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Mailed:
July 28, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re American Diamond Importers of St. Clair, Inc.

Serial No. 77745553

Molly B. Markley of Young Basile Hanlon & MacFarlane, P.C.
for American Diamond Importers of St. Clair, Inc.

Toby E. Bulloff, Trademark Examining Attorney, Law Office
117 (Brett Golden, Managing Attorney).

Before Seeherman, Bergsman and Lykos,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

American Diamond Importers of St. Clair, Inc.

("applicant") filed an intent-to-use application on the
Principal Register for the mark YELLOW EMERALD, in standard
character form, for "golden beryl gemstones," in Class 14.¹

¹ "Beryl" is "a mineral, beryllium aluminum silicate ... usually green, but also blue, rose, white and golden, and both opaque and transparent, the latter variety including the gems emerald and aquamarine." The Random House Dictionary of the English Language (Unabridged), p. 198 (2nd ed. 1987). The Board may take judicial notice of dictionary evidence. *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).

The Trademark Examining Attorney refused to register applicant's mark under Section 2(e)(1) of the Trademark Act of 1946, 15 U.S.C. § 1052(e)(1), on the ground that applicant's mark is merely descriptive of applicant's goods. According to the Examining Attorney, "the purchasing public has come to know golden-colored beryl gemstones as 'yellow emeralds.'"²

A term is merely descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the products it identifies. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). Whether a particular term is merely descriptive is determined in relation to the goods for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). In other words, the question is not whether someone presented only with the mark could guess the products listed in the description of goods. Rather, the question is whether someone who knows what the products are will understand the mark to convey information about them. *In re Tower Tech*,

² The Examining Attorney's Brief, unnumbered page 2.

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Inc., 64 USPQ2d 1314, 1316-1317 (TTAB 2002); *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990); *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

"On the other hand, if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive." *In re Tennis in the Round, Inc.*, 199 USPQ 496, 497 (TTAB 1978); *see also, In re Shutts*, 217 USPQ 363, 364-365 (TTAB 1983); *In re Universal Water Systems, Inc.*, 209 USPQ 165, 166 (TTAB 1980).

To support the descriptiveness refusal, the Examining Attorney submitted the following evidence.

1. An article entitled "Minerals and Gemstones" from *geoscience.org*.³ The article explains that an "[e]merald is the blue-green to grass-green gem variety of beryl. The beryl family also includes aquamarine (blue), morganite (pink) and golden beryl (yellow)."

³ August 27, 2009 Office Action.

2. What appears to be an advertisement from a website at *cgi.ebay.it* but directed to the U.S. market.⁴ The title of the advertisement is "Antique Nineteenth Century Handcrafted Genuine Natural Siberian Heliodor ("Yellow Emerald") Two-Third Carat Faceted Yellow Beryl Oval." The seller provides the following information:

Finally there is a yellow beryl, known as "yellow emerald" here in Russia, but to most of the world known as "heliodor", derived from the Greek for "gift of the sun". ... The color of yellow, or "golden beryl", is derived from traces of uranium and/or iron. ... The result is an exquisite and incredibly brightly colored semi-precious gemstone with lots of flash and fire. Though the color might be a bit like an intensely hued citrine, the flash is like a yellow sapphire or yellow diamond."

3. An excerpt from the *flicker.com* website presenting photographs of "The Beryls," including a "Golden Beryl (Yellow Emerald)."⁵

4. An excerpt from what appears to be an online forum from *The Ganoskin Project* website (*ganoskin.com*) regarding green amethyst.⁶ In response to an inquiry

⁴ August 27, 2009 Office Action. See also the "Timeless Treasures" webpage at the *csu-saaa.org* website featuring the same advertisement, attached to the September 21, 2010 Office Action.

⁵ August 27, 2009 Office Action.

