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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Wai Kwong Wong

Serial No. 76395781

Maria V. Hardison of Tassan & Hardison.

Scott Oslick, Trademark Examining Attorney, Law Office 108 (Andrew Lawrence, Managing Attorney).

Before Hanak, Quinn and Hairston, Administrative Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Wai Kwong Wong (applicant) seeks to register in standard character form DUCHESSE for “women’s clothing, namely, dresses, pants, skirts, tops, jeans and shorts.” The intent-to-use application was filed on April 9, 2002.

Citing Sections 2(e)(1) and 2(a) of the Trademark Act, the Examining Attorney has refused registration on the basis that applicant’s mark is both deceptively misdescriptive and deceptive as applied to the goods for which applicant seeks

registration. When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request an oral hearing.

To establish that a mark is deceptively misdescriptive pursuant to Section 2(e)(1), a two-fold test must be met. First, it must be shown that the mark misdescribes a characteristic or quality of the relevant goods or services. Second, it must also be shown that prospective purchasers are likely to believe that the misdescription actually describes the relevant goods or services.

In order for a mark to be held deceptive pursuant to Section 2(a), not only must the foregoing two tests be satisfied, but in addition, a third test must be satisfied, namely, that the misdescription is likely to materially affect the decision to purchase the relevant goods or services. In re Budge Manufacturing Co. Inc., 857 F.2d 773, 8 USPQ2d 1259, 1261 (Fed. Cir. 1988); In re Berman Bros. Harlem Furniture Inc., 26 USPQ2d 1514, 1515 (TTAB 1993).

We reverse the refusal to register because, at a minimum, the Examining Attorney has failed to prove the second part of the foregoing two and three part tests. In other words, the Examining Attorney has failed to prove that

prospective purchasers of women's apparel are likely to believe that the mark DUCHESSE actually describes women's clothing.

The record reveals that the word "duchesse" is an obscure word with two distinct meanings. Applicant notes that "duchesse" is the Middle English form of the word "duchess" which is defined as "the wife or widow of a duke," or as "a woman who holds the rank of duke in her own right." Applicant cites the Merriam-Webster Online dictionary. Applicant further points out that this online dictionary does not have any other meaning for the word "duchesse." This Board has consulted its own dictionary which defines the word "duchesse" as likewise being a Middle English form of the word "duchess." Webster's New World Dictionary (2d ed. 1970). This second dictionary, like the Merriam Webster OnLine dictionary, contains no other definition for the word "duchesse."

As applied to women's clothing, the mark DUCHESSE, meaning "duchess," does not describe or misdescribe said clothing. Rather, when viewed as but a variation of the word "duchess," the mark DUCHESSE is merely laudatory as applied to women's clothing suggesting that the clothing is fit for nobility. In this sense, the mark DUCHESSE functions like

the words “princess” or “queen” as applied to women’s clothing.

The Examining Attorney has never contended that the mark DUCHESSE, if understood to mean “duchess,” is deceptively misdescriptive or deceptive as applied to women’s clothing. Rather, it is the contention of the Examining Attorney that the mark DUCHESSE has a second meaning which is not found in dictionaries, and that this second meaning of the mark DUCHESSE causes it to be deceptively misdescriptive and deceptive as applied to women’s clothing. In this regard, the Examining Attorney has made of record fewer than 25 articles and advertisements in which the word “duchesse” is used to describe a type of satin or silk. For example, the September 9, 2001 edition of the Pittsburgh Post-Gazette contains a story which reads, in part, as follows: “Steve Stolman’s clothes are known for fabulous fabrics … such as … duchesse satin ballskirt ($350).” Another article appearing in the March 18, 1995 edition of The New York Times makes reference to “satin duchesse skirts.” The January 29, 1995 edition of The San Francisco Examiner contains the following sentence: “She should probably go for a very clean shape, very classical, in one fabric, like a duchesse satin.”

The Examining Attorney's evidence demonstrates that as used to describe a type of fabric, the word "duchesse" is an extremely obscure term. As previously noted, the Examining Attorney made of record fewer than 25 articles and advertisements using the word "duchesse" to describe a type of fabric. Moreover, in all of the articles and advertisements made of record by the Examining Attorney, the word "duchesse" always appears in conjunction with the word "satin" or, to a much lesser extent, the word "silk." In not one of the articles or advertisements made of record by the Examining Attorney does the word "duchesse" stand alone. Said word is always followed by, or in a very few cases, preceded by the words "satin" or "silk."

Applicant has conceded that his women's clothing will not contain "duchesse satin." However, this does not mean that applicant's mark DUCHESSE is deceptively misdescriptive or deceptive as applied to women's clothing. Put quite simply, the word "duchesse" is an extremely obscure term with two distinct meanings. When viewed as an alternate spelling of the word "duchess," the mark DUCHESSE is not deceptively misdescriptive or deceptive, and the Examining Attorney does not contend otherwise. When used in this context, the mark DUCHESSE is but a laudatory term as applied to women's

clothing, much like the words “princess” and “queen.” As previously noted, the mark DUCHESSE suggests nobility.

Of course, the word “duchesse” has a second obscure meaning, namely, to identify a particular type of satin. However, even if we assume purely for the sake of argument that in this context the word “duchesse” misdescribes women’s clothing which does not contain duchesse satin, this does not mean that the mark DUCHESSE is deceptively misdescriptive or deceptive. Put quite simply, we find that, at a minimum, the Examining Attorney has simply failed to prove the second part of the test(s) for establishing that a mark is deceptively misdescriptive or deceptive. To elaborate, the Examining Attorney has failed to prove that prospective purchasers of women’s clothing would understand the word “duchesse,” <u>standing alone</u>, as indicating the fabric content of the clothing. As previously noted, all of the Examining Attorney’s evidence shows that when the word “duchesse” is used to indicate a type of fabric, it is always used in proximity to the words “satin” or “silk.” There is simply no evidence in the record that the word “duchesse” is ever used by itself to indicate the fabric content of women’s clothing.

Moreover, to the extent that a small number of purchasers of women’s clothing may understand the word

“duchesse,” they are just as likely to view it as an alternate form of the word “duchess” as they are to view it as indicating a type of satin or silk. As stated before, the Examining Attorney has never contended that if the word “duchesse” were understood to mean “duchess,” that the mark DUCKESSE would be either deceptively misdescriptive or deceptive as applied to women’s clothing.

Decision: The refusal to register is reversed.