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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Dillard's Inc.

Serial No. 75/479,731

Simor L. Moskowitz and Matthew J. Cuccias of Jacobson,
Price, Holman & Stern, PLLC for applicant.

Caitlin Riley, Trademark Examining Attorney, Law Office 108
(David E. Shallant, Managing Attorney).

Before Simms, Cissel and Seeherman, Administrative
Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Dillard's Inc. (applicant), a Delaware corporation,
located in Little Rock, Arkansas, has appealed from the
final refusal of the Trademark Examining Attorney to
register the mark DENIM RIDGE for men's shirts, shorts,
pants, jeans, jackets, and sweaters.¹

The Examining Attorney has refused registration under
Section 2(a) of the Act, 15 USC §1052(a), arguing that

¹Application Serial No. 75/479,731, filed May 5, 1998, based upon applicant's allegation of a bona fide intention to use the mark in commerce. During prosecution, pursuant to request, applicant submitted a disclaimer of the word "DENIM" apart from the mark.

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applicant's mark is deceptive. Applicant and the Examining Attorney have submitted briefs, and an oral argument was held.

We affirm.

It is the Examining Attorney's position that applicant's mark DENIM RIDGE for such goods as men's shirts, shorts, pants, jeans, and jackets is deceptive if the goods do not contain denim. During prosecution, the Examining Attorney advised applicant that, if its goods contain or will contain denim, it should amend the identification of goods to state that its goods are made of denim in whole or in part. Applicant initially stated that it anticipated that some but not all of its goods will be made of denim, but applicant did not amend its description of goods as requested by the Examining Attorney. The Examining Attorney stated that she would presume that applicant's goods will not be made of denim, in view of applicant's failure to amend its description of goods. Applicant did not thereafter claim that its goods will be made of denim in whole or in part.

The Examining Attorney has made of record definitions and other information about denim. For example, Webster's II New Riverside University Dictionary (1994) defines "denim" as follows:

1. a. A coarse twilled cloth used for jeans, overalls, and work uniforms. b. denims. Garments made of coarse denim. 2. A finer grade of denim material used in draperies and upholstery.

From The Modern Textile and Apparel Dictionary (4th Edition 1973), the Examining Attorney made of record the following information:

This fabric has a history that goes back, as far as is known, about 1,600 years to the present city of Nimes, France, where it was first known as "Serge de Nimes" and later Americanized into denim. In this country, this strong, sturdy fabric was first used between The War of 1812 and The War Between the States as covering for the famed Conestoga Wagons that carried hardy pioneers across the long trails going to the West.

This staple cotton cloth is rugged and serviceable, and is recognized by a left-hand twill on the face. Coarse single yarns are used most, but some of the cloth used for dress goods may be of better quality stock...

Standard denim is made with indigo-blue-dyed warp yarn and a gray or mottled white filling. It is the most important fabric in the work-clothes group and it is used for overalls, coats, jumpers, caps. Denim is also popular in dress goods in the women's wear field and has even been used as evening wear...

Finally, the Examining Attorney made the following definition of record from the AF Encyclopedia of Textiles

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(2nd Edition 1972): "strong fabric; launders well. Used for furniture covering, work clothing, and play suits."

Relying upon the test for deceptiveness set forth in *In re Budge Mfg. Co.*, 857 F.2d 773, 8 USPQ2d 1259 (Fed. Cir. 1988), *aff'g* 8 USPQ2d 1790 (TTAB 1988), the Examining Attorney argues that the word "DENIM" in applicant's mark misdescribes a characteristic, quality or composition of applicant's clothing; that prospective purchasers are likely to believe this misdescription of applicant's goods; and that this misdescription will affect the relevant public's purchasing decision. In this regard, the Examining Attorney points to the evidence, described above, that denim is a popular fabric from which clothing is made, that it is the most important fabric for working clothes, that it is rugged, launders easily and is, therefore, a desirable fabric.

The Examining Attorney has also made of record many third-party registrations wherein the listed goods are stated to be made of denim in whole or in part and wherein the term "DENIM" was disclaimed.

Applicant, on the other hand, argues that DENIM RIDGE does not connote a type of fabric and that potential purchasers would not believe that it does. According to applicant, the term DENIM in its mark is not such a term

that, if none of its clothing contains this fabric, purchasers would be deceived. In other words, the absence of denim from applicant's clothing will not affect the purchasing decision, applicant contends. Rather, applicant maintains that its mark is suggestive of a geographic location (applicant's record shows that Denim Hill is a summit in Sharp County, Arkansas) and that the mark "evoke[s] an association with the type of environment in which one is comfortable wearing more casual-style clothing." Supplemental Appeal Brief, 5. Applicant maintains that the Examining Attorney has not offered evidence to show that consumers are likely to believe that applicant's goods are made of denim or that they would believe the misrepresentation.

