

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: March 4, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re MCM Industries, LLC*  
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Serial No. 88380496  
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Steven Weigler and Cassidy Merriam of EmergeCounsel, LLC,  
for MCM Industries, LLC.

Esther Queen, Trademark Examining Attorney, Law Office 111,  
Chris Doninger, Managing Attorney.

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Before Wellington, Wolfson, and Pologeorgis,  
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

MCM Industries, LLC (“Applicant”) seeks registration on the Principal Register of the standard character mark JEWELLED LULLABY for “jewelry” in International Class 14.<sup>1</sup>

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark, as applied

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<sup>1</sup> Application Serial No. 88380496 was filed on April 10, 2019, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant’s allegation of a bona fide intention to use the mark in commerce.

to jewelry, so resembles the standard character mark LULLABY LINKS (with a disclaimer of LINKS) for “precious metal jewelry for babies to wear, namely, necklaces, bracelets, rings, and earrings made of pure silver and 24k gold” in International Class 14,<sup>2</sup> registered on the Principal Register, as to be likely to cause confusion, to cause mistake, or to deceive.

Additionally, pursuant to Section 6(a) of the Trademark Act, 15 U.S.C. § 1056(a), the Examining Attorney refused registration for Applicant’s failure to comply with a requirement to provide a disclaimer of the term JEWELLED.

When the refusals were made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, this appeal resumed. The appeal is fully briefed. For the reasons explained below, we reverse the refusal based on the disclaimer requirement; however, we affirm the refusal to register based on a likelihood of confusion.

### **I. Evidentiary Objection**

Applicant submitted new evidence with its appeal brief and the Examining Attorney objected to the submission of such evidence.<sup>3</sup> Because the record in an application should be complete prior to the filing of an appeal, *see* Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d), and TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) §§ 1203.02(e), 1207.01 (2020), we sustain the Examining

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<sup>2</sup> Registration No. 5094357, issued December 6, 2016.

<sup>3</sup> 13 TTABVUE 3. All citations in this opinion to the appeal record are to TTABVUE, the docket history system for the Trademark Trial and Appeal Board. Citations to the prosecution history of the application are to pages from the Trademark Status & Document Retrieval (“TSDR”) database of the United States Patent and Trademark Office (“USPTO”).

Attorney's objection and do not further consider the objected-to evidence.<sup>4</sup> *See In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1744 (TTAB 2018), *aff'd per curiam*, 777 F. App'x 516 (Fed. Cir. 2019); *In re Fiat Grp. Mktg. & Corp. Commc'ns S.p.A*, 109 USPQ2d 1593, 1596 (TTAB 2014).

## II. Disclaimer

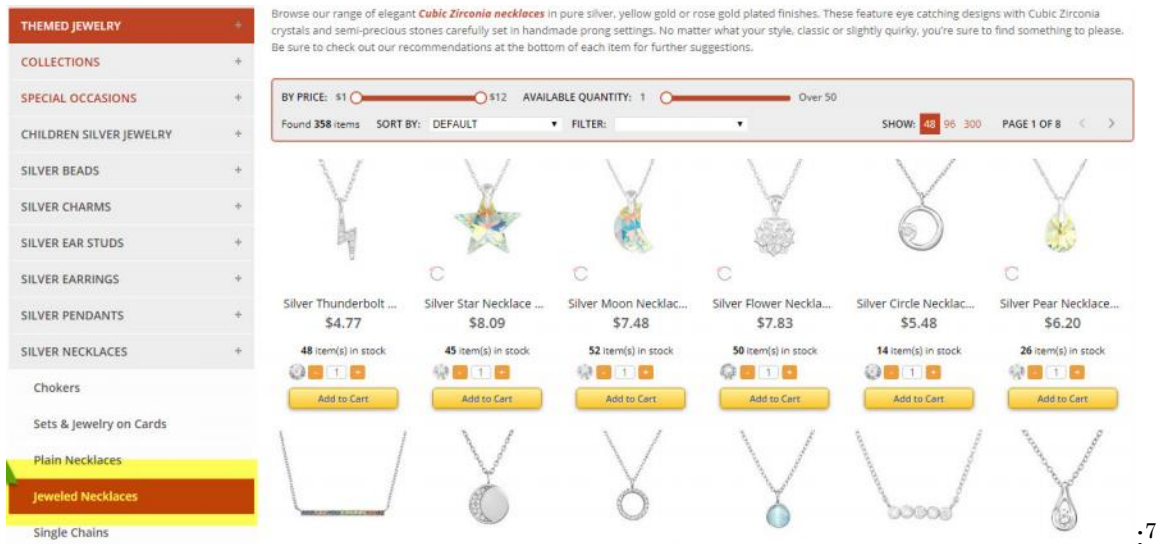
A requirement under Section 6 of the Trademark Act for a disclaimer of unregistrable matter in a mark is appropriate when that matter is merely descriptive or generic of the goods or services at issue. *See In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005). Merely descriptive or generic terms are unregistrable under Section 2(e)(1) of the Trademark Act and, therefore, are subject to a disclaimer requirement if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is a ground for refusal of registration. *See In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262, 1266 (Fed. Cir. 2015); *In re RiseSmart Inc.*, 104 USPQ2d 1931, 1933 (TTAB 2012).

