

This Opinion Is Not a
Precedent of the TTAB

Hearing: September 18, 2019

Mailed: January 21, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re QVC, Inc.

Serial No. 86670074

Kieran G. Doyle of Cowan of Liebowitz & Latman, P.C.
for QVC, Inc.

David I, Trademark Examining Attorney, Law Office 114,
Laurie Kaufman, Managing Attorney.

Before Mermelstein, Bergsman and Lynch,
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

I. Background and Motion to Amend

QVC, Inc. (Applicant) seeks registration on the Principal Register of the mark DENIM & CO. (in standard character form) for the following goods in International Class 25:¹

Women's clothing, namely, shirts, dresses, skirts, tops, bottoms, sweaters, shorts, pants, jackets, leggings, t-shirts made in whole or substantial part of denim; and

Women's clothing, namely, shirts, dresses, skirts, tops, bottoms, sweaters, shorts, pants, jackets, leggings, t-shirts made of materials other than denim all sold through interactive television and interactive online media wherein the clothing products offered for sale are modeled and whereby detailed information regarding such clothing products is provided including information as to the fabrics and materials from which such clothing products are made.

The application includes a disclaimer of DENIM only as to "women's clothing, namely, shirts, dresses, skirts, tops, bottoms, sweaters, shorts, pants, jackets, leggings, t-shirts made in whole or substantially part of denim." Applicant also claimed ownership of a prior registration of the mark DENIM & CO. (in typed drawing form),² with a disclaimer of DENIM, for "women's clothing made in whole or

¹ Serial No. 86670074 was filed January 22, 2015, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant's claim of first use anywhere and in commerce as of January 9, 1994. The identification is shown in two paragraphs to highlight the difference between the identified denim and non-denim clothing.

² A typed mark is the predecessor and legal equivalent of a standard character mark. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012); *see also* Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a) (referring to "Standard character (typed drawing)").

significant part of denim, namely jeans, pants, shirts, jackets, skirts, leggings and T-shirts,” in Class 25.³

The Examining Attorney partially refused registration of Applicant’s mark under Trademark Act Section 2(a), 15 U.S.C. § 1052(a), as deceptive when used for the identified clothing “made of materials other than denim,” and alternatively under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), as deceptively misdescriptive when used for the same goods. After the Examining Attorney made the partial refusal final, Applicant appealed. Applicant and the Examining Attorney filed briefs, and Applicant filed a motion to delete three items from its identification of goods. An oral hearing took place.

On the same date as its Reply Brief, Applicant moved to amend its identification to delete from the list of clothing “in whole or substantial part of denim” “sweaters,” “leggings,” and “t-shirts,” but explicitly stated that “Applicant does not request remand.”⁴ However, the Board does not act on such proposed amendments during the pendency of an ex parte appeal without remanding the application to the Examining Attorney, and we therefore deny the motion. *See* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1501.05 (2018); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1205.01 (2019) (explaining Board procedure when an applicant files an amendment during the appeal); *see also* TBMP § 1204 (“once applicant has filed an appeal brief, a request for reconsideration, even if filed within

³ Registration No. 1982121 issued June 25, 1996; renewed.

⁴ 7 TTABVUE.

six months of a final action, is treated as a request for remand for which good cause must be shown”).

Even a proposed deletion such as Applicant’s often raises other issues requiring further examination. For example, Applicant’s partial disclaimer is tied to the portion of the identification that Applicant proposes amending, and therefore requires a conforming amendment to strike from the partial disclaimer the same goods that would be deleted from the identification.⁵

Despite our denial of this motion, Applicant may achieve its desired objective. Regardless of the ultimate outcome of this appeal of the partial refusal, the application will be approved for publication at least as to the denim goods not subject to the refusal. Then, Applicant may submit the proposed amendment to these goods as a post-publication amendment. As provided in TMEP § 1505, “[i]f an applicant proposes to amend the identification after publication by ... deleting items in the existing identification, and the amendment is otherwise proper, the USPTO will approve the amendment, and the mark will not be republished.”

As to the clothing made of materials other than denim, we affirm the alternative partial refusals to register for the reasons below.

II. Deceptiveness

Trademark Act Section 2(a) bars registration of a mark that “consists of or comprises ... deceptive ... matter.” 15 U.S.C. § 1052(a). A deceptive mark cannot be

⁵ The conforming amendment would provide that “No claim is made to the exclusive right to use ‘DENIM’ apart from the mark as a whole for Women’s clothing, namely, shirts, dresses, skirts, tops, bottoms, shorts, pants, jackets, made in whole or substantial part of denim.”

registered on the Principal or Supplemental Register, 15 U.S.C. § 1091, and neither a claim of acquired distinctiveness nor a disclaimer of the deceptive matter renders it registrable. *In re White Jasmine LLC*, 106 USPQ2d 1385, 1391 (TTAB 2013).

A mark may be deceptive even if only a portion of the mark is deceptive. *See Am. Speech-Language-Hearing Assoc. v. Nat'l Hearing Aid Soc'y*, 224 USPQ 798, 808 (TTAB 1984). This includes marks such as Applicant's that comprise both purportedly deceptive matter (DENIM) and non-deceptive terms (& CO.). *Id.* "It is well established that a mark may be found deceptive on the basis of a single deceptive term that is embedded in a larger mark." *White Jasmine*, 106 USPQ2d at 1391.

We determine whether a mark is deceptive based on the description of goods. "Registrability of a mark is always considered in conjunction with the identified goods or services, for an applicant cannot obtain rights in a mark in the abstract, only in connection with specified goods or services." *In re ALP of S. Beach Inc.*, 79 USPQ2d 1009, 1019 (TTAB 2006); *see also Roselux Chem. Inc. v. Parson's Ammonia Co., Inc.*, 299 F.2d 855, 132 USPQ 627, 632 (CCPA 1962) (whether a term or mark is merely descriptive must be decided in relation to the goods for which registration is sought and the impact that it is likely to make on the average purchaser of those goods).

A proposed mark must be refused as deceptive if:

(1) it consists of or comprises a term that misdescribes the character, quality, function, composition, or use of the goods;

(2) prospective purchasers are likely to believe that the misdescription actually describes the goods; and

(3) the misdescription is likely to affect the purchasing decision of a significant or substantial portion of relevant consumers.

In re Budge Mfg. Co., 857 F.2d 773, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988); *see also In re Tapco Int’l Corp.*, 122 USPQ2d 1369, 1371 (TTAB 2017); *cf. In re Miracle Tuesday, LLC*, 695 F.3d 1339, 104 USPQ2d 1330, 1334 (Fed. Cir. 2012) (the test for materiality incorporates a requirement that a significant portion of the relevant consumers be deceived).

