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BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Waldman Diamonds Complete, LLC

Serial No. 76/134,279

Seth Natter of Natter & Natter for Waldman Diamonds
Complete, LLC.

Wanda Kay Price¹, Trademark Examining Attorney, Law Office
111 (Kevin Peska, Acting Managing Attorney).

Before Cissel, Chapman and Rogers, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

On September 29, 2000, Waldman Diamonds Complete, LLC
filed an application to register on the Principal Register
the mark shown below



Reflexions
BY JEM BRAGGİK

¹ This is the Examining Attorney who was assigned to write the
brief. She is not the same Examining Attorney who originally
examined the application.

for "jewelry" in International Class 14. Applicant included in the application a statement that "JEM BRAGGIK is not the name of a living individual." The application is based on applicant's assertion of a bona fide intention to use the mark in commerce.

The Examining Attorney originally refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of three prior registered marks issued to and owned by three different entities--(1) REFLECTIONS for "desk clocks" in International Class 14,² (2) "REFLECTIONS" BY JUDITH JACK for "jewelry" in International Class 14,³ and (3) the mark shown below



for "ladies' clothing, namely, sweatshirts, sweatpants, T-shirts, tank tops, sweaters, cardigans, vests, shirts, pants, jeans, jackets, shorts, jumpsuits, belts, rugger

² Registration No. 1,713,471, issued on the Principal Register on September 8, 1992, Section 8 affidavit accepted, renewed. The registration also includes goods in International Class 16, but these were not cited or argued by the Examining Attorney.

³ Registration No. 1,573,260, issued on the Principal Register on December 26, 1989, Section 8 affidavit accepted, Section 15 affidavit acknowledged, renewed. (The quotation marks are part of the mark.) The registration includes a statement that "The name 'Judith Jack' does not identify a particular living individual."

shirts, footwear, sleepwear and rainwear" in International Class 25.⁴

In addition, the Examining Attorney referenced as potential bars to registration two prior pending applications, filed by two different entities--(1) REFLECT for various clothing items in International Class 25,⁵ and (2) AUTHENTIC NORTHERN REFLECTIONS for "retail store services in the fields of clothing, clothing accessories, footwear, bags, jewelry and cosmetics" in International Class 35.⁶

The Examining Attorney also required that the "TM" designation be deleted from the drawing.

In response thereto, applicant submitted a substitute drawing; requested that the identification of goods be amended to read "jewelry, namely, rings with gemstones"; and argued there would be no likelihood of confusion between applicant's mark and the marks in each of the cited registrations and the referenced applications. In support of applicant's argument that the term "reflections" (or "reflexions") is suggestive and a weak mark in relation to jewelry, applicant submitted USPTO electronic printouts of

⁴ Registration No. 1,999,108, issued on the Principal Register on September 10, 1996.

⁵ Serial No. 78/017,648, filed July 20, 2000.

⁶ Serial No. 76/057,455, filed May 26, 2000.

registrations for the following three marks, all issued to and owned by three different entities: (1) REFLECTIONS SERIES BY BALFOUR for "finger rings engraved with the name of a scholastic institution and a student's year of graduation" in International Class 14,⁷ (2) DIAMOND REFLECTIONS for "watches, watch bracelets, watch cases and parts thereof, all made in whole or in part of diamonds" in International Class 14,⁸ and (3) REFLECTIONS OF FAITH for "jewelry" in International Class 14.⁹

In the second and Final Office action, the Examining Attorney accepted the substitute drawing and withdrew all cited registrations and applications except for Registration No. 1,573,260 for the mark "REFLECTIONS" BY JUDITH JACK for "jewelry."

Applicant appealed the final refusal to register. Briefs have been filed, but applicant did not request an oral hearing.

As a preliminary matter, we must clarify the status of applicant's amendment to its identification of goods, changing it from "jewelry" to "jewelry, namely, rings with

⁷ Registration No. 2,179,081, issued on the Principal Register on August 4, 1998. The term "series" is disclaimed.

⁸ Registration No. 1,538,109, issued on the Principal Register on May 9, 1989, Section 8 affidavit accepted. The term "diamond" is disclaimed.

⁹ Registration No. 2,322,887, issued on the Principal Register on February 29, 2000.

gemstones." Both applicant and the Examining Attorney argued this case referring to applicant's goods as "jewelry." When an applicant initially sets forth a broad identification of goods and then narrows that identification, it may not at a later time revert to the broader identification of goods. Although the Examining Attorney did not formally acknowledge the amendment to applicant's goods, applicant's amendment was unconditional and clearly narrowed the goods, and thus, it became part of the application file. The Trademark Rules and our precedent require the Board to consider the identification of goods as amended by applicant. See Trademark Rule 2.71(a); *In re Swen Sonic Corp.*, 21 USPQ2d 1794 (TTAB 1991); and *In re M. V Et Associes*, 21 USPQ2d 1628 (Comm. 1991). Accordingly, the narrowed identification of goods "jewelry, namely, rings with gemstones" is the operative identification of goods in this application.

Turning to the merits of the refusal to register, the Examining Attorney contends that applicant's mark, if used on its goods, would so resemble the previously registered mark "REFLECTIONS" BY JUDITH JACK for jewelry, as to be likely to cause confusion, mistake or deception. Specifically, the Examining Attorney argues that the terms "reflections" and "reflexions" are phonetic equivalents and

are the dominant portions of the respective marks; that both marks include the word "BY" followed by the name of an individual; that the marks are highly similar in overall commercial impression; that the marks sound alike; that the marks in the third-party registrations submitted by applicant each create a different commercial impression from those created by applicant's mark and the cited registrant's mark; that even if the terms "reflections" and "reflexions" are suggestive of a feature of jewelry, confusion may still be likely when marks create similar overall commercial impressions; that the goods, channels of trade, and purchasers are identical; and that any doubt on the issue of likelihood of confusion is resolved in favor of registrant.

