

2021-2114, 2021-2115

**United States Court of Appeals
for the Federal Circuit**

In re: DOLCE VITA FOOTWEAR, INC.,

Appellant.

*On Appeal from the United States Patent and Trademark Office,
Trademark Trial and Appeal Board, Serial Nos.
88554717 and 88554722*

BRIEF FOR APPELLANT

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**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT****CERTIFICATE OF INTEREST**

Case Number 2021-2114, -2115

Short Case Caption In re: Dolce Vita Footwear, Inc.

Filing Party/Entity Dolce Vita Footwear, Inc.

Instructions: Complete each section of the form. In answering items 2 and 3, be specific as to which represented entities the answers apply; lack of specificity may result in non-compliance. **Please enter only one item per box; attach additional pages as needed and check the relevant box.** Counsel must immediately file an amended Certificate of Interest if information changes. Fed. Cir. R. 47.4(b).

I certify the following information and any attached sheets are accurate and complete to the best of my knowledge.

Date: 07/15/2021

Signature: /s/ Maxwell C. Preston

Name: Maxwell C. Preston

<p>1. Represented Entities. Fed. Cir. R. 47.4(a)(1).</p>	<p>2. Real Party in Interest. Fed. Cir. R. 47.4(a)(2).</p>	<p>3. Parent Corporations and Stockholders. Fed. Cir. R. 47.4(a)(3).</p>
<p>Provide the full names of all entities represented by undersigned counsel in this case.</p>	<p>Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities.</p> <p><input checked="" type="checkbox"/> None/Not Applicable</p>	<p>Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities.</p> <p><input type="checkbox"/> None/Not Applicable</p>
<p>Dolce Vita Footwear, Inc.</p>		<p>Steven Madden, Ltd.</p>

Additional pages attached

4. Legal Representatives. List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

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William M. Merone	Hunton Andrews Kurth LLP	

5. Related Cases. Provide the case titles and numbers of any case known to be pending in this court or any other court or agency that will directly affect or be directly affected by this court’s decision in the pending appeal. Do not include the originating case number(s) for this case. Fed. Cir. R. 47.4(a)(5). See also Fed. Cir. R. 47.5(b).

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6. Organizational Victims and Bankruptcy Cases. Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

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TABLE OF CONTENTS

	Page
STATEMENT OF RELATED CASES	1
STATEMENT OF JURISDICTION.....	2
STATEMENT OF THE ISSUES.....	3
STATEMENT OF THE CASE.....	4
I. Prosecution of the Applications.....	4
II. Appeal to the Board.....	8
SUMMARY OF THE ARGUMENT	9
ARGUMENT	10
I. Standard of Review.....	10
II. The Board’s Finding of Deceptive Misdescriptiveness Was Based on Misapplication of the Law and Was Not Supported by Substantial Evidence.....	11
A. The Board erred in finding the CLEAR mark to be “merely descriptive” of <i>non-transparent</i> goods.....	11
B. The Board also erred in finding a likelihood of deception	14
1. Substantial evidence does not support the Board’s conclusion that reasonably prudent purchasers are likely to believe that Dolce Vita’s non-transparent goods are transparent.....	14
2. The Board erred by ignoring the fact that even a “quick glance” by consumers at Dolce Vita’s non-transparent goods would avoid any possible deception.....	15
3. The Board admits that visual inspection avoids deception.....	19

4.	The Board wrongly focuses on purely speculative, pre-point-of-sale “understandings”	20
	CONCLUSION.....	21

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>In re Abcor Development Corp.</i> , 588 F.2d 811 (CCPA 1978)	11, 13
<i>In re ALP of South Beach, Inc.</i> , 79 U.S.P.Q.2d 1009 (TTAB 2006)	18
<i>In re Automatic Radio Mfg. Co.</i> , 404 F.2d 1391 (CCPA 1969)	11
<i>Bass Buster, Inc. v. Gapen Mfg. Co.</i> , 420 F. Supp. 144 (W.D. Mo. 1976)	16
<i>In re Chamber of Commerce of the U.S.</i> , 102 U.S.P.Q.2d 1217 (Fed. Cir. 2012)	12
<i>In re Compagnie Generale Mar.</i> , 993 F.2d 841 (Fed. Cir. 1993)	10
<i>Earnhardt v. Kerry Earnhardt, Inc.</i> , 864 F.3d 1374 (Fed. Cir. 2017)	12
<i>In re Econoheat, Inc.</i> , 218 U.S.P.Q. 381 (TTAB 1983)	14, 15, 17
<i>Hoover Co. v. Royal Appliance Mfg. Co.</i> , 238 F.3d 1357 (Fed. Cir. 2001)	10, 21
<i>In re Kernoghan Brune Ltd.</i> , 2002 TTAB LEXIS 492 (TTAB July 30, 2002)	16
<i>Northwestern Golf Co. v. Acushnet Co.</i> , 226 U.S.P.Q. 240 (TTAB 1985)	16, 18
<i>In re Perfect Fit Industries, Inc.</i> , 223 U.S.P.Q. 92 (TTAB 1984)	11
<i>Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.</i> , 786 F.3d 960 (Fed. Cir. 2015)	10

<i>In re Robert Simmons, Inc.</i> , 192 U.S.P.Q. 331 (TTAB 1976).....	16, 17
<i>In re Salt Life, LLC</i> , 2017 TTAB LEXIS 276 (TTAB Aug. 3, 2017)	11
<i>In re Simple Mobility Tools LLC</i> , 2020 TTAB LEXIS 187 (TTAB March 13, 2020).....	11
<i>In re Strippit, Inc.</i> , 1997 TTAB LEXIS 318 (TTAB Feb. 25, 1997)	11, 13
<i>In re Woodward & Lothrop, Inc.</i> , 4 U.S.P.Q.2d 1412 (TTAB 1987)	18
Statutes	
15 U.S.C. § 1052(e)(1).....	<i>passim</i>

STATEMENT OF RELATED CASES

No other appeals in or from the same proceedings in the Trademark Trial and Appeal Board (the “Board”) were previously before this Court or any other appellate court. No case known to counsel to be pending in this Court or any other court or agency will directly affect or be directly affected by this Court’s decision in the pending appeal.

STATEMENT OF JURISDICTION

The Board had jurisdiction over the underlying *ex parte* proceedings based on 15 U.S.C. § 1070.

On April 29, 2021, the Board entered two final orders affirming the Examining Attorney's refusal to register Appellant Dolce Vita Footwear, Inc.'s CLEAR mark, which is the subject of Trademark Application Serial Nos. 88/554,717 and 88/554,722 (the "Applications"). (Appx1-32.)

The Federal Circuit has jurisdiction over Appellant's appeals of these decisions under 28 U.S.C. § 1295(a)(4)(B) and 15 U.S.C. § 1071(a).

On July 1, 2021, Appellant filed timely Notices of Appeal to this Court. (Appx248-250, Appx456-458.) The Court consolidated the two appeals on July 7, 2021.

STATEMENT OF THE ISSUES

1. In finding that Appellant's CLEAR mark is "deceptively misdescriptive" under 15 U.S.C. § 1052(e)(1), did the Board err in concluding that the mark is misdescriptive because:

- a. The Board ignored Appellant's restriction of its recitation of goods to exclude non-transparent goods; and
- b. The Board failed to recognize that the recited non-transparent goods could not plausibly be "clear."

2. In finding Appellant's CLEAR mark to be deceptive, did the Board err because:

- a. A quick glance by reasonably prudent consumers at the recited non-transparent footwear/clothing/bags would reveal that the goods are not transparent;
- b. The Board focused on speculative pre-point-of-sale "understandings" in the minds of consumers, instead of the reality of visual inspection at the point of sale; and
- c. The Board refused to follow the line of visual inspection cases in the TTAB, and instead distinguished these cases on irrelevant grounds.

STATEMENT OF THE CASE

Appellant Dolce Vita Footwear, Inc. (“Dolce Vita”) appeals the Board’s April 29, 2021 final orders, which affirmed the Examining Attorney’s refusal to register the CLEAR mark in connection with Dolce Vita’s Applications. (Appx1-32.) Through its Applications, Dolce Vita seeks to register the mark in connection with the following non-transparent goods in International Classes 25 and 18:

Class 25 – Footwear, lingerie, sleepwear, swimwear, and women’s clothing, namely, shirts, dresses, skirts, blouses; all of the foregoing excluding transparent goods.

Class 18 – Baggage tags, Handbags, Make-up bags sold empty, Purses and wallets, Tote bags, All-purpose sport bags, All-purpose carrying bags, Business card cases, Clutches, Coin purses, Credit card cases; all of the foregoing excluding transparent goods.

(Appx1, Appx16.)

I. Prosecution of the Applications

Dolce Vita filed the Applications on July 31, 2019. (Appx35, Appx268.) At that time, the identifications of goods did not exclude transparent goods. (*Id.*)

In the first Office Actions, the Examining Attorney refused the Applications based on mere descriptiveness. (Appx45, Appx279.) Specifically, the Examining Attorney found that “consumers will immediately understand that the proposed mark informs them that applicant provides clear footwear” and bags because “CLEAR is commonly used in connection with applicant’s goods and/or services.” (Appx45,

Appx279.) During a telephone conference regarding these refusals, however, the Examining Attorney also raised the prospect of a refusal based on deceptive misdescriptiveness, since Dolce Vita's CLEAR-branded goods are not transparent. (Appx71.)

Dolce Vita responded to both bases for refusal. First, Dolce Vita argued that CLEAR is arbitrary, rather than merely descriptive, because there "are no transparent items in Dolce Vita's collection." (Appx71-77, Appx304-310.) Second, Dolce Vita argued that CLEAR is not deceptively misdescriptive because "persons who encounter the CLEAR mark, as used on or in connection with footwear and bags" are not "likely to believe that the products are transparent because the consumers will necessarily see that the footwear and bags are not transparent." (Appx71-72, Appx304-305.)

Despite Dolce Vita's arguments, the Examining Attorney issued second Office Actions that refused the Applications on the ground that CLEAR was deceptively misdescriptive. (Appx82-83, Appx315-316.) The Examining Attorney found CLEAR to be misdescriptive because transparent footwear and bags are a "common type" of footwear and bags, and Dolce Vita's goods "do not in fact possess this feature or characteristic." (Appx83, Appx315.) The Examining Attorney also found that "the reasonably prudent consumer is likely to believe" that Dolce Vita's goods are transparent because "consumers regularly encounter footwear" and bags

that are “clear.” (*Id.*) In doing so, the Examining Attorney rejected Dolce Vita’s argument that consumers will readily see that the goods are not transparent. (*Id.*) In the alternative, the Examining Attorney maintained the refusal based on mere descriptiveness, rejecting Dolce Vita’s position that CLEAR is an arbitrary mark. (Appx83-84, Appx316.)