A. Does DENIM & CO. Consist of or Contain a Misdescription of the Goods?

Denim is a thick cotton cloth commonly used for clothing.⁶ Applicant’s identification sets out two categories of clothing – clothing made in substantial part of denim, and clothing made of materials other than denim. As noted, the term DENIM has been disclaimed as to clothing made in substantial part of denim. This refusal applies only to the non-denim clothing, which as explained below, DENIM misdescribes.

“Misdescriptiveness of a term may be negated by its meaning in the context of the whole mark inasmuch as the combination is seen together and makes a unitary impression.” *Budge*, 8 USPQ2d at 1261 (citing *A.F. Gallun & Sons Corp. v. Aristocrat Leather Prods., Inc.*, 135 USPQ 459, 460 (TTAB 1962) (COPY CALF not deceptive of non-leather goods because the mark as a whole indicates the goods “are imitations or

⁶ September 26, 2015 Office Action at 2-10; November 9, 2017 Office Action at 4-5. All references to the application record are to the USPTO’s Trademark Status and Document Retrieval (“TSDR”) system, available online at USPTO.gov.

copies of wallets and billfolds made of calf skin”)); *see also In re Simmons, Inc.*, 192 USPQ 331, 333 (TTAB 1976) (WHITE SABLE for “brushes used for artistic painting” is construed in light of the fact that the “characteristic color of sable fur is black” and thus white sable must come from a fictitious animal that cannot deceptively represent brush hair from a real animal). Applicant does not argue that its mark is unitary, and by entering a disclaimer in part, has implicitly conceded that the mark is not unitary with respect to denim clothing. *See In re Slokevage*, 441 F.3d 957, 78 USPQ2d 1395, 1399 (Fed. Cir. 2006) (“If a mark is unitary, meaning that it has no ‘unregistrable components’ and is an ‘inseparable whole,’ it is exempted from the disclaimer requirement because ‘it does not fit within the language of 15 U.S.C. § 1056(a).’”) (citation omitted). We see no reason that, by contrast, the mark should be considered unitary with respect to non-denim clothing.

Nonetheless, Applicant contends that in its DENIM & CO. mark, DENIM does not misdescribe the goods because it “does not refer to the material content of Applicant’s garments, but rather to a comfortable, casual and relaxed lifestyle, i.e., the “Denim Lifestyle.”⁷ To support this view, Applicant points to other companies using “denim” or “jeans” in marks or trade names in connection with both denim and non-denim clothing, and third-party registrations of marks that include these same terms for clothing either made explicitly from materials other than denim, or for clothing items that Applicant considers unlikely to be made from denim, such as

⁷ 4 TTABVUE 8 (Applicant’s Brief).

sweaters or socks.⁸ Applicant also submitted a blog titled “Style Synopsis A Denim Lifestyle.”⁹ In addition, Applicant contends that USPTO practice regarding marks with “denim” or “jeans” reflects a tolerance of such marks for clothing made from materials other than denim.

Considering the mark as a whole, we find that in DENIM & CO., consumers would perceive DENIM as a reference to the fabric. Applicant’s evidence that DENIM would be perceived as a lifestyle is minimal and unpersuasive. The record does not include any definitions from dictionaries or other reference works, mainstream publications, or other media sources with a wide reach supporting this alleged alternative definition, and the few references in the record to a “denim lifestyle,” such as in a blog or in the name of a photography display,¹⁰ fall far short of showing a widely understood alternative meaning of DENIM. Even these references are consistent with a lifestyle in which one wears denim fabric – for example, denim jeans – rather than a casual lifestyle that has nothing to do with denim clothing. The blog referring to “A Denim Lifestyle” shows multiple photos of a woman wearing denim, and contains text about wearing “everything denim,” “[d]enim is the ultimate go-to when in doubt. It is simply exquisite and chic no matter how you decide to style it.”¹¹ Clearly, this “denim lifestyle” is about wearing denim fabric.

⁸ March 24, 2016 Response to Office Action at 49-116.

⁹ January 31, 2018 Response to Office Action at 112-21.

¹⁰ January 31, 2018 Response to Office Action at 122-27.

¹¹ January 31, 2018 Response to Office Action at 112-21.

Also, Applicant's minimal evidence to support its lifestyle connotation is dwarfed by overwhelming evidence in the record of the widespread use of DENIM to refer to the fabric from which denim clothing is made. Examples from the record include screenshots from the Zappos website featuring "The Denim Shop" and a "Fall Denim Guide" for clothing made from denim fabric, stating that "denim has come a long way. The original pair of blue jean coveralls has given birth to a myriad of styles over the years: printed denim, patchwork denim, colored denim ... the list goes on and on."¹² The Banana Republic website also includes "The Denim Shop," touting "We've got great jeans...."¹³ Other webpages in the record, including The Gap,¹⁴ Macy's,¹⁵ Saks Fifth Avenue,¹⁶ and additional retailers, demonstrate that DENIM frequently is used to describe the fabric from which articles of clothing are made. "[D]eceptiveness, or misdescriptiveness, is not considered in the abstract. Instead, it must be determined in relation to the goods for which registration is sought. Therefore, the fact that a term may have different meanings in different contexts is not controlling." *Tapco Int'l*, 122 USPQ2d at 1372 (where one meaning of CLEAR would be considered descriptive or misdescriptive of the identified goods, rejecting argument that another meaning might apply). Thus, given that the ordinary definition of DENIM is a fabric, and the record reflects that this ordinary meaning routinely applies to clothing,

¹² September 26, 2015 Office Action at 14-16 (quote on 16).

¹³ April 27, 2016 Office Action at 10.

¹⁴ March 14, 2018 Office Action at 25-44.

¹⁵ April 27, 2016 Office Action at 30-41.

¹⁶ April 27, 2016 Office Action at 21-29.

Applicant falls far short of proving that an alternative definition, one not found in any dictionary, and not commonly used, applies instead. *Cf. In re Jim Crockett Promotions, Inc.*, 5 USPQ2d 1455, 1456 n.5 (TTAB 1987) (rejecting single dictionary definition of word where six other dictionaries did not define the word in the same manner).

We also do not find the third-party registrations of marks incorporating the words DENIM or JEANS probative of the proposed consumer perception advocated by Applicant. First, we do not consider the marks that include the term JEANS particularly relevant here. The record does not demonstrate that JEANS necessarily is interchangeable with or analogous to DENIM for purposes of the deceptiveness analysis.¹⁷

Second, some of the marks that include DENIM also include other matter that may change the connotation. For example, LIFE AFTER DENIM for clothing¹⁸ likely would be understood as for those who have left denim clothing behind and have chosen to wear other fabrics.

Third, some registrations covering clothing generally, without reference in the identification to denim fabric,¹⁹ predate the USPTO policy implemented in 2009 that for marks with potentially deceptive terms, the identification must reflect that the

¹⁷ For example, the Saks Fifth Avenue website features brown “Leather Skinny Jeans.” April 27, 2016 Office Action at 22.

¹⁸ March 24, 2016 Response to Office Action at 49-50.

