

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Bottega Veneta SA
Serial No. : 86/170,650 Examiner: Jordan A. Baker, Esq.
Filed : January 21, 2014 Law Office: 102

Mark : 

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

APPLICANT’S RESPONSE TO OFFICE ACTION DATED APRIL 7, 2014

The Examining Attorney has refused registration of Applicant’s mark  on the grounds that the mark is nondistinctive product design. Applicant respectfully disagrees and its substantive arguments are set forth below. The Examining Attorney has also requested an amendment of the description of the mark, which Applicant addresses herein. Accordingly, Applicant requests that the Application be passed to publication for the reasons that follow.

I. DESCRIPTION OF THE MARK

The mark consists of a configuration, namely a three-dimensional knot with caps at each end, affixed to a clasp on the goods.

II. ARGUMENT

As set forth fully below, Applicant’s mark  (hereinafter the “Knot Mark”) is inherently distinctive and serves as a source identifier when applied to the goods listed in the Application, namely handbags, shoulder bags, ladies' handbags, clutch bags and purses

(“Applicant’s Goods”). Applicant does not concede that the Knot Mark is not inherently distinctive. Nevertheless, Applicant further submits, in the alternative, that the Knot Mark should be registered on the Principal Register, on the additional basis that it has acquired distinctiveness pursuant to 15 U.S.C. §1052(f).

A. The Knot Mark Is Inherently Distinctive

The Examiner posits that the Knot Mark is nondistinctive product design and is ineligible for registration on the Principal Register absent a showing of secondary meaning. Applicant respectfully disagrees and asserts that the Knot Mark functions as a distinctive source indicator eligible for registration on the Principal Register because it is a unique design in the fashion industry and is capable of creating a commercial impression distinct from any accompanying matter. *See Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 196 U.S.P.Q. 289, 291 (CCPA 1977); *In re Right-On Co.*, 87 U.S.P.Q. 2d 1152 (TTAB 2008). The evidence submitted herewith clearly demonstrates that the Knot Mark is a unique and arbitrary design element as affixed to Applicant’s Goods, the use of which has resulted in consumers instantly associating the mark with Applicant’s Bottega Veneta brand and its products. As such, the Knot Mark serves a trademark purpose.

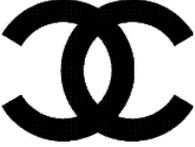
A symbol or design which has a decorative or ornamental characteristic may be registered if it also functions as a trademark. *See, e.g., In re Corning Glass Works*, 6 U.S.P.Q.2d 1032 (TTAB 1988); *App. Of Penthouse Intern. Ltd.*, 195 U.S.P.Q. 698 (CCPA 1977) (stylized key logo used on applicant’s jewelry found to be fanciful and arbitrary). There is no prescribed method or place to affix a mark and it is well settled that matter which serves as part of the aesthetic ornamentation may also serve as a source-indicating function. *See In re Watkins Glen International, Inc.*, 227 U.S.P.Q. 727, 728 (TTAB 1985); *In re Paramount Pictures Corp.*, 213 U.S.P.Q. 1111, 1114 (TTAB 1982). When determining whether a design functions as a source-

identifier, examining attorneys must consider the commercial impression of the proposed mark and the relevant practices in the trade. TMEP §1202.03.

Companies in the fashion industry have long used ornaments and other elements of handbag designs in a trademark manner to distinguish their goods from others. Therefore, consumers are conditioned to recognize such design elements as indicators of source. In fact, the U.S. Patent and Trademark Office has recognized the trademark significance of many such design elements by granting registrations in connection with use on handbags. For example,

Tory Burch has registered its “T” mark  (Reg. No. 3,029,795), 

Salvatore Ferragamo has registered its “bow” mark  (Reg. No. 1,684,442)

 and Chanel has registered its “CC” mark  (Reg. No.

1,734,822) . See list of trademark registrations and examples of use attached hereto as Exhibit 1. Therefore, Applicant’s Knot Mark is capable of functioning as a trademark and, as set forth herein, is recognized by customers and competitors alike as an indication of origin.

By virtue of Applicant’s use of the Knot Mark in the prominent position at the clasp of its handbags, there can be no doubt that the Knot Mark is recognized as an indicator of source. Consumers who see the Knot Mark in use on handbags instantly recognize it as a “Bottega

Veneta” bag and perceive the mark to be a source indicator, not merely a nondistinctive decoration.