As the Examining Attorney’s refusal focused on transparent footwear and bags, Dolce Vita proposed amendments to exclude transparent footwear and bags from the Applications’ identified goods. (Appx122, Appx341.) With these amendments, Dolce Vita argued that CLEAR could not be considered descriptive or misdescriptive as to the non-transparent footwear and bags in the amended Applications. (Appx122-123, Appx341-342.)

The Examining Attorney then issued Final Office Actions maintaining refusals on both grounds. (Appx129-131, Appx348-350.) With respect to deceptive misdescriptiveness, the Examining Attorney’s analysis was the same as in prior Office Actions, but now also included findings that: (a) transparent “other goods” are a “common type” of “other goods”; and (b) “the reasonably prudent consumer is likely to believe” that these “other goods” are transparent because “consumers regularly encounter” such “other goods that are clear.” (Appx130, Appx349.) The Examining Attorney also found that CLEAR was merely descriptive because the

Applications did not exclude all transparent goods, and thus covered certain potentially transparent goods. (Appx130-131, Appx349-350.)

After these Final Office Actions, Dolce Vita submitted for each application a Request for Reconsideration and Response to Final Office Action. (Appx179-188, Appx386-395.) As the Examining Attorney's latest refusal focused on all of the identified goods, Dolce Vita requested that the Applications be amended to state that "all" of the identified goods exclude "transparent goods". (See Appx180, Appx387.) Dolce Vita also requested reconsideration in view of these amendments. (Appx184-188, Appx391-395.) Dolce Vita explained that: (a) CLEAR is not misdescriptive because "it is not 'plausible' that non-transparent goods would be transparent" (Appx185-186, Appx392-393); (b) a reasonably prudent consumer is not likely to believe that Dolce Vita's non-transparent goods are transparent as "even a quick glance will obviate any deception" (Appx185-186, Appx392-393); and (c) CLEAR cannot be merely descriptive of Dolce Vita's entirely non-transparent goods (Appx188, Appx395).

The Examining Attorney denied the Requests for Reconsideration without substantive analysis (Appx193-194, Appx396-397), but accepted the requested amendments.¹

¹ Although the Examining Attorney did not expressly accept the amendments, the Board correctly found that the Examining Attorney had accepted the amendments. (Appx4, Appx20 (the Examining Attorney "apparently accepted

II. Appeal to the Board

On July 7, 2020, Dolce Vita filed a timely Notice of Appeal to the Board for each Application. (Appx204, Appx412.) On April 29, 2021, the Board affirmed the refusals based solely on deceptive misdescriptiveness. (Appx2, Appx17.) The Board found that CLEAR is misdescriptive of Dolce Vita's non-transparent goods because "consumers will immediately perceive the word 'clear' as describing a feature or attribute that Applicant's footwear and clothing could plausibly have" (Appx10, Appx27), but which those goods do not possess (the exclusion of transparent goods "conclusively establishes" misdescription) (Appx10-11, Appx27). The Board then found that consumers are likely to believe that Dolce Vita's non-transparent goods are transparent because: (a) transparent bags, cases, wallets, baggage tags, footwear, and clothing are a "fashion trend;" (b) Dolce Vita's non-transparent goods might be promoted without an image of the goods, and (c) consumers might think the non-transparent goods were transparent, even if they later understood that they were not when they glanced at the goods. (Appx14, Appx31)

With respect to the Examining Attorney's refusals based on mere descriptiveness, the Board found the issue to be moot (Appx2, Appx17), noting that the refusals on that basis "should have been withdrawn when the Examining

the further amendment"); Appx6, Appx21 (Dolce Vita's "identification of goods, as amended, specifically excludes transparent goods").)

Attorney ruled on the request for reconsideration” after Dolce Vita amended its applications to exclude all transparent goods (Appx4-5 n.7; Appx20 n.7). Accordingly, the issue of mere descriptiveness is not at issue on appeal.

On July 1, 2021, Dolce Vita filed timely Notices of Appeal to this Court. (Appx248-250, Appx456-458.) The Court consolidated the two appeals on July 7, 2021.

SUMMARY OF THE ARGUMENT

First, the Board erred in finding that CLEAR is misdescriptive of Dolce Vita’s non-transparent goods. The Board failed to focus, as required by statute and precedent, on the actual recitation of goods, *which is limited to non-transparent goods*. In addition to this legal error, the Board’s conclusion is not supported by substantial evidence. There is no evidence that consumers understand CLEAR to be misdescriptive in these circumstances, as non-transparent goods cannot plausibly be transparent.

Second, the Board erred in finding that reasonably prudent purchasers are likely to be deceived into believing that Dolce Vita’s non-transparent goods are transparent. There is no evidence in the record that any reasonably prudent consumer would believe, at the point-of-sale, that Dolce Vita’s non-transparent goods are transparent. The Board has not carried its burden of showing that deception is likely because (a) the Board’s holding regarding the likelihood of

deception was built entirely upon conjecture and speculation, and (b) the Board acknowledged that any prior misunderstandings can be rectified through visual inspection of the goods.

The Board's decisions affirming the Examining Attorney's refusal to register Dolce Vita's CLEAR mark as deceptively misdescriptive are erroneous and should be reversed.

ARGUMENT

I. Standard of Review

This Court reviews the Board's legal conclusions *de novo*, and reviews its factual conclusions for "substantial evidence." *Hoover Co. v. Royal Appliance Mfg. Co.*, 238 F.3d 1357, 1359 (Fed. Cir. 2001). "Substantial evidence requires 'more than a mere scintilla' and is 'such relevant evidence as a reasonable mind would accept as adequate' to support a conclusion." *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 964 (Fed. Cir. 2015) (citation omitted). Whether a mark is deceptively misdescriptive is a question of fact reviewed for substantial evidence. *See Hoover*, 238 F.3d at 1361 ("Whether a mark is misdescriptive is a question of fact, which we review under the substantial evidence standard." (citation omitted)); *cf. In re Compagnie Generale Mar.*, 993 F.2d 841, 845 (Fed. Cir. 1993) ("Whether a mark is primarily geographically descriptive or deceptively misdescriptive is a question of fact.").

II. The Board’s Finding of Deceptive Misdescriptiveness Was Based on Misapplication of the Law and Was Not Supported by Substantial Evidence

A trademark is deceptively misdescriptive under 15 U.S.C. § 1052(e)(1) only if it meets both parts of a two-part test: (1) the mark misdescribes the goods at issue; and (2) reasonably prudent purchasers would be likely to believe the misrepresentation. *See In re Perfect Fit Industries, Inc.*, 223 U.S.P.Q. 92, 93 (TTAB 1984); *see also In re Automatic Radio Mfg. Co.*, 404 F.2d 1391, 1396 (CCPA 1969) (deceptively misdescriptive marks are “misdescriptive” and “likely to deceive”). Here, the Board made legal and factual errors in its application of both parts of this test, neither of which is satisfied here.

A. The Board erred in finding the CLEAR mark to be “merely descriptive” of *non-transparent* goods

A mark is misdescriptive only if it is “merely descriptive” of “a significant aspect of the goods or services which the goods or services plausibly possess but in fact do not.” *In re Simple Mobility Tools LLC*, 2020 TTAB LEXIS 187, *12 (TTAB March 13, 2020) (citing cases); *In re Salt Life, LLC*, 2017 TTAB LEXIS 276, **8-9 (TTAB Aug. 3, 2017) (same). This determination must be made “in relation to the goods or services for which registration is sought.” *In re Strippit, Inc.*, 1997 TTAB LEXIS 318, *1 (TTAB Feb. 25, 1997) (citing *In re Abcor Development Corp.*, 588 F.2d 811, 813-14 (CCPA 1978)); *see also* 15 U.S.C § 1052(e)(1) (deceptive misdescriptiveness depends on the mark as “used on or in connection with the goods

of the applicant”). Indeed, this Court has explained that a mark is merely descriptive only if “someone who knows what the goods and services are will understand the mark to convey information about them.” *Earnhardt v. Kerry Earnhardt, Inc.*, 864 F.3d 1374, 1378 (Fed. Cir. 2017).

The crux of this appeal is that Dolce Vita is *not* seeking to register CLEAR for both transparent and non-transparent goods; rather, Dolce Vita is seeking to register the mark *only* for *non-transparent* goods. The determination of whether a mark is merely descriptive must be made in relation solely to those goods *for which registration is being sought*. See, e.g., *In re Chamber of Commerce of the U.S.*, 102 U.S.P.Q.2d 1217, 1219 (Fed. Cir. 2012); TMEP 1209.01(b).

Thus, the relevant question is whether CLEAR (meaning “transparent”) describes a feature or characteristic of the recited goods, which, by definition, are *not* transparent. As the Examining Attorney acknowledged, that is a logical impossibility. (*E.g.*, Appx83, Appx315 (recognizing that non-transparent goods “do not in fact possess [the] feature or characteristic” supposedly identified by the mark CLEAR).) The Board plainly erred because CLEAR simply cannot be a significant aspect of non-transparent goods. Said another way, the recited goods (non-transparent footwear, clothing, and bags) cannot “plausibly possess” transparent features.

The Board disregarded Dolce Vita’s exclusion of non-transparent goods on the basis that consumers will not know about the restriction: “We cannot assume that consumers of Dolce Vita’s goods will be aware that its identification is so restricted, and the restriction is not controlling of public perception.” (Appx11, Appx28.) But whether consumers know about the restriction is not the point. The restriction serves the important purpose of limiting the scope of the registration (and Dolce Vita’s rights) only to those goods for which the mark is not descriptive. The key point is that competitors will not be prevented, by virtue of the registration, from using the term “clear” as an adjective for their own transparent goods. In any event, the relevant statute does not focus on consumer knowledge of the recitation of goods, but instead on the goods themselves:

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—...(e) Consists of a mark which (1) when used on or in connection *with the goods of the applicant* is merely descriptive or deceptively misdescriptive of them.

15 U.S.C. § 1052(e)(1). The descriptiveness determination must be made “in relation to the goods or services for which registration is sought.” *In re Strippit, Inc.*, 1997 TTAB LEXIS 318, *1 (TTAB Feb. 25, 1997) (citing *In re Abcor Development Corp.*, 588 F.2d 811, 813-14 (CCPA 1978).

In sum, the mark CLEAR is simply incapable of being merely descriptive of non-transparent goods. Thus, the Board erred in finding that the first prong of the

two-part test under 15 U.S.C. § 1052(e)(1), namely, that the mark is misdescriptive, was satisfied.

B. The Board also erred in finding a likelihood of deception

1. Substantial evidence does not support the Board’s conclusion that reasonably prudent purchasers are likely to believe that Dolce Vita’s non-transparent goods are transparent

The Board erred not only in finding that the CLEAR mark was misdescriptive of Dolce Vita’s non-transparent goods, but also in finding that reasonably prudent consumers would be deceived into believing that those non-transparent goods are transparent.