¹⁹ *E.g.*, March 24, 2016 Response to Office Action at 70-77, 84-85

goods have the feature.²⁰ Before then, if the record in the application indicated that the goods had the feature in question, the identification might remain unchanged. That would not be acceptable under current examination practice. Particularly given this change, the third-party registrations do not reflect a current USPTO policy or practice with regard to denim clothing and deceptiveness.

Fourth, we are not convinced by Applicant's contention that it is nearly impossible that certain of the identified clothing goods could be made of denim fabric,²¹ such as "woven tops,"²² or even "swimwear." The record shows that a wide variety of items can be made from denim,²³ diminishing the prospect that consumers would consider particular articles of clothing off-limits for denim fabric.

Finally, each case must be decided on its own facts and issues, and prior registrations are not dispositive of the case before us. *See In re Cordua Rests*, 118 USPQ2d at 1635; *In re Gen. Mills IP Holdings II, LLC*, 124 USPQ2d 1016, 1027

²⁰ See Notice Announcing Trademark Examination Guides 01-09 and 02-09 on Deceptiveness Refusals issued May 11, 2009, 1349 CNOG 2823 (July 6, 2009).

²¹ See 4 TTABVUE 10-17 (Applicant's Brief) ("items that would almost certainly not be made from denim").

²² "Woven" can refer to any fabric made from interlaced threads. *See* Merriam-webster.com, entries for "woven" and "weave," accessed on October 7, 2019. We take judicial notice of the definitions. *See In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff'd*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *Threshold.TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1038 n.14 (TTAB 2010). The definition in the record of "denim" from merriam-webster.com defines it as a "woven" fabric. November 9, 2017 Office Action at 2. *See also* August 13, 2018 Office Action at 39 (answers.com) ("Denim is a weaving pattern, usually constructed of cotton."); *id.* at 45 (nickoftime.net, Nick of Time Textiles website states that "[w]oven fabrics include denim"). Thus, a woven top could be made of denim.

²³ September 26, 2015 Office Action at 11-21; April 27, 2016 Office Action at 2-41; January 10, 2017 Office Action at 86-148; March 14, 2018 Office Action at 2-41. Examples from the Banana Republic website include handbags and shoes. March 14, 2018 Office Action at 17.

(TTAB 2017) (comparisons to other cases “are rarely helpful, because the critical facts of different cases almost always differ substantially”). Ultimately, “even if the Office has — perhaps improvidently —, issued registrations of marks containing the term [DENIM] for goods not made of [denim] in circumstances like those presented here, we are not bound by those actions if we believe that registration in the case before us would be contrary to the statute.” *In re Shapely*, 231 USPQ 72, 75 (TTAB 1986). Overall, the third-party registrations and other evidence do not show that consumers would understand DENIM as a reference to a lifestyle rather than a fabric.

Although Applicant did not argue that the addition of “& CO.” to DENIM somehow changes the connotation of the mark, we address this point because of the dissenting opinion’s finding to this effect. CO. is an abbreviation of “company,”²⁴ which has numerous possible definitions, but the most common definition associated with the abbreviation is a “business enterprise.”²⁵ See *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1792-93 (TTAB 2002) (quoting *Goodyear’s India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598, 602 (1888) (“[t]he addition of the word ‘Company’ only indicates that parties have formed an association or partnership to deal in such goods....”)). We therefore find that in the context of clothing, the mark gives the impression of a business enterprise connected with denim fabric.

Even were we to consider the definition of “company” as a “group of persons” relied on in the dissenting opinion, we find no basis to expand this definition beyond persons

²⁴ September 26, 2015 Office Action at 30.

²⁵ September 26, 2015 Office Action at 33.

to instead refer to a group of non-denim fabrics. *See Caldwell Lace Leather Co. v. W. Filament, Inc.*, 173 USPQ 695 (TTAB 1972) (affirming deceptiveness refusal of NEOHIDE where NEO, added to otherwise deceptive term HIDE, could be susceptible to two possible interpretations, one of which would not negate deceptiveness). Rather, case captions from our precedent and that of our primary reviewing court show that business entities use “& Co.” and “and Co.” (emphasis added below) with some frequency, suggesting that the use of these terms is relatively unremarkable and does not create an unusual connotation or commercial impression. *E.g., Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 107 USPQ2d 1167 (Fed. Cir. 2013); *In re Becton, Dickinson and Co.*, 675 F.3d 1368, 102 USPQ2d 1372 (Fed. Cir. 2012); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973); *In re S. Malhotra & Co. AG*, 128 USPQ2d 1100 (TTAB 2018); *Swatch AG (Swatch SA) (Swatch Ltd.) v. M. Z. Berger & Co., Inc.*, 108 USPQ2d 1463 (TTAB 2013); *Gen. Motors Corp. v. Aristide & Co.*, 87 USPQ2d 1179 (TTAB 2008); *In re Sears, Roebuck & Co.*, 2 USPQ2d 1312 (TTAB 1987); *Liberty & Co., Ltd. v. Liberty Trouser Co., Inc.*, 216 USPQ 65 (TTAB 1982).

Moreover, as noted above, Applicant’s disclaimer of DENIM apart from the mark as a whole for its denim clothing undermines the proposition that DENIM & CO. is a unitary mark, wherein the combination of terms changes the meaning of the component terms. *See Slokevage*, 78 USPQ2d at 1399 (“A unitary mark creates a ‘single and distinct commercial impression.’”) (quoting *Dena Corp. v. Belvedere Int’l Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991)). As noted above, we find

no reason that the unitariness analysis should differ for the non-denim clothing. Applicant's mark is not analogous to the mark COPY CALF, found not deceptive for wallets and billfolds of synthetic and plastic material, because COPY CALF called to mind the expression "copy cat" and therefore suggested to purchasers that the goods were imitation leather. *See A.F. Gallun & Sons Corp. v. Aristocrat Leather Prods., Inc.*, 135 USPQ 459, 460 (TTAB 1962). Nothing about the addition of & CO. to DENIM creates that kind of difference in connotation.

B. Is the DENIM Misdescription Believable?

As discussed above, the record is replete with evidence of consumer exposure to denim clothing. The wide availability of denim clothing shows that a reference to DENIM for non-denim clothing would not only be false, but also would be plausible to consumers. *See Budge*, 8 USPQ2d at 1261 (where goods of the type at issue "can be and are made from" the material at issue, this creates an inference that the second prong of the deceptiveness test is satisfied).

According to Applicant, the following limitation included in its identification of goods prevents consumers from believing the misdescription when the mark is applied to non-denim clothing:

... sold through interactive television and interactive online media wherein the clothing products offered for sale are modeled and whereby detailed information regarding such clothing products is provided including information as to the fabrics and materials from which such clothing products are made.

