

This Opinion is not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board

In re Perry Textiles Inc.

Serial No. 86119296
filed November 14, 2013

Matthew H. Swyers, The Trademark Company, PLLC, for Applicant.

Gretta Yao, Trademark Examining Attorney, Law Office 118, Thomas G. Howell,
Managing Attorney.

**Before Mermelstein, Adlin, and Heasley, Administrative Trademark
Judges.**

Opinion by Mermelstein, Administrative Trademark Judge:

Alleging an intent to use its mark in commerce, Applicant Perry Textiles Inc.
seeks registration of the mark **WONDER DOWN** and design:



for use on “down alternative bed pillows; down alternative mattress toppers” in In-
ternational Class 20 and “down alternative mattress pads,” in International Class 24.

The Examining Attorney finally refused registration on the ground that Applicant's mark "consists of or comprises . . . deceptive . . . matter" when used in connection with the identified goods. Trademark Act § 2(a). Applicant appealed the refusal. Because Applicant's mark comprises deceptive matter, we affirm.

I. Applicable Law

The Court of Appeals for the Federal Circuit has established a three-part test for determining deceptiveness under Trademark Act § 2(a). All three conditions must be satisfied:

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 the decision to purchase?

In re Budge Mfg. Co., Inc., 857 F.2d 773, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988). *See also In re AOP LLC*, 107 USPQ2d 1644, 1646 (TTAB 2013).

There is no requirement that the entire mark be deceptive in order to refuse registration under section 2(a). A mark may be held deceptive if it merely "*comprises . . . deceptive . . . matter*," even if other elements of the mark are not deceptive. Many compound marks have been refused registration based on the deceptiveness of one element of the mark. *See, e.g., In re Budge Mfg. Co.*, 8 USPQ2d 1790 (TTAB 1987), *aff'd* 8 USPQ2d 1259 (Fed. Cir. 1988) (**LOVEE LAMB** for simulated sheepskin); *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047 (TTAB 2002) (**SUPER SILK** for silk-like fabric); *In re Perry Mfg. Co.*, 12 USPQ2d 1751 (TTAB 1989) (**PERRY NEW**

YORK for goods from North Carolina); *In re Shapely, Inc.*, 231 USPQ 72 (TTAB 1986) (**SILKEASE** for polyester dresses); *Evans Prods. Co. v. Boise Cascade Corp.*, 218 USPQ 160 (TTAB 1983) (**CEDAR RIDGE** for siding not made of cedar).

II. Discussion

According to the application, the applied-for “mark consists of a stylized swan above a depiction of water lines, above the words ‘**WONDER DOWN.**’” The Examining Attorney’s concern is with the word “DOWN.”

A. Is the term misdescriptive of the character, quality, function, composition or use of the goods?

Applicant and the Examining Attorney submitted a number of materials bearing on the meaning of the word “down,” including the following:

DOWN : noun

- 1 . the soft fine feathers with free barbs that cover the body of a bird and prevent loss of heat. In the adult they lie beneath and between the contour feathers
- 2 . another name for eiderdown (sense 1)
- 3 . (botany) a fine coating of soft hairs, as on certain leaves, fruits, and seeds
4. any growth or coating of soft fine hair, such as that on the human face

Resp. to Ofc. Action, May 26, 2015 (<http://dictionary.reference.com/browse/down>).

eiderdown

* * *

noun

1. down, or soft feathers, from the breast of the female eider duck.

2. a heavy quilt or comforter, especially one filled with eiderdown.

3. a warm, lightweight knitted or woven fabric of wool, cotton, or man-made fibers, napped on one or both sides, used for sleepwear, infants' clothing, etc.

Id. Dictionary.com unabridged (<http://dictionary.reference.com/cite.html?qh=eiderdown&ia=luna>) (links omitted).

downy

* * *

Full Definition of DOWNY

1 : resembling a bird's down

2 : covered with down

3 : made of down

4 : SOFT, SOOTHING

Id. Merriam-Webster Dictionary (no URL provided).

down² (doun)

n.

1. Fine, soft, fluffy feathers forming the first plumage of a young bird and underlying the contour feathers in certain adult bird. [*sic*]

2. Botany A covering of soft, short hairs, as on some leaves or fruit.

3. A soft, silky, or feathery substance, such as the first growth of a human beard.

Final Ofc. Action, Aug. 5, 2015, American Heritage Dictionary (<http://www.abdictionary.com/word/search.html?q=down>).