For its part, applicant has made of record other third-party registrations for marks which include the word "DENIM" and where there is no indication in the identification of goods that the goods are made of denim in whole or in part.² Accordingly, applicant argues that consumers are accustomed to seeing the word "DENIM" in trademarks for clothing that may not contain denim.

On remand, applicant introduced pages from various catalogs wherein applicant claims that the word "Denim" is

²However, these registrations include a disclaimer of this word.

used in connection with clothing and other goods that are not made of denim. For example, applicant points to a product described as "Denim Wool Dhurrie Rug," not made of denim.³ Other catalog pages use the word "Denim" and other phrases containing the word "Denim" ("Denim Heather," "Light Denim Heather," "Denim Blue Heather" and "Denim Blue"). Applicant also asks us to resolve any doubt on the issue of registrability in its favor.⁴

In response to some of the third-party registrations submitted by applicant, the Examining Attorney stated that they issued for goods which one would not expect to be made of or to contain denim, such as ceramic tile, sewing machines, pencils, cologne and paper products. Furthermore, the Examining Attorney argues that, with respect to the catalogs, the term "Denim" therein is used to identify a color. Finally, the Examining Attorney maintains that each case should be decided on its own facts, and that an Examining Attorney is not bound by the

³This rug is described as follows: "Enrich your room with the natural beauty and warmth of handwoven virgin wool. Denim blue with accents of rust and red in long-lasting colorfast Swiss dyes..."

⁴While the Examining Attorney objected to some of applicant's exhibits, applicant in fact submitted these exhibits with its unopposed motion to remand this case to the Examining Attorney. In the motion, applicant indicates that the Examining Attorney advised that she did not oppose the remand. On remand, the Examining Attorney did not take issue with this statement and did not object to the evidence at that time. Accordingly, we have considered all of the exhibits of record.

conclusions of other Examining Attorneys in different cases.

Section 2(a) of the Trademark Act, 15 USC §1052(a), bars registration of deceptive matter on the Principal Register. Deceptive marks may include marks that falsely describe the material content of a product. See *In re Intex Plastics Corp.*, 215 USPQ 1045 (TTAB 1982).

The Court of Appeals for the Federal Circuit has articulated the following test for whether a mark consists of or comprises deceptive matter:

- (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., *supra* (LOVEE LAMB held deceptive for seat covers not made of lambskin). The determinative nature of the third inquiry, *i.e.*, the materiality of the misdescription to the purchasing decision, is indicated in the following statement by the Board:

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If the mark misdescribes the goods, and purchasers are likely to believe the misrepresentation, but the misrepresentation is not material to the purchasing decision, then the mark is deceptively misdescriptive (citation omitted)...

Bureau National Interprofessionnel Du Cognac v.

International Better Drinks Corp., 6 USPQ2d 1610, 1615

(TTAB 1988).

In this case we believe the Examining Attorney has shown that the word "DENIM" in applicant's mark would be misdescriptive of applicant's clothing, most of which could well be made of denim, that potential purchasers would be likely to believe this misdescription, and that, because of the desirability of this fabric ("strong," "sturdy," "rugged," "launders well," "serviceable"), this misdescription will affect the decision to purchase applicant's clothing.

This case is not unlike the case of *Evans Products Co. v. Boise Cascade Corp.*, 218 USPQ 160 (TTAB 1983), wherein the Board held that the mark CEDAR RIDGE was deceptive for embossed hardboard siding not made of cedar. What we said in that case, at 163-64, with respect to a use-based application, is noteworthy:

...we believe that use of the mark CEDAR RIDGE for non-cedar siding products

which simulate cedar is likely to cause purchasers to believe that applicant's goods are in fact made of cedar, either in whole or in part. The denomination of applicant's product by this mark, which we believe signifies to purchasers that it is composed of cedar when it is not, is deceptive. [Citations omitted.]

Nor do we believe that the deceptive significance of the term CEDAR for a non-cedar product is lost by its combination with the word RIDGE. Indeed, applicant has acknowledged in its brief that the term "Ridge" suggests the surface configuration of the embossed hardboard siding. In this regard, deception has been found where the offending word has been combined with a suggestive term and even where the significance of the mark as a whole was not entirely clear. [Citations omitted.]

