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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Volk Art, Inc.**

Serial No. 74/**693,416**

Vivian Polak of LeBoeuf, Lamb, Greene & MacRae, L.L.P. for
Volk Art, Inc.

Susana Tuccillo, Trademark Examining Attorney, Law Office
109 (Deborah Cohn, Managing Attorney).

Before **Cissel**, Seeherman and Hohein, Administrative
Trademark Judges.

Opinion by **Cissel**, Administrative Trademark Judge:

On June 26, 1995, applicant filed an application to register the mark "BLANC DE CHINE" on the Principal Register for "porcelain, namely lamp bases, pots and figurines," in Class 21. The application was based on applicant's assertion that it possessed a bona fide intention to use the mark on the specified goods in commerce.

Applicant subsequently claimed ownership of Registration No. 1,912,617. That registration was issued on August 15, 1995 for the same mark for various items of clothing.

In the instant application, the Examining Attorney refused registration under Sections 2(a) and 2(e)(1) of the Trademark Act on the grounds that the mark sought to be registered is both deceptive, as applied to the goods set forth in the application, and also that it is deceptively misdescriptive of them. In support of the refusal to register, she made of record copies of excerpts from published articles retrieved from the Nexis® computerized database. The articles show that "blanc de Chine" is a term used to identify a valuable type of China or porcelain which was made in China between the fifteenth and nineteenth centuries. Typical examples of these excerpts include the following: "...the focus is on the great age of blanc de Chine--1640-1710..."; "...19th century French blanc de chine glazed terra cotta figures for \$12,500"; and "Blanc de chine is a great porcelain...."

The Examining Attorney took the position that the mark is deceptive within the meaning of Section 2(a) of the Act because, if applicant's goods are not blanc de Chine or do not contain blanc de Chine, the mark will deceive purchasers into thinking that they are or do, and the deception will be a material factor in the decision to buy the goods. She also argued that the mark is deceptively misdescriptive within the meaning of Section 2(e)(1) because, if applicant's goods are not blanc de Chine or they do not

contain blanc de Chine, consumers would nonetheless be likely to understand the mark as indicating that the goods bearing it either are blanc de Chine, or that they contain blanc de Chine.

Applicant responded to the refusals to register with argument against both grounds for refusal. Also submitted was the affidavit of Kawai Fong, applicant's Vice President. In it, Mr. Fong states that he is familiar with the products on which applicant intends to use the mark "BLANC DE CHINE"; that they will be newly manufactured items, not antiques; and that he is aware that the term refers to a type of antique porcelain produced hundreds of years ago, but that applicant's goods will neither be blanc de Chine nor contain blanc de Chine.

The Examining Attorney was not persuaded, and the refusals to register were made final in the next office action. Copies of additional excerpts from published periodicals were submitted which show that authentic blanc de Chine porcelain is quite valuable, very desirable, and collectable.

Applicant filed a Notice of Appeal on July 1, 1997. Both applicant and the Examining Attorney filed briefs, but no oral hearing was requested.

Attached to the brief was the affidavit of Anita Andrade, an attorney for applicant. Along with her

affidavit, applicant submitted copies of pages from the catalog Sotheby's Chinese Works of Art (September 23, 1997). In it, various items of authentic blanc de Chine porcelain are advertised for thousands of dollars each.

Ordinarily, such materials submitted with an appeal brief would not be considered by the Board because they were untimely submitted under Trademark Rule 2.142(d), but we have considered them in the instant case, because the Examining Attorney treated them as if they were properly of record and did not object to them. In fact, her own arguments concerning the value of authentic blanc de Chine are supported by these materials. Accordingly, we have considered them.

Based on this record and the applicable legal principles which relate to the two sections of the Act on which the refusals to register are predicated, we affirm both refusals to register. The term "BLANC DE CHINE" is unregistrable under Section 2(e)(1) of the Act because it would give prospective purchasers the idea that applicant's porcelain is actually blanc de Chine, which is not so. The term is unregistrable under Section 2(a) because that misinformation would likely be a significant factor in a customer's decision to purchase applicant's product.

