

This Opinion is not a  
Precedent of the TTAB

Mailed: October 15, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Boyle*

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Serial No. 85741096

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Gene S. Winter of St. Onge Steward Johnston & Reens LLC,  
for Tracy Boyle.

Matthew G. Galan, Trademark Examining Attorney, Law Office 113,  
Odette Bonnet, Managing Attorney.

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Before Quinn, Kuhlke and Kuczma,  
Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

Tracy Boyle (“Applicant”) seeks registration on the Principal Register of the  
mark:



for: jewelry, namely beaded bracelets and necklaces with and without crystals in International Class 14, and

on-line retail store services featuring beaded jewelry with and without crystals; retail store services featuring beaded jewelry with and without crystals in International Class 35.<sup>1</sup>

The Trademark Examining Attorney refused registration of Applicant's mark under § 2(a) of the Trademark Act, 15 U.S.C. 1052(a), on the ground that the mark comprises deceptive matter.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied Applicant's first and second requests for reconsideration, the appeal was resumed. Applicant and the Examining Attorney have filed briefs.

The sole issue on appeal is whether the term DIAMONDS in Applicant's Mark is deceptive within the meaning of Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a), as applied to "jewelry, namely, beaded bracelets and necklaces with and without crystals," and "on-line retail store services featuring beaded jewelry with and without crystals; retail store services featuring beaded jewelry with and without crystals."<sup>2</sup>

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<sup>1</sup> Application Serial No. 85741096 was filed on September 28, 2012, based upon Applicant's claim of first use anywhere and first use in commerce since at least as early as July 16, 2012. The application includes the following description of the mark: "The mark consists of two concentric ovals featuring wording and design elements. The outer oval features the wording 'DIAMONDS IN THE TROUGH' at the top and a series of seven diamond shapes with curved sides at the bottom. The inner oval features the design of a pig and several tufts of grass. A stylized diamond appears in the center of the pig."

<sup>2</sup> Applicant's final identification of goods and services submission was entered into the record on September 22, 2014.

Section 2(a) is an absolute bar to registration of an applied-for mark comprised of deceptive matter. A mark is deceptive if the following criteria are met:

- 1) The applied-for mark consists of or contains a term that misdescribes the character, quality, function, composition, or use of the goods and/or services;
- 2) Prospective purchasers are likely to believe that the misdescription actually describes the goods and/or services; and,
- 3) The misdescription is likely to affect a significant portion of the relevant consumers' decision to purchase the goods and/or services.

*See In re Budge Manufacturing Co.*, 857 F.2d 773, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988), *aff'g* 8 USPQ2d 1790 (TTAB 1987); *In re White Jasmine LLC*, 106 USPQ2d 1385, 1391-92 (TTAB 2013); *see also In re Spirits International, N.V.*, 563 F.3d 1347, 90 USPQ2d 1489, 1492-93, 1495 (Fed. Cir. 2009) (holding that the test for materiality incorporates a requirement that a “significant portion of the relevant consumers be deceived”).

A mark is deceptive even if only a portion of the mark is deceptive. *See American Speech-Language-Hearing Association v. National Hearing Aid Society*, 224 USPQ 798, 808 (TTAB 1984). This includes marks where a deceptive term is embedded in a composite mark, such as Applicant's, that includes additional nondeceptive wording and/or design features. *Id.* The law is clear; § 2(a) of the Trademark Act prohibits registration of deceptive matter, not merely deceptive marks. *See In re White Jasmine LLC*, 106 USPQ2d at 1391.

- A. Is the phrase “diamonds in the trough” in the mark “DIAMONDS in the TROUGH and Design” misdescriptive of the character, quality, function, composition or use of the goods and services?

For a term to misdescribe goods (or services), the term must be merely descriptive of a significant aspect of the goods (or services) which the goods (or services) could plausibly possess but in fact do not. *In re White Jasmine*, 106 USPQ2d at 1392; *In re Phillips-Van Heusen Corp.*, 63 USPQ 1047, 1051 (TTAB 2002). Applicant admits that her goods and services do not contain or feature diamonds,<sup>3</sup> contending that the primary and immediate commercial impression created by the Mark as a whole is not diamond jewelry. The phrase DIAMONDS IN THE TROUGH, according to Applicant, uses a double entendre to create a commercial impression indicating that her goods and services do not contain or feature actual diamonds. Applicant maintains that the phrase DIAMONDS IN THE TROUGH is a clever play on the phrase “diamond in the rough,” making isolation of the term “DIAMONDS” improper.<sup>4</sup>

