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Mailed: September 9, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Towle Manufacturing Company

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Serial No. 76373720

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Jay Begler of Buchanan Ingersoll for Towle Manufacturing Company

Alex S. Keam, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

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Before Simms, Quinn and Holtzman, Administrative Trademark Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Applicant, Towle Manufacturing Company, has appealed from the final refusal of the trademark examining attorney to register the mark CHARLESTON for "sterling silver plated flatware, namely, forks, knives and spoons."<sup>1</sup>

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<sup>1</sup> Application Serial No. 76373720, filed February 1, 2002, based upon an allegation of a bona fide intention to use the mark in commerce.

The trademark examining attorney has refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to its goods, so resembles the mark CHARLESTON GARDENS for the goods shown in the following two registrations as to be likely to cause confusion. The word "Charleston" has been disclaimed in both registrations.

Registration No. 2446082:<sup>2</sup>

"Candles" in Class 4

"Outdoor furniture; lawn furniture; living room furniture; dining room furniture, and sun room furniture" in Class 20

"Dinnerware" in Class 21

Registration No. 2636128:<sup>3</sup>

"Containers for plants; planters for flowers and plants; decorative household accessories and home accents, namely, cachepots not of precious metal, plate holders, dish stands, plant stands, flower baskets, vases, wastepaper baskets and household ornaments made of china, crystal, or porcelain; beverage glassware; tabletop decorative items not of precious metal, namely, serving pieces, namely, bowls, covered casseroles, cake stands, teapots, and platters, cachepots and containers used for floral or fruit centerpieces, napkin rings, place card holders, salt and pepper shakers, candle holders, and candlesticks; serving trays not of precious metal; and garden gloves" in Class 21.

When the refusal was made final, applicant appealed.

Briefs have been filed. An oral hearing was not requested.

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<sup>2</sup> Issued April 24, 2001.

<sup>3</sup> Issued October 15, 2002.

Here, as in any likelihood of confusion analysis, we look to the factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), giving particular attention to the factors most relevant to the case at hand, including the similarity of the marks and the relatedness of the goods. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976) and *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209 (TTAB 1999).

We turn first to the goods. It is well settled that the goods of the applicant and registrant need not be similar or even competitive to support a finding of likelihood of confusion. It is sufficient if the respective goods are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give rise to the mistaken belief that they emanate from or are associated with the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

Applicant's goods are sterling silver plated flatware and registrant's goods include dinnerware (Registration No. 2446082) and beverage glassware (Registration No. 2636128). Applicant has not disputed the relatedness of these goods and in fact they are closely related products. The numerous third-party registrations submitted by the Examining Attorney show that the same mark has

been registered by the same entity for flatware, on the one hand, and for dinnerware and beverage glassware, on the other.

Although the third-party registrations are not evidence of use of the marks in commerce, the registrations have probative value to the extent that they suggest that the respective goods are of a type which may emanate from the same source. See, e.g., *In re Albert Trostel & Sons Co.*, *supra*; and *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467 (TTAB 1988).

Applicant's and registrant's goods are obviously used together as complementary tableware products. Moreover, these goods are marketed through the same channels of trade to the same retail consumers. The website printouts submitted by the examining attorney show that these goods are advertised and displayed together on the same pages of the same online catalogs, often under similar marks. It is clear that these closely related tableware products, if offered under similar marks, would be perceived as emanating from the same source. Thus, we turn our attention to the marks.

When compared in their entireties, the marks CHARLESTON and CHARLESTON GARDENS are similar in sound, appearance, meaning and commercial impression. The word CHARLESTON is applicant's entire mark. Although that word has been disclaimed by registrant, it remains visually and aurally a significant part of the registered mark. It is well settled that while a disclaimed term may be

given less weight in determining whether the marks are confusingly similar, it cannot be ignored. See *Schwarzkoﬀ v. John H. Breck, Inc.*, 340 F.2d 978, 144 USPQ 433 (CCPA 1965). The commercial impression is engendered by the mark as a whole which is the way it would be encountered in the marketplace by purchasers. These persons would not be aware of a disclaimer, much less of its significance.

The word CHARLESTON contributes substantially to the overall commercial impression of registrant's mark. Whether or not disclaimed, the word CHARLESTON, along with GARDENS, will be used by purchasers to call for and refer to the goods. Thus, purchasers are likely to remember that word upon hearing or seeing the word CHARLESTON, alone, at a different time on closely related goods. Moreover, CHARLESTON and CHARLESTON GARDENS convey similar meanings, both marks connoting variations of the same geographic place. Because the goods are closely related tableware products, purchasers are likely to assume that CHARLESTON identifies another line of tableware emanating from registrant.

It is applicant's contention that because the word CHARLESTON is disclaimed in the registration, "virtually no weight" should be given this element in registrant's mark.

Applicant argues that

[w]hile the Examiner cited three decisions in support of his rejection, a careful reading of these decisions reveals that they are all distinguishable from the current case in one very material way. In each of these cases, it was the applicant, who sought to avoid confusion by disclaiming a conflicting portion of its mark. For broad policy reasons, applicants can not [sic] disclaim conflicting portions of marks to avoid confusion.

Distinguishing the cases cited by the examining attorney from the present case, it is applicant's position that

...by making no exclusive claim to the element CHARLESTON apart from the mark, the Registrant gave up all claims to confusion except to CHARLESTON GARDENS. To rule otherwise would make disclaimer practice illusory. It would permit the registration of a compound mark and give protection to the single element of that mark after it is rejected as unfit for registration. Such inconsistent approach is not what is contemplated by the Disclaimer section of the Lanham Act.

Applicant is reading those cases too narrowly. Purchaser perception is the controlling factor in a likelihood of confusion analysis. The principle is well established that marks are compared in their entireties, including disclaimed portions thereof, the way they are perceived and would be encountered by relevant purchasers in the marketplace. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). The effect of a disclaimer on purchasers who encounter marks in the marketplace is the same regardless of whether the disclaimed term appears in the registered mark or the applicant's mark. Thus, the principle applied in analyzing the marks must be the same.

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In view of the foregoing, we find that consumers familiar with dinnerware and beverage glassware sold under the mark CHARLESTON GARDENS would be likely to believe, upon encountering applicant's mark CHARLESTON for flatware, that the goods originated with or are associated with or sponsored by the same entity.

To the extent that there is any doubt as to the likelihood of confusion, such doubt must be resolved in favor of the registrant and prior user. Lone Star Mfg. Co. v. Bill Beasley, Inc., 498 F.2d 906, 182 USPQ 368 (CCPA 1974).

**Decision:** The refusal to register is affirmed.