Down feather

The down of birds is a layer of fine feathers found under the tougher exterior feathers. Very young birds are clad only in down. Powder down is a specialized type of down found only in a few groups of birds. Down is a fine thermal insulator and padding, used in goods such as jackets, bedding (duvets), pillows and sleeping bags. The discovery of feathers trapped in ancient amber suggests that some species of dinosaur may have possessed down-like feathers.

* * *

Human Use

* * *

Down is warm, lightweight and packable. If well cared for, it retains its loft up to three times longer than do most synthetics. However, when it is wet, the thermal properties of down are virtually eliminated. Down forms clumps if exposed to dampness or moisture, and will mildew if left damp. In addition, it will absorb and retain odors.

* * *

Resp. to Ofc. Action, May 26, 2015, Wikipedia (no URL given).

What Is a Down Pillow?

* * *

Down pillows are stuffed with soft down feathers, usually taken from geese or ducks. They are typically very soft and warm, and they tend to hold onto their supportive properties, called loft, over time. Products stuffed with down are often considered a symbol of luxury, and as such, they can be more expensive than conventionally stuffed bedding.

Ofc. Action, Nov. 26, 2014, wiseGEEK (<http://www.wisegeek.com/what-is-a-down-pillow.htm>).

What is down?

“Down” is the undercoating of waterfowl (goose, duck or swan) and consists of light, fluffy filaments growing from a central quill point, thereby creating a three dimensional

structure which traps air and gives down insulating ability.” — *Guide to the Labeling of Down and Feathers Enforcement Guidelines, March 2000* Down is designed to help keep waterfowl warm, but it is now commonly used and promoted as a “natural” stuffing for warm clothing and bedding* for humans instead.

Final Ofc. Action, Aug. 5, 2015 (<http://gentleworld.org/how-down-feathers-are-collected>).

How to Choose a Pillow

* * *

FILL TYPE

Down Pillows Down is the most luxurious of all fills and is Mother Nature’s warmest, lightest and most efficient insulator. Down has superior loft, fill power and breathability. Down is the light, fluffy insulating undercoat clustered beneath the feathers of geese and ducks which protect them from severe winter temperatures. Why is down ideal for pillows? Down conforms wonderfully to your head and neck. It holds up better than synthetic fills.

Id. (<http://www.thecompanystore.com/how-to-choose-a-pillow.html>).

* * *

“[I]t is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used or intended to be used, and the impact that it is likely to make on the average purchaser of such goods or services.” *In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1060 (TTAB 2002). Thus, although the word “down” may have other meanings in other contexts, we find that in the context of Applicant’s identified goods, “down” is a soft, fluffy under-layer of bird (usually waterfowl) feathers which is used as a natural filling known for its

properties of softness and insulation.

There is no dispute that Applicant's pillows, mattress toppers, and mattress pads are not made of or filled with feathers in whole or in part. Applicant made that clear when it amended its identification of goods to limit the goods to "down alternative" products. *See Resp. to Ofc. Action*, Oct. 23, 2014. In addition to the other evidence, Applicant's amendment itself makes clear the relevance of "down" to its goods, as well as the fact that Applicant's goods do not contain it. Thus, "DOWN" is *prima facie* misdescriptive of the character and composition of Applicant's goods.

Applicant argues that neither its mark as a whole (words and design) nor the word combination **WONDER DOWN** are misdescriptive of its goods. *App. Br.*, 6 TTABVue 7-8. But a mark need not be misdescriptive in its entirety in order to qualify as deceptive under Trademark Act § 2(a). Applicant's mark may be refused registration if the single word "DOWN" meets each prong of the *Budge* test. *In re White Jasmine LLC*, 106 USPQ2d 1385, 1391 (TTAB 2013).

Applicant cites *A.F. Gallun & Sons Corp. v. Aristocrat Leather Prods., Inc.*, 135 USPQ 459, 460 (TTAB 1962), for a contrary position, *App. Br.*, 6 TTABVue 8, but the case is inapposite. In *Gallun*, the opposer claimed that the mark **COPY CALF** was deceptive for wallets and billfolds not made of leather. The Board dismissed the opposition, finding that the mark as a whole was "obviously a play on the familiar expression 'copy cat,'" and that the term "COPY" in the mark "would immediately suggest to purchasers that [Applicant's goods] are imitations or copies of wallets and billfolds made of calf skin." *Id.* at 460. In essence, the Board found that "CALF" no

longer carried its ordinary meaning when combined with “COPY,” because in the combination, “CALF” became part of a play on the phrase “copy cat,” giving up its identity as a single word, and because the applicant’s use of “COPY” actually informed the purchaser that the goods were *not* made of calfskin.