Applicant contends that her mark uses an incongruous, unitary phrase with a very unique commercial impression that trumps any descriptive meaning of the word “diamonds.” Applicant argues that the Mark employs “ingenuity in its phraseology” and says “an expected thing in an unexpected way” citing *Ex parte Mooresville Mills, Inc.*, 102 USPQ 440, 441 (Comm’r Pat. 1954). As a result, according to Applicant, the descriptive significance of the word “diamonds” is lost

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<sup>3</sup> September 22, 2014 Applicant’s Request for Remand p. 3 (TSDR p. 4 of 6).

<sup>4</sup> Applicant’s Brf. p. 7 (7 TTABVUE 8). That a mark which clearly is recognizable as a double entendre is exempt from § 2(a) for that reason alone is an incorrect reading of the statute. *In re Fox*, 703 F.3d 633, 105 USPQ2d 1247, 1251 (Fed. Cir. 2012).

and all meaning is derived from the phrase in its entirety. TMEP § 1213.05(b)(iii) (2015); see also TMEP § 1213.05(b)(ii)(B).<sup>5</sup>

While agreeing that the literal meaning of the phrase DIAMONDS IN THE TROUGH is an animal feeding trough filled with diamonds,<sup>6</sup> Applicant contends this is not the commercial impression created by the Mark. Instead, Applicant argues the Mark plays on the expression “diamond in the rough” to indicate, in a very unique and recognizable way, that the goods and services bearing the Mark are a rare and unique commodity. According to Applicant, “[t]o suggest that diamonds, a very high cost, valuable commodity, would be found in such a location is laughable, which is the Mark’s intent.” Applicant asserts the phrase trumps the individual meaning of the word “diamonds,” and is a clever play on the expression “diamond in the rough” that employs a double entendre to indicate that the goods do not in fact, contain diamonds.<sup>7</sup>

While Applicant provides one scenario for the meaning of DIAMONDS IN THE TROUGH, we are not persuaded that is the predominant meaning presented by the term. When seeing the Mark, customers may recall the somewhat similar term “diamond in the rough.” This terminology, commonly applied to an individual, means that the person being referred to as a “diamond in the rough” is “one having exceptional qualities by lacking refinement or polish.”<sup>8</sup> If the phrase “diamond in

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<sup>5</sup> App. Brf. pp. 10-11 (7 TTABVUE 11-12).

<sup>6</sup> Applicant’s Brf. p. 11 (7 TTABVUE 12).

<sup>7</sup> Applicant’s Brf. p. 11 (7 TTABVUE 12).

<sup>8</sup> From May 21, 2014 Subsequent Final Action, p. 86 of 142, <http://www.merriam-webster.com/dictionary/diamond%20in%20the%20rough> 5/21/2014; p. 89 of 142,

the rough” were used in connection with jewelry, it would likely indicate a diamond in rough shape requiring the services of an expert to bring out its brilliance.

However, when customers see the phrase DIAMONDS IN THE TROUGH used in Applicant’s Mark, they are likely to initially think of and visualize an animal feeding trough filled with diamonds. Such an image does not convey the absence of diamonds. To the contrary, the fact that the wording used in the Mark is DIAMONDS IN THE TROUGH, *i.e.*, the plural use of the word “diamond,” distinguishes the mark from the known phrase “diamond in the rough” and is more likely to convey the concept of diamonds being offered for sale.

Moreover, Applicant’s Mark contains the word “diamonds” used in the term DIAMONDS IN THE TROUGH, together with a detailed line drawing of a diamond, and seven diamond-shaped designs. The diamond designs contained in the Mark confirm the impression created by the phrase DIAMONDS IN THE TROUGH. Given that the identification of goods and services, and Applicant’s admission, make clear that Applicant’s goods and services do not contain or feature diamonds, Applicant’s Mark contains a term and designs that misdescribe the character, quality, function, composition or use of its goods and services.

Thus, the first prong of the test articulated by the U.S. Court of Appeals for the Federal Circuit is met.

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<http://idioms.thefreedictionary.com/diamond+in+the+rough> 5/21/2014 “a person who has good qualities despite a rough exterior; a person with great potential.”

