

Applicant hereby responds to the Office Action dated November 22, 2013 as follows.

Applicant respectfully disagrees with the Examining Attorney that the trademark YOGA JEANS is either generic, or merely descriptive, as stated by the Examining Attorney in her Office action refusal of April 13, 2013; or highly descriptive as stated by the Examining Attorney in her Office action of November 22, 2013. Applicant also respectfully submits that the Examining Attorney is incorrect in refusing registration of Applicant's application for the mark YOGA JEANS over Applicant's Section 2(f) Affidavit and evidence that the YOGA JEANS has acquired secondary meaning and is thus eligible for registration.

Applicant submits that the pending refusal based on the mark being merely descriptive, generic, or highly descriptive is improper, and that the Examining Attorney should have given further consideration to Applicant's Section 2(f) evidence supporting that the subject Mark has acquired secondary meaning

The determination of whether a mark is generic follows a two-part inquiry (1) what is that genus of goods or services at issue; and (2) is the term sought to be registered understood by the relevant public primarily to refer to that genus of goods or services?

Here, it is important to properly identify the genus of goods that applies to Applicant's Mark YOGA JEANS. Applicant's mark YOGA JEANS identifies "fashion clothing for women and men" as indicated in its application, which includes jeans along with a variety of other types of garments. Such other garments are not "jeans," and evidence as to the meaning of the word "jeans" has already been made of record by the Examining Attorney.

The Examining Attorney has worked hard to find instances of third party uses of "yoga jean" to support her position that it is a descriptive or generic term, and has put in evidence examples culled from various blogs, newspaper and magazine articles and other parties' websites. However, Applicant submits that its mark is YOGA JEANS and that, therefore, pointing to other party's uses of terms such as "yoga pants," "jean yoga pants" and "jean-style yoga pants" is of little or no probative value in a determination of the registrability of YOGA JEANS for Applicant's line of fashion clothing. Applicant does not and has never disputed that there exists exercise wear, including pants, shorts and leggings designed

specifically for the practice of yoga, but Applicant's goods are not included in this genus of goods. Attached and herein made part of the record in support of Applicant's position is the first page of a Google search for the terms "yoga pants." As can be seen, there is not a single reference to Applicant's YOGA JEANS brand of fashion clothing. Expanding the Google search further, to the even more general term "yoga clothes" similarly results in not one single reference to Applicant's goods, nor to the the term "yoga jeans" (see attached).

Third-party registrations for marks that include the word JEANS in connection with various types of clothing, submitted in evidence on October 15, 2013, in response to the Office Action of April 13, 2013, notably SIDEWALK JEANS, LEG JEANS, PAJAMA JEANS, RUSTIC JEANS, L.A. JEANS, USED JEANS and SKINNY JEANS, despite being apparently ignored by the Examining Attorney, demonstrate that the USPTO does not necessarily treat such marks as being generic, merely descriptive or highly descriptive of clothing, including jeans.

Further, the Examining Attorney has included in evidence several instances where what she points to as a third party use of "yoga jeans" as an alleged generic, merely descriptive, or highly descriptive term, in fact refers to Applicant's YOGA JEANS trademarked goods. In so doing, the Examining Attorney *supports* Applicant's position rather than negates it. The evidence submitted by the Examining Attorney of an advertisement for SKINNY SAILOR YOGA JEANS in fact represents one style of Applicant's fashion garments, as can be seen by the attached evidence from the website NOTJUSTPRETTY.COM (note the identical photo of a model wearing brown colored high-heeled boots); and the article submitted in evidence by the Examining Attorney from POSTCITY.COM clearly refers to, and praises, Applicant's goods. It is stated in that article: "*Don't be alarmed, these aren't jeggings. We can assure you that these are proper, five-pocket jeans, made from high-quality denim right here in Canada. The product of Montreal-based Second Denim Co....*"

Applicant submits that it should not be held to the rigorous standard of policing all bloggers, newspaper reviewers, fashion commentators, retailers of its garments and others un-schooled in the fine points of ideal trademark presentation, to ensure its mark YOGA JEANS is connoted in bold face, and/or all caps font. A mark, for which an application which has been filed with a standard character claim, as is the mark at issue, entitles the owner to use of the mark in upper, lower, or mixed upper and lower case, and various fonts, without limitation.