A mark is not unregistrable merely because it may misdescribe the applicant’s goods—to be refused registration, a mark must be *deceptively* misdescriptive. *See* 15 U.S.C. 1052(e)(1); *In re Econoheat, Inc.*, 218 U.S.P.Q. 381, 383 (TTAB 1983). For a mark to be considered deceptively misdescriptive, the Office must establish that reasonably prudent consumers would be likely to *believe* the alleged “misrepresentation.” *See Econoheat*, 218 U.S.P.Q. at 383 (“Even an arguably deceptive term can be used as a mark on goods where no reasonable buyer would be deceived into thinking that the mark really connotes a quality of the goods.”).

Here, the alleged misrepresentation is that Dolce Vita’s non-transparent goods are, in fact, transparent—which is to say, “[e]asily seen through.” (*See, e.g.*, Appx83, Appx315.) It is beyond debate, however, that footwear, clothing, and bags

are the quintessential consumer goods that buyers will invariably visually inspect (and often try on) *before* purchase. Indeed, all the evidence submitted by Dolce Vita and the Examining Attorney confirms that footwear, clothing and bags (including the footwear Dolce Vita already sells under the CLEAR mark) are *displayed* to potential buyers at the point of sale, either online or in stores. (See Appx51-61, Appx71, Appx73-77, Appx85-117, Appx133-156, Appx285-295, Appx304, Appx306-310, Appx351-380.)

The record evidence in this case, as well as basic common sense, dictate that Dolce Vita's non-transparent footwear, clothing and bags will be seen by prospective purchasers at the point of sale, essentially precluding the possibility of deception by use of the mark CLEAR. At the very least, the Office and the Board have failed to establish that reasonably prudent consumers would likely believe that Dolce Vita's non-transparent goods are transparent. The Board's position is simply illogical and should be reversed.

2. The Board erred by ignoring the fact that even a “quick glance” by consumers at Dolce Vita’s non-transparent goods would avoid any possible deception

The Board has repeatedly held that if shoppers are likely to observe a product before making a purchase and “even a quick glance” would avoid any possible deception, there cannot be a deceptive misdescription. *See Econoheat*, 218 U.S.P.Q. at 383 (SOLAR QUARTZ not deceptively misdescriptive for space heaters where

“even a casual perception” of the goods would reveal they act “just like any other electric appliance” and are not solar-powered); *Northwestern Golf Co. v. Acushnet Co.*, 226 U.S.P.Q. 240, 242-43 (TTAB 1985) (singular term STEP not deceptively misdescriptive for a golf club with a multi-step shaft where “even a quick glance at the golf club will reveal that it has a multi-step shaft construction, and purchasers are not likely to purchase golf clubs without looking at them first”); *In re Robert Simmons, Inc.*, 192 U.S.P.Q. 331, 333 (TTAB 1976) (WHITE SABLE not deceptive for paint brushes made from synthetic fibers where “the characteristic color of sable fur is black whereas ... [applicant’s paint brush] bristles are white”). Similarly, in *In re Kernoghan Brune Ltd.*, 2002 TTAB LEXIS 492 (TTAB July 30, 2002), the Board found that purchasers were “not likely to believe that applicant’s jewelry contains blue rubies” because, among other reasons, “upon seeing the mark BLUE RUBY on applicant's goods” the purchaser would also see that “the jewelry does not contain any blue gemstones”. 2002 TTAB LEXIS 492, at *6-7.

Dolce Vita also cited below the decision in *Bass Buster, Inc. v. Gapen Mfg. Co.*, 420 F. Supp. 144 (W.D. Mo. 1976) where the court held that purchasers are “not deceived into believing that” a fishing lure “resembles a natural beetle by use of the name BEETLE” because the lures are “enclosed in a clear plastic envelope” such that purchasers can “observe the appearance of the lure before purchase”. *Id.* at 154.

As described above, the record evidence and common sense dictate that consumers shopping for footwear/clothing/bags will observe these non-transparent items before making a purchase and “even a quick glance” will dispel them of any potential misconception of transparency based on the mark CLEAR. Accordingly, a reasonably prudent purchaser is not likely to be deceived in this case.

Yet the Board (and the Examining Attorney) ignored visual inspection. The Board never addressed Dolce Vita’s argument—and the obvious fact—that any potential deception in this case would be avoided simply by a quick glance at the product by the consumer before purchase. It was error for the Board ignore and not apply the underlying holding of this line of cases, which are directly applicable here.

Furthermore, the Board failed to successfully distinguish the visual inspection cases, which are directly on point here. The Board found *Econoheat* irrelevant because solar-powered space heaters did not exist, whereas “clear” shoes/clothing/bags do exist. (Appx13-14, Appx30.) But that distinction is immaterial – the key point of the *Econoheat* decision was that any potential deception could be avoided by visual inspection. *See* 218 U.S.P.Q. at 383. The same is true here as well. Similarly, the Board asserted that the *Robert Simmons* decision found deception to be less likely because the first word of the mark was WHITE, which is the “antithesis of ‘black.’” (Appx13, Appx29-30). Once again, this ignores the *Robert Simmons* holding that any potential deception was avoided

by visual inspection. Finally, the Board concluded that *Northwestern Golf* was distinguishable because consumers might alternatively understand “STEP” to be used “as a synonym for ‘step pattern’”. (Appx13, Appx30.) But as the Board itself stated, alternative definitions are “not controlling” with respect to deceptive misdescriptiveness. (Appx11-12, Appx28-29) (“It is well settled that so long as any one of the meanings of a term is descriptive [or misdescriptive], the term may be considered to be merely descriptive [or misdescriptive].” (citation omitted)).)

Regarding visual inspection, the Board relied on two cases, both of which are readily distinguishable. In *In re Woodward & Lothrop, Inc.*, 4 U.S.P.Q.2d 1412 (TTAB 1987), visual inspection did not avoid deception because the mark at issue—CAMEO—has a definition that is not well-known, so a purchaser would not necessarily know if the product was a “cameo” with visual inspection. *See id.* at 1413-14. By contrast, here everyone knows what “clear” means, so purchasers can easily tell whether footwear/clothing/bags are clear or not without any special knowledge. *In re ALP of South Beach, Inc.*, 79 U.S.P.Q.2d 1009 (TTAB 2006) is distinguishable because it pertained to services, not goods. *See id.* at 1012. Indeed, the Board in *ALP* recognized the line of TTAB “cases where the casual observer of consumer products is presumed to be able to discover that the mark is obviously misdescriptive by looking at the involved goods.” *Id.*

3. The Board admits that visual inspection avoids deception

The Board admits that visual inspection avoids deception in this case:

Just because upon visually inspecting Applicant's footwear or clothing items consumers may understand that they do not include transparent or clear attributes does not negate their understanding before they inspect the goods.

(Appx30-31 (emphasis added); *see also* Appx14.)

Given the Board's admission, it was error for the Board to ignore the realities of visual inspection of the goods at issue by consumers prior to purchase and the associated line of cases discussed above. Furthermore, given the Board's admission, it was error for the Board to instead rely on purely speculative "understandings" that purchasers supposedly had prior to visual inspection. If visual inspection avoids deception, it is irrelevant what, if any, "understandings" the purchaser may have had *before* seeing the goods. The Board contends in conclusory fashion that visual inspection "does not negate their understanding before they inspect the goods" (*id.*), but of course it does. The Board provides no reasoning or evidence why visual inspection would not "negate" prior misunderstandings as to the transparency of non-transparent footwear/clothing/bags. To the contrary, the Board admits that visual inspection leads consumers to "understand that [the goods] do not include transparent or clear attributes". (*Id.*)

4. The Board wrongly focuses on purely speculative, pre-point-of-sale “understandings”

The Board’s holding on deception is based on pure speculation:

If Applicant’s goods were to be promoted by word-of-mouth or on social media or in print (e.g., in fashion blogs, magazine articles, or even Applicant’s future advertising) without an image of the goods, a reasonable consumer seeking what the record shows to be a fashion trend would believe that Applicant’s goods, promoted under the proposed CLEAR mark, would feature transparent or clear attributes. Pre-sale discussion and promotion leading to deception is likely in this case given the popularity of footwear with clear accents or elements and the fact that Applicant at one time offered a shoe with clear accents.

(Appx31 (emphasis added; citations omitted); see also Appx14.)

The quote above (representing the sum total of the Board’s ostensible factual basis for its deception holding) is built upon layers of faulty speculation that Dolce Vita might promote its footwear/clothing/bags without images of the goods. Significantly, the Board did not cite (nor could it cite) *any* record evidence that Dolce Vita’s footwear/clothing/bags are marketed without images of the goods. The Board itself recognizes the lack of evidence by using the subjunctive tense for its argument—“If Applicant’s goods were to be promoted...”—which shows the Board’s position is based on pure conjecture.

The Board then jumps to the conclusion that deception is likely “given the popularity of footwear with clear accents or elements” (Appx31) and “the popularity of transparent bags” (Appx14), but no showing has been made of “popularity.” And

the Board’s reliance on Dolce Vita’s prior offer of a single shoe with such accents is equally insufficient to prove deception. (*See* Appx22 (depicting a shoe by Dolce Vita with a transparent accent).)

In any event, even if the evidence showed a popular fashion trend, the statute’s prohibition of deceptively misdescriptive marks addresses potential harm at the point of sale. As this Court has explained, a misdescriptive mark is deceptively misdescriptive only if the misdescription “may materially induce a purchaser’s decision to buy.” *See Hoover*, 238 F.3d at 1361. When the purchaser is making the decision to buy, s/he is observing the shoes, and any prior notions of a “clear fashion trend” are dispelled.

CONCLUSION

As described above, the mark CLEAR, as applied to Dolce Vita’s non-transparent goods, is neither misdescriptive nor deceptive. Accordingly, the decisions of the Board affirming the Examining Attorney’s refusal to register the mark should be reversed.

Dated: March 1, 2022

Respectfully submitted,

BALLARD SPAHR LLP

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Addendum

This Opinion is a
Precedent of the TTAB

Mailed: April 29, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Dolce Vita Footwear, Inc.
—

Serial No. 88554722
—

Susan A. Smith of Ballard Spahr LLP,
for Dolce Vita Footwear, Inc.

Alison F. Pollack, Trademark Examining Attorney, Law Office 106,
Mary I. Sparrow, Managing Attorney.

