

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB DEC. 14, 99
U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

George H. Fuller & Son Co.
v.
Thomas A. Wheeler

Opposition No. 104,859
to application Serial No. 75/023,839
filed on November 24, 1995

Roberta Jacobs-Meadway of Panitch Schwarze Jacobs & Nadel,
P.C. for George H. Fuller & Son Co.

R. John Bartz, Esq. for Thomas A. Wheeler.

Before Hanak, Chapman and Bucher, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

Thomas A. Wheeler filed an application to register the
mark shown below

for "hand crafted jewelry and custom designed jewelry."
Applicant claimed a date of first use and first use in
commerce of May 1991.

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George H. Fuller & Son Co. has opposed registration of the mark, alleging that opposer "is and for many years has been engaged in the manufacture and sale of jewelry findings" (paragraph 2); that opposer owns Registration No. 1,751,189 for the mark shown below

for jewelry findings¹; that opposer has used its "F and design" mark continuously since 1892; and that applicant's mark, when used in connection with his goods, so resembles opposer's previously used and registered mark, as to be likely to cause confusion, mistake, or deception.

Applicant denied the salient allegations of the notice of opposition.

The record consists of the pleadings²; opposer's notices of reliance on a status and title copy of its pleaded registration prepared by the Patent and Trademark Office, photocopies of several third-party registrations, and applicant's responses to certain of opposer's discovery requests; and applicant's notices of reliance on a status

¹ Reg. No. 1,751,189 issued February 9, 1993. The claimed dates of first use and first use in commerce are 1892 and 1906, respectively.

² Opposer attached its company brochure as Exhibit A to the notice of opposition. The exhibit is not evidence on behalf of opposer and was not considered by the Board. See Trademark Rule 2.122(c) and TBMP §705.01.

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and title copy of his registration prepared by the Patent and Trademark Office for the mark shown below

for "hand crafted opal jewelry"³, photocopies of two third-party registrations, one printed publication, and applicant's responses to certain of opposer's discovery requests.

Both parties filed briefs on the case, and neither party requested an oral hearing.

Opposer's pleaded and proved registration on the Principal Register constitutes prima facie evidence of opposer's use of the mark shown therein for the goods identified in the registration as of the filing date of the application which matured into the registration. See *Liberty & Co., Ltd. v. Liberty Trouser Co., Inc.*, 216 USPQ 65 (TTAB 1982); and *Hyde Park Footwear Company, Inc. v. Hampshire-Designers, Inc.*, 197 USPQ 639 (TTAB 1977). Further, the registration is entitled to the statutory presumptions of Section 7(b) of the *Trademark Act*,

³ Reg. No. 1,952,641 issued January 30, 1996. The claimed dates of first use and first use in commerce are August 1984. The term "opal" is disclaimed. The registration includes the following statements: "The mark is lined for the colors blue, green, yellow, red and brown. The mark consists of an oval design within which is a rainbow forming the border of the oval. Within the rainbow border is a rising sun and the words "opal fields" superimposed on the sun."

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specifically, the validity of the registration, opposer's ownership of the mark, and opposer's exclusive right to use the mark in connection with the goods recited in the registration. Thus, in this case opposer is entitled to the presumption that it has used the mark shown below

for jewelry findings since January 14, 1991.

Through applicant's answers to certain of opposer's discovery requests which have been submitted as evidence herein, the record shows that applicant first used his involved mark (described by applicant as consisting of the letters "O F") in May 1991; that his mark is an abbreviation of his business name, OPAL FIELDS; that he sells his goods in a single small retail jewelry store in Honolulu, Hawaii; that he makes custom ordered jewelry, mainly with boulder opal, which is special ordered by purchasers over-the-counter in his retail jewelry store; and that he promotes his mark through local advertising. Further, this record also shows that before he filed his application, a trademark search of "O F and design" was conducted which did not reveal opposer's registration; and that he is aware of no instances of actual confusion.

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As noted above, opposer has filed a status and title copy of its pleaded registration.⁴ In view of opposer's ownership of a valid and subsisting registration for its mark for jewelry findings, the issue of priority does not arise. See *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); and *Carl Karcher Enterprises Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125 (TTAB 1995). Moreover, opposer's first use, as established in this case, is January 14, 1991, whereas applicant's established first use is May 1991.