Turning first to the refusal under Section 2(e)(1), we note that neither applicant nor the Examining Attorney

dispute what the two-part test is for determining whether a mark is misdescriptive under the Lanham Act. First, we must determine whether the term sought to be registered misdescribes the goods. Then, if it does, we must answer the question of whether anyone is likely to believe the misrepresentation. In order to determine whether Section 2(a) also bars registration, to the test for misdescriptiveness we must add the issue of whether, if the term is misdescriptive and prospective purchasers are likely to believe the misdescription, this misinformation would be a material factor in the decision to purchase the goods. See: *In re Budge Mfg. Co., Inc.*, 857 F.2d 773, 8 USPQ2d 1259 (Fed. Cir. 1988); *In re Quady Winery, Inc.*, 221 USPQ 1213 (TTAB 1984); *In re Ox-Yoke Originals, Inc.*, 222 USPQ 352 (TTAB 1983).

There can be no doubt that the term sought to be registered misdescribes the goods with which applicant intends to use it. Mr. Fong acknowledges that blanc de Chine is valuable antique porcelain, whereas applicant's lamp bases, pots and figurines will be newly manufactured items of porcelain, not valuable antiques.

Applicant's main argument in favor of registration of the term is basically that no one will believe that applicant's products are blanc de Chine, primarily because genuine blanc de Chine is so expensive. In support of this

argument applicant points to the information made of record by the Examining Attorney which notes that authentic blanc de Chine figures are valued at \$12,500 each. Applicant asserts that its goods will sell for "reasonable" prices, e.g., small bowls will be priced at \$125.00, and a footed bowl will go for \$245.00. The Examining Attorney, however, notes that not all authentic blanc de Chine costs thousands of dollars. Two excerpts from the published articles she made of record, for example, show that some may be had for considerably less. Two dishes are offered for \$100 to \$200, and a vase is priced at \$325. Moreover, although applicant argues that its porcelain will be sold at prices comparable to these, it is significant that nothing prohibits applicant from using the term as a mark on replicas of blanc de Chine figurines, or from selling them for prices comparable to, or only slightly less than, similar items of genuine blanc de Chine.

In the same sense, we are not persuaded by applicant's contention that no one will mistakenly believe applicant's goods are blanc de Chine because they will be sold only in applicant's retail stores along with housewares and clothing bearing the same mark. The application contains no such limitation, and even if it did, someone who is vaguely aware that blanc de Chine is valuable porcelain and sees it for sale at affordable prices in one of applicant's stores would

not necessarily be aware of other products being offered there under the same mark. Such a person would understand applicant's use of the term to indicate that the goods were in fact blanc de Chine, and at what may be bargain prices.

Applicant argues that prospective purchasers of its goods will be either scholars who have an understanding of what authentic blanc de Chine is, or ordinary consumers who have no idea. Neither will be misled, according to applicant. In the former instance, applicant contends, such experts will not mistake applicant's products for blanc de Chine because they know what blanc de Chine is and what its value is. In the latter situation, ordinary consumers will simply not know or care, argues applicant.

We agree with the Examining Attorney, however, that the misrepresentation caused by labeling applicant's products with the name of valuable antique goods of the same type will be believed by a significant part of the prospective purchasers of applicant's porcelain. Collectors or other experts may believe the goods to be either high quality replicas or genuine blanc de Chine at bargain prices. As the Examining Attorney notes, this would be particularly likely if the purchase were made from a catalog or other printed advertisement, under circumstances where the actual products were not available for inspection prior to ordering them. In this regard, it is significant to keep in mind

that notwithstanding applicant's argument that these products will only be sold in applicant's own stores, which will sell other household products and clothing under the same mark, the identification is not so restricted.

As we noted above, people who would only vaguely recognize the designation as an indication of high quality, value and hence, desirability, would nonetheless understand applicant's use of the term to indicate that applicant's goods are blanc de Chine. In addition, the evidence establishes that blanc de Chine is very desirable, so the mistaken belief or misunderstanding that applicant's products are blanc de Chine would be a material factor in the purchasing decision.

In summary, the term is unregistrable under Section 2(e)(1) of the Act because applicant's goods are not blanc de Chine, whereas porcelain purchasers who encounter the designation on applicant's products would believe that they are blanc de Chine. Further, the term is unregistrable under Section 2(a) of the Act, not just because the mark is a misrepresentation and the misrepresentation would be believed, but also because the misrepresentation would be a material factor in the decision to buy applicant's products.

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Accordingly, both refusals to register are affirmed.

R. F. Cissel

E. J. Seeherman

G. D. Hohein
Administrative Trademark Judge,
Trademark Trial & Appeal Board

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