Applicant argues that the Examining Attorney improperly dissected applicant's composite mark, rather than considering the mark as a whole; that the Examining Attorney improperly emphasized the term "REFLEXIONS" and substantially disregarded the words "JEM BRAGGIK"; that the term "REFLEXIONS" should not be considered the dominant feature of applicant's mark due to its highly suggestive nature with regard to jewelry; that if any aspect of the mark should be given less weight, it is the highly suggestive term "REFLEXIONS"; that consumers would perceive

the words "BY ___ ___" as referring to a "designer-endorsed" or "sponsored" product, with each relating to a different person with respect to the two marks; that considered in their entirety, applicant's mark and the registered mark create different commercial impressions; that the respective marks are different in appearance as applicant's mark includes the novel spelling of the word "REFLEXIONS," and the word appears in large, stylized lettering, as well as the completely different "designer-endorsed" type name "JEM BRAGGIK"; and that jewelry products are generally selected and purchased with care, thus obviating any possible confusion as to source.

We reverse the refusal to register. In reaching this conclusion, we have followed the guidance of the Court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

We turn first to a consideration of applicant's goods vis-a-vis those of the cited registrant. As explained above, applicant's goods are identified as "jewelry, namely, rings with gemstones" and registrant's goods are identified as "jewelry." Obviously applicant's goods are encompassed within the broader identification of goods in the cited registration. Thus, we find these identified goods are closely related. Likewise, we find no

differences in the channels of trade or purchasers. We must presume, given the identifications, that the goods will travel in the same channels of trade, and will be 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); and *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994).

Turning to a consideration of the marks, it is well settled that marks must be considered in their entirety, not dissected or split into component parts and each part compared with other parts. This is so because it is the entire mark which is perceived by the purchasing public, and therefore, it is the entire mark that must be compared to any other mark. It is the impression created by the involved marks, each considered as a whole, that is important. See *Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992); and *Franklin Mint Corporation v. Master Manufacturing Company*, 667 F.2d 1005, 212 USPQ 233 (CCPA 1981). See also, 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §23:41 (4th ed. 2001).

In this case, the cited registrant's mark is a typed presentation of the words "REFLECTIONS" BY JUDITH JACK,' whereas applicant's mark is composed of the stylized

presentation of the terms "REFLEXIONS BY JEM BRAGGIK." We believe the words "BY JUDITH JACK" and "BY JEM BRAGGIK" must be considered to make significant contributions to the commercial impressions of the respective marks, notwithstanding the smaller type used for that portion of applicant's mark. We agree with applicant that the names create an impression of a "designer-endorsed" or "sponsored" product; and these two disparate and distinct names therefore create separate commercial impressions for each of the two marks. Further, applicant's stylized and large presentation of the term "REFLEXIONS" must be considered. Overall, we find that these two marks, when considered in their entireties, create different commercial impressions. Moreover, when spoken, the marks sound different, and, in applicant's mark, the fictitious name "JEM BRAGGIK" will be as prominent as the term "REFLEXIONS."

Applicant argues that the word "reflections" is weak as shown by the third-party registrations of marks in the field of jewelry which include the word (or some form thereof) in the mark. Third-party registrations are not evidence of commercial use of the marks shown therein, or what happens in the marketplace, or that consumers are familiar with the third-party marks. See *Olde Tyme Foods*

Inc., v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992); and Spoons Restaurants Inc. v. Morrison Inc., 23 USPQ2d 1735 (TTAB 1991), aff'd unpub'd, Appeal No. 92-1086 (Fed. Cir. June 5, 1992). However, third-party registrations are competent to show that others in a particular industry have registered marks incorporating a particular term, and that such registrations in that trade are entitled to only a narrow scope of protection. See Henry Siegel Co. v. M & R International Manufacturing Co., 4 USPQ2d 1154 (TTAB 1987); In re Hamilton Bank, 222 USPQ 174 (TTAB 1984); and BAF Industries v. Pro-Specialties, Incorporated, 206 USPQ 166 (TTAB 1980).

Here applicant has made of record the following third-party registered marks, all of which include the word REFLECTIONS and are for the same or related goods as those of applicant and the owner of the cited registration: (i) REFLECTIONS SERIES BY BALFOUR for "finger rings engraved with the name of a scholastic institution and a student's year of graduation," (ii) DIAMOND REFLECTIONS for "watches, watch bracelets, watch cases and parts thereof, all made in whole or in part of diamonds," and (iii) REFLECTIONS OF FAITH for "jewelry." In addition, the Examining Attorney, through her original cited registrations and prior pending applications, made several others of record as well (e.g.,

AUTHENTIC NORTHERN REFLECTIONS for "retail store services in the fields of ... jewelry..."). Thus, it appears that the term REFLECTIONS is hardly a unique term for use in connection with jewelry.

When the marks, "REFLECTIONS" BY JUDITH JACK and applicant's mark



are considered in their entireties as the purchasing public would view them, we find that the sound, appearance, and commercial impressions created by the two marks are dissimilar.

Based on a consideration of the relevant du Pont factors in this ex parte record, we find no likelihood of confusion.

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