The Examining Attorney required Applicant to disclaim the wording JEWELLED on the ground that the term is merely descriptive of Applicant's jewelry. In support, the Examining Attorney relies on definitions for the word, as an adjective, meaning "adorned, set with, or made from jewels" or "a jeweled object has been decorated with

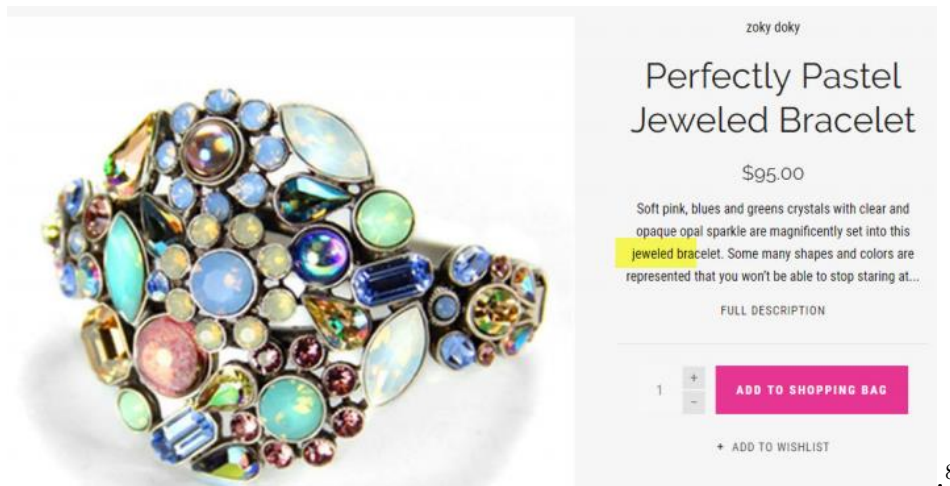
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<sup>4</sup> In its reply brief, Applicant "recognizes that certain evidence submitted with Applicant's appeal brief that was not previously submitted during prosecution will not be considered by the Board," (14 TTABVUE 4), but requests that the Board consider Applicant's arguments based on other evidence that was timely and properly submitted by Applicant. To be sure, the Board has given consideration to all of Applicant's arguments based on properly and timely submitted evidence.

jewels.”<sup>5</sup> The Examining Attorney also submitted marketplace evidence showing the term used descriptively in connection with jewelry by several third parties.<sup>6</sup> For example:



and



<sup>5</sup> Attached to October 10, 2019 Office Action, TSDR pp. 2-3.

<sup>6</sup> In total, the Examining Attorney attached printouts showing 10 different examples of the term “jeweled” in use in connection with jewelry. *Id.*, TSDR pp. 4-13.

<sup>7</sup> *Id.*, TSDR p. 4. The example here is “jeweled necklaces.”

<sup>8</sup> *Id.*, TSDR p. 5.

The Examining Attorney also argues:

Further, the wording “JEWELLED” is a separable component of the mark. The mark itself is composed of an adjective (JEWELLED) and a noun (LULLABY) and these terms when used together have no well-recognized meaning or significance such that consumers would view the mark as being unitary. Thus, the wording “JEWELLED” is a separable element of the mark that must be disclaimed.

Citing *In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1288 (TTAB 2006) and TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) (October 2018) §§ 1213.05(b)(iv), (g), (g)(i).

In arguing against the requirement for a disclaimer of JEWELLED, Applicant argues that the term is actually a transitive verb<sup>9</sup> and that the Examining Attorney “completely dismisses Applicant’s arguments regarding third-party evidence of registrations in Class 14 where the term JEWELLED was not required to be disclaimed. Applicant notes that these were not simply examples of **some** Class 14 registrations where a disclaimer was not required—there are zero examples of past registrations where the term has required a disclaimer.” (Emphasis in original). In support, Applicant relies on 4 registrations for marks with the term: JEWELLED OCCASIONS, JEWELLED TRIGGER, JEWELLED MOMENTS, and BT JEWELLED (stylized with design), all for “jewelry” and none with a disclaimer.<sup>10</sup> Applicant

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<sup>9</sup> Applicant points to the definition, taken from THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE website and submitted by the Examining Attorney, providing the meaning for “jeweled” as “tr. v. . . . to adorn with jewels . . . to fit with jewels.” June 20, 2019 Office Action, TSDR p. 20.

