

**THIS OPINION IS NOT A  
PRECEDENT OF  
THE TTAB**

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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Disney Enterprises, Inc.

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Serial No. 77235868

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David M. Kelly and Lynn M. Jordan of Finnegan Henderson  
Farabow Garret & Dunner, LLP for Disney Enterprises, Inc.

Stephen Aquila, Trademark Examining Attorney, Law Office  
113 (Odette Bonnet, Managing Attorney).

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Before Hairston, Cataldo and Bergsman, Administrative  
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Disney Enterprises, Inc. has filed an application to register the mark TIANA (standard character form) for the following goods: "athletic shoes; bandanas; baseball caps; beach cover-ups; beachwear; belts; bikinis; blazers; boots; bow ties; bras; caps; chaps; cloth bibs for babies; coats; dresses; ear muffs; footwear; gloves; golf shirts; Halloween costumes; hats; head bands; head wear; hosiery; infant wear; jackets; jeans; jerseys; kerchiefs; leotards;

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leg warmers; mittens; necklaces; night shirts; night gowns; overalls; pajamas; pants; panty hose; polo shirts; ponchos; rainwear; robes; sandals; scarves; shirts; shoes; skirts; shorts; slacks; slippers; sleepwear; socks; stockings; sweaters; sweat pants; sweat shirts; swimsuits; tank tops; tights; t-shirts; underwear; vests; wrist bands" in International Class 25.<sup>1</sup>

Registration has been finally refused pursuant to Trademark Act §2(d), 15 U.S.C. §1052(d), on the ground that applicant's mark, when used on applicant's goods, so resembles the previously registered mark TIANA for "jewelry, diamonds" in International Class 14,<sup>2</sup> as to be likely to cause confusion. Applicant has appealed. Applicant and the examining attorney have filed briefs. We affirm the refusal.

Our determination under Trademark Act §2(d) is based upon an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also

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<sup>1</sup> Application Serial No. 77235868 was filed on July 23, 2007, based upon applicant's assertion of its bona fide intent to use the mark in commerce.

<sup>2</sup> Registration No. 2810758 issued on February 3, 2004.

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*Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 554 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We turn first to the *du Pont* factor of the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. We find that applicant's mark TIANA (in standard character form) and the cited mark TIANA (also in standard character form) are identical in every respect, and applicant does not argue to the contrary. Use of identical marks is a fact which "weighs heavily against applicant." See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 165, 223 USPQ 1289 page cite (Fed. Cir. 1984); and *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993).

We turn next to a consideration of the *du Pont* factor of the similarity or dissimilarity of the goods. We note that if the marks are the same, as in this case, it is only necessary that there be a viable relationship between the

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goods in order to support a finding of likelihood of confusion. See *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983).

Furthermore, it is not necessary that applicant's goods and the registrant's goods be identical or even competitive in order to support a finding of likelihood of confusion. It is sufficient if the respective goods are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used in connection therewith, give rise to the mistaken belief that they emanate from or are associated with a single source. See *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

Although applicant is correct that there is no per se rule that clothing, on the one hand, and jewelry/diamonds, on the other hand, are related goods, we find that at the very least, applicant's women's "dresses," "shirts," "skirts," and "sweaters" are sufficiently related to registrant's "jewelry" that confusion is likely to result from the use thereon of the identical marks involved in this case. See *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) [A

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Section 2(d) refusal is proper if there is a likelihood of confusion involving any of the goods listed in the application and the cited registration.]

In support of their opposing arguments regarding the similarity of the goods, the examining attorney and applicant have introduced competing third-party registration evidence. The examining attorney submitted twenty-four use-based registrations for marks which include in their respective identifications of goods both clothing, including women's dresses, shirts, skirts, and/or sweaters, on the one hand, and jewelry, on the other hand.

Applicant introduced eight instances (sixteen registrations) when registrations issued to different entities for similar marks, one covering clothing or shoes, and the other covering jewelry and/or diamonds.

"Third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, although not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, may nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source." *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988), aff'd 864 F.2d 149 (Fed. Cir.

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1988). See also *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993).

