

THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Paper No. 18

JQ

Mailed: September 9, 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Orion Diamond Inc.

Serial No. 75/824,874

Ezra Sutton for applicant.

Michael L. Engel, Trademark Examining Attorney, Law Office
108 (David Shallant, Managing Attorney).

Before Seeherman, Quinn and Hohein, Administrative
Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Orion Diamond Inc. to
register the mark PRINCESSA for "princess-cut diamond
rings, pendants and earrings."¹

The Trademark Examining Attorney has refused
registration under Section 2(d) of the Act on the ground
that applicant's mark, when applied to applicant's goods,

¹ Application Serial No. 75/824,874, filed October 18, 1999,
alleging first use anywhere and first use in commerce at least as
early as March 1998.

so resembles the previously registered mark shown below

PRINCESS

for "finger rings"² as to be likely to cause confusion.³

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

Applicant argues, in urging that the refusal be reversed, that the cited mark is weak and that it creates a different commercial impression from the one engendered by applicant's mark. In this connection, applicant submitted evidence of third-party registrations. Applicant also points to its ownership of a registration of the mark PERFECT PRINCESS for jewelry. Applicant does not dispute the similarity between the goods.

² Registration No. 44,936, issued August 1, 1905; fourth renewal.

³ Registration also was refused under Section 2(d) on the basis of Registration No. 1,929,254, issued October 24, 1995. A check of Office records shows that this registration was canceled pursuant to Section 8 on July 27, 2002. Accordingly, insofar as the appeal was based on the refusal to register in view of Registration No. 1,929,254, the appeal is dismissed as involving a moot question.

The Examining Attorney maintains that the marks PRINCESS (stylized) and PRINCESSA look and sound alike, and that the addition of a final letter "A" in applicant's mark does not create a significantly different commercial impression from registrant's mark. The Examining Attorney also points to the identity, at least in part, between the goods.

Before turning to the merits of the appeal, we focus our attention on the Examining Attorney's objection to the third-party registration evidence. During the prosecution of the application, applicant submitted a computer printout from a private database listing fourteen third-party registrations of marks which include the term "PRINCESS" for jewelry. The Examining Attorney, in response, made no objection to the listing, but rather considered this evidence. Applicant then submitted, with its appeal brief, a printout retrieved from the same private database showing seventeen third-party registrations and six third-party pending applications for marks comprising, in part, the term "PRINCESS" for jewelry. In his appeal brief, the Examining Attorney objected to the evidence attached to applicant's appeal brief, asserting that the evidence was improperly introduced inasmuch as the printout was not generated by the Office's automated records.

By considering the earlier printout, the Examining Attorney waived his right to object to the fourteen third-party registrations which were listed in that printout, nine of which appear again in the printout attached to the appeal brief. The objection is sustained, however, as to the additional third-party applications and registrations that were sought to be introduced for the first time by the printout attached to the appeal brief. Firstly, as a general rule, evidence submitted with an appeal brief is untimely. Trademark Rule 2.142(d). Secondly, in order to properly introduce third-party registrations and/or applications, soft copies of the registrations or the electronic equivalents thereof generated by the Office's automated search system must be submitted.

We now turn our attention to the Section 2(d) refusal. Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

The goods in the application and the cited registration are legally identical, at least in part, insofar as the application lists "princess-cut diamond rings" and the registration lists "finger rings." The term "finger rings" is presumed to encompass rings of all such types, including diamond rings. Further, the jewelry items "diamond pendants" and "diamond earrings" in the application are otherwise closely related to registrant's "finger rings." It also is presumed that the goods move in the same channels of trade and are purchased by the same classes of purchasers. In re Elbaum, 211 USPQ 639 (TTAB 1981).

Accordingly, we turn to the question of whether the respective marks are sufficiently similar such that their use in connection with the legally identical jewelry item, rings, and otherwise closely related jewelry items, pendants and earrings, would be likely to cause confusion. In this connection, we note that if the goods are identical, as they are here, at least in part, "the degree of similarity [between the marks] necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Applicant's mark PRINCESSA and registrant's mark PRINCESS (stylized) are substantially similar in sound and appearance, differing by only the final letter "A" in applicant's mark and the slight stylization of registrant's mark. As to connotation, applicant has offered no meaning for its mark, and it is quite likely, given the similarities in sound and appearance, that prospective purchasers will view the marks as having similar, if not identical meanings. In this connection, we take judicial notice of the dictionary listing showing that the Spanish word "princesa" means "princess" in English. Cassell's Spanish-English, English-Spanish Dictionary (1959).

Although applicant's mark differs from the Spanish word by an additional letter "s," it is likely that prospective customers familiar with the Spanish language will view the word as meaning "princess" in English. And, even if the term "princess" is viewed as suggestive when applied to rings, the marks convey the same suggestion.

The evidence of third-party registrations is entitled to little weight in evaluating whether there is a likelihood of confusion. See, e.g., *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973); and *In re Hub Distributing, Inc.*, 218 USPQ 284, 285-86 (TTAB 1983). We particularly note that all of

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the existing registered marks include additional words, and none of the marks is as similar to registrant's mark as is the mark sought to be registered herein. For the same reasons, applicant's ownership of the registered mark PERFECT PRINCESS does not compel a different result. In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

We also have considered the fact that certain diamond rings may be quite expensive and involve a discriminating purchase. However, in view of the substantial similarity between the marks, even careful purchasers are likely to be confused when encountering the marks on rings and closely related jewelry items.

We conclude that consumers familiar with registrant's finger rings sold under the mark PRINCESS (stylized) would be likely to believe, upon encountering applicant's mark PRINCESSA for diamond rings, pendants and earrings, that the jewelry items originated with or were somehow associated with or sponsored by the same entity.

Decision: The refusal to register is affirmed.