

LEGAL AND PRIVACY

## Rejection of Valentino trademark application: How the US trademark office evaluates trademarks

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Italian luxury house Valentino markets, under the collection name ROCKSTUD SPIKE, a highly touted line of accessories featuring signature metal spikes as a major decorative motif.

Items in the collection are sold for as much as \$2,000 to \$3,000 at trendy department stores.

So, naturally, Valentino sought to register the line mark ROCKSTUD SPIKE for various leather accessories.

The U.S. Trademark Office had other ideas. Under Trademark Office practice, the term SPIKE was descriptive of the goods, and had to be "disclaimed," or no registration.

Valentino refused, and appealed to the Trademark Trial and Appeal Board (TTAB).

In April the TTAB issued a decision maintaining the denial of the registration. But it did allow Valentino 30 days to file a disclaimer.

The *Valentino* case provides valuable insights for luxury and fashion goods companies to understand how the Trademark Office evaluates marks for being "descriptive," when it requires disclaimers, and how companies should respond when the Trademark Office requires such a disclaimer.

Appreciation of these principles can help avoid wasteful expenditure of resources on legal positions that may not matter to the company.

Valentino's application

Valentino applied to register ROCKSTUD SPIKE for two types of goods: leather accessories such as handbags and wallets and clothing items including dresses and blouses.

The examining attorney allowed the application, but subject to Valentino "disclaiming" the term SPIKE. Otherwise, the application would be refused. The TTAB affirmed that position.

## Descriptive terms

A trademark, by definition, is a term or symbol that identifies goods as those of one particular source. To be protectable, a trademark law has to be "distinctive" capable of distinguishing goods as those of one source.

Some terms are not "distinctive" and can never become trademarks.

"Handbag" is a generic term that identifies a particular item, not a particular handbag manufacturer. So no handbag company may own trademark rights in that term for handbags and every handbag manufacturer is entitled to use that term.

Whether a term is "distinctive" is judged in relation to the goods. The same mark can be distinctive for some goods and not distinctive for others.

APPLE is generic for apples, but not generic for computers. So Apple Computer owns the mark APPLE with respect to those products.

"Descriptive" terms are those that immediately convey information concerning a quality or characteristic of the product. This is close to, but not quite the same as, a generic term.

Descriptive terms are not protectable, initially, as trademarks. But if association with one source is built up over time through marketing and sales then the company may claim trademark rights.

Descriptive terms are generally not good candidates for trademarks. They are weak, not initially protectable, and may take a long time to build up enough recognition and association with one brand before there is any level of trademark protection. And even if they do reach the required level of brand association, other companies can continue to use them in their descriptive sense to describe their own goods.

## Disclaimers

What if a trademark has multiple parts, only some of which are generic or descriptive?

A well-known example is STARBUCKS COFFEE. The first term is clearly distinctive of the product (coffee or caf services). But the second term is generic no caf could ever own or register COFFEE as a trademark.

The Trademark Act provides that the Trademark Office may require what is known as a "disclaimer." This means that the trademark owner states, as part of the registration, that it is claiming no rights in the generic or descriptive term, apart from the whole mark.

This is to ensure that competitors are free to use that non-protectable portion. If Joe adopts the caf name JOE'S COFFEE, then Starbucks has no basis to complain. The disclaimer rule ensures that the trademark owner has made this limitation clear in its registration.

So, Starbucks which was required to disclaim COFFEE had to state that it was making no claim to that term, apart from the whole mark. Starbucks has rights in the mark STARBUCKS COFFEE, but not COFFEE by itself.

## The *Valentino* ruling

The issue before the TTAB was whether SPIKE is descriptive for the types of goods in Valentino's application. If it was, then the disclaimer requirement was proper.

The TTAB noted that a "spike" is generally defined as a long, pointed metal object, and further that Valentino's handbags do indeed appear to be decorated with spikes.

Further, the term "spike" had been used by various reviewers to describe Valentino's own products. One reviewer noted that a Valentino bag was "punctuated with the Italian label's signature spikes." Another noted that Valentino jackets and coats "were scattered with metal spikes."

And what is more said the TTAB, the term "spike" was used by other luxury retailers and luxury houses such as Neiman Marcus, Gucci and Prada to describe different luxury items that were decorated with spikes. And, articles in *Vogue* and other fashion periodicals discussed the use of spikes as decorative features for products of different fashion houses apart, from Valentino.

The TTAB also noted that, to be considered descriptive, all that is required is that the term "describe a single, significant ingredient, quality, characteristic, function, feature, purpose or use of the goods." And SPIKE clearly qualified that Valentino's handbags are decorated with spikes was one significant characteristic of its products, even if there are other characteristics it does not describe.

ROCKSTUD SPIKE Not a unitary mark

Once SPIKE was found to be descriptive, then a disclaimer would generally be required for that term.

Valentino argued, however, that its mark would be viewed as a single merged mark.

One exception to the disclaimer requirement is where the mark as a whole in this case, ROCKSTUD SPIKE is a "unitary" mark, meaning that the elements of the mark are so integrated or merged together that they cannot be regarded as separable.

In other words, the entirety of the mark creates a "singular impression" on consumers. Where that is shown, then the trademark owner can escape a disclaimer requirement.

But Valentino provided no evidence that consumers viewed its mark that way. And, given that SPIKE has often been used alone to describe handbags and apparel of other fashion houses, it was likely that consumers would perceive the SPIKE term in ROCKSTUD SPIKE as having its own significance, describing the item as one with spikes.

Bottom line: the TTAB affirmed the requirement that Valentino disclaim the term SPIKE. Fortunately for Valentino, it was given 30 days to file a disclaimer, in which case its application would be allowed.

So, how should Valentino have proceeded?

Valentino spent significant, precious resources fighting what ended up as a losing battle. Could it have evaluated its position differently earlier on? What can other luxury goods and fashion companies learn from this case?

A disclaimer requirement is not the same thing as a full rejection the Trademark Office is in fact *allowing* the registration, but subject to a condition: file a disclaimer on part of the applied-for mark. Even with a disclaimer, the registration will often still be very valuable.

The questions companies in Valentino's position should ask are (1) how important is the disclaimed term to the company, and (2) how likely will the company be able to assert trademark rights in that term alone.

Sometimes the answer is obvious. Starbucks would never be able to claim rights in the generic term COFFEE, so in reality, disclaiming that term concedes nothing. Agreeing to the disclaimer allowed Starbucks to obtain a registration in STARBUCKS COFFEE, which itself has great value to the company.

In Valentino's case the question was, could or would Valentino ever claim that SPIKE *alone* is associated with its accessories line, or that it has trademark rights in that term *alone*?

As the TTAB noted, several other luxury goods companies use that same term to describe items with spikes. It seems farfetched that Valentino could ever claim trademark rights in that term, standing alone.

So, it appears that the better course would have been for Valentino to simply accept the disclaimer and obtain its registration a course it may yet follow now.

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