

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Mailed:
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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Scalamandre Silks, Inc.

Serial No. 76619367

Myron Amer of Myron Amer, P.C. for Scalamandre Silks, Inc.

Attiya Malik, Trademark Examining Attorney, Law Office 112
(Angela Wilson, Managing Attorney).

Before Seeherman, Bucher and Walsh, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Scalamandre Silks, Inc. seeks registration on the
Principal Register of the mark **BERMUDA CLOTH** (*in standard
character format*), for goods identified, as amended, as
"textile, namely, of woven acrylic fibers."¹

This case is now before the Board on appeal from the
final refusal of the Trademark Examining Attorney to

¹ Application Serial No. 76619367 was filed on November 4,
2004 based upon applicant's allegation of a *bona fide* intention
to use the mark in commerce.

register this designation based upon the following three grounds:

1. That applicant's mark, when used in connection with the identified goods, so resembles the mark **BERMUDA** (*in standard character format*), which was registered for "window coverings, namely, vertical blinds"² in International Class 20, as to be likely to cause confusion, to cause mistake or to deceive. However, inasmuch as this registration has now been cancelled under Section 8 of the Act, this substantive basis for refusal has been rendered moot.
2. That the amended identification of goods, "textile, namely, of woven acrylic fibers," is indefinite, and hence, unacceptable.
3. That the word "Cloth" is an unregistrable component of this mark and hence, should be disclaimed apart from the mark as shown.

² Registration No. 2256829 issued on June 29, 1999, claiming first use anywhere and first use in commerce at least as early as November 1, 1997. However, according to the records of the United States Patent and Trademark Office, this registration has now been cancelled under Section 8 of the Act.

Applicant and the Trademark Examining Attorney have submitted briefs - significant portions of which deal with the now moot issue of likelihood of confusion.

Identification of goods

The Trademark Examining Attorney calls our attention to TMEP § 1402.03, "Specificity of Terms Used in Identifying Goods and Services." She argues that the current identification of goods must be amended because it is too broad.³ She takes the position that this identification of goods is indefinite, with the first part suggesting that the goods are finished textile fabrics but with the latter portion seeming to name a raw material.

The Trademark Examining Attorney is also correct in noting that the current proposed identification of goods is silent as to the stage of manufacture and the attendant fields of use. In order to correct this, the Trademark Examining Attorney further proposes that applicant amend the identification, if appropriate, to clarify that they are to be used " ... for home interiors."

³ In the application as originally filed, applicant identified its goods as "a textile, namely, of woven acrylic fibers." In response to the Trademark Examining Attorney's requirement, applicant slightly amended the identification of goods by deleting the term "a" so that the identification reads "textile, namely, of woven acrylic fibers" - the identification of goods that is currently at issue.

While this suggestion seems to comport with the uses shown in applicant's web pages, applicant refused to accept this amendment, arguing that its woven acrylic fibers are "not a textile fabric," and in fact, "could be used as a braid or cord for trimming a pillow, or furniture."

(Applicant's brief, p. 3).⁴

We note that the Trademark Office's "Acceptable Identification of Goods and Services Manual" - a listing of descriptions of goods (and services) deemed acceptable for use as identifications in applications - lists the following items: "chemical fiber fabrics," "cotton base mixed fabrics," "inorganic fiber mixed fabrics," "polyester fabric," "semi-synthetic fiber fabrics," "synthetic fiber fabrics" and "woven fabrics," among others.

Applicant has identified its goods as "textile, namely, of woven acrylic fibers." This identification is the equivalent of "woven acrylic fiber textiles," and would be understood as such by those attempting to ascertain

⁴ While we do not agree with the Trademark Examining Attorney on this particular requirement, we do note that applicant's own arguments on appeal serve to muddy the waters. By arguing that its woven acrylic fibers are "not a textile fabric" and "could be used as a braid or cord for trimming a pillow, or furniture," applicant raises a new specter of an indefinite identification of goods as well as possible misclassification. For example, synthetic fibers for textile use are classified in International Class 22 (acrylic yarn, for example), while fringes and tassels are classified in International Class 26.

applicant's rights, should a registration issue for that identification. Accordingly, we find the instant identification of goods to be sufficiently definite.⁵ The fact that this specific identification language does not appear in the Identification Manual does not mean, *per se*, that it is unacceptable. While the Identification Manual contains identifications that are acceptable, it does not purport to be an exhaustive list.

In view of applicant's arguments, as reported in footnote 4, regarding possible uses of its goods, and the classification concerns raised earlier by the Trademark Examining Attorney, we find that applicant's goods, as identified, are appropriately classified with other textile fabrics in International Class 24. We also note that, according to the evidence placed into the record by the Trademark Examining Attorney, applicant's website shows its goods are finished cloth fabrics used in upholstering sofas, ottomans, etc.

Accordingly, on this requirement, we reverse the refusal of the Trademark Examining Attorney.

⁵ Certainly this identification is as definite as the examples listed above from the Identification Manual.

Disclaimer

Section 6 of the Trademark Act, 15 U.S.C. § 1056(a), provides that "the Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable." Section 2(e)(1) of the Act, 15 U.S.C.

§ 1052(e)(1) prohibits, *inter alia*, registration of a term which, when used on or in connection with the goods of the applicant, is merely descriptive of them.

As noted, the Trademark Examining Attorney has required that applicant disclaim the word "Cloth" inasmuch as it is merely descriptive. Although this remains an intent-to-use application, the record shows that applicant is using the applied-for mark in connection with cloth upholstery fabrics, as noted above. Applicant's website entries show usage such as "fabric-20252 BERMUDA CLOTH" and "cloth-20252 BERMUDA CLOTH." On these web pages, the product categories parallel to "fabric" or "cloth" are "chair," "trim," "valance," "shade," "ottoman," etc.⁶ Hence, applicant itself uses the term "Cloth" as a category designation for the involved goods.

⁶ http://www.scalamandre.com/collect/collection_room/collection_roomframe.htm

As to applicant's conclusion that its composite mark comprises a unitary term ("the two words are so merged together that they cannot be divided to be regarded as separable elements," from applicant's reply brief, p. 2), applicant does not explain why this term is unitary, and we fail to see any such unity.

Decision: The refusal to register based upon an unacceptable identification of goods is hereby reversed. On the other hand, the refusal to register absent applicant's compliance with the Trademark Examining Attorney's requirement to disclaim the word "Cloth" (on the ground that this phrase is merely descriptive in connection with the identified goods) is affirmed.

Nonetheless, in accordance with Trademark Rule 2.142(g), this decision will be set aside and this application will be returned to the Trademark Examining Attorney to place in condition for publication for opposition, if applicant, no more than thirty days from the mailing date of this decision, submits an appropriately worded disclaimer, namely:

No claim is made to the exclusive right to use the word "Cloth" apart from the mark as shown.