The third-party registration evidence overwhelmingly favors the examining attorney's position with respect to the relatedness of women's dresses, shirts, skirts and sweaters, on the one hand, and jewelry, on the other hand. As for applicant's evidence, two of the eight sets of registrations relied upon by applicant cover shoes and jewelry/diamonds; two sets cover hosiery and diamonds; and two sets cover clothing and diamonds. Only two sets cover women's clothing and jewelry, in particular. In any event, as often noted by the Board, each case must be decided on its own merits. We are not privy to the records in the files of such registrations and, moreover, the determination of registrability of particular marks by the trademark examining attorneys cannot control the result in another case involving a different mark. See *In re Nett Designs, Inc.*, 57 USPQ2d 1564 (Fed. Cir. 2001). In sum, we find that the third-party registration evidence submitted by the examining attorney demonstrates the existence of a viable relationship between, at the very least, women's' dresses, shirts, skirts and sweaters, on the one hand, and jewelry, on the other hand. In addition, we find that jewelry such as necklaces and earrings are complementary

to, and would be purchased and worn together with, women's dresses and sweaters, for example. See *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991) [women's shoes are complementary to women's pants, blouses, shorts and jackets because they may be part of a coordinated outfit]. The *du Pont* factor of the similarity between the goods favors a finding of likelihood of confusion.

With respect to the *du Pont* factor of trade channels and classes of purchasers, because neither applicant's identification of goods nor the identification of goods in the cited registration includes any restrictions, we presume that the respective goods would be marketed in all normal channels of trade for such goods and to all normal classes of purchasers of such goods. *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Applicant's women's dresses, shirts, skirts and sweaters could be offered and sold to the same classes of purchasers in the same trade channels (e.g. department stores and mass merchandisers). This factor favors a finding of likelihood of confusion.

Under the *du Pont* factor of conditions under which sales are made, applicant argues that the purchasers of jewelry are sophisticated. However, there are no limitations in registrant's identification of goods. Therefore, the identification is broad enough to encompass

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costume jewelry which may be sold to ordinary consumers. Considering that this type of jewelry is relatively inexpensive, it is likely therefore to be purchased casually and on impulse, thereby increasing the possibility of confusion. Thus, the conditions under which sales are made is a factor that weighs in favor of a finding of likelihood of confusion.

Finally, applicant argues that registrant's TIANA mark is a weak mark entitled to only a narrow scope of protection. Specifically, applicant contends that registrant's mark is weak because "Tiana" is both a personal name and a foreign term that is suggestive of the cut of registrant's diamonds.

In support of its position that personal names such as "Tiana" are weak, applicant points to the Board's statement in *Aileen, Inc. v. Eileen Togs, Corp.*, 188 USPQ2d 698, 700 (TTAB 1975), that "surnames and given names, per se, because of their proliferation of use, are generally considered to fall within the designation of 'weak' marks ..."

With respect to the weakness of registrant's TIANA mark because it is suggestive, applicant has submitted evidence showing that the name "Tiana" means "princess" in Greek (Exhibit A-"[www.yeahbaby.com/meaning-name](http://www.yeahbaby.com/meaning-name)"); that



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registrant uses the mark TIANA to denote a "square modified cushion cut" diamond (Exhibit B-"Proprietary/Patented Diamond Cuts"); that a "square cut" diamond is also known as a "princess cut" (Exhibit J-"Wikipedia"); and that a person identified as Fred Knobloch of registrant Brite Star Diamond stated in a magazine article that the TIANA cut was "developed to underscore the virtues of a princess cut," and the mark TIANA was selected because "the word means princess." (Exhibit K-"Professional Jeweler Magazine").

Applicant's arguments do not persuade us that registrant's mark is entitled to only a narrow scope of protection. First, to the extent that purchasers would understand the meaning of the foreign word TIANA, this term would have the same meaning, i.e., "princess," in both marks. There is no additional word in registrant's mark which changes the meaning or commercial impression of the marks. Third, and regardless of whether the marks would be perceived as a given name or foreign term, even if marks which consist of the term TIANA are considered to be weak, even weak marks are entitled to protection where confusion is likely. Here, notwithstanding any alleged weakness in the term TIANA, the marks are identical and the goods are related.

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In view of the foregoing, we conclude that consumers familiar with registrant's jewelry sold under the mark TIANA would be likely to believe, upon encountering applicant's women's dresses, shirts, skirts, and sweaters, sold under the identical mark TIANA, that the goods originated with or are associated with or sponsored by the same entity.

To the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

**Decision:** The refusal to register under Trademark Act §2(d) is affirmed.