture of the covering.” The applicant further stated that: “Paper wine labels long have served as visually distinctive trademarks. Applicant’s innovative velvety surface covering tightly affixed to a wine bottle serves as a touch distinctive trademark.” In addition, the applicant stated: “There is no function for applicant’s velvety feel of its wine bottles other than to distinguish them from all other wine bottles, which lack a similar feel, and to indicate the source of the wine, from applicant.”

As a result of the applicant’s April 17, 2006 response, the Examiner withdrew her refusal to register the mark on the ground that “it is not inherently distinctive product packaging,” and on July 5, 2006, the mark was approved for publication. U.S. Registration No. 3,155,702 issued on October 17, 2006.

C. **APPLICANT’S MARK IS ENTITLED TO REGISTRATION BECAUSE IT IS AN INHERENTLY DISTINCTIVE TOUCH MARK**

Like the mark in the Velvet Mark Registration, Applicant’s highly unique leather texture mark “serves as a touch distinctive trademark” and should be registered without the need to show acquired distinctiveness. When consumers encounter Applicant’s unique leather texture on a bottle of wine, it is the sensation they feel that causes them to recognize the source of that bottle of wine as coming from Applicant. Indeed, there is no function for Applicant’s leather texture on its wine bottles other than to distinguish them from all other wine bottles – which the Examiner concedes all lack a similar feel by virtue of his inability to find any confusingly similar marks – and to indicate their source.

The Examiner claims that Applicant’s highly unique leather texture mark constitutes product configuration trade dress, which, under *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205 (2000), cannot be inherently distinctive. However, as explained above, and as was the case with the Velvet Mark Registration, it is the tactile sensation consumers experience when they encounter Applicant’s mark that serves as a source indicator, not any particular configuration of the bottle. As was also the case with the Velvet Mark Registration, Applicant’s leather texture does not make Applicant’s wine bottles any more useful. *See Wal-Mart*, 529 U.S.

at 212-13 (reasoning that, unlike a trademark whose “predominant function” remains source identification, product design often serves other functions, including rendering the product more useful).

**II. CONCLUSION**

The PTO has already registered a texture mark for goods that are identical to Applicant’s goods. For this reason and the reasons described more fully above, Applicant respectfully requests that the Examiner’s refusal to register under Sections 1, 2 and 45 be withdrawn, and that the application be allowed for publication.

Respectfully submitted,

Dated: August 6, 2010

\_\_\_\_/s/ Michelle Turnbull /s/

Michelle Turnbull  
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