

This Opinion is Not a
Precedent of the TTAB

Mailed: August 19, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re YourGemologist, LLC

Serial No. 86228244

Matthew H. Swyers of The Trademark Company,
for YourGemologist, LLC.

Siddharth Jagannathan, Trademark Examining Attorney, Law Office 114,
K. Margaret Le, Managing Attorney.

Before Seeherman, Kuczma and Masiello,
Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

YourGemologist, LLC (“Applicant”) seeks registration on the Principal Register
of the mark YOURGEMOLOGIST (in standard characters) for:

Providing educational information in the academic field of
gemology for the purpose of academic study in
International Class 41.¹

The Examining Attorney refused registration of Applicant’s mark under Section
2(d) of the Trademark Act, 15 USC § 1052(d), citing Registration No. 2857455 as a

¹ Application Serial No. 86228244 was filed on March 21, 2014, based upon Applicant’s
claim of first use anywhere and use in commerce since at least as early as October 22, 2000.

bar to registration. Registration No. 2857455, owned by Canary Investments Inc., is for the mark MYGEMOLOGIST (in standard characters) for:

Gemological services, namely providing information
regarding gems via the Internet in International Class
42.²

After the refusal to register was made final, Applicant appealed to this Board. Applicant and the Examining Attorney have filed briefs. For the reasons set forth below, the refusal to register is affirmed.

Our determination under § 2(d) is based on an analysis of all 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). Not all of the *du Pont* factors are relevant to every case, and only factors of significance to the particular mark need be considered. *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. *See Federated Foods, Inc. v. Fort Howard Paper 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.”). We have carefully considered all of the evidence of record as it pertains to the relevant *du Pont* factors, as well as Applicant’s

² Registration No. 2857455 issued on June 29, 2004; renewed.

arguments (including any evidence and arguments not specifically discussed in this opinion). To the extent that any other *du Pont* factors for which no evidence or argument were presented may nonetheless be applicable, we treat them as neutral.

A. Similarity of the Services, Channels of Trade and Customers

Applicant's services are:

“providing educational information in the academic field of **gemology** for the purpose of academic study” (emphasis added),

while Registrant's services are:

“gemological services, namely **providing information** regarding **gems** via the Internet.” (emphasis added).

Inasmuch as “gemology” is defined as “the science dealing with natural and artificial gemstones”³ both parties' services consist of “providing information” regarding gems. While Applicant provides “educational information . . . for the purpose of academic study,” Registrant's identification is not limited to the type of information or its purpose. Thus, Registrant's identification is broad enough to include the type of educational information Applicant provides. Similarly, Applicant has not limited the means by which its information is provided. One of the methods by which Applicant could disseminate its information is via the Internet as Registrant does. Indeed, Applicant's specimen reflects that Applicant uses the Internet to disseminate its information.

³ Dictionary definitions of “gemology” (based on Random House Dictionary, © Random House, Inc. 2014 from Dictionary.com located at <http://dictionary.reference.com/browse/gemology> attached to July 1, 2014 Office Action.

Applicant argues that its mark is used exclusively in connection with providing educational information in the academic field of gemology for the purpose of academic study while Registrant's mark is used as a chat tool in a retail setting. However, the question of likelihood of confusion is determined based on the identification of the services stated in the application and registration, not on extrinsic evidence of actual use. See *Stone Lion Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)). The cited mark is registered for providing information regarding gems via the Internet, and this identification includes providing, via the Internet, educational information in the academic field of gemology for the purpose of academic study.

Because the services are legally identical in part, they must be presumed to travel in the same channels of trade, and to be rendered to the same class of purchasers. *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981), citing *The Kalart Co., Inc. v. The Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958); see also, *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (absent restrictions in the application and registration, identical goods are presumed to travel in the same channels of trade to the same class of purchasers; the Board was entitled to rely on this legal presumption in determining likelihood of confusion).

Based on the foregoing, the *du Pont* factors of the similarity of the services, trade channels and customers favor a finding of likelihood of confusion.