While the Examining Attorney has managed to find a few isolated instances where the term “yoga jean” or “yoga jeans” has been used by other parties to reference a garment that is not that of Applicant, these instances are few and far between, and/or no longer exist. The Examining Attorney’s example of use of “Yoga Jeans” by Liz Claiborne is no longer current (see attached screen capture of a search for “yoga Jeans” on the Liz Claiborne website, returning a nil result), nor is the Examining Attorney’s example of use by retailer J.C. Penney of “yoga jean” (see attached screen capture indicating the product is no longer offered). Finally, the Nordstrom ad for Applicant’s clothing clearly refers to “Yoga Jeans by Second Denim” in red letters, above the term the Examining Attorney references as showing generic use, being “Second Yoga Jeans”. Applicant submits that “Yoga Jeans by Second Denim” not only properly connotes the mark YOGA JEANS, but also identifies Applicant as the source of the goods.

Turning them to the question of whether YOGA JEANS has acquired distinctiveness, under Section 2(f) for Applicant’s goods during the relevant time period, the record is replete with newspaper and magazine articles wherein the term YOGA JEANS is used as a mark, to refer to Applicant and its brand of clothing, including fashion jeans. The term frequently appears in these articles with an initial capital letter, which is consistent with trademark use.

Applicant began using YOGA JEANS in the United States in connection with its clothing, in 2007, and Applicant has marketed its clothing with significant commercial success since that time, as indicated by its approximately \$55 million in gross sales between 2007 and 2013, and (see Wazana Affidavit filed in evidence on October 15, 2013) and its 255 US retailers by October of 2013, with almost half a million dollars expended in advertising and promoting the YOGA JEANS brand. The record shows that the term is consistently used by Applicant in the manner of a mark, and that it has been extensively promoted by Applicant as such. The one remaining example Examining Attorney points to is the online retailer “Vistara.” While it is conceded that Vistara does, on its website, make use of the term “Yoga Jean,” in the *singular* form, the following is the product description: “*This multitalented peace [sic] combines the fit and comfort of your favorite yoga pant with groovy jean styling.*” Applicant also wishes the Examining Attorney to take note that Vistara appears to be retailer devoted to yoga wear and dancewear, and that its page offering “Yoga Jean also offers “Wave Yoga Pant” and “Lace Yoga Pant” as well as other leggings and exercise-type wear (see attached screen capture).

The record ably demonstrates that Applicant's YOGA JEANS clothing has been the subject of widespread, unsolicited publicity in local and national, as well as international, media resulting in significant exposure of the term to the public as a trademark and source identifier, all of which should be given due and proper weight by the Examining Attorney.

In further support of its claim of Section 2(f) acquired distinctiveness, Applicant herein submits an additional Affidavit of Eric Wazana, attesting to the continued growth of sales and retailers in the United States of its YOGA JEANS brand clothing, representing a 46% increase since 2013, and its investment in promoting the YOGA JEANS brand of clothing at industry trade shows around the country. Also attached and submitted in evidence in support of Applicant's 2(f) claim is a map, taken from Applicant's website, of the United States showing cross country retail outlets for YOGA JEANS, as well as a "store locator" map of the US Northeast area alone.

Also submitted herein by way of additional evidence in support of Applicant's 2(f) claim, is a screen capture from the on-line retailer sale-fire.com, under a search conducted for YOGA JEANS. As can be seen, the entire first page of 32 separate entries, consistently refer to Applicant's YOGA JEANS, without a single exception.

Finally, Applicant submits a second supplemental Affidavit, attaching letters from two of its US retailers, confirming that YOGA JEANS is a brand name for clothing that customers ask for my name. The fact that the second attached letter, Exhibit 2, does not properly present the trademark as YOGA JEANS should not, Applicant submits, be deemed an example of generic use but of the typical unschooled trademark reference common to retailers, bloggers and those whose business is not the safeguarding of exact and proper trademark usage. The intent and spirit of both retailers' letters is clear: that Applicant has developed and promoted a successful brand of clothing, with a significant following in the United States, so as to have acquired the requisite secondary meaning, or acquired distinctiveness under Section 2(f).

For all of the foregoing reasons, Applicant respectfully requests that its YOGA JEANS trademark application be approved and submitted for publication.