⁶ *Id.*

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regarding the role of gemology in the sale of gems, the host provided the following explanation:

Gemstones are divided into Groups [sic], species and varieties in order that we know what the heck they ARE. That's why we offer morganite (the pink *variety* of the beryl *species*) instead of "pink emerald." Or heliodor (the orange yellow "variety" of the beryl *species*) instead of "yellow emerald".

5. A page from the *YellowEmerald.com* website.⁷ The webpage displays a YELLOW EMERALD logo as follows:



The "About" webpage includes the following text:

What are Yellow Emeralds?

Yellow Emeralds are in the beryl family of minerals typically grown as hexagonal crystals with a Mohs scale of hardness of 7.5-8.

Beryls can come in such colors as green (emeralds), blue (aquamarine), yellow (the more green/yellow varieties are called heliodor), pink (morganite), red (bixbite, and white, though most are colorless (goshenite).

Unlike green emeralds, Yellow Emeralds have far fewer flaws. Most emeralds are irradiated and coated with oils to

⁷ March 14, 2010 Office Action. We note that this website is associated with applicant because American Diamond Importers is listed as a co-owner of the website's copyright. In fact, in its September 14, 2010 Response, applicant claimed ownership of the website.

bring out the richness in color, but Coughlin Jewelers' Yellow Emeralds are completely untreated and natural.

Some beryl gemstones can lose their color if exposed to heat and sunlight, but Yellow Emeralds will always maintain their beautiful rich color, guaranteed.

6. An excerpt from the *Luckygemstones.com* website providing information regarding "Heliodor Jewelry."⁸ The website provides the following information:

Heliodore [sic] is the name for Yellow Beryl. Often called *Yellow Emerald*, it is the same gemstone (i.e., Beryl) as the esteemed Emerald, but with different trace elements providing color. Usually an intense yellow color, deeper than a Citrine, though sometimes with traces of green. (Emphasis in the original).

7. An advertisement from the *Mothersdaygift.net* website offering for sale a "Yellow Emerald and Aquamarine Fashion Ring."⁹ The advertisement reads, in pertinent part, as follows:

Festive and elegant hand-crafted fashion ring with a huge, natural Yellow Emerald of exceptional clarity and brilliance. Rare Yellow Emerald is also known as Yellow Beryl or "Heliodor."

⁸ *Id.*

⁹ *Id.*

8. An article from *The Voice* newspaper (June 13, 2010) (*voicenews.com*) regarding a mudslide affecting access to a mine containing yellow emeralds.¹⁰ The article references Pat Coughlin of Coughlin Jewelers, which appears to be applicant or at least to have a business relationship with applicant (see Item 12 of applicant's submissions, *infra*, an advertisement by Coughlin Jewelers which applicant has described as its own advertisement).

Coming off record-breaking sales of the yellow emerald at the St. Clair jewelry store, Coughlin was notified of terrible news.

A Brazilian mudslide caused by heavy rains closed the yellow emerald mine.

* * *

With his own personal production crew in tow, Coughlin departed May 18 on a two-day flight to Brazil. The exact location of the yellow emerald mine will not be disclosed.

"In order to get to the yellow emerald mine, it takes four flights, one train, one bus, and one car." Coughlin said.

* * *

The yellow emerald premium golden beryl gemstone is a rare gem which had all the same physical properties of a green emerald. The trace element of iron causes the color to be yellow instead of green. ...

¹⁰ September 21, 2010 Office Action.

"For hundreds of years the yellow emerald was discarded, it's yellow because of the iron in the ground, in their mind it wasn't valuable," Coughlin said. ...

* * *

The pressure was mounting to create something new. Coughlin literally stumbled upon the yellow emeralds. He wasn't clear on how consumers would react to his new find.

Carol Walters of Richmond is attracted to emeralds. She was one of the first to purchase a yellow emerald.

