

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 12/16/98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hartz & Company, Inc.

Serial No. 75/019,666

Herbert Cohen of Wigman, Cohen, Leitner & Myers, P.C.
for applicant.

Robert C. Clark, Jr., Trademark Examining Attorney, Law
Office 108 (David Shallant, Managing Attorney).

Before Simms, Seeherman and Wendel, Administrative
Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Hartz & Company, Inc. has filed an application to
register the mark TALLIA for "cuff links and stud sets for
use with formal wear shirts".¹

Registration has been finally refused under Section
2(d) of the Trademark Act, on the ground of likelihood of

¹ Ser. No. 75/019,666, filed Nov. 13, 1995 based on a bona fide
intent to use. Ownership of Reg. No. 1,943,279, issued Dec. 26,
1995, for the mark TALLIA for "men's and women's clothing,
namely, suits, jackets, pants, blouses" has been claimed.

confusion with the mark TALIA and design, as depicted below, which is registered for use in connection with "jewelry".²

Applicant and the Examining Attorney have filed briefs, but the request for an oral hearing was withdrawn.

We look first to the degree of similarity of the goods involved here. Although applicant argues that registrant's goods and its goods are sophisticated jewelry items which would be sold in different types of stores, this claimed distinction is without support. As pointed out by the Examining Attorney, the issue of likelihood of confusion must be determined on the basis of the goods as identified in the application and the cited registration. In addition, in the absence of specific limitations therein, our consideration should include all the normal and usual channels of trade for the goods. See *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). The only limitation

² Reg. No. 1,393,982, issued May 20, 1986, claiming first use dates of Feb. 1, 1985. Section 8 affidavit accepted; Section 15 affidavit submitted.

in applicant's identification relates to the manner of use of applicant's cuff links and stud sets, not to the particular type of stores in which the items may be purchased. Whether or not, as argued by applicant, applicant's goods are generally sold in retail and specialty stores specializing in the sale and rental of men's formal wear, the application is not so restricted.

Furthermore, the "jewelry" of registrant is completely unrestricted as to type, cost or place of sale. While the design portion of the registered mark consists of a representation of a woman's ring, the goods are not limited to rings or even to women's jewelry. Accordingly, we agree with the Examining Attorney that the goods identified in the registration, i.e., jewelry, fully encompass the specific jewelry items of applicant. Furthermore, the Examining Attorney has made of record several third-party registrations as evidence of the listing by others of cuff links and stud sets as specific items to be covered under the general category of "jewelry."³

Thus, we must determine the issue of likelihood of confusion on the basis that the goods are legally identical jewelry items which would travel in the same channels of

³ We note that applicant's identification of goods in the application as initially filed listed other jewelry items,

trade and might be encountered by the same prospective purchasers in the same stores. It is well established that when the goods are identical or closely related, the degree of similarity of the marks necessary to uphold the likelihood of confusion decreases. See *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

With respect to the present marks, the Examining Attorney argues that the dominant feature of the registered mark is the word TALIA, with the ring design only being used as a background for the word. He considers the word TALIA to be a strong, fanciful term with no apparent meaning, whereas the ring design is suggestive of the goods with which it is being used. Thus, from the Examining Attorney's viewpoint, it is the word portion of the registered mark which would be the more significant in terms of creating a commercial impression and, as a result, registrant's TALIA mark and applicant's TALLIA mark would create similar impressions.

Applicant contends that the design feature of the registered mark cannot be so disregarded. Instead, according to applicant, the "gemstone ring design" serves

including items worn by women, such as brooches, earrings and bracelets.

as the distinguishing portion of the registered mark and eliminates the likelihood of confusion with applicant's mark. Applicant argues that the addition of a second "L" to the word portion in applicant's mark and the prominence of the design in registrant's mark result in "distinctly different overall commercial impression[s]."

Although it is true that in determining the likelihood of confusion marks must be considered in their entirety, it is well established that there is nothing improper in giving more or less weight to a particular feature of a mark. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). If the word portion of a mark rather than the design feature is more likely to be remembered and relied upon by purchasers in referring to the goods, it is the word portion which will be accorded more weight. See Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A., 32 USPQ2d 1192 (TTAB 1994); In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987).

Here we consider the word portion TALIA to be the dominant portion of the registered mark. The design of a ring, when used in connection with jewelry, is clearly suggestive, if not descriptive, of the goods and is less likely to be remembered by purchasers as a source indicator. See In re Appetito Provisions Co., *supra* at

1554 [sandwich design merely descriptive of type of food sold in registrant's restaurant and thus word portion of mark is the dominant element]. Accordingly, the overall commercial impressions which will be created by the marks, and which will be remembered by potential purchasers over a period of time, will be created by the words TALIA and TALLIA. Inasmuch as these words are very similar in appearance and virtually identical in sound, and inasmuch as it is a general impression which is often retained by purchasers, confusion is likely as to the source of the jewelry items offered under these marks. See *Faberge, Inc. v. Madison Shirt Corp.*, 192 USPQ 223 (TTAB 1976) and the cases cited therein.

Applicant has further raised the argument that its prior registration for the same mark TALLIA for clothing items entitles applicant to expand to other goods normally licensed by clothing designers. In particular, applicant claims that the cuff links and stud sets for which it now seeks registration of the mark TALLIA are closely related to the formal wear sold by applicant for many years under its TALLIA mark.

Applicant's argument is to no avail. The mark TALIA and design has been previously registered by another for jewelry items. Applicant cannot rely upon use and

Ser No. 75/019,666

registration of the mark TALLIA for clothing as a defense under Section 2(d), when it is now seeking to register the mark for the goods listed in the cited registration. See *In re L.C. Licensing, Inc.*, ___USPQ2d___, S.N. 75/132,969 (TTAB Nov. 20, 1998)[applicant cannot rely upon prior registration of LIZSPORT in connection with apparel and accessories as defense against likelihood of confusion with previously registered mark LIZ for fragrances and personal care products, when applicant is seeking to register LIZSPORT for fragrances and personal care products].

Accordingly, we find that there is a likelihood of confusion if applicant's mark TALLIA is used on its particular jewelry items, cuff links and stud sets for formal wear, in view of the previously registered TALIA and design mark for jewelry in general.

Decision: The refusal to register under Section 2(d) is affirmed.

R. L. Simms

E. J. Seeherman

H. R. Wendel

Ser No. 75/019,666

Trademark Administrative Judges,
Trademark Trial and Appeal Board