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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Spina Technology Corporation

Serial No. 85456039

Mark B. Harrison of Venable LLP for Spina Technology Corporation.

Dominic R. Fathy, Trademark Examining Attorney, Law Office 104
(Chris Doninger, Managing Attorney).

Before Quinn, Gorowitz and Hightower,
Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Spina Technology Corporation ("applicant") filed, on October 25, 2011, an intent-to-use application, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), to register the designation BLAZING SILKS (in standard characters) for "full line of clothing; t-shirts, sweatshirts, hooded pullovers, tank tops, footwear, socks, jackets, button down shirts, polo shirts, dresses, skirts, jeans, shorts, sweatpants, neckties, aprons, belts, gloves, jerseys, baseball caps and hats, and headwear" in International Class 25.

The trademark examining attorney refused registration under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a), on the ground that applicant's designation consists of or includes deceptive matter in relation to applicant's goods.

When the refusal was made final, applicant filed a request for reconsideration. When the request was denied, applicant appealed. Both applicant and the examining attorney filed briefs.

We affirm.

The examining attorney maintains that use of the term "SILKS" in applicant's proposed mark for clothing is deceptive because, as "unequivocally" stated by applicant, the clothing is not made of silk.¹ More specifically, the examining attorney contends that the applied-for mark, which includes the term "SILK," misdescribes the composition of the clothing; that purchasers are likely to believe that the misdescription actually describes the clothing; and that the misdescription is likely to affect a significant portion of the relevant consumers' decision to purchase the clothing. In support of the refusal, the examining attorney relied upon dictionary

¹ The Board did not see any explicit statement by applicant that its goods are not made of silk. Applicant did state, however, that "the public, in viewing the applicant's mark, will not be deceived into believing that the goods contain silk." (Response, Aug. 17, 2012). This statement, coupled with applicant's failure to contest the examining attorney's view, are sufficient for us to conclude that applicant's goods, in fact, are not made of silk.

definitions of "silk" and "silks," an excerpt from Wikipedia, and excerpts retrieved from third-party websites.

Applicant argues "that the words SILK and SILKS do not have the same meaning or commercial impression, and that the mark BLAZING SILKS is therefore not deceptive." (Brief, p. 1). In this connection, applicant asserts that the term "silks" has come to identify the brightly colored garments of a horse jockey or harness driver. Although applicant concedes that horse racing jerseys did at one time contain silk, the term "silks" has taken on a meaning of its own separate and apart from an indication of the fabric silk. Applicant sums up its position as follows:

The applicant is using the term SILKS in its mark BLAZING SILKS to evoke the image of a horse race (and a play on the famous movie BLAZING SADDLES), and it is in that way in which the applicant's mark would be perceived. The public, in viewing applicant's mark, will not be deceived into believing the goods contain silk; rather, they will understand the meaning of SILKS, and will associate applicant's mark with jockeys and horse racing, and not with the fabric "silk."
(Brief, p. 3).

In support of its argument, applicant submitted dictionary definitions of "silks."

The Court of Appeals for the Federal Circuit has articulated the following test for whether a mark consists of or comprises deceptive matter:

(1) Is the term misdescriptive of the character, quality, function, composition or use of the goods?

(2) If so, are prospective purchasers likely to believe that the misdescription actually describes the goods?

(3) If so, is the misdescription likely to affect a significant portion of the relevant consumers' decision to purchase?

In re Spirits Int'l, N.V., 563 F.3d 1347, 90 USPQ2d 1489, 1493 (Fed. Cir. 2009); *In re Budge Mfg. Co.*, 857 F.2d 773, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988), *aff'g* 8 USPQ2d 1790 (TTAB 1987).

Section 2(a) of the Trademark Act is an absolute bar to the registration of deceptive matter on either the Principal Register or the Supplemental Register. A deceptive mark may be comprised of a deceptive term embedded in a composite mark that includes additional non-deceptive wording, or a term that alludes to a deceptive quality, characteristic, function, composition, or use. See *In re White Jasmine LLC*, 106 USPQ2d 1385 (TTAB 2013); *Am. Speech-Language-Hearing Ass'n v. Nat'l Hearing Aid Society*, 224 USPQ 798 (TTAB 1984). Of particular significance in the present appeal, deceptive marks may include marks that falsely describe the content of a product. *In re White Jasmine LLC*, 106 USPQ2d at 1394 (holding the term WHITE in the proposed mark WHITE JASMINE deceptive for tea that did not include white tea, where the evidence established that consumers perceive that white tea has desirable health benefits); *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047 (TTAB 2002) (holding