9. An entry regarding "Heliodor Gemstones" in the *HubPages.com* website.¹¹

Heliodor - a Beryl Gemstone

Heliodor is a stone belonging to the Beryl Gemstones family. It is also referred to as the Golden Beryl or Yellow Emerald. Heliodor can appear in a spectrum of colors ranging from yellow to yellow-green and orange to brown.

In response to the refusal on the ground that applicant's mark is merely descriptive, applicant argued that the term YELLOW EMERALD is suggestive of the features and characteristics of golden beryl gemstones because a

¹¹ September 21, 2010 Office Action.

"Yellow Emerald" does not exist and, therefore, the term "Yellow Emerald" is incongruous.¹²

While Applicant submits the Golden Beryls are yellow colored and that the "YELLOW" portion of Applicant's mark is descriptive, Applicant disagrees that the Golden Beryl gemstone is part of the Emerald family. Emeralds are a completely different variety of Beryl gemstone and are classified as such in numerous industry reference guides.¹³

In other words, golden beryl gemstones are not emeralds and emeralds are not yellow, therefore, the term "Yellow Emeralds" is not merely descriptive. Applicant contends that it has combined the words "Yellow" and "Emerald" "to create a unique designation for its Golden Beryl gemstones."¹⁴

The term "Emerald" is not immediately descriptive of Applicant's goods, but rather suggestive of many characteristics such as "high quality", "rare" and "green". A purchaser has to pause and reflect on the significance of the term "Emerald" to understand

¹² Applicant's Brief, p. 6. Applicant attached previously submitted exhibits to its brief. Some applicants are under the impression that attaching previously-filed evidence to a brief is a courtesy or convenience to the Board. It is neither. When considering a case for final disposition, the entire record is readily available to the panel. Because we must determine whether such attachments are properly of record, citation to the attachment requires examination of the attachment and then an attempt to locate the same evidence in the record developed during the prosecution of the application, requiring more time and effort than would have been necessary if citations were directly to the record developed during prosecution.

¹³ Applicant's Brief, p. 2.

¹⁴ Applicant's Brief, pp. 3-4.

that it suggests Applicant's goods are high quality, rare and have a green hue to their yellow stones.¹⁵

Applicant submitted the evidence listed below to support its argument that YELLOW EMERALD is not merely descriptive. The evidence purportedly shows that the gem industry does not refer to golden beryl as "yellow emerald."

1. An excerpt from the American Gem Trade Association (agta.org) referring to beryl.¹⁶

Like people, gems come in closely related families. One of the most important gem families is beryl. With a trace of chromium to bestow a fabulous green, beryl becomes emerald, the rare and valuable green gem. If instead, nature includes a trace of iron in one valence state, beryl is aquamarine. If the iron in beryl has a different valence state, it isn't pale blue: it turns a rich golden yellow. Golden beryl is as brilliant as aquamarine, with a warm sunny color.

2. An excerpt from what appears to be a manual, the GEM IDENTIFICATION Separation Supplement (1993), distributed by the Gem Institute of America, listing the varieties of beryls, including, *inter alia*, emerald, aquamarine, and golden.¹⁷

¹⁵ Applicant's Brief, p. 5.

¹⁶ March 1, 2010 Response.

¹⁷ *Id.* See also the GEM REFERENCE GUIDE, distributed by the Gem Institute of America, noting that an emerald should not be

3. An excerpt from the International Colored Gemstone Association website (gemstone.org) discussing beryls.¹⁸

Aquamarine, emerald and morganite are all beryls - just like golden beryls, yellowish-green heliodor, colourless goshenite and the rare red beryl. Whether blue, green, yellow, colourless or pink, their chemical and physical properties essentially correspond; it is only in their colours that they differ from one another so much.

* * *

The emerald is closely related to the aquamarine. This most valuable of all the beryls is given the most beautiful, intense and glowing green imaginable, namely emerald green, by chrome and/or vanadium. ...

* * *

Golden beryl holds a fascination with its fine spectrum of yellow hues, from a weak lemon yellow to a warm golden color.