—
Before Taylor, Adlin and Larkin,
Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Dolce Vita Footwear, Inc. (“Applicant”) seeks registration on the Principal Register of the proposed mark CLEAR (in standard characters) for, as amended,

“Baggage tags, Handbags, Make-up bags sold empty, Purses and wallets, Tote bags, All-purpose sport bags, All-purpose carrying bags, Business card cases, Clutches, Coin purses, Credit card cases; all of the foregoing excluding transparent goods” in International Class 18.¹

¹ Application Serial No. 88554722 was filed on July 31, 2019, based upon Applicant’s allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the grounds that it is deceptively misdescriptive or, in the alternative, merely descriptive, of Applicant's identified goods. We affirm the refusal to register on the ground that Applicant's mark is deceptively misdescriptive; the alternative ground for refusal that the mark is merely descriptive is moot.

I. Procedural Background

A review of the examination history will help clarify how the alternative refusals were issued. As originally filed, the application identified the goods as "baggage tags; handbags; make-up bags sold empty; purses and wallets; tote bags; all purpose [sic] sport bags; all-purpose carrying bags; business card cases; clutches; coin purses; credit card cases." The Examining Attorney initially refused registration on the ground that the applied-for mark is merely descriptive of the goods, relying in part on the definition of "clear" as "[e]asily seen through; transparent,"² and arguing that the word "clear" is used by competitors to describe a feature of bags.

² October 28, 2019 Office Action; TSDR 5. THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (<https://www.ahdictionary.com/word/search.html?q=clear>).

Citations to the examination record refer to the USPTO's online Trademark Status and Document Retrieval system (TSDR) by page number in the downloadable .pdf versions of the documents.

Citations to TTABVUE throughout the decision are to the Board's public online database that contains the appeal file, available on the USPTO website, www.USPTO.gov. The first number represents the docket number in the TTABVUE electronic case file and the second represents the page number(s), if applicable.

In response to the Office Action, Applicant explained that there are no transparent items in its CLEAR collection, and made of record materials showing items included in its “CLEAR” collection.³

Applicant, generally referencing an October 28, 2019 telephone conference with the Examining Attorney, also addressed the yet-to-be-raised issue of deceptive misdescriptiveness,⁴ arguing that its use of CLEAR is completely arbitrary, and that it is not likely that persons could be fooled into thinking Applicant’s identified bags are transparent because the consumer must see the goods when purchasing them and will see that they are not transparent.

In her November 22, 2019 Office Action, the Examining Attorney maintained the mere descriptiveness refusal and, based on Applicant’s admission that its bags were not transparent, alternatively refused registration on the ground that the applied-for mark is deceptively misdescriptive of the goods.

Applicant responded to the November 22, 2019 Office Action by arguing against the refusals, and by proposing an amendment to its identification of goods to add the following limiting language: “all of the foregoing excluding transparent bags, purses, and clutches.”

³ The materials submitted by Applicant only show use of the proposed CLEAR mark in connection with footwear. Accordingly, these materials have little probative value in this case which involves non-transparent baggage tags, bags and cases.

⁴ Applicant particularly noted in its response that when its counsel advised the Examining Attorney that its products are not transparent, the Examining Attorney responded that if the mark is not descriptive, then it is deceptively misdescriptive. Applicant’s November 14, 2019 Response; TSDR 7.

The Examining Attorney then issued a Final Office Action on February 10, 2020, maintaining both Section 2(e)(1) refusals as to all the identified goods.⁵

Prior to the deadline for filing a notice of appeal, on June 29, 2020, Applicant filed a Request for Reconsideration, proposing a second amendment to its identification of goods to exclude “transparent goods” from all of the identified items and offering additional arguments against the Section 2(e)(1) refusals.⁶

The Examining Attorney denied the Request for Reconsideration and apparently accepted the further amendment to the exclusionary language to the identification of goods.⁷

⁵ The Final Office Action did not directly address Applicant’s proposed amendment to the identification of goods, however, the Examining Attorney includes the limiting language in her references to the goods in her brief. We therefore consider the amendment to have been accepted. We would be remiss if we failed to point out that when a proposed amendment is acceptable to the Examining Attorney, the next Office Action should so state, leaving no room for doubt going forward or in the case of an appeal.

⁶ Applicant asserts in its Request for Reconsideration that the Examining Attorney untimely submitted new arguments and evidence and should have instead issued a non-final Office Action. A review of the action shows that no new issues were raised and the refusals were confined to the previously stated merely descriptive and deceptively misdescriptive refusals. *See In re Adlon Brand GmbH*, 120 USPQ2d 1717, 1725 (TTAB 2016) (“Neither Applicant’s new evidence and arguments regarding the outstanding refusal under Section 2(e)(4), submitted with its request for reconsideration, nor the Examining Attorney’s submission of additional evidence regarding the same refusal, provided in response to that request, raised a new issue such as to make appropriate a nonfinal Office Action ...”) (citations omitted). The Examining Attorney’s inclusion of supplementary evidence directed to additional enumerated goods in support of previously issued refusals was not inappropriate. Applicant could have addressed the additional evidence in its Request for Reconsideration, but did not do so.

⁷ We presume so because the amendment was not rejected, nor was any rationale offered in support of rejection. Although not addressed in the denial of the request for reconsideration, the proceeding records have been updated and the subsequently-filed appeal briefs refer to amended goods. This decision refers to the goods as amended. In addition, the Examining Attorney’s failure to expressly accept Applicant’s second proposed amendment restricting all of the identified goods to non-transparent items may have led to the maintenance of the

Applicant then filed a timely Notice of Appeal on July 7, 2020. The appeal is fully briefed.

II. Whether Clear is Deceptively Misdescriptive of Applicant's Goods

Because of the amendment to exclude all "transparent goods" from the application, we start with the deceptive misdescriptiveness refusal.

A. The Examining Attorney's Arguments and Evidence

The Examining Attorney maintains that Applicant's proposed mark is deceptively misdescriptive of the identified goods. The Examining Attorney particularly argues: (1) the evidence shows that the proposed CLEAR mark means "easily seen through; transparent" which is merely descriptive of Applicant's goods in that the public will believe that Applicant provides transparent bags; (2) it is plausible that Applicant's bags, baggage tags and cases would possess such a feature because the evidence shows that clear bags and cases are common⁸; and (3) a reasonably prudent purchaser is likely to believe the representation (implied by the word "clear") because it is

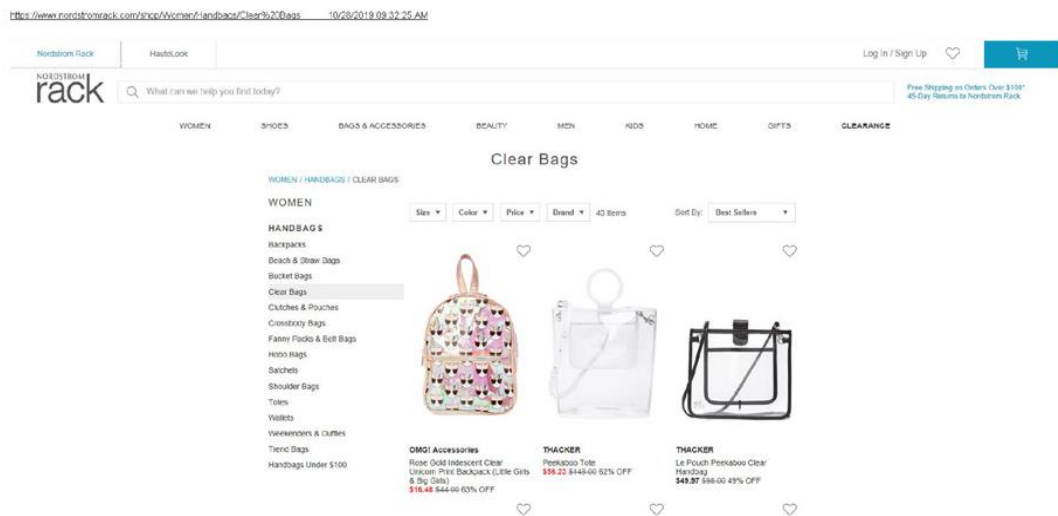
merely descriptive refusal, which, after that amendment, should have been withdrawn when the Examining Attorney ruled on the request for reconsideration.

⁸ Applicant's identification of goods includes additional items in Class 28 apart from the ones specifically discussed above. However, if an applicant's mark is merely descriptive or deceptively misdescriptive for any of the listed goods in a single class in the application it cannot be registered in that class. "A descriptiveness [or deceptively misdescriptive] refusal is proper 'if the mark is descriptive [or misdescriptive] of any of the [goods or] services for which registration is sought.'" *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005)).

common for bags and cases to be clear or transparent, but Applicant's identification of goods, as amended, specifically excludes transparent goods.⁹

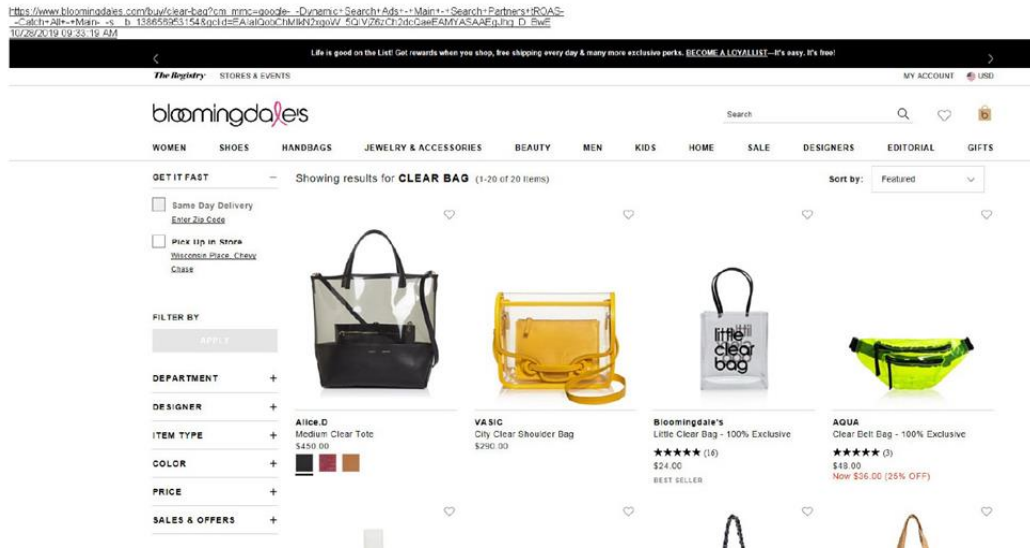
In addition to the noted definition of the word "clear," to show that CLEAR describes a feature or characteristic that bags, cases, and baggage tags plausibly possess, the Examining Attorney submitted the following:

- Screenshots from the third-party websites of Nordstrom Rack and Bloomingdale's showing descriptive use of the word in connection with bags, as shown below:¹⁰



⁹ Examining Attorney's Brief. 8 TTABVUE 5-9.

¹⁰ October 28, 2019 Office Action; TSDR 8-9 and 15-16.