Upon carefully examining the language of the limitation, however, we find it ineffective to foreclose deceptiveness under the Trademark Act. We take judicial notice of the following definition of “interactive”:²⁶

involving the actions or input of a user

especially : of, relating to, or being a two-way electronic communication system (such as a telephone, cable television, or a computer) that involves a user’s orders (as for information or merchandise) or responses (as to a poll)

Thus, any television show or website allowing the consumer to order merchandise qualifies as interactive.

While we address in turn first that the clothing is modeled, and then that detailed information is provided, we emphasize that we have considered the identification – and these restrictions – as a whole. The fact that clothing is “modeled,” which sometimes consists of a photo of someone wearing the clothes on Applicant’s website, does not prevent a consumer from believing the misdescription. The record shows that denim comes in a variety of colors and patterns, with the Wikipedia entry for “denim” in the record noting that denim can be dyed blue, black, and “other colors, such as red, pink, purple, grey, rust, mustard, and green.”²⁷ The Gucci and Gap websites show denim jeans and denim jackets in floral, colorblock, and patchwork

²⁶ Entry for “interactive” in Merriam-webster.com, accessed October 10, 2019. The Board may take judicial notice of dictionary definitions, including those from online dictionaries. *See White Jasmine*, 106 USPQ2d at 1392 n.23 (Board may take judicial notice of online dictionaries that exist in printed format or have regular fixed editions).

²⁷ September 26, 2015 Office Action at 6. *See* TBMP § 1208.03 (2019) and cases cited therein regarding Wikipedia evidence.

patterns.²⁸ And the Zappos Denim Shop webpage refers to “the myriad of styles over the years: printed denim, patchwork denim, colored denim ... the list goes on and on.”²⁹ The Textileschool.com article on denim notes that “[t]oday, denim has many faces. It can be printed, striped, brushed, napped and stonewashed.”³⁰ Even Applicant’s own promotional material states that its DENIM & Co. How Fitting! Jeans come in “6 Colors.”³¹ Because denim can have such a varied appearance, and as the pictures of clothing in the record on various retail websites illustrate, even where clothing is modeled, it is visually challenging to distinguish denim from non-denim fabrics. Thus, for example, seeing an online photograph or video of a “modeled” article of clothing that could even be made of faux denim³² would not necessarily lessen the believability of Applicant’s misdescription.

We turn next to the provision in the identification of goods that “detailed information regarding such clothing products is provided including information as to the fabrics and materials from which such clothing products are made.” This wording indicates that in the course of a consumer’s experience with Applicant’s interactive

²⁸ January 10, 2017 Office Action at 125 (Gucci); March 14, 2018 Office Action at 24, 25, 28 (Gap).

²⁹ September 26, 2015 Office Action at 16.

³⁰ August 13, 2018 Office Action at 25.

³¹ March 24, 2016 Response to Office Action at 31. Although this page, which includes “ORDER NOW”, does not have a separate disclosure of the fabric content of the jeans, given Applicant’s assertion that jeans equate to denim, we presume these are denim jeans.

³² For example, “jeggings” is defined as “a legging that is designed to resemble a tight-fitting pair of denim jeans and is made of a stretchable fabric.” Merriam-webster.com entry for “jeggings,” accessed October 10, 2019. Applicant appears to feature DENIM & CO. jeggings on its website, but the fabric content is either not present or not legible. March 24, 2016 Response to Office Action at 135.

television or online media, presumably while viewing the modeled clothing, the clothing's fabric and materials are communicated. Similar arguments about fabric content disclosure repeatedly have been made and rejected in prior deceptiveness cases. The *Budge* court responded to the applicant's contention that the use of "lamb" in its mark was not deceptive because its advertising disclosed that its seat covers were made of "simulated sheepskin" by stating:

Misdescriptiveness of a term may be negated by its meaning in the context of the whole mark inasmuch as the combination is seen together and makes a unitary impression. . . . The same is not true with respect to explanatory statements in advertising or on labels which purchasers may or may not note and which may or may not always be provided. The statutory provision bars registration of a mark comprising deceptive matter. Congress has said that the advantages of registration may not be extended to a mark which deceives the public. Thus, the mark standing alone must pass muster, for that is what the applicant seeks to register, not extraneous explanatory statements.

Budge, 8 USPQ2d at 1261 (citations omitted); *see also In re Hinton*, 116 USPQ2d 1051, 1052 n.4, 1053-54 (TTAB 2015) (rejecting applicant's argument regarding the meaning of its mark based on examples of its advertising).

Perhaps mindful of the *Budge* court's point that explanatory information might not always be provided, the applicant in *Woolrich Woolen Mills* went a step further by providing assurances that the accurate fabric content always must appear on the clothing label pursuant to federal law. However, the Board was unmoved:

Applicant has placed great reliance on the fact that federal law requires clothing to bear a fiber content label and argues that consumers who are concerned about the fabric would check this label and would not be deceived by the mark. We do not find this argument persuasive for two

reasons. If consumers were truly deceived by the mark they would be likely to treat the mark as indicating the fiber content and therefore not feel the need to check the content label. Second, the fiber content label may not remain with the clothing if it is involved in a subsequent sale. *See also In re Shapely, Inc.*, 231 USPQ 72 (TTAB 1986), for an additional discussion of the fiber-labeling argument.

Woolrich Woolen Mills, 13 USPQ2d 1235, 1238 (TTAB 1989).

Both reasons apply in this case as well, even though Applicant's channel of trade involves interactive media. First, consumers using Applicant's website may focus on the more conspicuously displayed DENIM & CO. mark (at least in the examples in the record) without paying attention to whatever fabric content disclosure is provided, which, based on the identification, we cannot be assured would be prominent. *See Shapely*, 231 USPQ at 74 ("there is no basis in this record for inferring that women purchasers habitually check the label of the clothing fabric before making a purchase"). Applicant's limitation in the identification also does not apply to its advertising. Applicant submitted promotional materials that advertise its clothing with photos of models and general descriptions such as "chunky knit shawl-collar sweater" and without fabric content disclosures, directing prospective customers "[t]o order these DENIM & CO. fashions, search the item numbers on QVC.com."³³ Another similar example that has no fabric content disclosure appears below:

³³ March 24, 2016 Response to Office Action at 163.

Special Email Offer

TODAY'S SPECIAL VALUE

Order now before it appears on QVC

► What's New? ► Classic Stretch Denim ► Top 10 Tops ► Outerwear
► Entire Collection ► Video Preview

DENIM & Co. Fashions

Mix, Match, Maximize

This 3-piece *Today's Special Value*® from *Denim & Co.*® fashions is perfect to mix, match and layer with jeans or any casual outfit. It's a great transitional set for your wardrobe, you can wear it now straight through springtime! You get so many different looks for 1 great price. Maximize your closet right through this email!



Black Tan

Retail Value \$XX.xx • QVC Price \$XX.xx
Today's Special Value \$XX.xx*

A6549 • *Denim & Co.*® Jacket, Button Front Shirt, & T-shirt Set

Dark Rose

Order Now

On Tuesday, January 16, tune in for *Denim & Co.*® **13th Anniversary** at Midnight, 11am, & 10pm ET.



