

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing: December 3, 2015

Mailed:
January 14, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re The Hyman Companies, Inc.

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Serial No. 85483397

Timothy D. Pecsénye and Matthew A. Homyk of Blank Rome LLP for The Hyman Companies, Inc.

Rebecca Smith, Trademark Examining Attorney, Law Office 110 (Chris A.F. Pedersen, Managing Attorney).

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Before Mermelstein, Gorowitz, and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

The Hyman Companies, Inc. (“Applicant”) has applied to register on the Principal Register the mark DIAMONDESS in standard characters¹ for “jewelry primarily comprised of simulated diamonds and gemstones,” in International Class 14.²

¹ Application Serial No. 85483397 filed on November 30, 2011 under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), on the basis of Applicant’s stated *bona fide* intention to use the mark in commerce.

² This form of the identification of goods, which Applicant entered into the record in its response filed September 14, 2012, has not been properly entered into the USPTO’s automated database, which currently identifies the goods only as “jewelry.”

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 mark comprises deceptive matter. When the refusal was made final, Applicant requested reconsideration and also filed a notice of appeal with this Board. The Examining Attorney denied the request for reconsideration and this appeal proceeded. Applicant and the Examining Attorney filed briefs and an oral hearing was held on December 3, 2015.

The Examining Attorney contends that the term DIAMOND, which is a component of Applicant's mark, is deceptive matter within the meaning of Section 2(a) of the Trademark Act. A mark is deceptive if:

- (1) it contains matter that is misdescriptive of the character, quality, function, composition or use of the goods;
- (2) prospective purchasers would be likely to believe that the misdescription actually describes the goods; and
- (3) the misdescription would be likely to affect a significant portion of the relevant consumers' decision to purchase the goods.

In re Budge Mfg. Co., 857 F.2d 773, 775, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988), *aff'g* 8 USPQ2d 1790 (TTAB 1987); *In re Spirits Int'l, N.V.*, 563 F.3d 1347, 90 USPQ2d 1489 (Fed. Cir. 2009). “[A] ‘deceptive’ mark is one in which the misdescription or falsity is ‘material’ in that it is likely to significantly induce a purchaser's decision to buy.” 2 J. Thomas McCarthy, *MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION* § 11:55 (4th ed. September 2015); *see In re California Innovations Inc.*, 329 F.3d 1334, 66 USPQ2d 1853, 1854 (Fed. Cir. 2003) (“This test's central point of analysis is materiality because that finding shows that the

misdescription deceived the consumer.”). Section 2(a) is an absolute bar to the registration of a mark comprising 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. *In re White Jasmine LLC*, 106 USPQ2d 1385, 1391 (TTAB 2013).

There is no question that the word DIAMOND misdescribes the composition of Applicant’s goods. The identification of goods indicates that the goods contain not diamonds, but “simulated diamonds,” and Applicant has frankly acknowledged as much. Accordingly, the first element of the test is satisfied.

The record also persuades us that the misdescriptive aspect of Applicant’s mark would be a material inducement to purchase the goods for a significant portion of the relevant customers. A “diamond” is defined as “a very hard clear colorless stone used in *expensive* jewelry ...” MACMILLAN DICTIONARY (emphasis added).³ A Wikipedia entry for “diamond” indicates that diamond is “the *most popular* gemstone”; “Diamonds have been *treasured* as gemstones since their use as religious icons in ancient India”; “The most familiar use of diamonds today is as gemstones used for adornment, a use which dates back into antiquity.” (Emphasis added).⁴ A Wikipedia entry for “Diamonds as an investment” states that “The value of diamonds as an investment is of *significant interest to the general public*, because they are expensive gemstones, often purchased in engagement rings, due in part to a successful 20th century marketing campaign by De Beers.” It refers to “the *prized*

³ Office Action of May 12, 2014 at 177.

⁴ Office Action of March 14, 2012 at 15-16.

optical properties of cut and polished [diamonds]”; and to “diamonds in larger sizes becom[ing] increasingly *rare and valuable*.” (Emphasis added.)⁵ The evidence is sufficient to show that if customers were to believe that Applicant’s goods incorporate diamonds, most would view such goods as particularly valuable and desirable, and this misimpression would be a material inducement in the decision to purchase the goods. Accordingly, the third element of the test of deceptiveness is satisfied.

We turn finally to the second element of the test, *i.e.*, whether prospective purchasers would be likely to believe that the word “diamond” actually describes the Applicant’s goods.

To make a *prima facie* showing of what prospective purchasers “would be likely to believe” is an admittedly difficult burden; in this case the burden is upon the Examining Attorney. To show what customers would believe when viewing Applicant’s mark, the Examining Attorney has submitted, in addition to the materials, already discussed, regarding the meaning and public perception of the word “diamond,” dictionary definitions of “ess” and “-ess.” Typical of these are the following from RANDOM HOUSE KERNERMAN WEBSTER’S COLLEGE DICTIONARY (2010):

ess:

n.

1. the letter *S, s*.
2. something shaped like an *S*.

⁵ Office Action of May 12, 2014 at 187-188.

