

This Opinion Is Not a
Precedent of the TTAB

Mailed: December 13, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Chow Tai Fook Jewellery Company Limited

Serial No. 87374361

Diane J. Mason of LeClairRyan LLP,
for Chow Tai Fook Jewellery Company Limited.

Thomas Young, Trademark Examining Attorney, Law Office 120,
David Miller, Managing Attorney.

Before Taylor, Wellington, and Gorowitz,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Applicant Chow Tai Fook Jewellery Company Limited seeks to register on the
Principal Register the mark T MARK, in standard characters, for, in part:¹

Precious metals and their alloys; goods in precious metals or coated therewith,
namely, jewelry, key rings, key chains, jewelry cases, watches, jewelry charms,
medals, figurines, tie clips, cuff links, sculptures, decorative pins in the nature
of jewelry, decorative boxes, jewelry ornaments in the nature of jewelry; jewelry,
precious stones, semi-precious stones, gemstones, pearls, jades, diamonds,

¹ Application Serial No. 87374361 was filed March 16, 2017, under Section 44(e) of the Trademark Act, based on Applicant's ownership of a foreign (Hong Kong) registration No. 303814227. The application also covers goods and services in Classes 9, 35, and 42, which the Examining Attorney made clear are not subject to the "partial refusal." 9 TTABVUE 3.

rubies, sapphires, emeralds; horological and chronometric instruments, clocks, watches; cases for jewelry in International Class 14.

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 to the goods identified in Class 14 of the application, so resembles the registered mark:²



for "jewelry" in International Class 14, as to be likely to cause confusion, to cause mistake, or to deceive.

After the Examining Attorney made the refusal final, Applicant requested reconsideration and appealed to this Board. The request for reconsideration was denied by the Examining Attorney. The appeal is briefed. We affirm the refusal to register.

I. Likelihood of Confusion

Our determination under Section 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.*, 315 F.3d 1311, 65 USPQ2d 1201,

² Registration No. 4512182, issued April 8, 2014. The colors red and gold are claimed as a feature of the mark and the registration contains a statement that "the name 'T J MARC' in the mark does not identify a living individual.

1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the relatedness of the goods or services and the similarities between the marks. *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.”).

A. Identity of the Goods/ Trade Channels/ Classes of Purchasers

With regard to the goods and channels of trade, we must make our determinations under these factors based on the goods as they are identified in the application and the cited registration. *See In re Dixie Rests.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); *see also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Hous. Computs. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

In this case, Applicant’s identification of goods includes “jewelry,” which is also listed in the cited registration. Thus, these goods are identical in part.³

In view of the identity of the goods, and in the absence of restrictions or limitations in their identifications, it is presumed that the channels of trade and classes of customers for these goods are the same. *See In re Viterra Inc.*, 671 F.3d 1358, 101

³ Applicant’s Class 14 goods also includes “jewelry cases, ... jewelry charms,” that are either encompassed by or closely related to Registrant’s identified “jewelry.” Nevertheless, we focus our likelihood of confusion analysis on the identical jewelry goods; it is sufficient for a refusal based on likelihood of confusion that relatedness is established for any item encompassed by the identification of goods in a particular class in the application. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

USPQ2d 1905, 1908 (Fed. Cir. 2012) (legally identical goods are presumed to travel in same channels of trade to same class of purchasers); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *In re Am. Cruise Lines, Inc.*, 128 USPQ2d 1157, 1158 (TTAB 2018). Accordingly, the factors involving the relatedness of the goods and their trade channels and classes of purchasers weigh heavily in favor of finding a likelihood of confusion.

B. Conditions of Sale – Consumer Care

Applicant argues that “jewelry is purchased by consumers with care” because it is usually a “very personal” item and “can often be expensive.”⁴ However, the identifications of Applicant’s and Registrant’s goods includes “jewelry,” without any restriction as to quality or price point. We must presume that the jewelry includes inexpensive jewelry items that may be purchased without more than ordinary care. Indeed, we must base our decision on the least sophisticated potential consumers. *See, e.g., In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1649 (TTAB 2008) (where identification of “jewelry” in application was not limited by price, Board was required to “assume that the jewelry includes inexpensive items that consumers would purchase with nothing more than ordinary care.”). As a result, this *du Pont* factor is neutral in our analysis.