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An excerpt from another of Applicant's promotional communications appears below, showing an item number for ease of ordering, but most of the items do not contain fabric content disclosures.

³⁴ March 24, 2016 Response to Office Action at 126.

d&co.
denim • concepts

1 WEEK ONLY • SPECIAL INSIDER EMAIL OFFER
Quantities are limited, order now!

50% OFF
QVC price

A10752 • Tunic with Stretch Jersey Tank
👉 CLEARANCE Price \$16.00

A6289 • Zip Front Cardigan with Mockneck
👉 CLEARANCE Price \$13.00

A60247 • Drawstring Skirt with Ruffle Hem
👉 CLEARANCE Price \$15.50

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Applicant’s website also appears to offer not only “ADD TO CART” buttons, but also “SPEED BUY” buttons under each item, suggesting that consumers need not engage in a careful review of additional information beyond the prominent DENIM & CO. mark.³⁶ These promotional materials expose the reality that consumers can and would encounter the mark through pre-sale advertising that does not include the supposedly clarifying information mentioned in the identification of goods, contrary to the dissenting opinion’s statement otherwise. Thus, whether in advertising or on Applicant’s website, a reasonably prudent purchaser may not see the supposedly clarifying fabric information. *See Hinton*, 116 USPQ2d at 1052 (reasonably prudent purchaser standard applies to deceptiveness analysis).

³⁵ March 24, 2016 Response to Office Action at 127.

³⁶ March 24, 2016 Response to Office Action at 131-39.

As to the second reason cited by *Woolrich Woolen Mills*, modeling the clothing and giving the fabric content during its initial sale through interactive media clearly will “not remain with the clothing if it is involved in a subsequent sale.” 13 USPQ2d at 1238.

Moreover, Applicant’s own promotional materials show that even where fabric content disclosures are made in accordance with the identification of goods, they may be ambiguous and would not obviate potential deception as to denim. Denim is a type of cotton, but not all cotton is denim. Applicant’s advertising shows that at times Applicant gives “cotton” as the fabric content for clothing apparently made of denim. Of course, “cotton” would also be the fabric content for clothing made of non-denim cotton fabrics. In one promotion for DENIM & CO. Stretch Knit Denim Boot-Cut Jeans, Applicant describes the pants as “the comfort of knit pants with the classic look of denim!” and then gives the fabric content as “96% cotton, 4% spandex.”³⁷ Similarly, another promotion shows a “Denim Jumper” on the same page as a “Stretch Metallic Jacquard Top,” and the fabric content disclosure for the denim jumper is “98% cotton/2% spandex body, cotton trim,” while the presumably non-denim top’s fabric content disclosure is “58% cotton/38% polyester/4% spandex.”³⁸ Thus, we are not persuaded by declaration testimony from Applicant’s Vice President and Deputy General Counsel, David O’Connor, that “[t]he fabric content of DENIM & CO. clothing is clearly and conspicuously marked for the consumer; thus there can

³⁷ March 24, 2016 Response to Office Action at 145.

³⁸ March 24, 2016 Response to Office Action at 141.

be no plausible question of deception. Both on air and online, QVC identifies the material from which its DENIM & CO. garments are made.”³⁹ For a consumer who saw the DENIM & CO. mark used for an article of clothing that could be made of denim, but is instead made of some other type of cotton fabric, Applicant’s fabric content disclosure of “cotton” would not obviate the deception.⁴⁰

Applicant also suggests that because it has used the proposed mark for over 23 years for non-denim as well as denim clothing, consumers would not expect all DENIM & CO. clothing to be made of denim. Mr. O’Connor testified, based on his seven years with the company, that Applicant has used DENIM & CO. on women’s clothing continuously for over 23 years, with substantial advertising expenditures and significant sales.⁴¹ Applicant also submitted Bridget Love’s declaration

³⁹ July 10, 2017 Response to Office Action at 14.

⁴⁰ Creative limitations to the identification of goods rarely succeed in meaningfully restricting how the relevant public may encounter or perceive the mark. *Cf., e.g., In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017) (affirming Board finding that an identification restricting the goods to those “associated with William Adams, professionally known as ‘will.i.am,’” imposed no meaningful limitation on the nature of the goods or the trade channels or classes of purchasers of the goods); *In re Yarnell Ice Cream, LLC*, 2019 USPQ2d 265039, *15 (TTAB 2019) (“notwithstanding the limitation that the goods are marketed by a mascot named Scoop at product promotions and distributions, we must assess the registrability of Applicant’s proposed mark for ‘frozen confections and ice cream’ consumed by members of the general public.”); *Bd. of Regents, Univ. of Tex. Sys. v. S. Ill. Miners, LLC*, 110 USPQ2d 1182, 1190-93 (TTAB 2014) (finding that although opposer’s clothing items were limited by the wording “college imprinted” and the applicant’s identical or highly similar items were limited by the wording “professional baseball imprinted,” these restrictions did not distinguish the goods, their trade channels, or their relevant consumers in any meaningful way).

⁴¹ July 10, 2017 Response to Office Action at 12; *see also* March 24, 2016 Response to Office Action at 117.

testimony, based on her two years of experience at that time as a Director of Buying in Applicant's Apparel Division, stating that DENIM & CO. "covers a full range of casual apparel" with "actual denim products" making up less than 15% of the inventory, and a plan to increase that to 30%.⁴² However, this 23 years of use does not overcome the deceptiveness refusal. *See White Jasmine LLC*, 106 USPQ2d at 1391 (acquired distinctiveness does not obviate deceptiveness refusal); *see also Tapco*, 122 USPQ2d at 1374 (ten years of use promoting mark for goods without the feature in the mark does not establish a lack of believability of the misdescription); *In re Woolrich Woolen Mills Inc.*, 13 USPQ2d at 1238 ("a refusal made under Section 2(a) cannot be overcome merely because a mark has enjoyed long and extensive use").

We find that consumers would believe that the identified clothing is made from denim, satisfying the second prong of the deceptiveness analysis. *See, e.g., In re E5 LLC*, 103 USPQ2d 1578, 1583 (TTAB 2012) ("We find that, because the evidence shows that copper is a common supplement or ingredient in dietary supplements, consumers will believe, based on the mark [ALPHA CU] and the goods at issue, that applicant's goods contain copper. Thus, the second prong of the Section 2(a) deceptiveness test has also been satisfied."); *Tapco*, 122 USPQ2d at 1373 (evidence that "some adhesives are, in fact, clear and that this feature is touted to consumers" sufficient to satisfy burden that proposed mark KLEER ADHESIVES satisfied second element of *Budge* test).

⁴² October 27, 2016 Response to Office Action at 7.