B. Similarity of Marks

Marks are compared for similarity or dissimilarity in their entireties as to appearance, sound, meaning and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1722*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005); *In re E.I. du Pont de Nemours & Co.*, 177 USPQ at 567.

When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the services offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *In re Davia*, 110 USPQ2d 1810, 1813 (TTAB 2014). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of service marks. *United Global Media Group, Inc. v. Tseng*, 112 USPQ2d 1039, 1049, (TTAB 2014); *L'Oréal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012).

Both marks contain the term GEMOLOGIST. As noted in the WISEGEEK article provided with the initial Office Action, a “gemologist” is a certified professional who works in the field of “gemology.”⁴ This common portion of each mark imparts the same meaning to consumers; that the information provided will

⁴ See July 1, 2014 Office Action: <http://www.wisegeek.com/what-does-a-gemologist-do.htm> 06/27/2014.

concern gems, and that the services will be provided by a certified professional “gemologist.”

Each mark consists of two words combined into a single term with no space between the words. In addition to containing the descriptive term GEMOLOGIST, each mark begins with a possessive pronoun that refers to the individual, *i.e.*, YOUR- in Applicant’s mark and MY- in Registrant’s mark. YOUR- and MY- both suggest that the services are personalized. Because of the similarity between YOUR- and MY-, especially when combined with another descriptive term such as GEMOLOGIST, consumers are likely to remember the trademarks as indicating that the services are personalized. The absence of a space between these pronouns and the term GEMOLOGIST not only results in both marks having a common structure, it also makes any difference between MY- and YOUR- less visually noticeable, because these words do not stand apart. Thus, when “MY” and “YOUR” are combined with the term “GEMOLOGIST,” the resulting marks convey the same overall commercial impression to the average consumer who retains a general rather than specific impression of trademarks, namely, that both Applicant and Registrant will offer personalized services or act as one’s personal gemologist. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); *L’Oréal S.A. v. Marcon*, 102 USPQ2d at 1438.

C. Actual Confusion

Lastly, Applicant argues that it is not aware of any instances of actual confusion.⁵ Accordingly, Applicant maintains that confusion is not likely and submits that this *du Pont* factor also favors registration of Applicant's mark. The fact that an applicant in an *ex parte* case is unaware of any instances of actual confusion is generally entitled to little probative weight in the likelihood of confusion analysis inasmuch as the Board in such cases generally has no way to know whether the registrant likewise is unaware of any instances of actual confusion, nor is it usually possible to determine that there has been any significant opportunity for actual confusion to have occurred. *See, e.g., In re Opus One Inc.*, 60 USPQ2d 1812, 1817 (TTAB 2001); *In re Jeep Corporation*, 222 USPQ 333, 337 (TTAB 1984); *In re Barbizon International, Inc.*, 217 USPQ 735, 737 (TTAB 1983). Therefore, we find that this *du Pont* factor is neutral.

D. Conclusion

The commercial impressions of Applicant's mark YOURGEMOLOGIST and the cited mark MYGEMOLOGIST are sufficiently similar in their entireties that customers are likely to be confused as to the source of the in-part identical services

⁵ Applicant refers to an affidavit supplied in connection with Applicant's Office Action Response, noting the length of time during which Applicant has used its mark in connection with its services and its co-existence with Registrant's mark without confusion. 4 TTABVUE 13. The application file does not contain such an affidavit. Even if it did, it would not affect our decision because an applicant's uncorroborated statements of no known instances of actual confusion are of little evidentiary value. *See In re Majestic Distilling Co.*, 65 USPQ2d at 1205 (citing *In re Bissett-Berman Corp.*, 476 F.2d 640, 177 USPQ 528, 529 (CCPA 1973) (stating that self-serving testimony of appellant's corporate president's unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion)).

provided under them. On balance, we conclude that there is a likelihood of confusion based on the similarity between the marks and the services, and the presumed overlap in trade channels and purchasers.

Decision: The refusal to register Applicant's mark YOURGEMOLOGIST is affirmed.