-ess:

A suffix forming distinctively feminine nouns:
*countess; goddess; lioness.*⁶

Usage notes in the RANDOM HOUSE and AMERICAN HERITAGE dictionaries (which are for the most part in agreement) indicate that the suffix –ess is applied to existing words, most frequently “agent nouns in –or or –er,” such as the words “princess,” “duchess,” or “abbess.”⁷

On the basis of the definition of the word “ess,” the Examining Attorney argues that Applicant’s mark could be viewed “as simply a plural of the term ‘diamond.’”⁸ We find this contention unpersuasive. Nothing suggests that people would form the plural of the word “diamond” by adding the letters –ess; and the likely pronunciation of Applicant’s mark is noticeably different from the usual pronunciation of the plural word “diamonds.”

A much closer question is what impression customers would derive from Applicant’s mark if they perceive it as the word “diamond” combined with the feminizing suffix “-ess.” Applicant argues that the meaning of the mark DIAMONDESS is different from the meaning of the common word “diamond”:

[B]y adding the affix “-ESS” to the mark, [Applicant] transforms the meaning of the entire unitary mark from a mere precious gemstone to a female figure (e.g., heiress, hostess, sculptress, countess, duchess, mistress, princess, lioness, tigress).⁹

⁶ Office Action of May 12, 2014 at 204.

⁷ *Id* at 203-204.

⁸ Examining Attorney’s brief, 10 TTABVUE 9.

⁹ Applicant’s brief at 2, 7 TTABVUE 6.

[T]he lexical significance of adding the “-ESS” affix to the mark [] transforms the meaning of [Applicant’s] entire unitary mark from a mere precious gemstone to a female figure; considering that inanimate objects such as jewelry cannot plausibly take on a female form, as the morpheme “-ESS” demands, the term “DIAMONDESS” is a non-deceptive and incongruous coined term.¹⁰

[T]he coined, playful nature of [Applicant’s] unitary DIAMONDESS mark ... does not lead consumers to believe that [Applicant’s] jewelry is made with genuine diamonds.¹¹

Applicant points out that the USPTO has issued registrations for marks such as DIAMONDSTAR, DIAMONDEAU, DIAMONIQUE, DIAMONDAURA, DIAMONAIR, DIAMONFIRE, DIAMONORE, and DIAMONVITA COUTURE for jewelry made with simulated diamonds.¹²

Responding to these arguments, the Examining Attorney argues:

The addition of the suffix “-ESS” does not provide a basis for believing that the goods are in fact not made of real diamonds. ... [N]o evidence was presented to indicate that consumers would understand “-ESS” to refer to simulated diamonds or other gemstones. ... [T]he term “-ESS” when added to the term ‘diamond’ evokes the meaning of ‘diamond-NESS’ as in the state of being a diamond. This interpretation of the mark would increase the likelihood that consumers would believe the goods contain diamonds. In any case, the suffix “-ESS” does not have any known definition that would result in consumers understanding that when added to the term ‘diamonds’ would mean simulated diamonds.¹³

¹⁰ *Id.* at 4, 7 TTABVUE 8.

¹¹ *Id.* at 7, 7 TTABVUE 11.

¹² Request for reconsideration filed November 11, 2014 at 21-35.

¹³ Examining Attorney’s brief, 10 TTABVUE 8-10.

The first sentence of the Examining Attorney's quoted argument comes closest to expressing the critical question before us; but a more accurate statement of the question is whether the addition of the suffix –ESS provides a basis for *not* believing that the goods *are* in fact made of real diamonds. We need not find that DIAMONDESS would be understood to refer to simulated diamonds in order to find that the mark is nondeceptive. Neither must the mark include matter that literally negates the suggestion that the product contains diamonds in order to survive Section 2(a) analysis. Indeed, there is certainly no need that the mark be found to have any meaning at all, as a fanciful, meaningless mark would likely be the least likely to cause deception. For this reason, Applicant's emphasis on the coined nature of the mark is highly relevant. The fact that DIAMONDESS is not a real word necessarily makes more difficult the Examining Attorney's burden of demonstrating what prospective purchasers "would be likely to believe," because dictionary definitions cannot definitively pin down the meaning that customers will derive from a coinage.¹⁴

While acknowledging that this is a close case, we find that DIAMONDESS is not deceptive within the meaning of Section 2(a). Placing the word DIAMONDESS on a product is not the same as placing the word DIAMOND on it: the use of DIAMONDESS, which has no definite meaning, is objectively not a statement that the product is a diamond. While the presence of the word "diamond" within the mark obviously suggests the idea of a diamond, a costume jewelry merchant could

¹⁴ On the other hand, we do not wish to suggest that any alteration, however minor, that changes a common word into a coinage would be sufficient to render it non-deceptive.

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certainly, without deceptiveness, compare his goods to diamonds or say that they are diamondlike. In such a context, we believe the differences between “diamond” and DIAMONDESS in appearance, sound, and meaning are a sufficient signal to customers that they are not being offered a diamond.

Decision: The refusal under Section 2(a) is reversed.¹⁵

¹⁵ Prior to publication, the Examining Attorney should ensure that Applicant’s September 14, 2012 amendment to the identification of goods is properly entered into the record.