Thus, the sole issue before the Board is likelihood of confusion. Our determination of likelihood of confusion must be based on our analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

⁴ Opposer's pleaded Registration No. 1,751,189 issued on March February 9, 1993. The status and title copy of opposer's registration submitted with the notice of reliance was prepared by the Patent and Trademark Office in August 1997, and thus, does not include information as to the Section 8 affidavit, which was due on February 9, 1999. The records of this Office indicate that opposer timely filed a combined Section 8 and 15 affidavit, and that said combined affidavit was accepted and acknowledged, respectively, by this Office.

When a registration owned by a party has been properly made of record in an inter partes case, and there are changes in the status of the registration between the time it was made of record and the time the case is decided, the Board will take judicial notice of, and rely upon, the current status of the registration as shown by the records of the Patent and Trademark Office. See TBMP §703.02(a), at page 700-10, and the cases cited therein. The Board hereby takes judicial notice of the current status of opposer's pleaded registration.

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Based on the record before us in this case, we find that confusion is not likely.

We turn first to a consideration of the similarity or dissimilarity of the involved marks. While there is an obvious similarity in that both marks include the letter "F"; there are also obvious differences, specifically that opposer's mark consists of very sharp, thin, straight lines forming the letter "F" within a perfect circle, whereas applicant's mark is a very thick-lined rough approximation of a circle or an oval or the letter "O" with a similarly rough-hewn, thick-lettered "F" contained therein. The letter "F" could perhaps be spoken by consumers. "However, the spoken or vocalizable element of a design mark, taken without the design, need not of itself serve to distinguish the goods. The nature of stylized letter marks is that they partake of both visual and oral indicia, and both must be weighed in the context in which they occur." In re Electrolyte Laboratories Inc., 913 F.2d 930, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990).

The similarity or dissimilarity of some marks in appearance and commercial impression ultimately comes down to the "eyeball test." This is explained by J. Thomas McCarthy, at 2 McCarthy, McCarthy on Trademarks and Unfair Competition, §23:25 (4th ed. 1999) as follows (footnote omitted):

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Because a picture is worth a thousand words, there is little in the way of guidelines to determine the degree of visual similarity which will cause a likelihood of confusion of buyers. Obviously, for picture and design marks (as opposed to word marks), similarity of appearance is controlling. There is no point in launching into a long analysis of the judicial pros and cons regarding visual similarity of marks. Regarding visual similarity, all one can say is 'I know it when I see it.'"

The stylization of applicant's mark is distinctly different from that of opposer's mark. Moreover, opposer did not submit any evidence that its mark appears directly on the jewelry parts or, if so, that its mark remains visible to the purchasers of finished jewelry items. We find that these marks are not similar in appearance and commercial impression. See *Franklin Mint Corporation v. Master Manufacturing Company*, 667 F.2d 1005, 212 USPQ 233 (CCPA 1981).

Turning next to a consideration of the similarity or dissimilarity of the goods, applicant's goods are handmade, custom designed jewelry. While there is no testimony or other evidence explaining opposer's goods, both parties have referred to opposer's "jewelry findings" as parts or components of finished jewelry items. (opposer's brief, p. 8; applicant's brief, p. 5). The burden of proof to justify that the relationship of the parties' goods is such that confusion would be likely rests on the opposer, and

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opposer's sparse record in this case does not meet that burden. See *Chase Manhattan Bank, N.A. v. Life Care Services Corp.*, 227 USPQ 389 (TTAB 1985).⁵

Opposer argues that its goods are components of finished jewelry products such as those made by applicant; and that there is a common association between jewelry and jewelry findings. Opposer submitted several third-party registrations, all based on use in commerce, to show that "...it is common for companies to register the same mark for articles of jewelry and for findings" [opposer's notice of reliance under Trademark Rule 2.122(e)].⁶ This evidence is entitled to some probative value to the extent that third-party registrations suggest that the listed goods emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467 (TTAB 1988). Further, we acknowledge that there is a relationship which is obvious in

⁵ The Board stated in *Borg-Warner Chemicals, Inc. v. Helena Chemical Company*, 225 USPQ 222, 224 (TTAB 1983) as follows:

The Board in the past has found no likelihood of confusion even with respect to identical marks applied to goods and/or services used in a common industry where such goods and/or services are clearly different from each other and there is insufficient evidence to establish a reasonable basis for assuming that the respective goods as identified by their marks, would be encountered by the same purchasers. (citations omitted.)

