

This Opinion is not a
Precedent of the TTAB

Mailed: March 8, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board

—
In re Tang

—
Serial No. 87630035

—
Adam E. Schwartz of Schwartz Intellectual Property Law PLLC
for Guozhou Tang.

Katherine C. Weigle Examining Attorney, Law Office 101,
Ronald R. Sussman, Managing Attorney.

—
Before Kuhlke, Ritchie and Heasley,
Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Guozhou Tang (“Applicant”) seeks registration on the Principal Register of the standard character mark NEW SILK ROAD for various items of jewelry and jewelry related goods in International Class 14; leather and leather goods in International Class 18; and various clothing items in International Class 25.¹

¹ Application Serial No. 87630035 was filed on October 2, 2017, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intention to use the mark in commerce.

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a), on the ground that it is deceptive. The refusal to register only applies to the clothing in International Class 25. When the refusal was made final, Applicant appealed and briefs have been filed. We reverse the refusal.

In accordance with Section 2(a) of the Trademark Act, registration must be refused if a term is deceptive with respect to a feature or an ingredient of the identified goods. *In re Budge Mfg. Co. Inc.*, 857 F.2d 773, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988). The test for deceptiveness is whether all three of the following criteria are met:

- (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 purchasing decision of a significant portion of relevant consumers?

Id.; see also *In re Spirits Int'l, N.V.*, 563 F.3d 1347, 90 USPQ2d 1489, 1495 (Fed. Cir. 2009) (holding that the test for materiality incorporates a requirement that a "significant portion of the relevant consumers be deceived").

The Examining Attorney argues that SILK is misdescriptive of the goods because they are not primarily made of silk, consumers are likely to believe the misdescription, and the misdescription is material because clothing primarily made of silk is more appealing and desirable. Applicant argues that consumers would understand the mark NEW SILK ROAD as a reference to the historical Silk Road

widely known to consumers; the word SILK would not be taken by itself, rather consumers would perceive the meaning of the unitary whole NEW SILK ROAD. In support of its position, Applicant submitted an extended excerpt from Wikipedia describing the Silk Road:²

The Silk Road or Silk Route was an ancient network of trade routes that were for centuries central to cultural interaction originally through regions of Eurasia connecting the East and West and stretching from the Korean peninsula and Japan to the Mediterranean Sea. ... While the term is of modern coinage, the Silk Road derives its name from the lucrative trade in silk carried out along its length ... Trade on the Silk Road played a significant role in the development of the civilizations of China, Korea, Japan, the Indian subcontinent, Persia, Europe, the Horn of Africa and Arabia, opening long-distance political and economic relations between the civilizations. Though silk was certainly the major trade item exported from China, many other goods were traded, as well as religions, syncretic philosophies, and various technologies. ... In addition to economic trade, the Silk Road was a route for cultural trade among the civilizations along its network. ... In June 2014, UNESCO designated the Chang'an-Tianshan corridor of the Silk Road as a World Heritage Site.

The Examining Attorney is correct that “[a] mark is deceptive even if only a portion of the mark is deceptive.” Ex. Att. Br. 6 TTABVUE 10 (citing *In re White Jasmine LLC*, 106 USPQ2d 1385, 1391 (TTAB 2013) (WHITE JASMINE deceptive for tea that did not include white tea)). *See also In re Shapely, Inc.*, 231 USPQ 72 (TTAB 1986) (SILKEASE deceptive for clothing not made of silk). However,

² March 22, 2018 Response at 5. Citations to the application record refer to the Trademark Office’s online Trademark Status and Document Retrieval system (TSDR) by date and page number.

“[m]isdescriptiveness 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 Mfg.*, 8 USPQ2d at 1261 (citing *A.F. Gallun & Sons Corp. v. Aristocrat Leather Prods., Inc.*, 135 USPQ 459, 460 (TTAB 1962) (COPY CALF not descriptive, but rather suggests imitation of calf skin)).

Although the word SILK might be misdescriptive of goods not made with silk, we must consider the term with regard to the mark as a whole. *A.F. Gallun v. Aristocrat*, 135 USPQ at 460. *See also In re Sharky’s Drygoods Co.*, 23 USPQ2d 1061, 1062 (TTAB 1992) (reversing refusal under Section 2(a) to register PARIS BEACH CLUB because in context, PARIS is part of an incongruous and humorous phrase, and would not be understood as the geographic origin of the goods). Even in a Section 2(a) refusal that narrows the focus on the allegedly deceptive matter, the refusal may not be based on taking the term out of context when doing so would change its significance in the mark. *In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1748 (TTAB 2016).

We find THE NEW SILK ROAD to be more in the nature of COPY CALF and PARIS BEACH CLUB in that the term SILK in the phrase NEW SILK ROAD cannot be separated from the meaning derived from the whole mark NEW SILK ROAD. While it may be that the “Silk Road derived its name precisely because silk was a major trade product along such routes” (Ex. Att. Br. 6 TTABVUE 11), the meaning and commercial impression of the SILK ROAD is not limited to trading in silk products. The Silk Road is a historical trading route known for trade in many

products, as well as expanding economic, cultural and technological exchange around the world. Contrary to the Examining Attorney's position, the wording NEW SILK ROAD does "create a distinct, independent meaning, separate and apart from the significance of its parts." Ex. Att. 6 TTABVUE 11. Because taking the word SILK out of context changes the significance of the term, we find that SILK in the mark NEW SILK ROAD is not deceptively misdescriptive, and the applied-for mark, taken as a whole, is not deceptive under Section 2(a).

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