4. An excerpt from The Gem Guide (2009) explaining how to analyze the quality of colored gems.¹⁹ The categories of colored gems include, *inter alia*, "Beryl-Aquamarine," "Beryl-Emerald," and Beryl-Golden." The

referred to as a "green beryl" and that "red emerald" is an incorrect name for a red beryl. (March 1, 2010 Response).

¹⁸ *Id.*

¹⁹ *Id.*

Beryl-Golden has a "greenish yellow, yellow, or orangey yellow color."

5. An excerpt from the Color Encyclopedia of Gemstones (2nd ed.) defining "beryl."²⁰

Colors: Colorless, white, light green, olive green, blue-green to blue (aquamarine), deep green (emerald), pink or peachy pink (morganite), greenish yellow, yellow (heliodor), pinkish orange, red (bixbite).

Beryl is one of the most familiar minerals because of the many famous gem varieties it offers. These specific gem types are named according to color and chemistry. ... *Heliodor* or *golden beryl* derives its color from ferric iron, and the color ranges from pale yellow to deep yellowish orange. ... *Emerald* is the best known color variety, the color of which, a fine, intense green, is due to a trace of chromium replacing aluminum in the beryl structure. Emerald is, by definition, the green beryl colored by chromium. Other green beryls of various shades exist, which are simply termed *green beryl*, ... (Emphasis in the original).

6. A partial table of contents from the Consumer Guide to Colored Gemstones.²¹ The partial table of contents list, *inter alia*, two types of aquamarine, two types of emeralds, morganite, but no "yellow emerald."

²⁰ March 1, 2010 Response. See also Gemstones.

²¹ *Id.*

7. The *Wikipedia* entry for "Beryl."²² The entry identifies aquamarine, bixbite, emerald, golden beryl and heliodor, goshenite, and morganite as varieties of beryl. With respect to emerald, the entry provides that "[e]merald refers to green beryl," red beryl is also known as bixbite, red or scarlet emerald, and morganite is also known as pink beryl, rose beryl, or pink emerald.²³

8. The *mindat.org* website defines "heliodor" as "[a] golden yellow gem variety of Beryl."²⁴

9. The *GemologyOnline.com* website provides that when a beryl is green, it is an emerald and when it is yellow, it is a heliodor.²⁵

10. The *MineralsZone.com* website explains that in "the gemworld," a heliodor is also known as a "golden beryl."

11. An excerpt from the *mapsoftheworld.com* website regarding "Precious Metals and Stones" refers to the four main classes of beryl groups as classics, emerald, aquamarine and morganite.²⁶

²² *Id.*

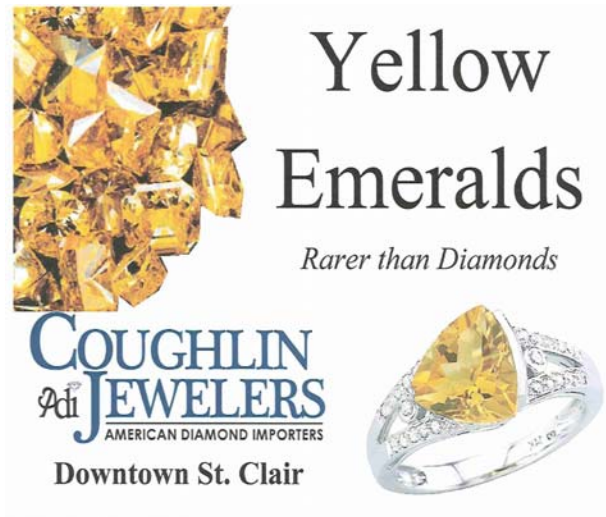
²³ *But see* the Gem Reference Guide entry at n. 17 stating the emerald should not be referred to as a green beryl.