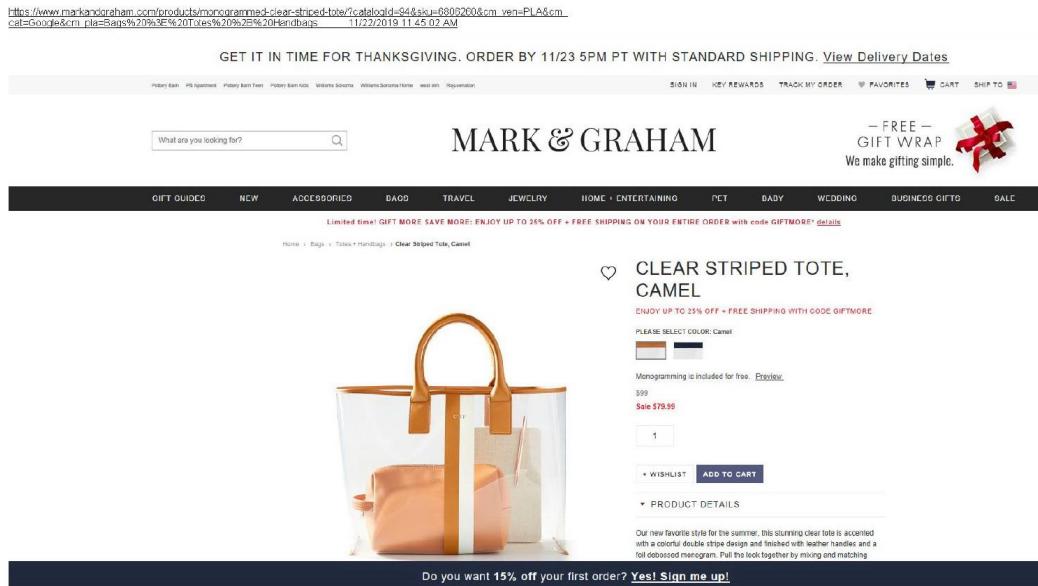


- An article in Travel and Leisure titled “9 Clear Bags You’ll Actually Be Able to Find Your Stuff in for Once” states:
 - With a transparent bag, you’re able to go in and grab whatever you set out for without wasting time rummaging through expired metro tickets while your bus driver rushes you in Portuguese. Plus, you’ll be much more inclined to stay organized, sheerly because the world can see the contents of your bag.¹¹
- An article in Rank & Style titled: “WE’VE JUST MADE FINDING THE PERFECT CLEAR HANDBAG SUPER EASY” states:
 - **Clear bags are having a moment again**, and we are definitely not mad about it. This cool nod to the ‘90’s is also practical as stadiums have introduced a new clear bag policy in an effort to up security. ... Is there any true downside to this trend? Fashion brands certainly don’t seem to think so **because they have all jumped at the chance to capitalize on it in the most stylish of ways.** From essential stadium bags to playful totes to glamorous clutches, click through our list of Top 10

¹¹ November 22, 2019 Office Action; TSDR 5-6.

clear handbags to help you find the perfect, transparent addition to your wardrobe.¹²

- A screenshot of the MARK & GRAHAM website, showing a “clear striped tote” bag.¹³



- Website screen shots¹⁴ from Amazon Fashion (www.amazon.com) featuring “clear vinyl luggage tags,”¹⁵ Capri Designs (https://clearstadiumbags.com) featuring “clear stadium bags,”¹⁶ Hammitt Los Angeles (www.hammitt.com) featuring “clear’ Tony SML” bag,¹⁷ Urban Outfitters (www.urbanoutfitters.com) featuring a “clear zip wallet,”¹⁸ Pop Sugar (www.popsugar.com) featuring a “clear makeup bag,”¹⁹ The Container Store (www.containerstore.com) featuring “Clear Makeup Bags & Toiletry

¹² *Id.* at TSDR 15-22 (emphasis added). The article also includes references and links to purchase the bags, but images of only three bags are shown.

¹³ *Id.* at TSDR 11.

¹⁴ Full website citations are found at the TSDR cites.

¹⁵ February 10, 2020 Office Action; TSDR 5-10.

¹⁶ *Id.* at TSDR 12.

¹⁷ *Id.* at TSDR 14-15.

¹⁸ *Id.* at TSDR 19-20.

¹⁹ *Id.* at TSDR 23-24.

Bags,”²⁰ and shopbop (www.shopbop.com) featuring clear bags, including crossbody bags.²¹

- An article from The Wall Street Journal (www.wsj.com) discussing the transparent bag trend, titled “Would You Carry a Clear Handbag? **The trend in transparent bags** is quite divisive among women. We examine the pros and cons of going clear[.]”²²

B. Applicable Law/Analysis

A mark is considered deceptively misdescriptive if: (1) the mark misdescribes a quality, feature, function, or characteristic of the goods or services with which it is used; and (2) consumers would be likely to believe the misrepresentation. *See In re Budge Mfg. Co.*, 857 F.2d 773, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988); *In re White Jasmine LLC*, 106 USPQ2d 1385, 1394 (TTAB 2013) (citing *In re Quady Winery, Inc.*, 221 USPQ 1213, 1214 (TTAB 1984)).

As to the first part of the test, a mark is misdescriptive when it is “merely descriptive, rather than suggestive, of a significant aspect of the goods or services which the goods or services plausibly possess but in fact do not.” *In re Hinton*, 116 USPQ2d 1051, 1052 (TTAB 2015) (citing *In re Shniberg*, 79 USPQ2d 1309, 1312 (TTAB 2006); *In re Phillips-Van Heusen*, 63 USPQ2d 1047, 1048 (TTAB 2005)). As to the second part, the reasonably prudent consumer test is applied in assessing whether consumers are likely to believe the misrepresentation. *In re Hinton*,

²⁰ *Id.* at TSDR 27-28.

²¹ *Id.* at TSDR 31-33.

²² *Id.* at TSDR 35-36 (emphasis added).

116 USPQ2d at 1052 (citing *R. J. Reynolds Tobacco Co. v. Brown & Williamson Tobacco Corp.*, 226 USPQ 169, 179 (TTAB 1985)).

The dictionary definition and third-party website evidence made of record by the Examining Attorney convince us that consumers will perceive CLEAR as describing a feature or characteristic that tote bags, handbags, makeup bags, wallet and baggage tags could plausibly have, namely that they are transparent, “clear,” or include transparent or “clear” elements. Indeed, Applicant stated in its brief:

For purposes of appeal, Applicant will not dispute the Examining Attorney’s assertion that CLEAR means “transparent” when applied to bags and cases. ... Given that, it thus follows that if a party tried to register CLEAR broadly for all forms of bags and cases, the mark would be descriptive because it would describe a feature or characteristic of *one form* of those goods (“transparent bags and cases”) *within* the broader definition.

Applicant’s br. pp. 4-5. (Emphasis supplied and internal citations omitted).²³

Applicant adds, however, that it “is not seeking to register CLEAR broadly for both ‘transparent *and* non-transparent bags and cases;’ it is only seeking to register it for non-transparent bags and cases.” *Id.* (Emphasis supplied).²⁴ Based on the evidence of record, we have no doubt that consumers will immediately perceive the word “clear” as describing a feature or attribute that Applicant’s baggage tags, and various types of bags and cases, could plausibly have. We therefore find that Applicant’s restriction of its identification of goods to non-transparent or non-clear goods is sufficient to show (and in fact conclusively establishes) that the proposed CLEAR mark misdescribes a

²³ 6 TTABVUE 5-6.

²⁴ *Id.* at 6.

feature or attribute of the goods in that Applicant's identified goods do not possess the characteristic of being "clear." *See generally* Trademark Manual of Examining Procedure § 1209.04 (Oct. 2018), and the authorities cited therein. Thus the first part of the test for deceptive misdescriptiveness has been satisfied.

Applicant's contention that its proposed mark CLEAR does not describe a plausible feature of its goods because it has restricted its identification to exclude transparent goods is unavailing. We cannot assume that consumers of Applicant's goods will be aware that its identification is so restricted, and the restriction is not controlling of public perception. *See In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1187-88 (TTAB 2018). *Cf., e.g., In re Clorox Co.*, 578 F.2d 305, 198 USPQ 337, 340 (CCPA 1978) ("[T]he locus of potential confusion is [not] in the files of the PTO."); *In re Wada*, 48 USPQ2d 1689, 1692 (TTAB 1998) (public is unaware of disclaimers that "quietly reside" in the records of the Office).

Moreover, Applicant cannot avoid a finding of deceptive misdescriptiveness by excluding from its identification the very characteristic that its mark is misdescribing. *Cf. In re ALP of South Beach, Inc.*, 79 USPQ2d 1009, 1010 (TTAB 2006) ("We find that the word CAFETERIA used in connection with restaurant services that explicitly exclude cafeteria-style restaurants does misdescribe the services."). In addition, the record is devoid of any evidence that, as Applicant proposes, the word "clear" suggests other meanings when used for or in connection with baggage tags, bags and cases. Even so, that a term may have other meanings in different contexts is not controlling. *See In re Bright-Crest, Ltd.*, 204 USPQ 591, 593

(TTAB 1979). “It is well settled that so long as any one of the meanings of a term is descriptive [or misdescriptive], the term may be considered to be merely descriptive [or misdescriptive].” *In re Mueller Sports Med., Inc.*, 126 USPQ2d 1584, 1590 (TTAB 2018); *In re Canine Caviar Pet Foods, Inc.*, 126 USPQ2d 1590, 1598 (TTAB 2018).

Having determined that the term misdescribes the goods, we now assess whether consumers are likely to believe the misrepresentation. Again, the evidence shows that various types of bags, cases, wallets and baggage tags may be transparent or “clear” in whole or in part, and that those goods are described as such by those in the industry and by ordinary consumers. As the record reflects, “[c]lear bags are having a moment again”²⁵ and fashion brands have jumped to capitalize on the trend, in all likelihood because of the heightened security measures employed at airports, stadiums and other public facilities. Also, as to baggage tags, clear elements are expected so that one may easily verify ownership of one’s luggage. As a result, consumers seeing the proposed mark CLEAR for baggage tags, cases, and various types of bags, in particular, are likely to believe that those goods are clear or transparent even though they are not.

We are unpersuaded by Applicant’s assertion that reasonably prudent consumers are unlikely to believe the “misrepresentation,” because bags and cases are displayed to potential buyers at the point of purchase for visual inspection before purchase.²⁶ In making this argument, Applicant relies on three Board decisions: *In re Econoheat, Inc.*, 218 USPQ 381, 383 (TTAB 1983) (SOLAR QUARTZ for space heaters), *Nw. Golf*

²⁵ November 22, 2019 Office Action; TSDR 11.

²⁶ 6 TTABVUE 7-8.

