

**This Opinion is Not a
Precedent of the TTAB**

Mailed: December 28, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Powerful Vision Limited
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Serial No. 79145119
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Pam Kohli Jacobson of Betts, Patterson & Mines P.S.,
for Powerful Vision Limited.

Cynthia Y. Rinaldi, Trademark Examining Attorney, Law Office 107,
J. Leslie Bishop, Managing Attorney.

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Before Bergsman, Gorowitz and Heasley,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Powerful Vision Limited (“Applicant”) seeks registration on the Principal Register of the mark DIAMOND X COLLECTION (in standard characters) for

Mirrors; mirrored bathroom furniture made of plastic, mild steel, stainless steel and aluminum; mirrored bathroom cabinets made of plastic, mild steel, stainless steel and aluminum; mirrored cabinets made of plastic, mild steel, stainless steel and aluminum; mirrors enhanced by electric lights, in Class 20.¹

¹ Application Serial No. 79145119 was filed on January 23, 2014, under Section 66(a) of the Trademark Act of 1946, 15 U.S.C. § 1141f(a), based upon Applicant’s International Trademark Registration No. 1198350, registered on January 23, 2014.

The Trademark Examining Attorney has refused registration of Applicant's mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles the registered mark DIAMOND (typed drawing form) for "wooden cabinets," in Class 20, as to be likely to cause confusion.² In addition, the Trademark Examining Attorney issued a final requirement for Applicant to disclaim the exclusive right to use the word "Collection."³

When the refusal and requirement were made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm the refusal to register and the requirement to disclaim the exclusive right to use the word "Collection."

I. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. *See Federated Foods, Inc. v. Fort Howard Paper*

² Registration No. 1231958, issued March 22, 1983; second renewal.

Prior to November 2, 2003, "standard character" drawings were known as "typed" drawings. A typed mark is the legal equivalent of a standard character mark. TMEP § 807.03(i) (October 2015).

³ In her brief at 12 TTABVUE 4, the Trademark Examining Attorney withdrew the requirement that Applicant disclaim the exclusive right to use the word "Diamond."

Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

A. *The similarity or dissimilarity of the marks.*

We turn first to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In a particular case, “two marks may be found to be confusingly similar if there are sufficient similarities in terms of sound *or* visual appearance *or* connotation.” *Kabushiki Kaisha Hattori Seiko v. Satellite Int’l, Ltd.*, 29 USPQ2d 1317, 1318 (TTAB 1991), *aff’d mem.*, 979 F.2d 216 (Fed. Cir. 1992) (citation omitted). *See also Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1519 (TTAB 2009) (citing *Krim-Ko Corp. v. Coca-Cola Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”)).

“The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). *See also San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d*

mem., 972 F.2d 1353 (Fed. Cir. 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Since the goods are mirrors, mirrored bathroom furniture and cabinets, and wooden cabinets, the average customer is an ordinary consumer.

The marks DIAMOND and DIAMOND X COLLECTION are similar because they share the word DIAMOND. Because Applicant's mark DIAMOND X COLLECTION incorporates Registrant's entire mark, consumers familiar with Registrant's DIAMOND wooden cabinets are likely to perceive DIAMOND X mirrored cabinets as a different line of Registrant's DIAMOND products. While the fact that Applicant's mark incorporates Registrant's entire mark does not *ipso facto* mean that the marks are similar, under the circumstances in this case, the Board and its primary reviewing court have often found that such marks are similar. *See, e.g., In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (applicant's mark ML is similar to registrant's mark ML MARK LEES); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406, 407 (CCPA 1967) (THE LILLY as a mark for women's dresses is likely to be confused with LILLI ANN for women's apparel including dresses); *Hunter Indus., Inc. v. Toro Co.*, 110 USPQ2d 1651, 1660-61 (TTAB 2014) (applicant's mark PRECISION is similar to registrant's mark PRECISION DISTRIBUTION CONTROL); *In re United States*

Shoe Corp., 229 USPQ 707, 709 (TTAB 1985) (CAREER IMAGE for women's clothing stores and women's clothing likely to cause confusion with CREST CAREER IMAGES for uniforms including items of women's clothing). In *United States Shoe*, the Board observed that “Applicant's mark would appear to prospective purchasers to be a shortened form of registrant's mark.” 229 USPQ at 709.

Likewise, consumers are likely to refer to Applicant's mark DIAMOND X COLLECTION as DIAMOND X because DIAMOND X appears as the first part of Applicant's mark and it is an arbitrary term when used in connection with the products listed in Applicant's description of goods; whereas the term COLLECTION is likely to be perceived as Applicant's collection of such products.⁴ “[U]sers of language have a universal habit of shortening full names – from haste or laziness or just economy of words. Examples are: automobile to auto; telephone to phone; necktie to tie; gasoline service station to gas station.” *In re Abcor Development Corp.*, 588 F.2d 511, 200 USPQ 215, 219 (CCPA 1978) (J. Rich, concurring).

