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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Rubie's Costume Co., Inc.

Serial No. 75/410,355

Barry E. Negrin of Levisohn, Lerner, Berger & Langsam for
Rubie's Costume Co., Inc.

Kimberly Krehely, Trademark Examining Attorney, Law Office
107 (Thomas Lamone, Managing Attorney)

Before Simms, Cissel and Rogers, Administrative Trademark
Judges.

Opinion by Simms, Administrative Trademark Judge:

Rubie's Costume Co., Inc. (applicant), a New York
corporation, has appealed from the final refusal of the
Trademark Examining Attorney to register the mark RUBIESILK
for fabric used in the manufacture of masquerade costumes.¹
The Examining Attorney has refused registration under

¹ Application Serial No. 75/410,355, filed December 23, 1997,
based upon allegations of use and use in commerce since November
30, 1997.

Ser. No. 75/410,355

Section 2(a) of the Act, 15 U.S.C. § 1052(a), arguing that applicant's mark is deceptive as applied to its goods.²

Applicant and the Examining Attorney have submitted briefs, but no oral argument has been requested.³

We affirm.

In *In re Budge Manufacturing Co. Inc.*, 857 F.2d 773, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988), the U.S. Court of Appeals for the Federal Circuit stated its agreement with the standard set out by the Board in *In re Shapely, Inc.*, 231 USPQ 72, 73 (TTAB 1986):

- (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?

Applicant argues that its mark is not misdescriptive of its fabric, contends that prospective purchasers are not likely

² Section 2 of the Act, 15 USC §1052, provides, in part:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it--

- (a) Consists of or comprises immoral, deceptive, or scandalous matter...

³ The Examining Attorney has objected to the material submitted with applicant's appeal brief. To the extent that this material has not previously been introduced or referred to by applicant,

to believe that its goods are composed of silk, and does not believe that any misdescription in its mark is likely to affect the decision to purchase. Applicant states that its fabric sold under the mark is incorporated into finished costumes and that those completed costumes are sold as a RUBIE'S costume with RUBIESILK fabric.

Applicant's attorney states that applicant is the world's largest manufacturer of Halloween and masquerade costumes and accessories. According to applicant, its costumes are inexpensive (\$20 to \$30 at most), in contrast to genuine silk costumes, which are more expensive. Applicant argues that, in view of the price of its costumes, potential purchasers are not likely to believe that they are purchasing genuine silk costumes. Rather, according to applicant, potential purchasers will believe that the costumes sold under the mark are made from fabric that simulates silk.

Applicant also contends that its masquerade costumes are, by their very nature, imitations providing an appearance of some real or imaginary character, person or animal. For this reason as well, applicant maintains that

the Examining Attorney's objection is sustained. See Trademark Rule 2.142(d) and TBMP §§ 1207.01 and 1207.03.

consumers will not believe that applicant's goods are made of real silk.

Finally, applicant contends that the prefix "RUBIES", argued to be the dominant part of applicant's mark, informs consumers that applicant's goods are not real silk but only a silky fabric from Rubie, the owner of a number of registrations which begin with this prefix. Applicant states that, in the two years its goods have been sold under this mark, it is unaware of any instances where consumers have believed that the fabric was made of silk.

We agree with the Examining Attorney, however, that applicant's mark is deceptive within the meaning of Section 2(a).

"Silk" is defined as "a fine, lustrous fiber composed mainly of fibroin and produced by certain insect larvae to form cocoons, especially the strong, elastic, fibrous secretion of silkworms used to make thread and fabric... Thread or fabric made from this fiber... A garment made from this fabric." The American Heritage Dictionary (3Rd Edition). See Final Refusal, p. 2. The Examining Attorney has made of record evidence that costumes, such as a French maid's costume, and even Halloween costumes, are sometimes made of silk. The Examining Attorney has also made of record evidence that the price of silk has dropped

in recent years due to mass production in China and evidence that that country has increased its production of silk garments and costumes.

Applicant has admitted that its goods are not made of silk but is "a material which [applicant] believes masquerades as and feels like silk.". Applicant's brief, p. 5 and applicant's Response, filed February 9, 1999, p. 2. With respect to the commercial impression created by applicant's mark, the Examining Attorney has pointed to the specimens of record (shown below) wherein the suffix "SILK"

is shown with a capital "S". We agree with the Examining Attorney that this display encourages the impression that applicant's fabric is composed of silk--that the silk comes from Rubie. We also believe that the evidence of record shows that it would be reasonable for potential purchasers to believe that applicant's masquerade costumes, even relatively inexpensive ones, are composed of silk, either completely or in part. Further, because of the desirable characteristics of silk, the fact that the purchasing

public may believe that applicant's goods are composed of silk would materially affect their decision to buy. See *In re Shapely, Inc., supra* ("SILKEASE" held deceptive for women's blouses and ladies' dresses made of polyester crepe de chine). It is also noteworthy what the Board stated therein, at 75, concerning the fact that other terms containing the word "SILK" may have been registered by others (an argument raised by applicant herein).

Moreover, even if the Office has -- perhaps improvidently -- issued registrations of marks containing the term "silk" for goods not made of silk in circumstances like those presented here, we are not bound by those actions if we believe that registration in the case before us would be contrary to the statute.

Decision: The refusal of registration is affirmed.

R. L. Simms

R. F. Cissel

G. F. Rogers
Administrative Trademark Judges
Trademark Trial and Appeal Board