C. Is the Misdescription Material to the Purchasing Decision?

We turn next to the third prong of the deceptiveness test, whether the misdescription is likely to affect the purchasing decision of a significant portion of relevant consumers. Thus, we assess whether prospective purchasers consider denim clothing particularly appealing or desirable. *See White Jasmine*, 106 USPQ2d at 1392 (citing *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694, 1698-99 (TTAB 1992)).

According to the Examining Attorney, consumers desire such clothing because “denim is strong and durable, easy to clean and comfortable.”⁴³ Merriam-webster.com defines “denim” as “a firm durable twilled usually cotton fabric...,”⁴⁴ and the Wikipedia entry on denim opens by describing denim as “sturdy cotton.”⁴⁵ Other articles make clear that denim is known as durable and comfortable.⁴⁶ Answers.com describes denim as a “rugged cotton twill textile,”⁴⁷ and the Textileschool.com article on “Denim Fabrics” describes denim as “a strong, durable fabric.”⁴⁸

One blogger on HLM Clothing opines that “... one simple advantage of wearing denim jeans is that they are highly durable and very cost effective clothing to wear and stylish at the same time.”⁴⁹ A style website, Bustle.com, features an article to convince those “not fully sold on allowing denim to become your main squeeze,”

⁴³ 6 TTABVUE 6 (Examining Attorney’s Brief).

⁴⁴ November 9, 2017 Office Action at 2.

⁴⁵ September 26, 2015 Office Action at 4.

⁴⁶ *E.g.*, September 26, 2015 Office Action at 23; August 13, 2019 Office Action at 8.

⁴⁷ August 13, 2018 Office Action at 37.

⁴⁸ August 13, 2018 Office Action at 25.

⁴⁹ March 14, 2018 Office Action at 47.

pointing out that it lasts longer, darker denim can be worn to the office even though it is “the most comfortable thing you are wearing,” and is durable because it is “a sturdy cotton twill textile.”⁵⁰ Another article on “Advantages of Jeans” reports that “[d]enim is a long lasting fabric and this is why it was used in designing jeans which were initially considered ‘work clothes.’”⁵¹ According to the Nick of Time Textiles website, “[i]f you have ever put on a pair of denim pants made using woven fabrics, then you know just how strong woven fabrics are.... Most denim jeans can be worn until they go out of style without showing any major signs of wear and tear.”⁵²

Applicant itself touts some advantages of denim on its website, noting about a jacquard print topper jacket, for example, “because it’s denim, you won’t sacrifice comfort for a second.”⁵³

The record also reflects that some major clothing retailers feature a special section or special webpages just for denim clothing, such as Banana Republic’s “The Denim Shop”⁵⁴ and Zappos.com’s “The Denim Shop” and “Fall Denim Guide.”⁵⁵ Major retailers thus structure their online retail sites to facilitate shopping for denim in particular. We infer from this that a significant portion of prospective customers must be especially motivated to shop for and purchase denim clothing.

⁵⁰ March 14, 2018 Office Action at 51-57.

⁵¹ August 13, 2018 Office Action at 33.

⁵² *Id.* at 45-46.

⁵³ March 24, 2016 Response to Office Action at 36.

⁵⁴ April 27, 2016 Office Action at 10.

⁵⁵ September 26, 2015 Office Action at 14-16.

The record in its entirety convinces us that whether clothing is denim is material to the purchasing decision of a significant portion of the relevant consumers. The record lacks direct evidence of the consumer perception of the mark and motivation in purchasing, notwithstanding conclusory statements about these issues from Applicant's declarants.⁵⁶ Nonetheless, "indirect evidence of materiality is permitted, and an inference of materiality may be made...." *In re Les Halles de Paris J.V.*, 334 F.3d 1371, 67 USPQ2d 1539, 1542 (Fed. Cir. 2003) (discussing materiality in the context of Section 2(e)(3) geographic misdescriptiveness). Here, the record strongly reflects the desirability of denim clothing, and makes such an inference appropriate. The evidence as a whole shows that consumers are motivated to purchase denim in particular, at least in part because it is considered a strong and durable yet comfortable and stylish fabric.

D. Conclusion as to Deceptiveness

Having determined that each of the three prongs of the deceptiveness test is met, we conclude that the partial refusal to register DENIM & CO. for Applicant's identified non-denim clothing is appropriate and therefore affirm it.

⁵⁶ Mr. O'Connor states that "consumers are purchasing these items due to the high quality of these goods and due to the well-established fame and extensive goodwill associated with the DENIM & CO. mark, and not because of their mistaken notion that QVC's [non-denim] clothing is made of denim." July 10, 2017 Response to Office Action at 19. Ms. Love states that "our customers would not deem the Denim & Co. name as descriptive of a denim brand." October 27, 2016 Response to Office Action at 7.

III. Deceptive Misdscriptiveness

Because the refusal as deceptive under Section 2(a) absolutely bars registration, the question of a disclaimer of DENIM as deceptively misdescriptive becomes moot. *White Jasmine*, 106 USPQ2d at 1394. However, in the interest of completeness, we consider deceptive misdescriptiveness in the alternative, and the disclaimer requirement based thereon.

While Applicant casts doubt on the procedural propriety of this requirement, referring it to it as the introduction of “a different argument” and “newly introduced,” we find that the Examining Attorney properly raised it during prosecution. Both the March 14, 2018 Office Action and the August 13, 2018 final Office Action clearly set out a disclaimer requirement based on deceptive misdescriptiveness, citing 15 U.S.C. § 1052(e)(1). TMEP § 1203.02(e)(i) (emphasis added) gives the following guidance regarding procedures for deceptiveness refusals, when a mark is clearly misdescriptive:

If the misdescription would be believable and material, issue a deceptiveness refusal under §2(a) with supporting evidence, **an alternative refusal under §2(e)(1) as deceptively misdescriptive (or disclaimer requirement if appropriate)**, and all other relevant refusals and/or requirements.

Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), prohibits registration of terms that are deceptively misdescriptive of the goods to which they are applied. The test for deceptive misdescriptiveness is identical to the first two prongs of the deceptiveness test – in this case whether DENIM in DENIM & CO. misdescribes the non-denim clothing goods as identified, and whether consumers likely would believe

the misdescription. *See White Jasmine*, 106 USPQ2d at 1395. For the reasons discussed in the deceptiveness analysis, both prongs of the test for deceptive misdescriptiveness are satisfied.

Thus, DENIM in Applicant's DENIM & CO. mark is deceptively misdescriptive and the alternative requirement for a disclaimer on that basis is affirmed.

Decision: The partial refusal to register the mark on the ground that it is deceptive under Trademark Act Section 2(a) is affirmed as to:

Women's clothing, namely, shirts, dresses, skirts, tops, bottoms, sweaters, shorts, pants, jackets, leggings, t-shirts made of materials other than denim all sold through interactive television and interactive online media wherein the clothing products offered for sale are modeled and whereby detailed information regarding such clothing products is provided including information as to the fabrics and materials from which such clothing products are made.