Co. v. Acushnet Co., 226 USPQ 240, 242-43 (TTAB 1985) (POWER-STEP for golf clubs), and *In re Robert Simmons, Inc.*, 192 USPQ 331, 333 (TTAB 1976) (WHITE SABLE for paint brushes made from synthetic fibers).

We find these decisions to be distinguishable in material respects from this case. Unlike this case, the mark at issue in *Robert Simmons* included the word “sable,” which is defined in, for example, the online version of MERRIAM-WEBSTER, as “the color black,” yet the mark also included the term “WHITE” the antithesis of “black” so consumers would not be deceived into believing WHITE SABLE paint brushes would be made from the hair or fur of a sable.²⁷ In *Northwestern Golf*, unlike in this case, the term at issue (“STEP”) did not necessarily have a misdescriptive meaning to consumers: purchasers would not “necessarily construe the word ‘STEP’ in applicant’s [POWER-STEP] mark as signifying that applicant’s golf club shaft has but a single step.”²⁸ *Nw. Golf*, 226 USPQ at 242. Rather, “they might just as readily believe that the word ‘STEP’ is used in the mark as a synonym for ‘step pattern.’” *Id.* at 243. Finally, in *Econoheat*, there did not appear to be any evidence of solar-powered quartz space heaters and, in fact, the term “Solar” referred to some other attribute of the device: the type of heat emitted. *See* 218 USPQ at 382. Here, by contrast, there is

²⁷ www.merriam-webster.com/dictionary/sable, last visited March 15, 2021. The Board may take judicial notice of dictionary definitions, including online dictionaries which exist in printed format. *See In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002).

²⁸ The term “step” in that context meant a discrete point on the shaft of a golf club where the shaft narrowed as it extended further from the handle and approached the club head. *Nw. Golf*, 226 USPQ at 241.

plentiful evidence of use of the term “clear” to describe transparent examples of the goods at issue, and Applicant has offered no other possible meaning the term could have in the context of these goods. Accordingly, we do not find that these cases support Applicant’s arguments.

That upon visually inspecting Applicant’s baggage tags, bags and cases consumers may understand that they do not include transparent or clear attributes does not negate their understanding before they inspect the goods. If Applicant’s goods were to be promoted by word-of-mouth or on social media or in print (*e.g.*, in fashion blogs, magazine articles, or even Applicant’s future advertising) without an image of the goods, a reasonable consumer seeking what the record shows to be a fashion trend would believe that Applicant’s goods, promoted under the proposed CLEAR mark, would be transparent or clear or feature such attributes. *See, e.g., In re Woodward & Lothrop Inc.* 4 USPQ2d 1412, 1414 (TTAB 1987) (CAMEO held deceptively misdescriptive of jewelry items because while a reasonable purchaser carefully examining jewelry which has no cameos or cameo-like elements may not be deceived into believing that it does, not all jewelry would be purchased in that manner; some jewelry may be purchased from catalogs which either inadequately describe or depict the jewelry items.); *see also ALP of South Beach*, 79 USPQ2d at 1014 (finding that pre-sale deception may occur without a sale taking place based on the deception). Pre-sale discussion and promotion leading to deception is likely in this case given the popularity of transparent bags.

In view of the above, we find that the second part of the deceptive misdescriptiveness test also has been satisfied.

C. Conclusion

After reviewing the evidence of record, we find that both parts of the deceptive misdescriptiveness test have been satisfied and are unrebutted and, accordingly, Applicant's proposed mark is deceptively misdescriptive within the meaning of Section 2(e)(1). In view of our determination on the ground of deceptive misdescriptiveness, the alternative ground for refusal that the mark is merely descriptive is moot.

Decision: The refusal to register Applicant's proposed mark CLEAR for the identified goods on the ground that it is deceptively misdescriptive under Trademark Act Section 2(e)(1) is affirmed.

This Opinion is a
Precedent of the TTAB

Mailed: April 29, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Dolce Vita Footwear, Inc.
—

Serial No. 88554717
—

Susan A. Smith of Ballard Spahr LLP,
for Dolce Vita Footwear, Inc.

Alison F. Pollack, Trademark Examining Attorney, Law Office 106,
Mary I. Sparrow, Managing Attorney.

—
Before Taylor, Adlin and Larkin,
Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Dolce Vita Footwear, Inc. (“Applicant”) seeks registration on the Principal
Register of the proposed mark CLEAR (in standard characters) for, as amended,

Footwear, lingerie, sleepwear, swimwear, and women’s
clothing, namely, shirts, dresses, skirts, blouses; all of the
foregoing excluding transparent goods

in International Class 25.¹

¹ Application Serial No. 88554717 was filed on July 31, 2019, based upon Applicant’s
allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the
Trademark Act, 15 U.S.C. § 1051(b).

The Trademark Examining Attorney finally refused registration of Applicant's mark on the grounds that it is deceptively misdescriptive or, in the alternative, merely descriptive, of Applicant's identified goods, both under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). We affirm the refusal to register on the ground that Applicant's mark is deceptively misdescriptive; the alternative ground for refusal that the mark is merely descriptive is moot.

I. Procedural Background

We first review the application prosecution history to clarify how the alternative refusals were issued. As filed, the application identified the goods as "Footwear; Lingerie; Sleepwear; Swimwear; Women's clothing, namely, shirts, dresses, skirts, blouses." The Examining Attorney initially refused registration on the ground that the proposed mark is merely descriptive of the identified goods, relying in part on the definition of "clear" as "[e]asily seen through; transparent,"² and arguing that the word "clear" is commonly used to describe a feature of footwear and that consumers will immediately understand from Applicant's proposed mark that Applicant provides clear footwear.

² October 28, 2019 Office Action; TSDR 5. THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (<https://www.ahdictionary.com/word/search.html?q=clear>).

Citations to the examination record refer to the USPTO's online Trademark Status and Document Retrieval system (TSDR) by page number in the downloadable .pdf versions of the documents.

Citations to TTABVUE throughout the decision are to the Board's public online database that contains the appeal file, available on the USPTO website, www.USPTO.gov. The first number represents the docket number in the TTABVUE electronic case file and the second represents the page number(s), if applicable.

Traversing the refusal, Applicant explained that there are no transparent items in its CLEAR collection, and made of record materials showing items in that collection, including the following photograph taken at an “August 16, 2019 shoe show in NYC”:³



Applicant, generally referencing an October 28, 2019 telephone conference with the Examining Attorney, also addressed the yet-to-be-raised issue of deceptive misdescriptiveness,⁴ arguing that its use of CLEAR is completely arbitrary, and that no consumer could be fooled into thinking Applicant’s footwear is transparent because the consumer must see the goods when purchasing them and will see that they are not transparent.

³ November 14, 2019 Response; TSDR 10-11, 13.

⁴ Applicant particularly noted in its response that when its counsel advised the Examining Attorney that its products are not transparent, the Examining Attorney responded that if the mark is not descriptive, then it is deceptively misdescriptive. *Id.* at TSDR 7.

In the November 22, 2019 Office Action, the Examining Attorney maintained the mere descriptiveness refusal and, based on Applicant's admission that its footwear is not transparent, alternatively refused registration on the ground that the proposed mark is deceptively misdescriptive of the goods.

Applicant responded to the November 22, 2019 Office Action with arguments against the refusals, and proposed an amendment to the identification of goods that would limit the identified footwear portion of the identification to "footwear, excluding transparent footwear."

The Examining Attorney then issued a Final Office Action on February 10, 2020, maintaining both Section 2(e)(1) refusals as to all identified goods.⁵

Prior to the deadline for filing a notice of appeal, on June 11, 2020, Applicant requested reconsideration of the final refusals, seeking to further amend its identified goods to exclude from all of the identified items "transparent goods,"⁶ and with

⁵ The Final Office Action did not directly address Applicant's proposed amendment to the identification, but in discussing the goods in her brief, the Examining Attorney refers to the originally identified "footwear" as "footwear, excluding transparent footwear." We therefore consider the amendment to have been accepted. We would be remiss if we failed to point out that when a proposed amendment is acceptable to the Examining Attorney, the next Office Action should so state, leaving no room for doubt going forward or in the case of an appeal.

⁶ Applicant asserts in its Request for Reconsideration that the Examining Attorney untimely submitted new arguments and evidence in her Final Office Action and should have instead issued a non-final Office action. A review of the action shows that no new issues were raised and the refusals were confined to the previously stated merely descriptive and deceptively misdescriptive refusals. *See In re Adlon Brand GmbH*, 120 USPQ2d 1717, 1725 (TTAB 2016) ("Neither Applicant's new evidence and arguments regarding the outstanding refusal under Section 2(e)(4), submitted with its request for reconsideration, nor the Examining Attorney's submission of additional evidence regarding the same refusal, provided in response to that request, raised a new issue such as to make appropriate a nonfinal Office Action") (citations omitted). The Examining Attorney's inclusion of supplementary evidence directed to clothing items in support of previously issued refusals was not inappropriate. Applicant

additional arguments against the refusals. The Examining Attorney denied the Request for Reconsideration and apparently accepted the further amendment to the exclusionary language to the identification of goods.⁷ Applicant then timely filed this appeal, which is fully briefed.

II. Whether CLEAR is Deceptively Misdescriptive of Applicant's Goods

Because of the amendment to exclude transparent footwear from the application, we start with the deceptive misdescriptiveness refusal.

A. The Examining Attorney's Arguments and Evidence

The Examining Attorney maintains that Applicant's proposed mark is deceptively misdescriptive of the identified goods. The Examining Attorney particularly argues: (1) the evidence shows that the proposed CLEAR mark means "easily seen through; transparent" which is merely descriptive of Applicant's goods in that the public will

could have addressed the Examining Attorney's additional evidence in its Request for Reconsideration, but did not do so.