<sup>10</sup> Copies of the registrations were attached to Applicant’s response filed April 1, 2020, TSDR pp. 8-11. We note Applicant attached additional registrations for marks with the term JEWELLED; however, these registrations did not cover “jewelry” and thus have little, if any, probative value in connection with the disclaimer requirement for jewelry goods.

correctly acknowledges that “each case must be decided on its own facts,” but argues that “wavering from the Office’s prior decisions is generally more helpful when there are actually underlying facts that support the divergence from prior procedure — some underlying fact that makes this case different from the others.”<sup>11</sup>

Whether the word JEWELLED is being used as an adjective or a transitive verb, it is a modifier and may be understood as describing an object that is adorned or fitted with jewels. We also take judicial notice of a second definition of the term “jeweled,” as a transitive verb, meaning “to give beauty to as if with jewels: embellish.”<sup>12</sup> A lullaby is “a song used to lull a child to sleep; cradlesong.”<sup>13</sup> Thus, a “jeweled lullaby” may be understood in an incongruous and nonsensical manner to mean a lulling song for children that is fitted with jewels or, what is more likely, a “jeweled lullaby” may be understood as connoting an embellished or beautified version of a lullaby. This latter, more plausible meaning not only creates a unitary expression but also incongruously employs the word “jeweled” in the mark in a poetic or metaphoric manner that is not merely descriptive of the jewelry. In other words, Applicant’s use of the term JEWELLED in its mark can be distinguished from much of the third-party Internet evidence which shows the term combined with other descriptive or generic,

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<sup>11</sup> 14 TTABVUE 10.

<sup>12</sup> “Jeweled.” *Merriam-Webster.com*. 2021. <https://www.merriam-webster.com> (March 2, 2021). The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016).

<sup>13</sup> Definition, from website Dictionary.com, attached to Applicant’s September 17, 2019 Response, TSDR p. 5.

jewelry-related terms, e.g., bracelet, necklace, etc. Thus, there can be no mistake that the term “jeweled” in those uses is clearly meant to inform the consumer that a particular piece of jewelry has been fitted with jewels.

With respect to the Examining Attorney’s reliance on the Board’s *Brown-Forman* decision, that case involved the mark GALA ROUGE for wine and whether a disclaimer of “Rouge” (red) was necessary. The Board affirmed the disclaimer requirement finding the mark “has no obvious, immediate and inherent unitary significance which would cause purchasers to view ROUGE as modifying GALA [meaning ‘party’], rather than as describing the wine.” *In re Brown-Forman Corp.*, 81 USPQ2d 1288.<sup>14</sup> In the present case, however, the term “jeweled” is being used as an adjective or transitive verb, modifying LULLABY, and the entire mark conjures an embellished or beautified lulling song for babies. Thus, unlike GALA ROUGE, the combination of terms, JEWELLED LULLABY, presents a unitary expression with a meaning that is not merely descriptive of the goods.

Ultimately, we find that JEWELLED, when viewed and understood in Applicant’s entire mark, JEWELLED LULLABY, is not merely descriptive of the goods. Accordingly, the requirement to disclaim this term, under Section 6(a) of the Trademark Act, is reversed.

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<sup>14</sup> It is also notable that “rouge,” as the French equivalent of the word “red,” carries particular significance in describing a type of wine. Its position as the last word in the mark emphasizes that highly descriptive significance. No similar attribute of “jeweled” is under consideration here.

### **III. Likelihood of Confusion**

Our determination of the issue of likelihood of confusion is based on an analysis of all the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) (“*DuPont*”). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). We consider each *DuPont* factor for which there is evidence and argument. See, e.g., *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). When analyzing these factors, the overriding concern is not only to prevent buyer confusion as to the source of the goods, but also to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *In re Country Oven*, 2019 USPQ2d 443903 at \*2-3 (citing *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993)).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. See *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *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.”).

