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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pearl River Chinese Products Emporium, Inc.¹

Serial No. 75406111

Deborah A. Nilson of Rozan & Nilson, LLP for Pearl River Chinese Products Emporium, Inc.

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Before Seeherman, Chapman, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On December 11, 1997, Pearl River Chinese Products Emporium, Inc. (applicant) applied to register the mark PEARL RIVER, in standard character form, on the Principal Register for services ultimately identified as "retail department store services, specializing in traditional Chinese goods" in Class 35. The application (Serial No.

¹ U.S. Patent and Trademark Office assignment records now reflect that the current owner of the application is Pearl River Mart, Inc. Reel/Frame No. 3028/0507. See also Request for Reinstatement of Appeal dated October 15, 2004.

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75406111) contains an allegation of a date of first use of July 1, 1978, and a date of first use in commerce of December 15, 1987.

The examining attorney initially cited numerous registrations and also identified several applications as potential bars to registration. Ultimately, the examining attorney finally refused registration of applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C.

§ 1052(d), because of Registration Nos. 1,540,400 and 1,750,211. In its reply brief,² applicant points out that Registration No. 1,750,211 for the mark PEARL RIVER CLOTHING CO. and design was cancelled pursuant to Section 8 of the Trademark Act. Therefore, this registration no longer forms a bar to registration of applicant's mark.

Accordingly, the only issue remaining in this appeal is whether applicant's mark PEARL RIVER for the identified services is confusingly similar to the mark PEARL RIVERS, Registration No. 1,540,400, in standard character form, for "mother of pearl jewelry" in Class 14. The registration issued on May 23, 1989 (Section 8 affidavit accepted). The registration contains a disclaimer of the term "Pearl."

² To the extent that the reply brief contains evidence that was not previously of record, we have not considered it.

The examining attorney argues that the addition of the letter "s" in RIVERS in registrant's mark is not sufficient to distinguish the marks and that "[c]onsumers who see virtually identical marks used to identify jewelry items and department store services are likely to believe that registrant's jewelry items are house brands of the department store." Brief, unnumbered pages 3-4. On the other hand, applicant argues that there "is no 'under the same roof' rule that all products with similar marks sold in one store will engender confusion." Brief at 5.

After the examining attorney made the refusal final, this appeal followed.

We reverse.

The Federal Circuit and the Court of Customs and Patent Appeals have set out the factors that we should consider when there is a question of likelihood of confusion. In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential

characteristics of the goods [or services] and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

The first factor that we consider is whether the marks are similar in sound, appearance, meaning, and commercial impression. We agree that the words PEARL RIVER and PEARL RIVERS are virtually identical. Therefore, their pronunciation and appearance would be very similar.

Regarding the meanings of the marks, there certainly are some similarities, but there are also differences. We start by observing that the name of a river in which the plural form "rivers" is used would be somewhat peculiar and it may suggest an individual's name.³ Also, as used in association with services limited to department store services specializing in traditional Chinese goods applicant's mark PEARL RIVER is likely to call to mind the Pearl River in China. At this point, we take judicial notice that in The Random House College Dictionary (1973), an entry for Pearl River refers to Chu-Kiang, and an entry under that name refers to "a river in SE China ... Also

³ See, e.g., Request for Reconsideration, Google searches, www.msdt.k12.in.us ("Mrs. Pearl Rivers Technology Assistant"); www.bea.gov ("John L. Munz, Pearl Rivers"); www.lib.lsu.edu ("Louisiana leaders: Notable Women in History ... Eliza Nicholson (Pearl Rivers) 1849-1896 Poet, Newspaper Owner and Editor").

called Canton River, Pearl River.”⁴ Registrant’s mark consists of the words PEARL RIVERS for mother of pearl jewelry with the term “pearl” disclaimed. The word PEARL, as used in registrant’s mark, obviously has a descriptive connotation. “Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’” Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), quoting, In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985). See also In re Code Consultants Inc., 60 USPQ2d 1699, 1702 (TTAB 2001) (Disclaimed matter is often “less significant in creating the mark’s commercial impression”). Therefore, the meanings of the marks differ to consumers. Furthermore, the differences in the meanings would result in somewhat different commercial impressions. Applicant’s mark is likely to be viewed as referring to the Pearl River while registrant’s mark would likely refer to the composition of the pearl jewelry and to rivers where pearls are found.⁵

⁴ We take judicial notice of these entries. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff’d, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

⁵ Pearls are found in rivers. See Request for Reconsideration, Google Searches, www.amnh.org (“Caesar may have invaded Britain in part to gain access to the pearl beds of the Tay and Isla

Also, because registrant's goods are pearls and pearls are associated with rivers, besides the highly descriptive nature of the word Pearl itself, the registered mark has a suggestive meaning when used with mother of pearl jewelry. Therefore, the registrant's mark is not entitled to a broad scope of protection.

Another important factor is the relationship between applicant's services and registrant's goods. We agree with applicant to the extent that it argues that there is no "under the same roof" rule that all products with similar marks sold in one store will cause confusion. See Federated Foods, 192 USPQ at 29 ("A wide variety of products, not only from different manufacturers within an industry but also from diverse industries, have been brought together in the modern supermarket for the convenience of the consumer. The mere existence of such an environment should not foreclose further inquiry into the likelihood of confusion arising from the use of similar marks on any goods so displayed"). See also Irwin Auger Bit Co. v. Irwin Corp., 134 USPQ 37, 39 (TTAB 1962):

It is common knowledge that there are sold in many hardware, grocery, variety and drug stores an almost unlimited variety of goods including tools, housewares, electrical appliances, seed, fertilizer,

Rivers"); www.greatriver.com ("Mississippi River Mussels (clams) produce pearls").

furniture and toys. The public being well aware of the diversity of goods to be found in such stores is not going to believe that all of those goods could originate with a single source.

Similarly, there is no per se rule that confusion is likely simply because the marks involved concern department store services and an item that could be sold in a department store. In this case, applicant's services are department store services specializing in traditional Chinese products and registrant's goods are mother of pearl jewelry. While we have no disagreement with the examining attorney's basic argument that department stores and even department stores specializing in traditional Chinese products may also sell jewelry,⁶ on this record, we cannot find that these goods and services are closely related. The examining attorney has submitted registrations showing that two stores, Dillard's (2 registrations) and I. Magnin, have registered the same mark for jewelry and department store services. See Registration Nos. 2,252,541; 2,189,280; and 980,735. The other third-party registrations made of record by the examining attorney are for department store services featuring, inter alia, the sale of jewelry as part of these services. These

⁶ Indeed, applicant does sell jewelry. Response dated December 18, 1998, New York Post, December 26, 1996.

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registrations do not support the argument that department stores use the same mark as a service mark for the department store services and as a house mark on jewelry sold in the store, while the Dillard's and I. Magnin registrations are not sufficient for us to make such a finding.

In this case, when we balance the various du Pont factors, we hold that confusion is not likely here.

Decision: The examining attorney's refusal to register under Section 2(d) is reversed.