In addition, Applicant, at footnote 5 of its brief, points to a related application for the mark CLEAR BY DOLCE VITA (Serial No. 88554548), noting that "the Examining Attorney *agreed* that CLEAR is not Descriptive for 'non-transparent clothing.'" (Emphasis supplied). The action of the Examining Attorney in the related case has no effect on the disposition of this appeal which involves a different mark. Nevertheless, the prior decisions and actions of other trademark examining attorneys in registering other marks are not binding upon the USPTO or the Board. *See In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1793 n.10 (TTAB 2017). Each case is decided on its own facts, and each mark stands on its own merits. *Id.*

⁷ We presume so because the amendment was neither rejected nor was any ground raised for rejection. Although not addressed in the denial of the request for reconsideration, the proceeding records have been updated and the subsequently-filed appeal briefs refer to further amended goods. This decision refers to the goods as so amended. In addition, in this case, the Examining Attorney's failure to expressly accept Applicant's second proposed amendment restricting all the identified goods to non-transparent items may have led to the maintenance of the merely descriptive refusal, which, after that amendment, should have been withdrawn when the Examining Attorney ruled on the request for reconsideration.

believe that Applicant provides transparent footwear and clothing; (2) it is plausible that Applicant's footwear and clothing could possess such a feature because the evidence shows that clear footwear and clothing, such as lingerie and dresses are common⁸; and (3) a reasonably prudent purchaser is likely to believe the representation (implied by the word "clear") because consumers commonly encounter footwear and clothing that are clear or transparent, even though Applicant's identification of goods, as amended, specifically excludes transparent goods.⁹

In addition to the noted definition of the word "clear," to show that CLEAR describes a feature or characteristic that footwear plausibly possesses, the Examining Attorney submitted screenshots from Applicant's website, as well from the websites of third parties Steve Madden and Nordstrom,¹⁰ Zappos, PrettyLittleThing, boohoo, and U.S. Shein,¹¹ and Asos,¹² all showing descriptive use of the word "clear" by competitors in connection with features and characteristics of footwear, such as transparent straps and heels. Excerpts from the screen captures are shown below (emphasis added):

⁸ In this case, all of the identified goods are in the same class. If an applicant's mark is merely descriptive or deceptively misdescriptive for any of the listed goods in a single class in the application it cannot be registered in that class. "A descriptiveness [or misdescriptiveness] refusal is proper 'if the mark is descriptive [or misdescriptive] of any of the [goods or] services for which registration is sought.'" *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005)).

⁹ Examining Attorney's brief. 8 TTABVUE 5-8.

¹⁰ October 28, 2019 Office Action; TSDR 8-17.

¹¹ November 22, 2019 Office Action; TSDR 5-9 and 24-37.

¹² February 10, 2020 Final Office Action; TSDR 27.

Serial No. 88554717

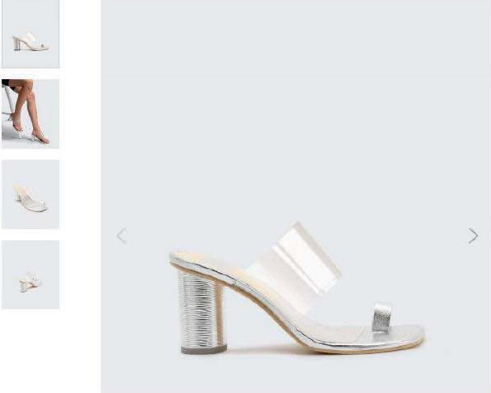
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10/28/2019 09:06:07 AM

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NAOMIE HEELS IN SILVER

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DETAILS | SIZE CHART

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- 94% Synthetic, 6% Leather
- Heel Height: 3.35"

https://www.stevemadden.com/image/search-ras/#?s=clear%20shoes 10/28/2019 09:10:57 AM

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STEVE MADDEN

WHAT'S NEW BEST SELLERS WOMEN'S MEN'S KIDS HANDBAGS ACCESSORIES SM AMBASSADORS SALE

Clear Shoes 2071 results

Related Searches: clear heels, clear pumps, clear sandals, clear flats, clear booties

Sort by: Best Match

Colors

Size


- 5 (606)
- 5.5 (897)
- 6 (1200)
- 6.5 (1064)
- 7 (1492)

Show more


Type

- Women's Shoes (1474)
- Men's Shoes (337)
- Kid's Shoes (79)
- Tops (31)
- Accessories (27)


Show more



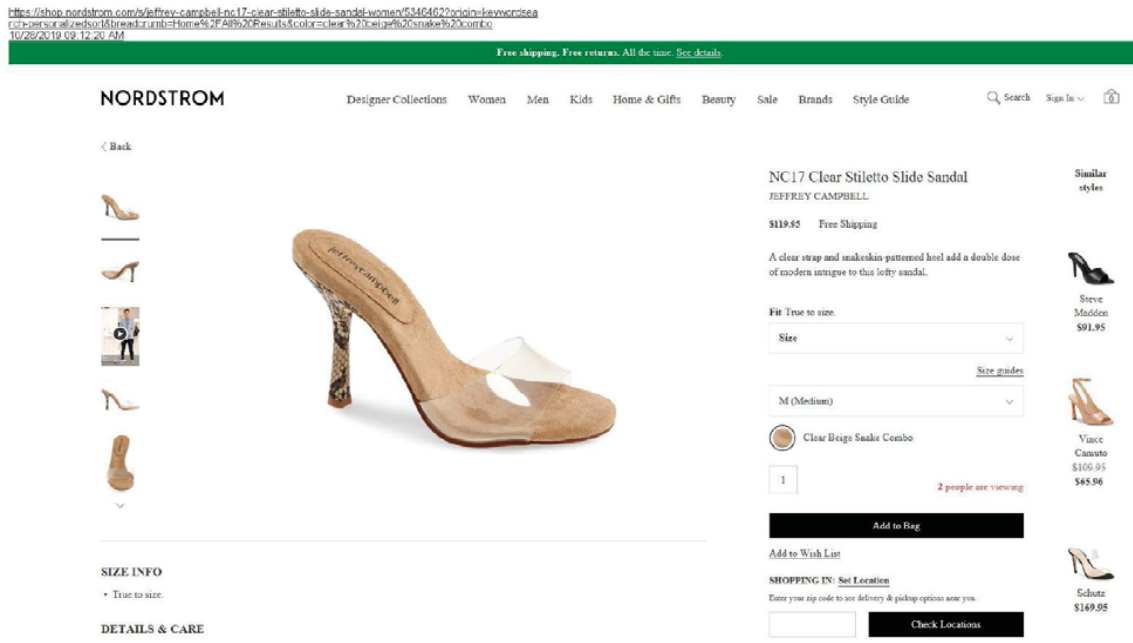
CLEARER CLEAR
\$93.95
214 Reviews



FEISTY NUDE
\$92.95
42 Reviews



VALA-S CLEAR
\$102.95
2 Reviews



The Examining Attorney also made of record a copy of an article from FN (<http://footwearnews.com>) titled “8 Clear Shoes to Prepare for Spring’s Transparent Takeover,” which discusses “[c]lear shoes” from eight footwear brands, including pictures of the shoes showing the “clear” features¹³ and an article from GLOWSLY titled “19 Best Transparent Clear Shoes to Channel Cinderella: PVC Shoe Trend.”¹⁴ The article discusses trends in clear shoes, provides links to 19 different styles and, in part, states:

Clear shoes were one of the big breakout trends on the spring/summer runways. We saw gorgeous transparent shoes on the catwalks of Chanel, Balmain, Yeezy, Prada and more. If you follow all the Instagram celebs, then you’ve probably been salivating over a

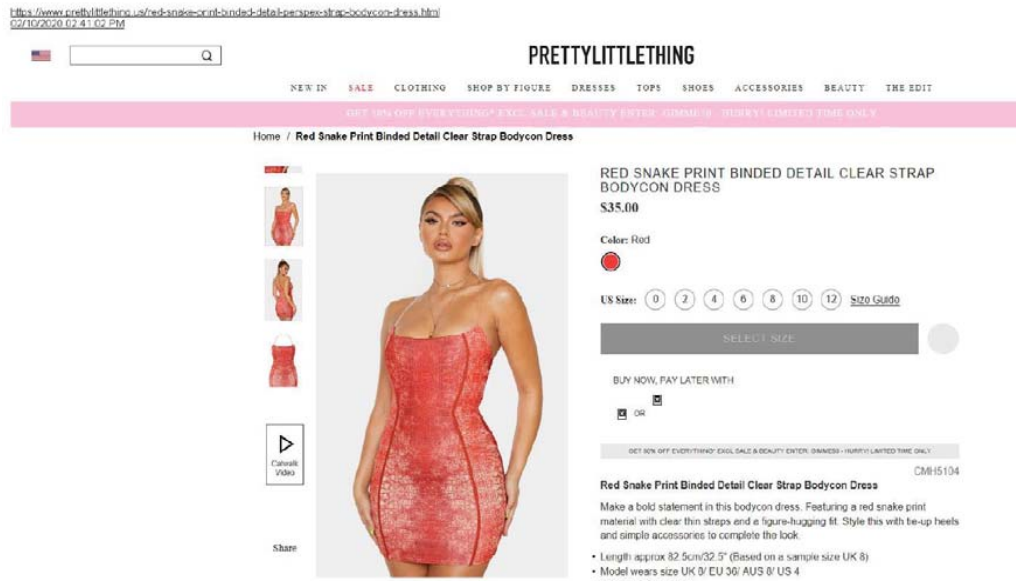
¹³ November 22, 2019 Office Action; TSDR 10-23.

¹⁴ February 10, 2020 Final Office Action; TSDR 30-46 (emphasis added).

Serial No. 88554717

- PrettyLittleThing

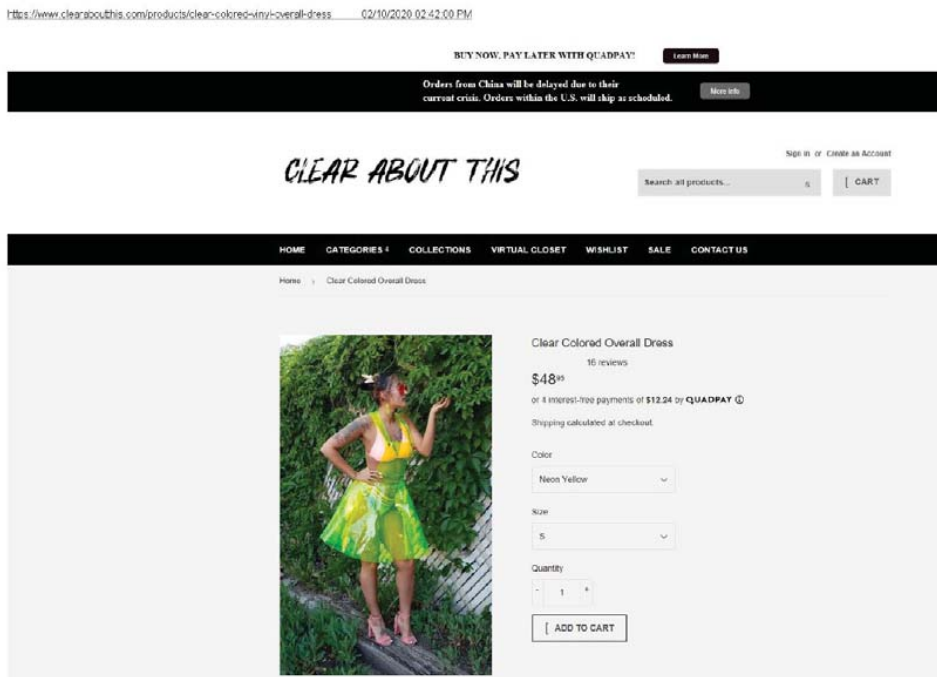
<https://www.prettylittlething.us/red-snake-print-binded-detail-clear-strap-bodycon-dress.html>
02/10/2020 02:41:02 PM



The screenshot shows the product page for a 'Red Snake Print Binded Detail Clear Strap Bodycon Dress' on the PrettyLittleThing website. The page features a large image of a model wearing the dress, a smaller thumbnail gallery on the left, and a 'Watch Video' button. The product title is 'RED SNAKE PRINT BINDED DETAIL CLEAR STRAP BODYCON DRESS' with a price of '\$35.00'. The color is 'Red' and the size is '12'. The page also includes a 'BUY NOW, PAY LATER WITH' section and a 'Share' button.

