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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Farouk Systems, Inc.

Serial No. 78646723

Ben D. Tobor of Greenberg Traurig, LLP for Farouk Systems, Inc.

Steven Fine, Trademark Examining Attorney, Law Office 110
(Chris A. F. Pedersen, Managing Attorney).

Before Drost, Kuhlke and Cataldo, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Farouk Systems, Inc., applicant, seeks registration on the Principal Register of the mark BIOSILK (in standard character form) for goods ultimately identified as "clothing, namely, women's blouses, sweaters, dresses, pants, jackets, and accessories; and men's clothing, namely, shirts, pants, jackets, and accessories" in International Class 25.¹

¹ Application Serial No. 78646723, filed June 8, 2005, alleging a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b).

Registration has been refused under Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), on the ground that applicant's mark is deceptive. In addition, the examining attorney also refused registration on the basis of a requirement that applicant amend its identification of goods to indicate, if accurate, that the clothing is made of silk.

When the refusals were made final, applicant appealed and briefs have been filed.²

As a preliminary matter, we note that the examining attorney does not address the requirement to amend the identification of goods other than to state that the requirement was made final and in connection with the refusal under Section 2(a) the examining attorney asserts that "since the applicant has declined to limit its clothing to clothing made of silk, the examining attorney must assume that at least some of the clothing will not be made of silk." Br. p. 3. Accordingly, we consider the requirement to amend the identification of goods no longer in issue and only consider the refusal under Section 2(a).

² The exhibits attached to applicant's reply brief are untimely and have not been considered. Trademark Rule 2.142(d). While the Board may take judicial notice of dictionary definitions, the Board may not take judicial notice of excerpts from online sources unless they have a printed equivalent. In re CyberFinancial.Net Inc., 65 USPQ2d 1789, 1791 n.3 (TTAB 2002).

Deceptiveness

The test for determining whether a mark is deceptive under Section 2(a) has been stated by the Court of Appeals for the Federal Circuit as: 1) is the term misdescriptive of the character, quality, function, composition or use of the goods; 2) are prospective purchasers likely to believe that the misdescription actually describes the goods; and 3) is the misdescription likely to affect the decision to purchase. In re Budge Manufacturing Co., Inc., 857 F.2d 773, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988) (LOVEE LAMB held deceptive for seat covers not made of lambskin). See also In re Phillips-Van Heusen Corp., 63 USPQ2d 1047 (TTAB 2002) (SUPER SILK held deceptive for clothing made of silk-like fabric) and In re Shapely, Inc., 231 USPQ 72 (TTAB 1986) (SILKEASE held deceptive as applied to clothing not made of silk).

As the examining attorney notes, absent a clarification in the identification of goods we must presume that the goods include items not consisting of silk. Indeed, applicant has stated that it "simply does not know of what materials its clothing line will be made of." Br. p. 3.

In traversing the refusal, applicant argues that the term BIOSILK is not misdescriptive of the goods because it

is "a single integrated term, or mark" and it does not begin with the term SILK. Br. p. 3. Further, applicant asserts that there is no definition for BIOSILK. See The Webster's New World Collegiate Dictionary (3rd ed. 1996) and online dictionary excerpts attached to Applicant's February 25, 2007 response. Rather, applicant argues that the meaning to prospective purchasers would be "a very famous coined mark that has had tremendous commercial success and recognition throughout the world" and applicant's "use in connection with clothing would be recognized as an expansion of a very well-known trademark to another product line." Br. p. 4. In support of this contention, applicant submitted a summary of results from the Google search engine based on a search of the word BIOSILK, wherein several of the "hits" relate to applicant's cosmetic goods.³

In support of his contention that BIOSILK is misdescriptive of the goods, the examining attorney states that "the mark is a combination of the prefix BIO- and the word SILK. It would be so perceived by prospective purchasers, who would therefore be led to believe that the

³ With regard to the third party registration referenced by applicant in its brief, we first note that the registration is not of record and, as such, is of no probative value. We further add that it is well established that each case must stand on its own and prior decisions by examining attorneys are not binding on the Board. In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

clothing items are made of or contain silk." Br. p. 3.

The examining attorney also argues that the addition of the prefix BIO does not "provide a basis for believing that the goods are in fact not made of real silk." Br. p. 3. The prefix BIO is defined as "life; living organisms or tissue." Merriam-Webster's Collegiate Dictionary (10th ed. 1999).⁴ The term SILK is defined as "a lustrous tough elastic fiber produced by silkworms and used for textiles." *Id.*⁵ Thus, the examining attorney argues that "one would expect a prefix connoting life and living things to be used in association with natural fibers rather than synthetic ones." Br. p. 4.

We find that the term BIOSILK when used on clothing would connote the natural fiber silk and, thus, would misdescribe clothing not made of silk. With regard to applicant's argument centered on the alleged renown of the word BIOSILK with applicant's cosmetic products, as the examining attorney stated "[w]hile consumers of hair care products may associate BIOSILK clothing with the source of

⁴ The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). The examining attorney requested judicial notice of another definition, but the dictionary excerpt was not attached to the brief, therefore, the Board provides its own reference.

⁵ *University of Notre Dame du Lac*, *supra*.

hair care or other products, many others who seek to purchase clothing would either not recognize the name or not think to associate the source of such clothing with the source of items other than clothing.”⁶ Br. pp. 5-6.

With regard to the next inquiry, whether consumers would believe the misrepresentation, silk is a common material for clothing and consumers would certainly believe that applicant’s clothing is made from silk.

We now consider whether the misdescription is likely to affect the decision to purchase. The examining attorney submitted printouts from several websites to show that silk is a desirable material for applicant’s goods. See “A 2 Z of Health, Beauty and Fitness,” health.learninginfo.org (“Silk is the most luxurious of the natural fibers...Silk has a low density and is therefore much lighter than wool, cotton, linen or rayon. Silk is used in dresses, skirts, blouses, jackets, accessories and underwear.”); and “Properties and Characteristics of Silk,” articlesender.com (“Cultivated silk ... has a number of interesting and desirable properties that have been admired for over 5,000 years ... Silk clothing keeps one cool in the summer, and

⁶ We further note that the search summaries provided by applicant are not sufficient to establish that its mark is well known for cosmetics. Cf. *In re Fitch IBCA, Inc.*, 64 USPQ2d 1058, 1060 (TTAB 2002).

it provides surprising warmth in the winter ... For all these reasons silk has been desired for centuries.") Based on the evidence of record, we find that the misdescription would effect the decision to purchase.

Finally, we are not persuaded that this case presents the possible exception noted in *In re Shapely, Inc.*, supra, wherein a term containing "silk for wearing apparel" may be registrable. The example given in *Shapely* is the adjective "silken" which has the "common connotation of something resembling silk rather than necessarily meaning silk content." *Shapely*, supra at 75. Here, the term contains the noun SILK modified by the prefix BIO which to the extent it adds meaning could serve to underscore it as a natural fiber.

In summary, the examining attorney has made a prima facia showing that the term BIOSILK is misdescriptive of applicant's clothing not made of silk, that potential purchasers would believe this misdescription, and that the presence or absence of silk would materially affect the purchasing decision, which has not been rebutted by applicant. Thus, we conclude that the mark BIOSILK is deceptive in connection with the identified goods.

Decision: The refusal to register under Section 2(a) of the Trademark Act is affirmed.