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SUPER SILK deceptive for clothing, namely dress shirts and sport shirts made of silk-like fabric); *In re Organik Technologies, Inc.*, 41 USPQ2d 1690 (TTAB 1997) (holding ORGANIK deceptive for clothing and textiles made from cotton that is neither from an organically grown plant nor free of chemical processing or treatment); *In re Shapely, Inc.*, 231 USPQ 72 (TTAB 1986) (holding SILKEASE deceptive as applied to clothing not made of silk); *In re Intex Plastics Corp.*, 215 USPQ 1045 (TTAB 1982) (holding TEXHYDE deceptive for synthetic fabric). However, marks containing a term identifying a material, ingredient, or feature should not be refused registration under § 2(a) if the mark in its entirety would not be perceived as indicating that the goods contained that material or ingredient. See *A. F. Gallun & Sons Corp. v. Aristocrat Leather Prods., Inc.*, 135 USPQ 459, 460 (TTAB 1962) (COPY CALF was found not deceptive for wallets and billfolds of synthetic and plastic material made to simulate leather, because it was an obvious play on the expression "copy cat" and suggested to purchasers that the goods were imitations of items made of calf skin). Further, the Office has offered the following guidance in TMEP § 1203.02(a) (2013):

[F]ormatives and other grammatical variations of a term may not necessarily be deceptive in relation to the relevant goods. For example, "silky" is defined, *inter alia*, as "resembling silk." See *The American*

Heritage[®] *Dictionary of the English Language: Fourth Ed.* 2000. Thus, a mark containing the term SILKY would not be considered deceptive (but might be unregistrable under §2(e)(1)). Dictionary definitions of such terms should be carefully reviewed to determine the significance the term would have to prospective purchasers. For example, although the term GOLD would be considered deceptive for jewelry not made of gold, the term GOLDEN would not be deceptive.

We now turn to consider each prong of the test to determine whether or not the applied-for mark BLAZING SILKS is deceptive when used in connection with clothing.

1. Is the term "Silks" in the mark BLAZING SILKS misdescriptive of the character, quality, function, composition or use of applicant's clothing?

Applicant focuses its argument on this prong, arguing that "the term SILKS is not the same as the term SILK" and that "[the term 'silks'] has its own separate dictionary definition ... as being the brightly colored garments worn by a jockey or harness racing driver." (Brief, p. 2).

As the starting point of our analysis, we note that "for a term to misdescribe goods, the term must be merely descriptive of a significant aspect of the goods which the goods could plausibly possess but in fact do not." *In re White Jasmine LLC*, 106 USPQ2d at 1392, citing *In re Philips-Van Heusen Corp.*, 63 USPQ2d 1047, 1051 (TTAB 2002). As indicated earlier, applicant's goods, in fact, are not made of silk.

The term "silk" is defined as "thin smooth cloth made from the fibers produced by an insect called a silkworm."

(macmillandictionary.com). The Wikipedia entry relied upon by the examining attorney includes the following information about silk:

a natural protein fiber, some forms of which can be woven into textiles. ... The shimmering appearance of silk is due to the triangular prism-like structure of the silk fiber, which allows silk cloth to refract incoming light at different angles thus producing different colors. ... Silk's absorbency makes it comfortable to wear in warm weather and while active. Its low conductivity keeps warm air close to the skin during cold weather. It is often used for clothing such as shirts, ties, blouses, formal dresses, high fashion clothes, lingerie, pajamas, robes, dress suits, sun dresses and kimonos.

The entry chronicles a long history of the use of silk for clothing, dating back to 3500 BC.

To state the obvious, the term "silk" immediately describes, without conjecture or speculation, a significant feature of clothing. That is, purchasers will clearly understand that because clothing may be made of silk, the term "silk" in a mark designates that the clothing is silk clothing or at least includes silk.

In making this finding, we have considered the distinction between the terms "silk" and "silks." With respect to applicant's main argument that this distinction is critical to

the analysis, the term "silks" is defined as "the bright colored shirt worn by a jockey (someone who rides a horse in a race)." (macmillandictionary.com). A similar definition, submitted by applicant, appears in The American Heritage Dictionary of the English Language (3d ed. 1992), also indicating that "silks" are "emblematic of the stable." The examining attorney introduced excerpts of third-party websites that relate to the meaning of "silks" in horse racing: "In the 1700s silk fabric came all the way from the orient to Europe in beautiful, vibrant colors to be sewn into the racing silks of the day." (classicsilksusa.com); "As racing has changed, so too have colors. Called silks because the early variations were, in fact, silk, today most are actually nylon or [L]ycra." (belmontstakes.com); "The shirts the riders wore were really made from silk. Today the jockeys' garments are made of super-light synthetic material which allows for an optimum performance." (horseracingjockeys.com).