⁶ We note that one of the third-party registrations does not include both jewelry and jewelry findings in the identification of goods (Reg. No. 317,247--"jewelry for personal wear or adornment, not including watches").

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that component parts of jewelry are an integral part of finished jewelry. However, there is no rule that the parts utilized to make the finished product and the finished product are per se related products within the context of trademark law. See e.g., *In re Albert Trostel*, supra (wherein the Board found no likelihood of confusion between PHOENIX for leather sold in bulk and PHOENIX for all-purpose sports bags, luggage, attache cases, portfolio briefcases, and handbags).

It is true that inasmuch as neither applicant's application nor opposer's registration include any type of restriction as to trade channels or purchasers, we must presume that the involved goods are sold in all the normal channels of trade to the usual classes of purchasers for such goods. See *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

Applicant sells finished jewelry to the general public; whereas, opposer sells component parts of jewelry to those who assemble and finish pieces of jewelry. In our consideration of the respective channels of trade and respective purchasers, we consider the following statements made by opposer in its brief on the case:

"Jewelry findings are sold to individuals who assemble and finish pieces of pieces of jewelry, for example, jewelry manufacturers, wholesalers, retailers

and/or jewelry designers, who then sell such jewelry items to jewelry distributors, manufacturers, wholesalers, retailers, and the general public. Individuals who make and sell jewelry, and secure finished and unfinished goods may encounter both jewelry of the type encompassed by Applicant's identification of goods and [Opposer's] jewelry findings..." (brief, p. 9)

"Normal channels of trade for both parties' goods include retail stores, wholesale distributors of jewelry, and any other location where jewelry is sold and repaired. Normal purchasers include jewelry retailers, wholesalers, and others who design, produce, sell and repair jewelry." (brief, p. 10).

Thus, according to opposer, the only common purchasers are jewelry manufacturers, wholesalers, retailers, and/or jewelry designers; and these purchasers of opposer's goods in turn sell the assembled and finished pieces of jewelry to others. These potentially common purchasers of both parties' goods are knowledgeable about the products in this field and their sources for such products. Therefore, the likelihood that the common purchasers would be confused by the use of these involved marks on the differing goods is much less than if both marks were encountered by the ultimate purchasers of applicant's goods. See *In re Albert Trostel*, supra.

Even if two parties conduct business in the same fields, and even with some of the same companies, the mere purchase of the goods by those companies does not, by

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itself, establish similarity of trade channels or overlap of customers. See *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1998) (reversing a Board finding of likelihood of confusion between opposer's registered mark EDS for computer programming services in, inter alia, the medical field and applicant's mark E.D.S. for power supplies and battery chargers, generally incorporated into medical instruments).

Based on this record, we find that there are generally separate purchasers and separate channels of trade for applicant's and opposer's respective goods. To whatever extent there may be a few common purchasers, they are knowledgeable regarding their sources and would not be likely to be confused.

Opposer's argument that its mark is "strong" and thus is afforded a broader scope of protection is unsupported by any evidence. See *Fossil Inc. v. Fossil Group*, 49 USPQ2d 1451 (TTAB 1998). Cf. *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

The absence of any actual confusion is not a crucial factor to our decision. The absence of confusion is not surprising given the differences between the marks, and the separate channels of trade to different purchasers.

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Finally, the Trademark Act does not speak in terms of remote possibilities of confusion, but rather, the likelihood of such confusion occurring in the marketplace. Our primary reviewing court has stated that more than a mere possibility of confusion must be shown; instead, there must be demonstrated a probability or likelihood of confusion. See *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, supra, quoting from *Witco Chemical Company, Inc. v. Whitfield Chemical Company, Inc.*, 418 F.2d 1403, 164 USPQ 43 (CCPA 1969) as follows: "We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with *de minimis* situations but with the practicalities of the commercial world, with which the trademark laws deal." See also, *Triumph Machinery Company v. Kentmaster Manufacturing Company Inc.*, 1 USPQ2d 1826 (TTAB 1987).

We conclude that prospective customers for applicant's goods are not likely to believe that applicant's goods emanate from the same source as opposer's goods, nor that they are approved or sponsored by opposer, nor that applicant's business is the business of, or is associated with opposer. That is, under the du Pont test, we conclude that confusion is unlikely in this case.

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Decision: The opposition is dismissed.

E. W. Hanak

B. A. Chapman

D. E. Bucher
Administrative Trademark Judges,
Trademark Trial and Appeal Board