²⁴ *Id.*

²⁵ *Id.*

²⁶ *Id.*

12. An advertisement by applicant purportedly to demonstrate that yellow beryl gemstones are not emeralds.



The evidence of record shows that the beryl family includes emeralds, golden beryl, aquamarine and morganite. The different beryl gemstones have the same qualities and characteristics but with different trace elements providing the color.²⁷ Thus, a green beryl is an emerald, a blue beryl is an aquamarine, a pink beryl is morganite and a yellow beryl is a golden beryl. The "Emerald is the best known color variety."²⁸ It is specifically mentioned as a type of beryl in the dictionary definition of beryl. One vendor wrote that "[t]he true emerald remains one of the

²⁷ Luckygemstones.com, [The Voice \(voicenews.com\)](http://The Voice (voicenews.com)), agta.com, gemstone.com, gemologyOnline.com, and Color Encyclopedia of Gemstones.

²⁸ Color Encyclopedia of Gemstones. See also cgi.ebay.it and csu-saaa.org ("The most widely recognized varieties of beryl are aquamarine and emerald").

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most treasured of all gemstones."²⁹ Because emeralds are perceived as a well-known and valuable beryl gemstone, vendors try to associate yellow beryl gemstones with the valuable and well-known emerald by calling golden beryl gemstones yellow emeralds.

Applicant's own advertisement (No. 12 above) uses the term "Yellow Emeralds" to describe the gemstones, not their source: "Yellow Emeralds *Rarer than Diamonds.*" Consumers exposed to this advertisement will consider "Yellow Emeralds" to be the name of the goods. This is not a single inadvertent instance of improper trademark use by applicant. In applicant's *yellowemerald.com* website, applicant identified "Yellow Emeralds" as a member of the beryl family.

What are Yellow Emeralds?

Yellow Emeralds are in the beryl family of minerals typically grown as hexagonal crystals with a Mohs scale of hardness of 7.5-8.

Applicant did not identify Yellow Emeralds as its proprietary name (*i.e.*, a trademark used to identify applicant's golden beryl gemstones). Rather, applicant identified Yellow Emeralds as a member of the beryl family

²⁹ "Minerals and Gemstones" at *geoscience.org*. See also *gemstone.org* ("This most valuable of all the beryls").

of minerals. Applicant is using the term "Yellow Emeralds" in a generic fashion. There is nothing in the text of its website that would cause readers to understand that the term "Yellow Emerald" is supposed to be a proprietary term that is the exclusive property of applicant.

We find that the evidence submitted by the examining attorney, recounted above, is sufficient to show that consumers perceive the term "Yellow Emerald" as describing golden beryl gemstones. While applicant argues that it is not technically correct to refer to a golden beryl as a yellow emerald, the evidence of record demonstrates that there are people and publications in the industry that use the term "yellow emerald" for such gems, including applicant.

Thus, we are not persuaded by applicant's argument that because there are no yellow emeralds, the term YELLOW EMERALD is not descriptive.

Emerald is a type of Beryl gemstone and that one type of Beryl may be golden or yellow colored. However, to call a Golden Beryl a Yellow Emerald does not immediately describe the Golden Beryl gemstone because a yellow colored Beryl gem is not an Emerald. The term "Emerald" is not interchangeable with the term "Beryl."³⁰

³⁰ Applicant's Brief, p. 3.

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The evidence shows that the type of beryl depends upon the color (e.g., an emerald is green, an aquamarine is blue, and a golden beryl is yellow) and that consumers understand the term yellow emeralds to refer to golden beryl. Because of this perception, the term yellow emerald has lost whatever incongruity it may have had. Accordingly, when a consumer sees the mark YELLOW EMERALD used in connection with a golden beryl gemstone, the consumer immediately knows that the product is a golden beryl gemstone or a yellow emerald gemstone. In view of the foregoing, we find that applicant's mark YELLOW EMERALD is merely descriptive of golden beryl gemstones.

Decision: The refusal to register is affirmed.