[C]ompanies are frequently called by shortened names, such as Penney's for J.C. Penney's, Sears for Sears and Roebuck (even before it officially changed its name to Sears alone), and Ward's for Montgomery Ward's, and Bloomies for Bloomingdales.

Marshall Field & Co. v. Mrs. Fields Cookies, 25 USPQ2d 1321, 1333 (TTAB 1992).

See also, Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ

⁴ The word “Collection” is defined, *inter alia*, as “a line of products produced for one season, as those developed by a designer: *promoted the summer collection in the store window.*” YourDictionary.com derived from **THE AMERICAN HERITAGE DICTIONARY** (date illegible) (7 TTABVUE 5).

390, 395 (Fed. Cir. 1983); *Big M Inc. v. The United States Shoe Co.*, 228 USPQ 614, 616 (TTAB 1985).

The significance of the word “Diamond” in Applicant’s mark DIAMOND X COLLECTION is further reinforced by its location as the first part of the mark. *See Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (“Veuve” is the most prominent part of the mark VEUVE CLICQUOT because “veuve” is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word); *Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”).

While our discussion has focused on the shared word “Diamond,” we are aware the analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). *See also Franklin Mint Corp. V. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion”). On the other hand, there is nothing

improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re National Data Corp.*, 224 USPQ at 751. As noted above, the word “Diamond,” as the first part of Applicant’s mark, will be perceived as the dominant element of Applicant’s mark because it is an arbitrary term, the term DIAMOND X will be perceived as part of the line of DIAMOND products, and the commercial impression of the term “Collection” is that of an informational statement informing consumers of Applicant’s DIAMOND X line of mirrors and mirrored cabinets.

In view of the foregoing, we find that the marks DIAMOND and DIAMOND X COLLEECTION are similar in terms of appearance, sound, connotation and commercial impression.

B. The similarity or dissimilarity and nature of the goods.

As noted above, Registrant’s mark DIAMOND is registered for wooden cabinets and Applicant is seeking to register its DIAMOND X COLLECTION for mirrors, mirrored bathroom cabinets and mirrored cabinets made of plastic, mild steel, stainless steels and aluminum. The term “wooden cabinets” encompasses mirrored bathroom cabinets and mirrored cabinets. Because we do not read limitations into the identification of goods, we must presume that Registrant's wooden cabinets include all types of wooden cabinets, including mirrored cabinets made of wood and mirrored bathroom cabinets made of wood. *See Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983) (“There is no specific limitation and

nothing in the inherent nature of Squirtco's mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The Board, thus, improperly read limitations into the registration"). Thus, Registrant's goods are related to Applicant's goods because Registrant's identification of goods includes mirrored bathroom cabinets and mirrored cabinets, albeit made of wood rather than other materials.

This presumption is corroborated by Applicant's sales of DIAMOND X COLLECTION illuminated mirrors in "Solid Oak Bathroom Cabinets."⁵ Similarly, Pottery Barn sells Quiklook mirrors and wooden cabinets,⁶ and Ikea sells Hemnes mirrors and wooden cabinets.⁷

In view of the foregoing, we find that the goods are related.

C. Channels of trade.

Because there are no limitations as to channels of trade or classes of purchasers in the description of goods in the application or cited registration, it is presumed that Applicant's goods and Registrant's goods move in all channels of trade normal for those goods, and that they are available to all classes of purchasers for those goods. *See Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973); *Kalart Co. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139, 140 (CCPA 1958); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992). As noted above, because Registrant's wooden cabinets encompass mirrored

⁵ 5 TTABVUE 5-8

⁶ 5 TTABVUE 9-16 to 6 TTBVUE 2-3 and October 9, 2014 Office Action.

⁷ 6 TTABVUE 4-9 and October 9, 2014 Office Action.

bathroom cabinets and mirrored cabinets, we must presume that those goods move in the same channels of trade and are sold to the same classes of consumers. In this regard the IKEA, Wayfair and Pottery Barn websites submitted by the Trademark Examining Attorney show that the products at issue are sold through the same channels of trade.⁸

Applicant asserts that because Applicant's goods and Registrant's goods are different, they move in different channels of trade.⁹ The only limitation in Applicant's description of goods is that the cabinets are made of plastic, mild steel, stainless steels and aluminum as compared to Registrant's wooden products. The description of goods in the cited registration does not have a restriction in its channels of trade, so those goods are presumed to move in all the normal channels of trade for those goods. And as we have seen, such goods can and do move in the same channels of trade. Applicant also contends that a restriction in the description of goods may avoid a likelihood of confusion, but it has not made a further restriction in its description of goods.

D. Balancing the factors.

Because the marks are similar, the goods are related and the goods move in the same channels of trade, we find that Applicant's mark DIAMOND X COLLECTION for "mirrors; mirrored bathroom furniture made of plastic, mild steel, stainless steel and aluminum; mirrored bathroom cabinets made of plastic, mild steel, stainless steel and aluminum; mirrored cabinets made of plastic, mild steel, stainless steel

⁸ 5 TTABVUE 9-16 to 6 TTABVUE 2-16 and October 9, 2014 Office Action.