#### **A. Relatedness of the Goods; Their Trade Channels & Classes of Consumers**

The second *DuPont* factor concerns the “similarity or dissimilarity and nature of the goods,” and the third *DuPont* factor concerns “[t]he similarity or dissimilarity of established, likely-to-continue trade channels.” *Stone Lion Capital Partners, LP v.*



*Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1159 (Fed. Cir. 2014) (quoting *DuPont*, 177 USPQ at 567). We make our determination under these factors based on the goods as they are identified in the application and the cited registration. *In re Ox Paperboard*, 2020 USPQ2d 10878, \*5 (TTAB 2020) (citing *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *Octocom Sys., Inc. v. Houston Comput. Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

Here, the goods are legally identical given Applicant's "jewelry" encompasses Registrant's more tailored identification of "precious metal jewelry for babies to wear, namely, necklaces, bracelets, rings, and earrings made of pure silver and 24k gold." In addition, because the involved goods are legally identical, we presume that they travel through the same channels of trade to the same classes of purchasers, considerations under the third *DuPont* factor. *See American Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011) (where the services were legally identical, "the marketing channels of trade and targeted classes of consumers and donors are the same"); *see also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding Board entitled to rely on this legal presumption in determining likelihood of confusion).

In view of the identity of goods and trade channels, the second and third *DuPont* factors weigh strongly in favor of a finding that confusion is likely.

## **B. The Similarity of the Marks**

We turn now to the first *DuPont* factor, involving a comparison of the marks in appearance, sound, and connotation, and commercial impression. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *Inn at St. John’s*, 126 USPQ2d at 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)). We assess not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are so similar that confusion as to the source of the goods offered under the respective marks is likely to result. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (citing *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713 (Fed. Cir. 2012)).

In comparing the marks, we are mindful that where, as here, the goods are legally identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Coach Servs.*, 101 USPQ2d at 1721; *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Prods. Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

Here, we find the marks JEWELLED LULLABY and LULLABY LINKS are very similar based on the presence in both marks of the word LULLABY. The shared term helps make the marks look and sound alike.

Viewing the marks in their entireties, as we must, we find the overall commercial impressions created by them are extremely similar. That is, as discussed supra, Applicant's mark, will likely be understood by consumers as conveying an expression of a fanciful lullaby. Similarly, the commercial impression derived from Registrant's mark is also dominated by a lullaby connotation because not only does the mark begin with the term LULLABY, but the latter term, LINKS, is merely descriptive of jewelry and was disclaimed by the Registrant.<sup>15</sup> Disclaimed matter that is descriptive of or generic for a party's goods or services is typically less significant or less dominant when comparing marks. *In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997).

In weighing the importance of both marks sharing the term LULLABY, we note that this word has no demonstrated meaning in connection with jewelry and thus it is considered arbitrary and strong in the context of the involved goods. At best, it may be slightly suggestive of Registrant's jewelry that is "to be worn by babies." However, that same suggestive meaning may be conveyed by Applicant's JEWELLED LULLABY

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<sup>15</sup> As the Examining Attorney notes in her brief (13 TTABVUE 8), there is "third party evidence of record [that] clearly shows that the goods in the registration, such as necklaces, contain links," citing evidence attached to June 20, 2019 Office Action, TSDR pp. 4-5, 8, 19 and October 10, 2019 Office Action, TSDR pp. 4, 7- 9, and 11-12.

given Applicant's goods may also include jewelry to be worn by babies. We further note that there is no evidence of any third-party use of the term LULLABY or that it is otherwise weak in connection with jewelry. Indeed, in this regard, the Examining Attorney submitted evidence showing that Applicant and Registrant are the only entities seeking to register marks with this term.<sup>16</sup>

In sum, we find the marks, JEWELED LULLABY and LULLABY LINKS are overall similar in appearance, sound, and connotation, and commercial impression, and this *DuPont* factor also weighs in favor of a finding a likelihood of confusion.

### **C. Conclusion on Likelihood of Confusion**

Because the goods are legally identical and travel in the same trade channels, we conclude that consumers are likely to be confused as to their source when these goods are sold under the overall similar marks, JEWELED LULLABY and LULLABY LINKS.

### **Decision:**

The refusal to register Applicant's mark based on the disclaimer requirement under Section 6(a) of the Trademark Act is reversed. However, we affirm the refusal to register under Section 2(d) of the Trademark Act based on a likelihood of confusion.

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<sup>16</sup> In the May 21, 2020 Office Action, at TSDR p. 1, the Examining Attorney states that a "search of record dated 5/21/20 from the USPTO's X-Search database show[s] that only three records exist for jewelry," and included a copy of an application (Ser. No. 88776954) owned by Applicant. The search results from the USPTO's X-Search database were placed in the Application file on the same date.