- Clear About This

<https://www.clearaboutthis.com/products/clear-colored-mix-overall-dress> 02/10/2020 02:42:00 PM



The screenshot shows the product page for a 'Clear Colored Overall Dress' on the Clear About This website. The page features a large image of a model wearing the dress, a product title 'Clear Colored Overall Dress' with a price of '\$48.99', and a 'QUADPAY' financing option. The color is 'Neon Yellow' and the size is 'S'. The page also includes a 'BUY NOW, PAY LATER WITH QUADPAY!' banner and a 'More Info' button.

B. Applicable Law/Analysis

A mark is considered deceptively misdescriptive if: (1) the mark misdescribes a quality, feature, function, or characteristic of the goods or services with which it is used; and (2) consumers would be likely to believe the misrepresentation. *See In re Budge Mfg. Co.*, 857 F.2d 773, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988); *In re White Jasmine LLC*, 106 USPQ2d 1385, 1394 (TTAB 2013) (citing *In re Quady Winery, Inc.*, 221 USPQ 1213, 1214 (TTAB 1984)).

As to the first part of the test, a mark is misdescriptive when it is “merely descriptive, rather than suggestive, of a significant aspect of the goods or services which the goods or services plausibly possess but in fact do not.” *In re Hinton*, 116 USPQ2d 1051, 1052 (TTAB 2015) (citing *In re Shniberg*, 79 USPQ2d 1309, 1312 (TTAB 2006); *In re Phillips-Van Heusen*, 63 USPQ2d 1047, 1048 (TTAB 2005)). As to the second part, the reasonably prudent consumer test is applied in assessing whether consumers are likely to believe the misrepresentation. *In re Hinton*, 116 USPQ2d at 1052 (citing *R. J. Reynolds Tobacco Co. v. Brown & Williamson Tobacco Corp.*, 226 USPQ 169, 179 (TTAB 1985)).

The dictionary definition and third-party website evidence made of record by the Examining Attorney convince us that consumers will perceive CLEAR as describing a feature that footwear, lingerie, skirts and dresses could plausibly have, namely that such goods are transparent, “clear,” or include transparent or “clear” accents or elements. Indeed, Applicant stated in its brief:

For purposes of appeal, Applicant will not dispute the Examining Attorney’s assertion that CLEAR means

“transparent” when applied to footwear. ... Given that, it thus follows that if a party tried to register CLEAR broadly for all forms of footwear, the mark would be descriptive because it would describe a feature or characteristic of at least *one form* of footwear (namely, “transparent footwear”) *within* the broader definition.

Applicant’s brief pp. 4-5. (Emphasis supplied and internal citations omitted.)¹⁶ And, the record shows that at one time Applicant offered a shoe that it described as having “clear accents.”¹⁷ Applicant adds, however, that it “is not seeking to register CLEAR for both ‘transparent *and* non-transparent footwear;’ it is only seeking to register it for non-transparent footwear.” *Id.* at p. 5. (emphasis supplied).¹⁸ Based on the evidence of record, we have no doubt that consumers will immediately perceive the word “clear” as describing a feature or attribute that Applicant’s footwear and clothing could plausibly have. We therefore find that Applicant’s restriction of its identification of goods to non-transparent or non-clear goods is sufficient to show (and in fact conclusively establishes) that the proposed CLEAR mark misdescribes a feature or attribute of the goods in that Applicant’s identified footwear and clothing items do not possess the characteristic of being “clear.” *See generally* TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1209.04 (2018), and the authorities cited therein. Thus, the first part of the test for deceptive misdescriptiveness has been satisfied.

¹⁶ 6 TTABVUE 5-6.

¹⁷ October 28, 2019 Office Action; TSDR 8.

¹⁸ 6 TTABVUE 6.

Applicant's contention that its proposed mark CLEAR does not describe a plausible feature of its goods because it has restricted its identification so that the recited goods do not include transparent footwear and clothing is unavailing. We cannot assume that consumers of Applicant's goods will be aware that its identification is so restricted, and the restriction is not controlling of public perception. *See In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1187-88 (TTAB 2018). *Cf., e.g., In re Clorox Co.*, 578 F.2d 305, 198 USPQ 337, 340 (CCPA 1978) (“[T]he locus of potential confusion is [not] in the files of the PTO.”); *In re Wada*, 48 USPQ2d 1689, 1692 (TTAB 1998) (public is unaware of disclaimers that “quietly reside” in the records of the Office).

Moreover, Applicant cannot avoid a finding of deceptive misdescriptiveness by excluding from its identification the very characteristic that its mark is misdescribing. *Cf. In re ALP of South Beach, Inc.*, 79 USPQ2d 1009, 1010 (TTAB 2006) (“We find that the word CAFETERIA used in connection with restaurant services that explicitly exclude cafeteria-style restaurants does misdescribe the services.”). In addition, the record is devoid of any evidence that, as Applicant proposes, the word “clear” suggests other meanings when used for or in connection with footwear or clothing. Even so, that a term may have other meanings in different contexts is not controlling. *See In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). “It is well settled that so long as any one of the meanings of a term is descriptive [or misdescriptive], the term may be considered to be merely descriptive

[or misdescriptive].” *In re Mueller Sports Med., Inc.*, 126 USPQ2d 1584, 1590 (TTAB 2018); *In re Canine Caviar Pet Foods, Inc.*, 126 USPQ2d 1590, 1598 (TTAB 2018).

Having determined that the term misdescribes the goods, we now assess whether consumers are likely to believe the misrepresentation. Again, the evidence shows that footwear and clothing may be transparent or “clear” or include “clear” elements, such as heels and straps on footwear and straps on clothing, and that those goods are described as such by those in the industry and by ordinary consumers. As the record reflects, “clear shoes were one of the big breakout trends on the spring/summer runways.” As a result, consumers seeing the proposed mark CLEAR for footwear and clothing items are likely to believe that those items are clear or transparent even though they are not.

We are not persuaded by Applicant’s assertion that reasonably prudent consumers are unlikely to believe the “misrepresentation,” because footwear and clothing are goods that buyers will visually inspect before purchase. In making this argument, Applicant relies on three Board decisions: *In re Econoheat, Inc.*, 218 USPQ 381, 383 (TTAB 1983) (SOLAR QUARTZ for space heaters), *Nw. Golf Co. v. Acushnet Co.*, 226 USPQ 240, 242-43 (TTAB 1985) (POWER-STEP for golf clubs), and *In re Robert Simmons, Inc.*, 192 USPQ 331, 333 (TTAB 1976) (WHITE SABLE for paint brushes made from synthetic fibers).

We find these decisions to be distinguishable in material respects from this case. Unlike this case, the mark at issue in *Robert Simmons* included the word “sable,” which is defined in, for example, the online version of MERRIAM-WEBSTER, as “the

color black,” yet the mark also included the term “WHITE” the antithesis of “black” so consumers would not be deceived into believing WHITE SABLE paint brushes would be made from the hair or fur of a sable.¹⁹ In *Northwestern Golf*, unlike here, the term at issue (“STEP”) did not necessarily have a misdescriptive meaning to consumers: purchasers would not “necessarily construe the word ‘STEP’ in applicant’s [POWER-STEP] mark as signifying that applicant’s golf club shaft has but a single step.”²⁰ *Nw. Golf*, 226 USPQ at 242. Rather, “they might just as readily believe that the word ‘STEP’ is used in the mark as a synonym for ‘step pattern.’” *Id.* at 243. Finally, in *Econoheat*, there did not appear to be any evidence of solar-powered quartz space heaters and, in fact, the term “Solar” referred to some other attribute of the device: the type of heat emitted. *See* 218 USPQ at 382. Here, by contrast, there is plentiful evidence of use of the term “clear” to describe transparent examples of the goods at issue, and Applicant has offered no other possible meaning the term could have in the context of these goods. Accordingly, we do not find that these cases support Applicant’s arguments.

Just because upon visually inspecting Applicant’s footwear or clothing items consumers may understand that they do not include transparent or clear attributes

¹⁹ www.merriam-webster.com/dictionary/sable, last visited March 15, 2021. The Board may take judicial notice of dictionary definitions, including online dictionaries which exist in printed format. *See In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002).

²⁰ The term “step” in that context meant a discrete point on the shaft of a golf club where the shaft narrowed as it extended further from the handle and approached the club head. *Nw. Golf*, 226 USPQ at 241.

does not negate their understanding before they inspect the goods. If Applicant's goods were to be promoted by word-of-mouth or on social media or in print (*e.g.*, in fashion blogs, magazine articles, or even Applicant's future advertising) without an image of the goods, a reasonable consumer seeking what the record shows to be a fashion trend would believe that Applicant's goods, promoted under the proposed CLEAR mark, would feature transparent or clear attributes. *See, e.g., In re Woodward & Lothrop Inc.*, 4 USPQ2d 1412, 1414 (TTAB 1987) (CAMEO held deceptively misdescriptive of jewelry items because while a reasonable purchaser carefully examining jewelry which has no cameos or cameo-like elements may not be deceived into believing that it does, not all jewelry would be purchased in that manner; some jewelry may be purchased from catalogs which either inadequately describe or depict the jewelry items.); *see also ALP of South Beach*, 79 USPQ2d at 1014 (finding that pre-sale deception may occur without a sale taking place based on the deception). Pre-sale discussion and promotion leading to deception is likely in this case given the popularity of footwear with clear accents or elements and the fact that Applicant at one time offered a shoe with clear accents.

In view of the above, we find that the second part of the deceptive misdescriptiveness test also has been satisfied.

C. Conclusion

After reviewing the evidence of record, we find that both parts of the deceptive misdescriptiveness test have been satisfied and are unrebutted and, accordingly, Applicant's proposed mark is deceptively misdescriptive within the meaning of

Serial No. 88554717

Section 2(e)(1). In view of our determination on the ground of deceptive misdescriptiveness, the alternative ground for refusal that the mark is merely descriptive is moot.

Decision: The refusal to register Applicant's proposed mark CLEAR for the identified goods on the ground that it is deceptively misdescriptive under Trademark Act Section 2(e)(1) is affirmed.

**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITATIONS

Case Number: 2021-2114, -2115

Short Case Caption: In re: Dolce Vita Footwear, Inc.

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