⁹ 10 TTABVUE 8.

and aluminum; mirrors enhanced by electric lights” is likely to cause confusion with the registered mark DIAMOND for “wooden cabinets.”

II. Requirement to Disclaim the Exclusive Right to Use “Collection.”

The Trademark Examining Attorney required Applicant to disclaim the exclusive right to use the word “Collection” “because it merely describes a feature of Applicant’s goods (*i.e.*, the goods are a line of products). *See* Section 6(a) of the Trademark Act of 1946, 15 U.S.C. §1056(a) (“The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable”). Pursuant to Section 2(e)(1) of the Trademark Act of 1946, 15 U.S.C. §1052(e)(1), merely descriptive matter in a mark is unregistrable; it therefore is subject to disclaimer under Section 6(a). The Office may refuse registration of the entire mark if Applicant fails to comply with a proper disclaimer requirement. *See In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859, 1861 (Fed. Cir. 1987); *In re Grass GmbH*, 79 USPQ2d 1600, 1602 (TTAB 2006).

A term is merely descriptive of goods within the meaning of Section 2(e)(1) if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012). *See also, In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Whether a mark or a component of a mark 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). A term need not immediately convey an idea of each and every specific feature of the goods or services in order to be considered merely descriptive; it is enough if it describes one significant attribute, function or property of them. *See In re Gyulay*, 3 USPQ2d at 1010; *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). This requires consideration of the context in which the mark is used or intended to be used in connection with those goods or services, and the possible significance that the mark would have to the average purchaser of the goods in the marketplace. *See In re Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219; *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007); *In re Abcor Dev. Corp.*, 200 USPQ at 218; *In re Venture Lending Assocs.*, 226 USPQ 285 (TTAB 1985). 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. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-1317 (TTAB 2002)). *See also 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).

As noted above, the word “Collection” is defined, *inter alia*, as “a line of products produced for one season, as those developed by a designer: *promoted the summer collection in the store window.*”¹⁰ Applicant, on its website, displays its mark as follows:¹¹



It advertises the products as follows:

1. “The large bathroom mirrors in the collection provide a beautiful focal point in larger, open spaces.”¹²;
2. A “range of outstanding bathroom mirrors”;¹³ and
3. “[O]ur range of oak demister cabinets.”¹⁴

Thus, Applicant is using the word “Collection” to describe its DIAMOND line of products.

Applicant argues that the mark DIAMOND X COLLECTION is a unitary term and that, therefore, a disclaimer is not required. A unitary mark is a mark with multiple elements that create a single and distinct commercial impression separate

¹⁰ YourDictionary.com derived from **The American Heritage Dictionary** (date illegible) (7 TTABVUE 5).

¹¹ October 9, 2014 Office Action and 4 TTABVUE 5.

¹² October 9, 2014 Office Action.

¹³ October 9, 2014 Office Action.

¹⁴ 5 TTABVUE 7.

and apart from the meaning of its constituent elements. *Dena Corp. v. Belvedere International Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991). *See also In re Kraft, Inc.*, 218 USPQ 571, 573 (TTAB 1983) (the elements of a unitary mark are so integrated or merged that they cannot be regarded as separate elements, and it is obvious that no claim is made other than to the entire mark). In *Kraft*, the Board explained that a unitary mark could be created “where the words which have been put together function as a unit, with each relating to the other rather than directly to the goods.” 218 USPQ at 573.¹⁵ *See also In re EBS Data Processing, Inc.*, 212 USPQ 964, 966 (TTAB 1981).

To determine whether a composite mark is unitary, the Board must determine “how the average purchaser would encounter the mark under normal marketing of such goods and also . . . what the reaction of the average purchaser would be to this display of the mark.” *In re Magic Muffler Service*, 184 USPQ 125, 126 (TTAB 1974). This can best be accomplished by looking at the specimen filed with the application because it shows how the mark is used in connection with the goods or services. *In re Magic Muffler Service*, 184 USPQ at 126. Since this application was filed based on Applicant’s International Registration and not use in commerce, there is no specimen. However, as noted above, we have the benefit of Applicant’s website submitted by the Trademark Examining Attorney.

¹⁵ *In re Kraft*, the Board found that the mark LIGHT N’ LIVELY was unitary because it had a suggestive significance apart from the merely descriptive significance of the individual term LIGHT for reduced calorie mayonnaise. Based upon that reasoning, the Board held that a disclaimer of the term LIGHT was unnecessary.

Applicant displays the word “Collection” in a different size and font than the term “Diamond X.” The commercial impression engendered by the display of Applicant’s mark is the DIAMOND X collection of mirrors and cabinets. The word “Collection” is used in its dictionary meaning in a display distinct from the term “Diamond X.”

In view thereof, the requirement that Applicant disclaim the exclusive right to use the word “Collection” is affirmed.

Decision: The refusal to register Applicant’s mark DIAMOND X COLLECTION is affirmed.

The requirement that Applicant disclaim the exclusive right to use the word “Collection” is affirmed.