

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

Mailed:
March 19, 2010

Hearing:
January 20, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re F.X. Nachtmann Bleikristallwerke GmbH

Serial No. 77373377

Kenneth F. Florek of Hedman & Costigan, P.C., for
Bleikristallwerke GmbH.

Daniel Capshaw, Trademark Examining Attorney, Law Office 110
(Chris A.F. Pedersen, Managing Attorney).

Before Grendel, Holtzman, and Ritchie, Administrative Trademark
Judges.

Opinion by Ritchie, Administrative Trademark Judge:

Bleikristallwerke GmbH ("applicant") filed an application
to register the mark PLATINUM GLASS¹ for goods identified as:

"glassware, porcelain and earthenware for household and
kitchen use, namely, beverage glassware, bowls, basins,
saucers, coasters, gravy boats, serving spoons, ladles,
scoops, dippers, plates, dishes, cake stands, compotes,
vases, carafes, amphora, meal trays, tier trays, serving
trays, punch bowls, cups, glasses, wine glasses, goblets,
chalices, tumblers, whiskey glasses, brandy snifters, long
drink glasses, grappa glasses, martini glasses, sherry
glasses, cocktail glasses, champagne flutes, general
purpose drinking glasses, coffee glasses, jugs, jars, tots,

¹ Serial No. 77373377, filed January 16, 2008, pursuant to Section 1(b)
of the Trademark Act, 15 U.S.C. §1051(b), alleging a *bona fide* intent
to use in commerce, and disclaiming the exclusive right to use "GLASS"
apart from the mark as shown.

crocks, cans, pots, noggins, beer mugs, tankards, mugs, decanters, pitchers, bottles, flasks, cruets, flagons, sugar bowls and creamers sold separately and together as a unit, salt and pepper shakers sold separately and together as a unit, oil and vinegar bottles sold separately and together as a unit and sold empty, egg cups, butter dishes, jars for jams and jellies, insulating jars, candy boxes, champagne coolers, funnels, napkin rings, stoppers, candleholders, pot warmers, cheese covers; containers for household and kitchen not of precious metal or coated therewith," in International Class 21.

The Trademark Examining Attorney 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 PLATINUM SERIES,² in typed drawing format, for the goods identified below that when used on or in connection with applicant's identified goods, it is likely to cause confusion or mistake or to deceive:

International Class 8: "cutlery and kitchen tools, namely, knives, paring knives, utility knives, boning knives, slicing knives, bread knives, chef knives, steak knives, cheese knives, grapefruit knives, bar knives, folding pocket knives, serving forks, spaghetti serving forks, cooking forks, BBQ forks, BBQ tongs, serving tongs, ice tongs, shrimp deveiners, fruit and vegetable slicers, cheese slicers, mandoline slicers, bagel slicers, non-electric fruit and vegetable peelers, apple corers, cheese cutting planes, cheese graters, food graters, pizza cutters, non-electric food scrapers and choppers, nutcrackers not of precious metal, non-electric can openers; manicure implements, namely, cuticle scissors, nail scissors, cuticle nippers, nail nippers, nail clippers, tweezers, nail files, nose scissors, mustache scissors, baby scissors, stork scissors, barber shears, thinning shears; manicure sets";

² Registration No. 2338919, issued April 4, 2000, based on first use and first use in commerce in all classes on September 30, 1996, and disclaiming the exclusive right to use "SERIES" apart from the mark as shown.

International Class 9: "measuring cups and spoons, coffee measuring scoops, and meat thermometers"; and

International Class 21: "kitchen utensils, namely, serving spoons, slotted spoons, basting spoons, bar mixing spoons, mellow ballers, ice cream scoops, turners, wide turners, grill turners, BBQ turners, ladles, gravy ladles, spatulas, pie and cake servers, food mashers, strainers, skimmers, lemon zesters, egg separators, garlic presses, vegetable brushes, pastry brushes, non-electric dough blenders, pastry crimpers, butter curlers, whisks, non-electric meat tenderizers, colanders, bowls, mixing bowls, bagel holders, napkin holders, paper towel holders, banana caddies, bottle openers, jar openers, corkscrews, cork pullers, wine stoppers, bottle corks, wine pourers with caps, cocktail shakers, ice buckets, strainers, jiggers, pepper grinders, pepper and salt grinders, salt and pepper shakers."

Upon final refusal of registration, applicant filed a timely appeal. Both applicant and the examining attorney filed briefs, and applicant filed a reply brief. For the reasons discussed herein, the Board affirms the refusal to register.

We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a 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 Company, 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 goods or 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 discuss each of the *du Pont* factors as to which applicant or the examining attorney submitted argument or evidence.³

The Goods and Channels of Trade

The items in the application are identical-in-part to those in the cited registration. The identical items in Class 21 are "bowls," "serving spoons," "ladles," and "salt and pepper shakers." In addition to these identical items, there are various closely-related ones.

To demonstrate that close relationship of the various other items in the application and the cited registration, the examining attorney submitted numerous use-based, third-party registrations identifying items from each. Copies of use-based, third-party registrations may serve to suggest that the goods are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993).