By contrast, the word “DOWN” in Applicant’s mark has no similar relationship to either the word “WONDER” or anything else in Applicant’s mark which changes or lessens the misdescriptive import of “DOWN,” as it applies to Applicant’s goods. We agree with the Examining Attorney that the appearance of “WONDER” before “DOWN” does not change the meaning of “DOWN,” but simply implies that Applicant’s “DOWN” has unexpected or superior properties.¹ *Ex. Att. Br.*, 8 TTABVue 4–5. Moreover, in *Gallun* the word “COPY” suggested to the purchaser that the goods were *not* made of calfskin. But quite unlike the word “COPY,” the image of a waterfowl in Applicant’s mark promotes, rather than dispels, the notion that “DOWN” in the mark is a reference to the feathery filling of some pillows, mattress toppers, and mattress pads because it is known that such birds are a source of down.²

Gallun teaches that it is appropriate to consider the meaning of “DOWN” in the context of Applicant’s mark to determine its misdescriptiveness. In other words, the

¹ We take judicial notice of the definition of “wonder” attached to the Examining Attorney’s brief: “[a] feeling of surprise mingled with admiration, caused by something beautiful, unexpected, unfamiliar, or inexplicable.”; “[t]he quality of a person or thing that causes wonder.” (<http://www.oxforddictionarise.com/us/definition/american/english/wonder>). See Fed. R. Evid. 201.

² Applicant’s evidence indicates that while down is often gathered from ducks and geese, it can also come from other birds such as marabou, turkey, *Resp. to Ofc. Action*, May 26, 2015 (Wikipedia), and swan. *Final Ofc. Action* (<http://gentleworld.org/how-down-feathers-are-collected>).

question in the first prong of the *Budge* test is what would the word in question mean to purchasers seeing the mark on the identified goods? If the feathery meaning of “DOWN” is lost in the context of Applicant’s mark, it is not misdescriptive and purchasers would not be deceived. But once we have determined — as we do — that “DOWN” has not lost its misdescriptive meaning in Applicant’s mark, the fact that it is but one element in Applicant’s otherwise-not-misdescriptive mark does not preclude a finding that the mark comprises deceptive matter.

Applicant posits that “[f]ormatives and other grammatical variations of a term may not necessarily be deceptive in relation to the relevant goods.” *App. Br.* 6 TTABVue 8. As a general principle, we agree. But Applicant does not explain why the word “DOWN” as it appears in the applied-for mark on the identified goods would not inform the prospective purchaser (incorrectly) that down is a component of Applicant’s goods. If it is Applicant’s position that “DOWN” has some other (non-misdescriptive) meaning in this context, Applicant has not suggested what it might be.

The first prong of the *Budge* test is satisfied.

B. Are prospective purchasers likely to believe that the misdescription actually describes the goods?

The Examining Attorney submitted a variety of evidence supporting her assertion that prospective purchasers are likely to believe (incorrectly) that Applicant’s goods feature down. This evidence demonstrates that goods such as Applicant’s can and frequently do include down, and that they are advertised as such. For example, in addition to the evidence set out above, pages from the Amazon.com website show

advertisements for pillows, mattress toppers and mattress pads filled partially or entirely with down. *Ofc. Action*, Nov. 26, 2014 (<http://www.amazon.com>). Likewise, advertisements from The Company Store and Cuddledown show the promotion of down pillows and down mattress pads. *Final Ofc. Action*, Aug. 5, 2015 (<http://www.thecompanystore.com/royal-luxury-soft-pillow-for-stomach-sleepers/PMS1.html>); (<http://www.cuddledown.com/itemdy00.aspx>).

Because purchasers of pillows, mattress toppers, and mattress pads frequently encounter in the marketplace such goods filled with down, they will readily believe that Applicant's goods feature down as a component, when in fact they do not. Applicant apparently concedes this point, as the issue is not discussed in its brief on appeal.

The second prong of the *Budge* test is satisfied.

C. Is the misdescription likely to affect the decision to purchase?

The last prong of the *Budge* test concerns materiality. Are purchasers likely to act on the misdescription in the mark? Again, the record supports the conclusion that the misdescription in this instance is material. Applicant lists several factors for consideration of materiality:³ superior quality, enhanced performance or function, difference in price, health benefit, and religious practice or social policy. *App. Br.*, 6 TTABVue 10 (quoting TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1203.02(d)(i)).

³ Although Applicant lists these objective criteria, it fails to *apply* them to the facts of this case. As discussed, some of them militate in favor of finding that the misdescription is material to consumers. We note that the last listed factor — “religious practice or social policy” — seems inapplicable to the facts at hand.

The evidence establishes that many people prefer down as a filler for their bedding and seek it out for its desirable qualities. For example: “Down is warm, lightweight and packable. If well cared for, it retains its loft up to three times longer than do most synthetics.” Wikipedia (no URL given).