- B. Are prospective purchasers likely to believe that the misdescription actually describes the goods and/or services?

According to Applicant, because the Mark's use of the word "diamonds" does not actually misdescribe the goods, consideration of the deceptiveness test's second element is unnecessary. Even assuming the word "diamonds" misdescribes the goods and services covered by the Mark, Applicant asserts that the Mark still is not deceptive because consumers will not believe that the misdescription actually describes the goods and services given the overall commercial impression created by the Mark as a whole.<sup>9</sup>

Applicant argues that a consumer encountering the Mark would immediately recognize this clever alteration of a known expression and understand the phrase's incongruity to indicate that the jewelry does not contain actual diamonds.<sup>10</sup> Additionally, Applicant argues that the Mark is a design mark that contains more than just the DIAMONDS IN THE TROUGH phrase.<sup>11</sup> Applicant concludes, without support, that consumers encountering the design mark would certainly recognize the clever play on the expression "diamond in the rough" and deduce that the word "diamond" is not meant to indicate jewelry.<sup>12</sup>

On the other hand, the Examining Attorney contends that consumers are likely to believe the misdescription presented in Applicant's Mark because jewelry is often comprised of diamonds and customers regularly seek out and purchase diamonds

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<sup>9</sup> Applicant's Brf. p. 12 (7 TTABVUE 13).

<sup>10</sup> Applicant's Brf. p. 12 (7 TTABVUE 13).

<sup>11</sup> Applicant's Brf. p. 12 (7 TTABVUE 13).

<sup>12</sup> Applicant's Brf. p. 13 (7 TTABVUE 14).

from entities holding themselves out as dealing in diamonds.<sup>13</sup> In support, the Examining Attorney submits evidence of jewelry retailers that extol and market the desirability of diamonds through use of the term “diamond” and images of diamonds.<sup>14</sup>

Applicant notes that based on the Examining Attorney’s reasoning, every mark containing the word “diamonds” for jewelry not made of diamonds would be deceptive. Applicant contends this is clearly not the case given the number of registered marks for non-diamond jewelry that use the word “diamond.” In further support, Applicant notes that consistency in examination has been recognized as a goal of the Office. However, the Board must assess each mark on the evidence presented in the record. *In re Nett Designs*, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); *In re Rodale, Inc.*, 80 USPQ2d 1696, 1700 (TTAB 2006). Only a few of the registrations cited by Applicant are admissible and there is little persuasive value in those registrations for marks that do not contain the word “diamonds” which are readily distinguishable from Applicant’s Mark and its goods and services.<sup>15</sup>

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<sup>13</sup> Examining Attorney’s Brf. (23 TTABVUE 9).

<sup>14</sup> See for example, attached screen captures at <http://www.bluenile.com/diamondjewelry>, <http://www.helzberg.com/>, <http://www.jared.com/en/jaredstore>, <http://www.debeers.com/> and <http://www.zales.com/jewelry101/index.jsp?page=diamonds>, attachments to May 21, 2014 Final Office Action pp. 50-62, 67-69 of 142.

<sup>15</sup> Several of the registrations included in Applicant’s June 21, 2013 Response to Office Action and January 14, 2014 Request for Reconsideration have been cancelled or were registered based on a foreign registration. For example, the four registered marks Applicant mentions on p. 13 of its brief, are not relevant. Registration No. 3,953,068 (AOTC CREATED DIAMONDS COLOUR. OUR PASSION. for synthetic diamonds) is based on a Canadian registration; and Registration Nos. 3,506,497 (GEMESIS THE CULTURED DIAMOND for synthetic diamonds), 3,319,808 (A DIAMOND MAY BE FOREVER BUT A CUBIC ZIRCONIA IS FOR RIGHT NOW for jewelry and retail store services featuring jewelry, mail order services featuring jewelry; telephone order services featuring jewelry;



Although Applicant argues her Mark uses an incongruous unitary phrase with a very unique commercial impression that trumps any descriptive meaning of the word “diamonds,” we do not find that to be the case. Applicant contends that DIAMONDS IN THE TROUGH is a play on the expression “diamond in the rough.” Even if customers were to make some association with the phrase “diamond in the rough,” that would not diminish the impact of the words “DIAMONDS IN THE TROUGH,” which certainly bring to mind diamond gems, particularly in light of the plural use of the word “diamonds.”