B. The Knot Mark Has Acquired Distinctiveness Pursuant to 15 U.S.C. 1052(f)

Should the Examiner reject Applicant’s argument that the Knot Mark is inherently distinctive, Applicant asserts that registration of its Knot Mark is warranted on the additional basis that it has acquired secondary meaning pursuant to 15 U.S.C. 1052(f). Applicant’s evidence submitted herewith (*see* Declaration of Carlotta Corazza (hereinafter “Corazza Dec.”), attached hereto as Exhibit 2) demonstrates that Applicant’s Knot Mark has acquired distinctiveness as a result of: (1) Applicant’s substantially exclusive and continuous use of the Knot Mark on handbags since at least as early as 2001; (2) Applicant’s substantial revenue derived from the sale of handbags bearing the Knot Mark; (3) Applicant’s dedication of significant resources to advertise and promote handbags bearing the Knot Mark; (4) recognition of the fame and significance of the Knot Mark and its association with Applicant in the media and popular culture; and (5) the acknowledgment of fame and the significance of the Knot Mark and its association with Applicant by fashion and retail industry experts. Such evidence goes well beyond the requisite *prima facie* showing that the Knot Mark has become distinctive in the marketplace. *Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1576 (Fed. Cir. 1988). Therefore, the Application for the Knot Mark should be passed to registration.

i. Applicant Has Substantially Exclusive and Continuous Use of the Knot Mark on Handbags

Applicant was founded in Vicenza Italy in 1966 by Renzo Zengiaro and Michele Taddei and is one of the world’s premier luxury brands which emphasizes a philosophy of individuality and confidence. Corazza Dec. at ¶5. Bottega Veneta has been steeped in the traditions of Italy’s master leather craftsmen and has long been celebrated for its exceptional creativity and the

quality of its products. Corazza Dec. at ¶5. The qualities that define Bottega Veneta remain steadfast: outstanding craftsmanship, innovative design, contemporary functionality and the highest quality materials. Applicant has a deep commitment to its ateliers, where artisans of remarkable skill combine traditional mastery with breathtaking innovation. In 2006, in recognition of the importance of artisanal craftsmanship and the fragility of tradition, Bottega Veneta opened a school to train and support future generations of leather artisans. *Id.* at ¶6.

Applicant's merchandise attracts highly sophisticated and discerning consumers who value the extraordinary craftsmanship and excellent quality and design of Bottega Veneta products. Corazza Dec. at ¶7. Applicant distributes and sells Bottega Veneta-branded merchandise, including fine apparel, footwear, handbags, jewelry, sunglasses, fragrances and a variety of other products and accessories, in nearly 230 Bottega Veneta boutiques worldwide, including the United States, and in 110 high-end retail department stores such as Neiman Marcus, Bergdorf Goodman, Saks Fifth Avenue, Nordstrom and Bloomingdale's. A broad range of Bottega Veneta brand merchandise is also available for sale on Applicant's official website, www.bottegaveneta.com, and websites affiliated with high-end fashion retailers, such as www.neimanmarcus.com, www.saksfifthavenue.com and www.nordstrom.com, and other luxury fashion e-commerce sites such as www.net-a-porter.com. *Id.*

In or around 2001, Applicant created handbags featuring the Knot Mark, which served no functional purpose. Corazza Dec. at ¶8. Handbags featuring the Knot Mark are one of Applicant's most recognized and beloved handbags and interpretations of the Knot Mark have ranged from refined to the fanciful. *Id.* at ¶8; *see also* Exhibit A to Corazza Dec.

A favorite of celebrities and socialites, including Nicole Kidman, Emma Stone, Charlize Theron, Julianne Moore, Gwyneth Paltrow, Sandra Bullock, Leighton Meester, Jennifer Connelly, Sienna Miller, Anna Paquin, Salma Hayek, Kim Kardashian, Diane Kruger and

Michelle Williams, handbags featuring the Knot Mark have appeared in every Bottega Veneta collection since 2001. Corazza Dec. at ¶9; *see also* Exhibit B to Corazza Dec. Many styles of handbags featuring the Knot Mark are extremely limited in availability, with editions ranging from 100 to as little as 25, depending upon production and the availability of the rare materials used to make them. Corazza Dec. at ¶10. Examples of Applicant’s catalogs featuring the Knot Mark are attached as to Corazza Dec. as Exhibit C.

In 2008, Applicant launched a traveling exhibition called “The Knot: A Retrospective” featuring over 50 versions of handbags bearing the Knot Mark. At each location, a cocktail reception was held for invited customers and press while they viewed the exhibition. Corazza Dec. at ¶11; Corazza Dec. at Exhibit D.