Down is the most luxurious of all fills and is Mother Nature’s warmest, lightest and most efficient insulator. Down has superior loft, fill power and breathability. Down is the light, fluffy insulating undercoat clustered beneath the feathers of geese and ducks which protect them from severe winter temperatures. Why is down ideal for pillows? Down conforms wonderfully to your head and neck. It holds up better than synthetic fills.

The Company Store (<http://www.thecompanystore.com/how-to-choose-a-pillow.html>).

Our Down-Only Promise is Important To You

We don’t do feathers. We only do down. Feathers are cheap filler for low quality pillows. Down floats, feathers fall. Down is 3D, feathers are only 2D. Down has loft, feathers are flat.

Ofc. Action, July 30, 2014 (<http://www.thepillowbar.com/vA-all-about-down.php>).

Benefits of Down

Why Synthetics aren’t as good as Down:

Down provides approximately three times the warmth per ounce compared to even the best synthetics, which can mat and lump together. Over time this can leave empty cold spots, while Down continually re-lofts and molds itself to the body.

Down has the marvelous ability to breath and “wick away [illegible] body moisture, which keeps the user, dry and warm. Most synthetics do not allow perspiration from the body to escape to the outside, therefore the user experiences clamminess and becomes cold.

Down is also the most eco-friendly product on the market, as everything from harvest to final production is a practice

in eliminating waste. All by-products of the processing are biodegradable and the product itself is naturally occurring. The difference between the Synthetics and Down in respect to their carbon footprint is staggering.

Ounce for ounce, Down is the warmest insulating material available and given the proper care, should last as long as you do. You can wash it, dry it, scrunch it up tight and it always bounces back to its original fluffy form.

Ofc. Action, Nov. 26, 2014 (http://www.featherind.com/benefits_down.htm).

Why Use Down?

Down feathers are especially soft feathers found on the undersides of birds, beneath the outer layer of larger, more rugged, feathers. Their small, interlocking fibers serve to insulate the birds' bodies from cold temperatures and moisture. When used in pillows, it interlocks with itself to hold warm air close to the user's head. This characteristic provides a lot of warmth, making it ideal for those living in colder climates.

Id. (<http://www.wisegeek.com/what-is-a-down-pillow.htm>).

This evidence demonstrates that down is regarded by many to be of superior quality and provides enhanced performance because of its warmth, light weight, and loft, among other characteristics. That is not to say that Applicant's "down alternative" goods do not have their own desirable qualities or are not preferred by some purchasers. (For instance, many allergy sufferers⁴ prefer synthetic filler to down). But the issue is not the relative merit of down vs. down alternative filler, but whether an appreciable number of customers would choose to purchase down-filled goods based

⁴ We note that allergy sufferers and others who avoid down products for health reasons may also be deceived into believing that Applicant's goods contain down, and thereby *avoid* purchasing Applicant's own goods. However, we are not aware of any precedent applying this type of deception, and we do not rely on it for our decision.

on Applicant's use of the misdescriptive term.

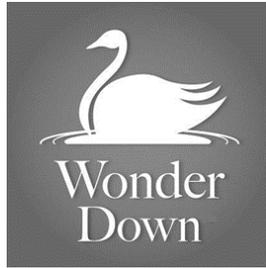
Particularly telling in this case is the price disparity between down-filled goods and those using synthetic filler. As Applicant itself pointed out, "[t]he Applicant's goods have a suggested retail price which is \$29.99 – \$34.99. Down pillows can retail from \$39.99 – \$199.99 depending on the fill power and quality of the down." *Resp. to Ofc. Action*, May 26, 2015. Applicant argues that the lower pricing of its goods makes them desirable, but that argument misses the point. While some purchasers are undoubtedly happy to purchase Applicant's goods at a lower price, the differential pricing of down- and synthetic-filled goods shows that a substantial number of consumers base their purchasing decision on whether the goods contain down. If purchasers did not care what their pillows, mattress toppers, and mattress pads were filled with, we would expect little or no price difference based on filling. Yet it is clear that a substantial number of consumers are willing to pay a premium — and in some cases a hefty premium — to purchase down-filled products. This price disparity and the other evidence of record make clear that Applicant's misdescription affects the purchasing decisions of a substantial number of customers.

The third prong of the *Budge* test is satisfied.

III. Conclusion

Upon full consideration of all the evidence and argument of record, we find that Applicant's trademark

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comprises deceptive matter within the meaning of Trademark Act § 2(a).

Decision: The refusal to register Applicant's mark is affirmed.