In the alternative, the requirement for a disclaimer of DENIM on the ground that is deceptively misdescriptive under Trademark Act Section 2(e)(1) is affirmed as to the same goods. In due course, the application will proceed to publication with the remaining goods:

Women's clothing, namely, shirts, dresses, skirts, tops, bottoms, sweaters, shorts, pants, jackets, leggings, t-shirts made in whole or substantial part of denim.

Bergsman, Administrative Trademark Judge, dissenting:

I respectfully dissent from the majority's decision finding that the mark DENIM & CO. for the goods set forth below, as amended, is deceptive or that it is deceptively

misdescriptive requiring Applicant to disclaim the exclusive right to use the word “Denim” in connection with the following goods:

Women’s clothing, namely, shirts, dresses, skirts, tops, bottoms, sweaters, shorts, pants, jackets, leggings, t-shirts made of materials other than denim all sold through interactive television and interactive online media wherein the clothing products offered for sale are modeled and whereby detailed information regarding such clothing products is provided including information as to the fabrics and materials from which such clothing products are made.

The first reason for my dissent is that the mark DENIM & CO. has a meaning and engenders a commercial impression that is not deceptive. The term “Co.” is the abbreviation for the word “Company.”⁵⁷ “Company” is defined, inter alia, as “a number of individuals assembled or associated together; a group of people” or “an assemblage of persons for social purposes,” and “companionship; fellowship; association.”⁵⁸ In other words, “company” can mean a group. The mark DENIM & CO. when used in connection with denim clothing and clothing made from other materials engenders the commercial impression of denim and other materials in part due to Applicant’s long, extensive, and successful use of DENIM & CO. *See Woolrich Woolen Mills*, 13 USPQ2d at 1238 (holding that the significance of WOOLRICH is that of a trademark-indicating applicant because any descriptive or misdescriptive

⁵⁷ Dictionary.com based on THE RANDOM HOUSE UNABRIDGED Dictionary (2019) accessed September 4, 2019. The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *Threshold.TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1038 n.14 (TTAB 2010); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

⁵⁸ *Id.*

significance has been replaced by trademark significance as a result of applicant's long and extensive use).⁵⁹

The majority disagrees with the preceding analysis, arguing that the most common meaning of the word "Company" is a "business enterprise," which makes sense if the mark were DENIM CO. However, the mark is DENIM & CO. used in connection with clothing made from denim and other materials. Thus, the meaning and commercial impression of the mark changes to a meaning and commercial impression that is not deceptive (i.e., denim and other materials).

Applicant's disclaimer of the term "Denim" is of little import because it applies to the clothing made of denim, not the goods at issue in the appeal. In other words, for purposes of this appeal, Applicant has not disclaimed the exclusive right to use the word "Denim." In addition, consumers are not aware of disclaimers that reside in trademark registrations and they play little, if any, role in determining the meaning or commercial impression of a mark. *See Cancer Care, Inc. v. Am. Family Life Assurance Co. of Columbus*, 211 USPQ 1005, 1014 (TTAB 1981) ("a disclaimer does not serve to remove the matter from the mark, the mark as a whole triggers the commercial impression engendered by the mark, purchasers encountering the mark are not aware of disclaimers, and the mark must be considered as a whole in evaluating the similarity of the mark to the prior user's mark in determining the likelihood of confusion in marketing the same or similar services or goods

⁵⁹ Applicant provided information regarding its long and extensive use of DENIM & CO., as well as the renown of DENIM & CO., in the testimony declaration of David O'Connor. July 10, 2017 Response to Office Action at ¶¶4-6 (TSDR 12).

thereunder.”); *In re Franklin Press, Inc.*, 199 USPQ 819, 823 (TTAB 1978) (“disclaimers ‘slumber in the archives of the Patent Office’ because purchasers are neither aware of them nor of their significance.”).

Finally, the majority does not explain the basis for holding that “it is too much of a stretch to expand this definition to mean a group of other non-denim fabrics.” The majority offers only a conclusion.

The second reason for my dissent is that the majority fails to give proper weight to the explanatory information in the description of goods. “Registrability of a mark is always considered in conjunction with the identified goods or services, for an applicant cannot obtain rights in a mark in the abstract, only in connection with specified goods or services.” *ALP of S. Beach*, 79 USPQ2d at 1019; *see also In re E5 LLC*, 103 USPQ2d at 1580 (in analyzing a refusal under Section 2(a), the Board held that “how consumers will understand the meaning of the term ‘CU’ must be evaluated in relation to the goods for which registration is sought.”); *Simmons*, 192 USPQ at 332 (“In order for a mark to be deceptive and fall within the proscription of Section 2(a) of the Statute, it must ... have a tendency to deceive ... the average purchaser of the goods in connection with which the mark is used.”) (citing *Roselux Chem. Inc. v. Parson’s Ammonia Co., Inc.*, 132 USPQ at 632 (whether a term or mark is merely descriptive must be decided in relation to the goods for which registration is sought and the impact that it is likely to make on the average purchaser of those goods)). Thus, the Examining Attorney’s argument that “the relevant consumers that encounter the applicant’s goods in the marketplace are not aware of the limitations

put into the applicant's identification of goods,"⁶⁰ is inapposite because, as discussed above, we must consider the refusal in connection with the description of goods (i.e., apparel sold interactively where the products are modeled and detailed information about the composition of the clothing is provided).

Likewise, the Examining Attorney's argument that "deception can attach prior to seeing or encountering the goods on applicant's television and online ordering platforms,"⁶¹ is inapplicable. Because the description of goods provides that Applicant's apparel be sold through "interactive television and interactive online media," there is no opportunity for consumers to encounter Applicant's apparel before it is offered on television or online where Applicant provides information about its material composition.

In this regard, the majority's conclusion that "[t]he fact that clothing is 'modeled,' which sometimes consists of a photo of someone wearing the clothes on Applicant's website, does not prevent a consumer from believing the misdescription," is an incomplete analysis. The description of goods provides not only that the clothing is modeled, but that Applicant provides information about the material composition.

Applicant's description of goods makes it clear that the clothing products are not made of denim and that the apparel includes "detailed information regarding ... the fabrics and materials from which such clothing products are made." David O'Connor's

⁶⁰ Examining Attorney's Brief (6 TTABVUE 4).

⁶¹ *Id.*

testimony supports how Applicant markets its apparel in accordance with the description of goods to avoid deception.