The meaning of the term "silks" does not detract from the deception conveyed by the term when used for clothing. As shown by the excerpts of the third-party websites, the term "silks" originated from the fact that horse jockeys' jerseys actually were made of silk. We agree with the examining attorney's statement that "even if the term SILKS can refer to jerseys worn by jockeys, it further reinforces the importance of silk because of the fact that the jerseys were famously composed in

significant part of silk fiber material." (Brief, p. 6). In any event, we can only speculate as to how many consumers will even be aware of the meaning of the term "silks" as used in horse racing; likewise, although applicant claims that its proposed mark is "a play on the famous movie BLAZING SADDLES," there is no evidence to show either that the movie is famous or that consumers would even think of the movie when encountering applicant's proposed mark. The meaning of "silks" in the context of horse racing is simply overwhelmed by the commonly used and understood meaning of "silk" when the term "SILKS" appears in the proposed mark BLAZING SILKS as used in connection with clothing that is routinely made of silk, including neckties and dresses as listed in the application.

Further, the presence of the term "blazing" in the proposed mark does not diminish the deceptiveness of the mark as a whole. The term "blazing," when used as an adjective, means "burning brightly; of tremendous intensity or fervor." Random House Dictionary (2013).² Thus, the mark as a whole would connote clothing made of silk in "blazing" or bright colors or patterns.

Although applicant's clothing does not contain silk, consumers will expect that, upon encountering applicant's proposed mark on clothing, the goods will consist in significant

² The Board may take judicial notice of dictionary definitions. *In re Thomas White Int'l Ltd.*, 106 USPQ2d 1158, 1160 n.1 (TTAB 2013).

part of silk. The mark BLAZING SILKS as a whole misdescribes clothing that is not made of silk, as is the case for applicant's clothing. The first prong of the test is satisfied.

2. Are prospective purchasers likely to believe that the misdescription actually describes the clothing?

Given the commonly understood meaning of "silk" in the context of clothing, and the attractiveness and desirability of clothing made from silk (*see* discussion, *infra*), it is very likely that customers of applicant's clothing would believe that the clothing is made of silk when, in fact, it is not.

We find, therefore, that this prong of the test is satisfied.

3. Is the misdescription likely to affect a significant portion of the relevant consumers' decision to purchase?

To establish a *prima facie* case of deceptiveness, the examining attorney must provide sufficient evidence that the misdescriptive quality or characteristic would be a material factor in the purchasing decision of a significant portion of the relevant consumers. To do so, the examining attorney must provide evidence that the misdescriptive quality or characteristic would make the product or service more appealing or desirable to prospective purchasers. *In re White Jasmine LLC*, 106 USPQ2d at 1392 (*citing In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694, 1698-99 (TTAB 1992)). "A product or service is usually more desirable because of objective standards

or criteria that provide an objective inducement to purchase the goods and/or services beyond that of mere personal preference.”

TMEP § 1203.02(d). As stated in TMEP § 1203.02(d)(i):

The evidence must support a finding that goods or services that contain or feature the misdescriptive term are superior in quality to similar goods and/or services that do not. *For example, silk can be shown to be a more luxurious and expensive material because of the difficulty in making silk, its unique feel, and its breathability. (emphasis added).*

To show the appeal and desirability of silk as a fabric for clothing, the examining attorney submitted excerpts of third-party websites revealing the following information about silk:

Benefits of Silk. Besides its luxurious softness and lustrous beauty, there are various other benefits of silk that other fabrics, whether natural or man-made, simply cannot match. These advantages of silk have rightly earned silk its reputation as the queen of fabrics. If Why Silk is still a question in your mind, the following benefits of silk should remove any doubts. It is not just a question of comparison with other fabrics, some of these benefits and advantages place silk in a league of its own.

Among the listed benefits are its hypoallergenic properties, warmth in winter and coolness in summer, high absorbency while letting the skin breathe, sensitivity to skin problems, odor resistance, strength (comparable to steel yarn in tensile strength), wrinkle resistance, quickness in drying, ease to work

with, and ability to mix well with other fabrics.

(texeresilk.com; demurelookcom; mvstylenaturals.com).

These benefits are in the nature of objective standards that provide an inducement to purchase silk clothing beyond that of mere personal preference. Consumers are more likely to purchase clothing made of silk fiber than other fibers because of silk's desirable and superior qualities. The evidence shows that silk has several positive attributes so that the presence of "silks" in applicant's proposed mark BLAZING SILKS is likely to affect a significant portion of the relevant consumers' decision to purchase. Here, applicant's clothing is not made of silk, so the mark will deceive purchasers in making a decision to purchase applicant's clothing.

We find that the third prong of the test is satisfied.

Accordingly, based on the evidence of record, we conclude that the designation BLAZING SILKS, when used in connection with clothing not made of silk, is deceptive under Section 2(a).

Decision: The refusal to register is affirmed.