Finally the third-party registrations (submitted by applicant with respect to the issue of likelihood of confusion) containing the word "Cedar" or its phonetic equivalent are inconclusive. Although most of those registrations issued for wood products, it is not clear from the record whether those registrations covered goods which included cedar. In any event, we cannot draw the conclusion from these registrations alone that the public is so conditioned by the use of the word "Cedar" or a phonetic equivalent that they are likely to assume that the inclusion of this word in applicant's mark only suggests a cedar-like characteristic or appearance..

Here, too, we believe that applicant's mark DENIM RIDGE is deceptive because purchasers will believe that

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applicant's clothing is made from denim fabric. The Examining Attorney has presented a prima facie case that the misdescription contained in applicant's mark is likely to be believed and that, because denim is a desirable fabric, the misdescription contained in the mark will affect the purchasing decision. See also *In re Organik Technologies, Inc.*, 41 USPQ2d 1690 (TTAB 1997)(ORGANIK deceptive for clothing and textiles made from cotton that is neither from an organically grown plant nor free of chemical processing or treatment, notwithstanding applicant's assertions that the goods are manufactured by a process that avoids the use of chemical bleaches, because the identification of goods was broad enough to include textiles and clothing manufactured with chemical processes or dyes); *In re Shapely, Inc.*, 231 USPQ 72 (TTAB 1986)(SILKEASE held deceptive as applied to clothing not made of silk); *In re Intex Plastics Corp., supra* (TEXHYDE held deceptive as applied to synthetic fabric for use in the manufacture of furniture, upholstery, luggage and the like); *Tanners' Council of America, Inc. v. Samsonite Corp.*, 204 USPQ 150 (TTAB 1979)(SOFTHIDE held deceptive for imitation leather material); and *In re U.S. Plywood Corp.*, 138 USPQ 403 (TTAB 1963)(IVORY WOOD for lumber and timber

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products held deceptive since the goods were not made of ivorywood nor did they contain an ivorywood pattern).

Applicant's argument that its mark will be perceived as a geographic location is unsupported by anything in the record. There is no evidence of any place named Denim Ridge, only Denim Hill. Also, with respect to the use of such terms as "Denim Heather" and "Denim Blue" in the catalogs applicant has made of record, we agree with the Examining Attorney that these terms are being used as colors, and they do not show that the term "denim" is being used on products not made of denim.

Finally, a disclaimer of the deceptive matter cannot avoid the refusal under §2(a). See *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539, 1541-42 (Fed. Cir. 1999); *American Speech-Language-Hearing Association v. National Hearing Aid Society*, 224 USPQ 798, 808 (TTAB 1984); and *In re Charles S. Loeb Pipes, Inc.*, 190 USPQ 238, 241 (TTAB 1975). Accordingly, the disclaimer earlier entered into the record cannot serve to avoid the refusal.⁵

⁵ While the dissent points out, correctly, that the determination of descriptiveness or suggestiveness is sometimes subjective, we believe that the case law cited by the dissent, as well as other authority, supports the determination of misdescriptiveness and, therefore, of deceptiveness here. See, for example, *Hoover Co. v. Royal Appliance Manufacturing Co.*, 238 F.3d 1357, 57 USPQ2d

Decision: The refusal to register is affirmed.

Seeherman, Administrative Trademark Judge, dissenting;

As the majority correctly points out, the test for
deceptiveness set out in *In re Budge Mfg. Co.*, 857 F.2d

773, 8 USPQ2d 1259, 1260, is as follows:

- 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?
(emphasis added)

1720 (Fed. Cir. 2001)("Number One in Floorcare" held not inherently distinctive); *R. Neumann & Co. v. Overseas Shipments, Inc.*, 326 F.2d 786, 140 USPQ 276, 279 (CCPA 1964)("We are unable to subscribe to the reasoning...that 'DURA-HYDE' would at most merely suggest that appellee's nonleather goods of leatherlike appearance 'are as durable as leather' (emphasis supplied). The interjection of as between 'durable' and 'hide' supplies a distorted connotation"); and *In re Shapely, Inc. supra*, at 73 ("There is no question that the presence of the noun 'silk' as a prefix renders the mark SILKEASE misdescriptive of appellant's blouses and dresses which contain no silk fibers"). See also *In re Wada, supra* (Board's finding that the primary geographic significance was not lost by the addition of WAYS GALLERY in the expression NEW YORK WAYS GALLERY affirmed against an argument that the mark evoked a gallery that featured New York "ways" or "styles," appellant having failed to bring forth any evidence of a "New York style" of the goods). Similarly, applicant here has shown no evidence of the existence of a place called Denim Ridge, or any other connotation of this term.