In view of the foregoing, prospective purchasers are likely to believe that the misdescription DIAMONDS IN THE TROUGH actually describes goods having diamonds and/or services relating to diamonds. Thus, the Mark meets the second prong of the deceptiveness analysis.

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

In addition to the language DIAMONDS IN THE TROUGH, a prominently displayed image of a large, round-cut diamond appears in the very center of

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on-line store services featuring jewelry) and 1,709,928 (DIAMOND-CUT FLEX ROPE for jewelry; namely, chains for necklaces and bracelets) have not been maintained and are or will be cancelled. *See*, June 21, 2013 Office Action pp. 14-15, 20-22, 30-32 and 35-36. We do not consider either the cancelled registrations or the registrations based on foreign registrations submitted by Applicant. A cancelled registration is not entitled to any of the presumptions of Section 7(b) of the Trademark Act. *See, e.g., In re Hunter Publishing Co.*, 204 USPQ 957, 963 (TTAB 1979) (cancellation “destroys the Section [7(b)] presumptions and makes the question of registrability ‘a new ball game’ which must be predicated on current thought.”). Similarly, third-party registrations which have issued under § 44(e) of the Trademark Act, without any use in commerce, do not evidence exposure of the mark to U.S. consumers and have little persuasive value. *See, e.g., In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993).

Applicant's mark. This realistic and prominent design of a diamond further reinforces the notion that Applicant's goods and services emphasize diamonds as the subject matter of her goods and services.

A misdescriptive feature or characteristic of an applicant's mark is considered material in the purchasing decision of a significant portion of the relevant consumers when evidence shows that the misdescription would make the product or service more appealing or desirable to prospective purchasers. *See In re White Jasmine LLC*, 106 USPQ2d at 1392 (citing *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694, 1698-99 (TTAB 1992)); TMEP §1203.02(d).

Applicant does not dispute that the presence of diamonds would typically make jewelry more desirable to consumers.<sup>16</sup> The record is replete with evidence supporting the conclusion that consumers desire diamonds and diamond jewelry,<sup>17</sup> and guard against fake or imitation diamonds.<sup>18</sup>

The explanatory matter appearing on Applicant's specimen and the other record evidence of use upon which Applicant relies in an attempt to overcome the § 2(a) refusal<sup>19</sup> does not serve to overcome the deceptiveness of Applicant's Mark. *In re E5 LLC*, 103 USPQ2d 1578, 1581 (TTAB 2012). Indeed, Applicant's specimen shows

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<sup>16</sup> Applicant's Brf. p. 8 (7 TTABVUE 9).

<sup>17</sup> See evidence attached to May 21, 2014 Final Office Action pp. 44-45, 47-49, 58-60, 63-64, 71, 76-85 and February 1, 2013 Office Action pp. 5, 10 featuring Lexis articles regarding desirability of diamonds as jewelry.

<sup>18</sup> See evidence attached to May 21, 2014 Final Office Action, pp. 133-139, advising consumers to be cautious and aware of unknowingly purchasing fake diamonds.

<sup>19</sup> See for example, Applicant's Request for Reconsideration after Final Action, TSDR pp. 62-68.

use of a tag attached to Applicant's jewelry that bears an article having the appearance of a diamond.

Based upon the foregoing, whether or not real diamonds are present in a seller's goods, or related to a retailer's services, will materially affect the purchasing decisions of a significant portion of the relevant consumers in this market. Thus, the third and final prong of the test is met. *See In re Budge Mfg. Co.*, 8 USPQ2d at 1260.

#### D. Conclusion

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. It is well established that a mark may be found deceptive on the basis of a deceptive term that is embedded in a larger mark. *American Speech-Language-Hearing Association v. National Hearing Aid Society*, 224 USPQ at 808; also see 15 U.S.C. § 1052(a) (a trademark is ineligible for registration if "it [c]onsists of *or comprises* ... deceptive matter"). *See generally In re Fox*, 105 USPQ2d at 1250 (in § 1052(a), the term "comprises" means "includes"). The use of the term "DIAMONDS IN THE TROUGH," including the plural word "diamonds," is likely to convey that diamonds are part of Applicant's goods and related to its services. Inasmuch as Applicant's jewelry "with and without crystals," and related services, do not include diamonds, Applicant's Mark is deceptive.



**Decision:** The refusal to register Applicant's mark under § 2(a) is affirmed.