8. The fabric content of DENIM & CO. clothing is clearly and conspicuously marked for the consumer; thus there can be no plausible question of deception. Both on air and online, [Applicant] identifies the material from which its DENIM & CO. garments are made. These include jersey, cotton, gauze, gingham, seersucker, linen, terry, stretch lace, mesh lace, and leather, to name a few. For example, the “Product Detail” for each of the garments shown below announces the material from which the garment is made, right below the skew number for the product:

[A representative garment is reproduced below]

QVC » Product Detail

A390115

Denim & Co Fit & Flare Stretch Lace Elbow Sleeve Top

★★★★☆ (2)



9. Moreover, if the material is not explicitly mentioned in the Product Detail, it is listed under “Fabrication” and/or

“Content” under the caption “Description” below the picture of the item.⁶²

Therefore, even if consumers were not aware of the materials comprising Applicant’s apparel before encountering the products, it is very difficult to see how consumers are deceived by the mark into believing that Applicant’s apparel is made of denim when the apparel includes detailed information about its composition. Moreover, purchasers are not likely to purchase clothing without looking at the clothing and its description first. Such consumers would not, upon seeing the mark DENIM & CO. used for Applicant’s non-denim clothing as set forth in the description of goods, conclude that the apparel was made of denim.

The Examining Attorney and the majority base their analysis on the description of goods as clothing per se, not clothing sold through interactive television and interactive online media wherein “detailed information regarding such clothing products is provided including information as to the fabrics and materials from which such clothing products are made.” The Examining Attorney contends first, that consumers are not aware of restrictions or limitations in the description of goods and second, that Applicant’s detailed information regarding the composition of Applicant’s apparel is “akin to the argument that applicant’s advertising would make consumers aware of the misdescription,” but that advertising is not relevant in the descriptiveness analysis.⁶³ As noted above, registrability, even in a Section 2(a)

⁶² David O’Connor Decl. attached to the July 10, 2017 Response to Office Action (TSDR 14-17).

⁶³ Examining Attorney’s Brief (6 TTABVUE 4).

refusal that Applicant's mark is deceptive, is determined in connection with the description of goods or services at issue. In this appeal, Applicant's description of goods includes the explanatory statement that the apparel is sold through interactive television and interactive online media where the clothing is modeled and "detailed information regarding such clothing products is provided including information as to the fabrics and materials from which such clothing products are made." The explanation of how the goods are sold as part of the description of goods cannot be ignored.

In this regard, the TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) § 1203.02(f)(i) (2018) provides the following instruction:

Amending an identification of services to add "featuring" or "including" a material term (e.g., "restaurants featuring "organic cuisine" and "retail furniture stores including leather furniture") generally is sufficient to obviate deceptiveness. For example, as long as the identification indicates that the restaurant provides organic cuisine, or the furniture store sells leather furniture, there is no deception even if other types of food or furniture are also available.

Further, the Examining Attorney's and the majority's reliance on *Budge* is inapposite because, in *Budge*, the explanatory statements in advertising and labels were not part of the description of goods.⁶⁴ Likewise, the majority's reliance on *Woolrich Woolen Mills* and *Shapely* is inapposite because in those cases the Board discounted labeling requirements because there is no assurance that consumers will check labels to determine fabric content. As noted numerous times in this dissent,

⁶⁴ *Id.*

the description of goods includes an expression that the clothing at issue includes information about its material composition. Providing information about the material composition is essential, not extraneous, to the description of goods.

The majority contends that “consumers using Applicant’s website may focus on the DENIM & CO. mark without paying attention to whatever fabric content disclosure is provided, which, based on the identification, we cannot be assured would be prominent.” If the Examining Attorney were concerned about the prominence of the fabric disclosure, he should have raised the issue during examination and required Applicant to provide a clarification in the description of goods. However, the Examining Attorney accepted the description of goods including providing information about the material content.

It is not the duty, nor within the capacity, of the USPTO to monitor consumers’ purchasing habits or to police how applicants and registrants use their marks outside of ensuring that they meet the requirements of the Trademark Act. Further, when branded products are also subject to federal labeling requirements, there is a stronger basis for concluding that the labeling and advertising combine to inform consumers unlikely to rely on the mark alone as a specification of the type of fabric a wide array of clothes are made of.

The majority contends, “Applicant submitted promotional materials that advertise its clothing with photos of models and general descriptions such as ‘chunky knit shawl-collar sweater’ and without fabric content disclosures.” If the advertisements do not include “information as to the fabrics and materials from

which such clothing products are made,” then those products are not covered by the description of goods in the registration. Plus, why is the conclusion that the mark, rather than the fabric content label or complementary advertising, will be relied on to inform the purchasers of fabric content, the more logical conclusion than the converse? If the concern is about initial interest deception, the likelihood of that type of deception being a problem is undercut by a long period of successful use of the mark. The mark would not have remained in use for as long as it has if it was repeatedly causing consumer deception.

Finally, the circumstances regarding Applicant’s long, extensive, and successful use of DENIM & CO. for clothing made of denim and other materials is similar to the facts in *Woolrich Woolen Mills*.

[T]he circumstances in this case are somewhat different because of applicant’s evidence of long use of the marks on a wide variety of clothing made of both woolen and nonwoolen fabrics. Applicant has stated that, by type of item, it offers more nonwoolen than woolen clothing, and the catalogs it has submitted demonstrate this point. Further, applicant uses its marks as housemarks for all of its clothing, of whatever fabric, as indicated in its identifications of goods. In view of these facts, consumers are likely to regard applicant’s marks as identifying all the clothing applicant sells and not believe they refer only to clothing made of wool.

Woolrich Woolen Mills, 13 USPQ2d at 1238. Likewise, Applicant has been using DENIM & CO. on women’s apparel since as early as January 1994 and it is Applicant’s “most popular and best-selling proprietary brand of clothing, selling

several million units' worth and literally billions of dollars' worth of DENIM & CO. branded garments over its 23 year history.”⁶⁵

With millions of consumers purchasing clothing items from [Applicant's] DENIM & CO. line over a 23 year period, it is abundantly clear that consumers are purchasing these items due to the high quality of these goods and due to the well-established fame and extensive goodwill associated with the DENIM & CO. mark, and not because of their mistaken notion that [Applicant's] jersey, cotton, gauze, gingham, seersucker, linen, terry, lace, and leather clothing is made of denim.⁶⁶

Accordingly, as in *Woolrich Woolen Mills*, consumers are likely to regard DENIM & CO. as identifying all clothing Applicant sells and not believe the mark refers only to clothing made of denim.

Under the circumstances, I conclude that DENIM & CO. as applied to “women’s clothing, namely, shirts, dresses, skirts, tops, bottoms, sweaters, shorts, pants, jackets, leggings, t-shirts made of materials other than denim all sold through interactive television and interactive online media wherein the clothing products offered for sale are modeled and whereby detailed information regarding such clothing products is provided including information as to the fabrics and materials from which such clothing products are made” is not deceptive.

I further conclude that because DENIM & CO. used in connection with the products set forth in the description of goods is not deceptive, the word “Denim” is not

⁶⁵ O’Connor Decl. ¶4 (July 10, 2017 Response to Office Action (TSDR 12)).

⁶⁶ *Id.* at ¶12 (TSDR 19).

deceptively misdescriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), and it need not be disclaimed.