

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JUNE 9, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Silmar S.p.A.

Serial No. 74/405,242

Fernanda M. Fiordalisi of Buchman and Archer for Silmar
S.p.A.

Amos T. Matthews, Trademark Examining Attorney, Law Office
108 (David Shallant, Managing Attorney).

Before Seeherman, Walters and Chapman, Administrative
Trademark Judges.

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

Silmar S.p.A. filed an application to register the
mark EMBROIDERED GOLD on the Principal Register. The
goods, as amended, are "necklaces, bracelets and earrings,
made of gold with or without precious stones".¹ Also by
amendment, applicant disclaimed the term GOLD.

¹ Application Serial No. 74/405,242, filed June 22, 1993. The
application is based on Section 44(d) and (e) with a priority
filing date of June 4, 1993 from Italian application No.

The Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its identified goods, so resembles the previously registered mark EMBROIDERED ENAMEL for "jewelry, and in particular bracelets, earrings, pendants, rings and beads"² as to be likely to cause confusion, mistake or deception. Following receipt of a copy of applicant's Italian registration, the Examining Attorney made the refusal to register under Section 2(d) final. Applicant appealed, and timely filed its brief.

The Examining Attorney filed his brief and a request that the application be remanded. The Board granted the request for remand. The Examining Attorney entered a new refusal to register the mark as merely descriptive under Section 2(e)(1); and in response, applicant amended its application to seek registration on the Supplemental Register. The Examining Attorney accepted this amendment, thereby obviating the Section 2(e)(1) refusal, and returned the application file to the Board; whereupon the Board allowed applicant time to file a supplemental brief or a

VI93C000122 (now Italian Registration No. 676.054 granted on April 15, 1996).

² Reg. No. 1,269,754 issued March 13, 1984, Section 8 affidavit accepted, Section 15 affidavit acknowledged. The term "ENAMEL"

reply brief. Applicant filed a reply brief. Applicant did not request an oral hearing.

We affirm the refusal to register. In reaching this conclusion, we have considered all of the relevant du Pont³ factors.

It is the Examining Attorney's position that the involved marks are similar in appearance, meaning and commercial impression; that applicant has incorporated the dominant portion of the registered mark and added a generic term thereto; that the addition of the highly descriptive terms GOLD or ENAMEL will not be perceived by purchasers as source indicators; and that the goods are in part identical (bracelets and earrings) and are otherwise related.

Applicant essentially contends that the Examining Attorney erred by dissecting the marks and analyzing them as consisting of the shared word EMBROIDERED and the generic word GOLD in applicant's mark and the descriptive word ENAMEL in the registrant's mark; that the common element, EMBROIDERED, is "highly suggestive and therefore weak" (brief, p. 4); and that when considered in their entirety the marks are not confusingly similar. In addition, applicant cites J. Thomas McCarthy, McCarthy on

is disclaimed. The claimed date of first use and first use in commerce is June 11, 1982.

Trademarks and Unfair Competition, §19:37 (4th ed. 1999), for the proposition that when reviewing conflicts where the cited registration is on the Supplemental Register, a different test should apply whereby registration will be precluded only if the marks are substantially identical and are used on substantially identical goods or services. Applicant then contends that this "different test" should also apply when the cited registration is on the Principal Register and the applicant seeks registration on the Supplemental Register.

The only issue we must determine is whether applicant's mark is so similar to the cited registered mark that when seen by purchasers used in connection with the same or similar goods it will be likely to cause confusion as to the source or origin of the goods. See *Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992).

Applicant's argument regarding the analysis to be used when either the cited registered mark or the applied-for mark is on the Supplemental Register is meritless. First, McCarthy's proposal of a "different test of likelihood of confusion" when the cited registration is on the

³ See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973).

Supplemental Register has been criticized by the Court of Appeals for the Federal Circuit as unfounded under the statute and the legislative history of the statute. See *Towers v. Advent Software Inc.*, 913 F.2d 942, 16 USPQ2d 1039, footnote 2 (Fed. Cir. 1990). See also, *In re Smith & Mehaffey*, 31 USPQ2d 1531 (TTAB 1994). Second, McCarthy did not propose that his "different test" for likelihood of confusion be applied when the cited registered mark is on the Principal Register, and applicant seeks a Supplemental Register registration.

As noted above, applicant's goods are "necklaces, bracelets and earrings, made of gold with or without precious stones," and the cited registrant's goods are "jewelry, and in particular bracelets, earrings, pendants, rings and beads." We note that applicant's goods are limited to jewelry made of gold. However, the cited registration is not limited to jewelry made of any particular material, and therefore applicant's gold jewelry is encompassed within the scope of the registrant's goods. We hold that the involved goods are essentially identical and/or closely related products. Applicant did not argue to the contrary.

Likewise applicant did not argue, and we do not find, any differences in the channels of trade or purchasers. We

must presume, given the identifications, that the goods travel in the same channels of trade, and are purchased by the same class of purchasers. See *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

Turning then to a consideration of the respective marks, it is well settled that marks must be considered in their entireties. However, our primary reviewing court has held that in articulating reasons for reaching a conclusion on the question of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature or portion of a mark. That is, one feature of a mark may have more significance than another. See *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

In this case, both marks include the word EMBROIDERED, which modifies the generic term GOLD to form applicant's mark, and which modifies the term ENAMEL to form registrant's mark. Both marks are presented in the same format. Moreover, the Lexis/Nexis evidence submitted by the Examining Attorney with his refusal to register based on mere descriptiveness (an issue not before us in view of applicant's amendment to the Supplemental Register)

indicates that there may be a type of jewelry which is "embroidered" (i.e., embellished or detailed). That is, ENAMEL and GOLD are obviously two different words, but they each appear to refer to a subset or a type of jewelry finish. Even assuming registrant's mark is highly suggestive, such trademarks are nonetheless entitled to protection. See *Continental Scale Corporation v. Weight Watchers International, Inc.*, 517 F.2d 1378, 186 USPQ 321 (CCPA 1975); *In re Great Lakes Canning, Inc.*, 227 USPQ 483 (TTAB 1985); and *In re L. R. Brock Ind. Inc.*, 218 USPQ 1055 (TTAB 1983). See also, *The Maytag Co. v. Luskin's Inc.*, 228 USPQ 747 (TTAB 1986).

The commercial impression created by the marks involved herein is substantially similar. See *The Wella Corporation v. California Concept Corporation*, 558 F.2d 1019, 194 USPQ 419 (CCPA 1977); and *In re South Bend Toy Manufacturing Company, Inc.*, 218 USPQ 479 (TTAB 1983).

Purchasers may assume that EMBROIDERED GOLD is just a variant of registrant's EMBROIDERED ENAMEL mark, used to identify a new line of jewelry made of gold. That is, purchasers are likely to assume that applicant's goods come from the same source as registrant's goods or are in some way sponsored by or associated with registrant. See *In re Imperial Jade Mining, Inc.*, 193 USPQ 725 (TTAB 1976).

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

E. J. Seeherman

C. E. Walters

B. A. Chapman
Administrative Trademark
Judges, Trademark Trial and
Appeal Board