Thus, before reaching the question of whether a mark is deceptive, namely, that the misdescription is likely to affect the decision to purchase, we must first consider whether the mark is deceptively misdescriptive.

The first question is whether the term DENIM RIDGE is misdescriptive of the character, quality, function, composition or use of the goods. It is on this point that I disagree with the majority.

The test for determining whether a mark is deceptively misdescriptive is essentially the same for that in determining whether a mark is merely descriptive of the goods or services. Specifically, the mark as a whole must misdescribe the goods or services by conveying immediate or precise significance with respect to the applicant's goods or services, such as by immediately describing an alleged specific feature, quality or characteristic of the applicant's goods. *U.S. West Inc. v. BellSouth Corp.*, 18 USPQ2d 1307 (TTAB 1990) (THE REAL YELLOW PAGES found to be not merely descriptive or deceptively misdescriptive for yellow page classified directories).

Although the word DENIM would clearly be deceptively misdescriptive of the clothing items identified in the application which are not made of denim, the mark which is before us is not DENIM per se, but DENIM RIDGE. As this

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Board has said in making determinations as to whether marks are merely descriptive, there is often a thin line of distinction between a suggestive and a merely descriptive term, and it is often difficult to determine when a term moves from the realm of suggestiveness into the sphere of impermissible descriptiveness. *In re Recovery, Inc.*, 196 USPQ 830 (TTAB 1977).

In this case, I think that DENIM RIDGE falls on the suggestive side of that line. The mark does not convey that the clothing is made of denim; rather, DENIM RIDGE conjures up a place in the country or outdoors in which one can wear casual clothing. As a result, I would find the mark to be suggestive. See *Hoover Co. v. Royal Appliance Manufacturing Co.*, 238 F.3d 1357, 57 USPQ2d 1720 (Fed. Cir. 2001) (THE FIRST NAME IN FLOORCARE held suggestive, and not deceptively misdescriptive of electrical vacuum cleaners).⁶

The CEDAR RIDGE case, *Evans Products Co. v. Boise Cascade Corp.*, 218 USPQ 160 (TTAB 1983), quoted in the majority opinion, is distinguishable on its facts. The

⁶ The majority comments that this case supports the position that DENIM RIDGE is deceptively misdescriptive, noting that the mark NUMBER ONE IN FLOORCARE was held not to be inherently distinctive. I would point out that this holding referred to the opposer's unregistered mark which had been asserted in connection with its claim of likelihood of confusion; applicant's mark, THE FIRST NAME IN FLOORCARE, was applied for on the Principal Register without resort to Section 2(f), and the Court held that this mark is not deceptively misdescriptive.

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applicant in that case acknowledged "that the term 'Ridge' suggests the surface configuration of [its] embossed hardboard siding." Id. at 164. In the present case, on the other hand, RIDGE has no descriptive significance whatsoever with respect to the identified clothing. On the contrary, RIDGE is an arbitrary term for such goods.

We note that in the Cedar Ridge decision the Board stated "deception has been found where the offending word has been combined with a suggestive term and even where the significance of the mark as a whole was not entirely clear. Id. at 164. The cases cited in support of this proposition, however, reflect use of suggestive terms which relate to the misdescriptive term in such a way that the term in its entirety takes on a misdescriptive meaning. For example, in *R. Neumann & Co. v. Bon-Ton Auto Upholstery, Inc.*, 326 F.2d 799, 140 USPQ 245 (CCPA 1964), VYNAHYDE was held to be deceptive and deceptively misdescriptive of plastic film and plastic film made into furniture slip covers; obviously the suggestive element VYNA modified HYDE. Similarly, the elements TEX in TEXHYDE, *In re Intex Plastics Corporation*, 215 USPQ 1045 (TTAB 1982) and DURA in DURA-HYDE, *R. Neumann & Co. v. Overseas Shipments, Inc.*, 326 F.2d 786, 140 USPQ 276 (CCPA 1964) modify HYDE. That is not the situation here, where

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the element DENIM modifies RIDGE, so that the mark DENIM RIDGE as a whole is suggestive of a casual setting, rather than of denim material.

Accordingly, I would reverse the refusal of registration.