³ We note that in its briefing, applicant referred to the "Polaroid" factors, referring to a Second Circuit decision used to determine infringement liability. *Polaroid Corp. v. Polaroid Electronics Corp.*, 287 F.2d 492, 128 USPQ 411 (2d Cir. 1961). Not all of these factors are relevant to determining *ex parte* registrability (although we have, of course considered all of applicant's evidence and arguments that are relevant to any *du Pont* factors). For example, the lack of evidence of "actual confusion" carries little weight, especially in an *ex parte* context. *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003) This is particularly so where, as here, applicant has an intent-to-use application and there has not yet been an opportunity for confusion to occur.

The examining attorney has also submitted Internet evidence from various websites such as www.oneida.com; www.pfaltzgraff.com; www.mikasa.com; and www.wmf.com, to show that various third parties sell various items identified in both the application and the cited registration via their websites under the same mark. This is further evidence that consumers expect to find both types of goods emanating from a common source.

With in-part-identical goods, and otherwise related goods, we find that this *du Pont* factor favors finding a likelihood of confusion.

The Channels of Trade

In the absence of specific limitations in the registration, we must presume that registrant's goods will travel in all normal and usual channels of trade and methods of distribution. *Squirtco v. Tomy Corporation*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983); see also *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992) (because there are no limitations as to channels of trade or classes of purchasers in either the application or the cited registration, it is presumed that the services in the registration and the application move in all channels of trade normal for those services, and that the services are available to all classes of purchasers for the listed services). Since there are no limitations on the channels of trade in applicant's identification of goods either,

we must make the same presumption with regard to applicant's goods.

In other words, there is nothing that prevents the registrant from selling its "bowls," "ladles," "serving spoons," and other items in the same stores, and indeed on the same shelves, as applicant's. Accordingly, we find that this *du Pont* factor weighs in favor of finding a likelihood of confusion as well.

The Marks

Preliminarily, we note that the more similar the goods at issue, the less similar the marks need to be for the Board to find a likelihood of confusion. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992). We consider and compare the appearance, sound, connotation and commercial impression of the marks in their entirety. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

In comparing the marks, we are mindful that the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods and/or services offered under the respective marks is likely to result. *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 unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *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).

Both marks consist of two words, beginning with the word PLATINUM. While we must not improperly dissect a mark, certain features may be considered dominant. *In re National Data Corp.*, 224 USPQ 749, 751 (Fed. Cir. 1985) ("[T]here 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 consideration of the marks in their entireties."). In particular, descriptive or disclaimed matter is generally considered a less dominant portion of a mark. *Id.* at 750. Both applicant and the registrant have disclaimed the descriptive portions of their marks that follow the term PLATINUM, i.e., GLASS and SERIES.

Applicant argues that the connotations of the marks are different, arguing that the term "PLATINUM" in the cited registration is a "laudatory" designation. However, that argument is not persuasive. First, there is no evidence that consumers would view "PLATINUM" in "PLATINUM SERIES" as a laudatory designation. Second, neither is there any evidence that such connotation would make applicant's mark less similar

to consumers. More likely, the fact that the mark in the cited registration refers to a "SERIES" makes it all the more likely that consumers will be confused into believing that applicant's goods offered under the "PLATINUM GLASS" mark are among the products in that "PLATINUM SERIES." This seems particularly likely since the goods offered by applicant and registrant under their respective identifications of goods are in-part-identical.

Finally, applicant argues that the cited registration is weak. In support of this argument, applicant cites a few third-party registrations that contain the term PLATINUM as evidence that consumers will distinguish its mark from that in the cited registration. Third-party registrations may be used to show that a term has been commonly registered for its suggestive meaning. However, the existence of three or four use-based registrations is not sufficient to prove that a mark is unprotectably weak. *See Giant Food Inc. v. Roos and Mastacco, Inc.*, 218 USPQ 521 (TTAB 1982) (even owner of weak mark is entitled to protection from likelihood of confusion).

In sum, we find this *du Pont* factor to also favor finding a likelihood of confusion.

Consumer Sophistication

Applicant urges us to consider consumer sophistication. Indeed, applicant suggests in its brief that the relevant consumers "must be considered sophisticated." (Appl's brief at 7). We disagree. We note that applicant attached to its brief

as Exhibit B what appears to be a sales specimen from the registrant. The examining attorney objected to this evidence as being improperly submitted for the first time on brief. The objection is sustained. See 37 CFR 2.142(d).⁴ Furthermore, to the extent applicant was attempting to use the information therein to show that the registrant's goods are expensive and that therefore its consumers are sophisticated, Exhibit B is not particularly useful in that regard. Rather, we are bound by the parties' respective descriptions of goods. *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("[t]he authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed." [citations omitted]).

Indeed, the record shows "ladles" as identified by both the application and the cited registration, listed on www.oneida.com, for \$7.99, alongside "serving spoons," also

⁴ It is not relevant, as applicant counters in reply, that this was part of the registration file and that the registration was in turn cited by the examining attorney in the present proceeding. The entire (and ongoing) prosecution file of the cited registration does not automatically become part of this proceeding. Applicant would have had to submit this paper, like any other, during the prosecution of the present application in order to enter into the record thereof.

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listed by both, for \$5.99. For goods in this price range, consumers often make impulse decisions, and may not stop to think about the difference between the marks.

Conclusion

In summary we have carefully considered all of the evidence and arguments of record relevant to the *du Pont* likelihood of confusion factors. We conclude that there is a likelihood of confusion between applicant's PLATINUM GLASS mark for the goods for which it seeks registration and the registered mark PLATINUM SERIES for the items identified therein, including the goods that are in-part-identical.

Decision: The refusal to register is affirmed.