As a result of such longstanding, substantially exclusive, and continuous use of the Knot Mark on Applicant’s Goods, consumers have come to instantly recognize the Knot Mark, as an indicator of source that is immediately identifiable with Bottega Veneta. TMEP §1212.06(a). Applicant’s use of the Knot Mark since at least as early as 2001 clearly constitutes “longstanding and continuous use” within the meaning of TMEP §1212.06(a). *See In re Uncle Sam Chem. Co.*, 229 U.S.P.Q. 233, 235 (TTAB 1986) (finding acquired distinctiveness where applicant demonstrated continuous use of SPRAYZON mark for eighteen years).

ii. Applicant’s Substantial Sales and Advertising Expenditures for Products Bearing the Knot Mark

Pursuant to TMEP 1212.06 (b), large-scale expenditures in promoting and advertising goods and services under a particular mark are significant to indicate the extent to which a mark has been used. Since its creation, Applicant has spent millions of dollars advertising handbags bearing the Knot Mark worldwide. Corazza Dec. at ¶12. In fact, since 2003, Applicant has spent in excess of \$5,000,000 in advertising handbags bearing the Knot Mark in the United States

alone. *Id.* Over the course of the last decade, advertisements featuring the Knot Mark have been featured in esteemed publications which reach a countless number of U.S. consumers such as *Vogue, Town & Country, Elle, Harper's Bazaar, W, Vanity Fair, InStyle, Interview, People, The Wall Street Journal* and *The New York Times*. Corazza Dec. at ¶13; *see also* Exhibit E to Corazza Dec. These advertisements draw upon and emphasize the connection between the Knot Mark and Bottega Veneta.

Applicant's advertising expenditures have clearly been successful, as sales of Applicant's Goods bearing the Knot Mark in the United States have totaled over \$18,000,000 over the course of the last decade. Corazza Dec. at ¶14.

iii. Widespread Recognition of the Fame and Significance of the Knot Mark and its Association with Bottega Veneta

Handbags bearing the Knot Mark were an instant classic and have been carried by celebrities and style icons such as Nicole Kidman, Charlize Theron, Julianne Moore, Gwyneth Paltrow, Sandra Bullock, Leighton Meester, Jennifer Connelly, Sienna Miller, Anna Paquin, Salma Hayek, Kim Kardashian, Diane Kruger and Michelle Williams. *See* Exhibit B to Corazza Dec.

The Knot Mark is instantly recognized and associated solely with the Bottega Veneta brand, a fact acknowledged by journalists for the leading fashion publications throughout the United States, including *Vogue, Elle, Harper's Bazaar, Women's Wear Daily* and *In Style*. Corazza Dec. at ¶15. Publications nationwide have independently referenced the Knot Mark in terms that clearly establish it as a source indicator of Bottega Veneta. For example, handbags bearing the Knot Mark have been described as "iconic", "instantly recognizable" and a "timeless creation." *Id.*; *see also* Corazza Dec. at Exhibit F. In addition, handbags featuring the Knot Mark are routinely featured in high-fashion magazine editorials. *See* Corazza Dec. at Exhibit G.

Such widespread unsolicited third-party recognition and media coverage of Applicant's Knot Mark is strong evidence that the mark has acquired distinctiveness. *See Harlequin Enterprises, Ltd. v. Gulf & Western Corp.*, 210 U.S.P.Q.2d 1 (2d Cir. 1981) (unsolicited media coverage of plaintiff's products supports finding of acquired distinctiveness); *American Ass'n for Advancement of Science v. Hearst Corp.*, 206 U.S.P.Q. 605 (D.D.C. 1980) (critical acclaim is valuable evidence of acquired distinctiveness).

iv. The Knot Mark is Recognized as a Source Indicator in the Fashion and Retail Industries

The fame and notoriety of the Knot Mark has long been recognized by experts in the retail and fashion industries, evidencing the mark's distinctiveness. For example, Applicant submits the declarations of renowned retail experts Judi Conn, a Senior Buyer & Vice President of Gorusch Ltd., a luxury retailer based in Colorado, Elyse Walker, owner of the high-end boutique Elyse Walker in Pacific Palisades, CA and David Rubenstein, General Manager at Jeffrey New York, an independent luxury retailer with locations in New York and Atlanta. (Exhibit H to Corazza Dec.), as further evidence that the Knot Mark has become a source indicator and has undoubtedly acquired distinctiveness in the marketplace. *See* TMEP 1212.06(c), *In re Bose Corp.*, 216 U.S.P.Q. 1001, 1005 (TTAB 1983) *aff'd* 772 F.2d 866 (Fed. Cir. 1985) (retailer's statement that he has been in contact with many purchasers of loudspeaker systems who would recognize the mark is competent evidence of secondary meaning).

IV. CONCLUSION

For all the foregoing reasons, Applicant respectfully requests that the Examining Attorney approve the Application for publication. If any unresolved issues still remain, the Examining Attorney is respectfully requested to telephone the undersigned in order to resolve said issues.

Respectfully submitted,

Dated: September 30, 2014

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