

To: MARC JACOBS TRADEMARKS L.L.C. (docketing@finnegan.com)
Subject: TRADEMARK APPLICATION NO. 79057254 - MARC JACOBS - 09620.0034
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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 79/057254

MARK: MARC JACOBS

79057254

CORRESPONDENT ADDRESS:

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RESPOND TO THIS ACTION:

<http://www.uspto.gov/teas/eTEASpageD.htm>

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: MARC JACOBS TRADEMARKS
L.L.C.

CORRESPONDENT'S REFERENCE/DOCKET NO :

09620.0034

CORRESPONDENT E-MAIL ADDRESS:

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OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE: 4/23/2009

This Office action is in response to applicant's communication filed on April 20, 2009. The applicant has provided entity information, an amended identification of the goods, a consent statement and a claim of ownership that are acceptable and have been made of record.

Applicant will note the following issues:

ORNAMENTATION REFUSAL

Registration is refused because the applied-for mark is merely a decorative or ornamental feature of the goods; it does not function as a trademark to identify and distinguish applicant's goods from those of others and to indicate the source of applicant's goods. Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051-1052, 1127; *see* TMEP §§904.07(b), 1202.03 *et seq.*; *see, e.g., In re Pro-Line Corp.*, 28 USPQ2d 1141 (TTAB 1993) (holding the wording BLACKER THE COLLEGE SWEETER THE KNOWLEDGE to be a primarily ornamental slogan that is not likely to be perceived as source indicator for t-shirts); *In re Villeroy & Boch S.A.R.L.*, 5 USPQ2d 1451 (TTAB 1987) (holding floral pattern design of morning glories and leaves for tableware nondistinctive and merely a decorative pattern with no trademark significance); *cf. In re*

The applied-for mark, as shown on the evidence of record, is merely ornamental because the mark is a repetitive design that covers the surface of applicant's goods. Please see attached web pages showing the mark applied to the surface of the identified goods. The ornamental or decorative nature of a given pattern or design is enhanced where the design is repeated over the entire surface of the product or packaging. *In re Soccer Sport Supply Co.*, 184 USPQ 345, 347 (C.C.P.A. 1975). "The deadening repetition of even a distinctive design may create a 'wallpaper' effect on the buyer who sees the pattern as mere 'background ornamentation.'" *Major Pool Equip. Corp. v. Ideal Pool Corp.*, 203 USPQ 577, 582 (N.D. Ga. 1979) (quoting J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §7:11, at 172).

In this case, applicant's mark is intended to cover the entire surface of its product or packaging to create such a "wallpaper" effect, and would be perceived as ornamental and not source-identifying for applicant's goods. See TMEP §§1202.03 *et seq.*

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

Option to Claim Acquired Distinctiveness

If applicant believes that its mark has acquired distinctiveness in the United States, that is, that it has become a distinctive source indicator for the goods and/or services, applicant may seek registration on the Principal Register under Trademark Act Section 2(f). See 15 U.S.C. §1052(f); TMEP §§1010, 1212.08. The Office will decide each case on its own merits.

In determining whether the proposed mark has acquired distinctiveness, the following factors are generally considered: (1) length and exclusivity of use of the mark in the United States by applicant; (2) the type, expense and amount of advertising of the mark in the United States; and (3) applicant's efforts in the United States to associate the mark with the source of the goods and/or services, such as unsolicited media coverage and consumer studies. See *In re Steelbuilding.com*, 415 F.3d 1293, 1300, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005). A showing of acquired distinctiveness need not consider all of these factors, and no single factor is determinative. *In re Steelbuilding.com*, 415 F.3d at 1300, 75 USPQ2d at 1424; see TMEP §§1212 *et seq.*

Evidence of acquired distinctiveness may include specific dollar sales under the mark, advertising figures, samples of advertising, and consumer or dealer statements of recognition of the mark as a source identifier, affidavits, and any other evidence that establishes the distinctiveness of the mark as an indicator of source. See 37 C.F.R. §2.41(a); *In re Ideal Indus., Inc.*, 508 F.2d 1336, 184 USPQ 487 (C.C.P.A. 1975); *In re Instant Transactions Corp.*, 201 USPQ 957 (TTAB 1979); TMEP §§1212.06 *et seq.*

In establishing acquired distinctiveness, applicant may not rely on use other than use in commerce that may be regulated by the United States Congress. Use solely in a foreign country or between two foreign countries is not evidence of acquired distinctiveness in the United States. *In re Rogers*, 53 USPQ2d 1741 (TTAB 1999); TMEP §§1010, 1212.08.

PLEASE NOTE THAT applicant cannot overcome the refusal by amending the application to the Supplemental Register, because a mark in an application under §66(a) of the Trademark Act is **not** eligible for registration on the Supplemental Register. Trademark Act Section 68(a)(4), 15 U.S.C. §1141h(a)(4); 37 C.F.R. §§2.47(c) and 2.75(c); TMEP §§801.02(b), 815, 816.01 and 1904.02(c).

REQUIREMENT FOR INFORMATION

Applicant must explain whether the mark is intended to be used on the surface of the identified goods and/or packaging for the identified goods. See 37 C.F.R. §2.61(b); TMEP §814. Failure to respond to this request for information can be grounds for refusing registration. See *In re DTI P'ship LLP*, 67 USPQ2d 1699, 1701 (TTAB 2003); TMEP §814.

MARK DESCRIPTION

With its response, applicant has provided a mark description that reads "The mark consists of a repeating pattern featuring the mark MARC JACOBS in stylized lettering." The description of the mark uses vague language that does not accurately describe the applied-for mark. Applications for marks not in standard characters must include an accurate and concise description that identifies all literal elements as well as any design elements in the mark. See 37 C.F.R. §2.37; TMEP §§808 *et seq.*

Therefore, applicant must provide a more detailed description of the applied-for mark. The following is suggested:

The mark consists of a repeating pattern of the wording MARC JACOBS in stylized lettering over the surface of the goods.

CLOSING

If applicant has questions about its application or needs assistance in responding to this Office action, please telephone the assigned trademark examining attorney.

/Tracy L. Fletcher/
Examining Attorney
Law Office 115
U.S. Patent and Trademark Office
Telephone: (571) 272-9471
Facsimile: (571) 273-9471

RESPOND TO THIS ACTION: Applicant should file a response to this Office action online using the form at <http://www.uspto.gov/teas/eTEASpageD.htm>, waiting 48-72 hours if applicant received notification of the Office action via e-mail. For *technical* assistance with the form, please e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned examining attorney. **Do not respond to this Office action by e-mail; the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

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