⁴ 7 TTABVUE 14, 15.

C. Purported Weakness of “TJ”

Applicant argues that “TJ has the connotation of a common nickname, and therefore is a somewhat weak mark, as demonstrated by the co-existing marks,” referencing a Wikipedia entry to “T.J. (given name),” a printout from an “eBabyNames” website for “TJ,” and a table of six third-party registrations.⁵ Applicant further concludes that “given the weakness of the term TJ, such marks are able to co-exist with the mark T for the same or highly related goods.”⁶

We disagree with Applicant’s assertion that the evidence demonstrates that the TJ element is weak due to extensive third-party use. While the sixth *du Pont* factor requires us to give weight to any commercial weakness based on third-party use of similar marks for the same or **similar** goods/ services, the record is devoid of such evidence. Only one of the six third-party registrations containing the letters TJ covers jewelry, whereas the others involve apparel or other facially unrelated goods. Moreover, as the Board explained in *In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1745 (TTAB 2016), “citation of third-party registrations as evidence of market weakness is unavailing because third-party registrations standing alone, are not evidence that the registered marks are in use on a commercial scale, let alone that consumers have become so accustomed to seeing them in the marketplace that they have learned to distinguish among them by minor differences.” *See also AMF*

⁵ 7 TTABVUE 8. Applicant’s referenced materials, including copies of the third-party registrations, were submitted by Applicant with its Request for Reconsideration. (6 TTABVUE).

⁶ *Id.* at 13.

Inc. v. Am. Leisure Prods., Inc., 474 F.2d 1403, 177 USPQ 268, 269-70 (CCPA 1973).

The record does not establish that the letter combination TJ or the letter T has any special meaning in connection with jewelry.⁷

In sum, we find no commercial weakness in “TJ,” or any element of either mark, in connection with jewelry.

D. Similarity of the Marks

We now address the first *du Pont* likelihood of confusion factor focusing on “the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d at 1691 (quoting *du Pont*, 177 USPQ at 567). “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) (quotation omitted).

The marks “must be considered ... in light of the fallibility of memory” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1 (CCPA 1977)). The proper focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of

⁷ In our analysis of the marks and their connotations and commercial impressions, we discuss any suggestiveness or weakness of the cited mark, or elements thereof.

trademarks. See *St. Helena Hosp.*, 113 USPQ2d at 1085; *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971). Because the goods are “jewelry,” the average purchaser is an ordinary consumer of jewelry and, in this respect, we reiterate that Registrant’s and Applicant’s jewelry, as described in the respective identifications of goods, is not limited to any range of quality or price point.

Our analysis is not predicated on dissection of the involved marks. *Stone Lion*, 110 USPQ2d at 1161. Rather, we are obliged to consider the marks in their entirety. *Id.*; 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.”). Nonetheless, 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 entirety. *Stone Lion*, 110 USPQ2d at 1161. For instance, as the Federal Circuit has observed, “[t]hat a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark” *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

In addition, where, as here, marks are used on legally identical goods, the degree of similarity between the marks necessary to support a determination that confusion is likely declines. *Bridgestone Ams. Tire Operations LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

With the aforementioned principles in mind, we find the respective marks,



and T MARK, are overall more similar than not. In terms of sound, they are very close. That is, consumers are likely to verbalize each mark by its respective initial letters, T or TJ, followed by the phonetic equivalents, MARK or MARC.

As to appearance, there is some similarity due to MARK being the larger term in Applicant's mark and MARC displayed prominently in the registered mark. We also remain cognizant that Applicant seeks registration of T MARK in standard characters, and therefore seeks protection of a mark that may be displayed in any font, including the same stylized font as Registrant's mark. *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017); *Viterra*, 101 USPQ2d at 1910; *SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983).

The crown design element, present in the registered mark but not in Applicant's mark, is a point of difference that does very little to distinguish the marks. It is not very prominent, being smaller in size than the lettering. Moreover, consumers will focus on the literal portion of Registrant's mark because consumers will use the letters/words, rather than the design, to refer to and call for the goods. *See Viterra*, 101 USPQ2d at 1908; *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987) (if a mark comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services). *See also CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983).

As to the marks' overall meaning and commercial impression, they also are related in that consumers may understand each as a combination of similar initials followed by very similar first names.⁸ Specifically, Applicant's T MARK may be understood as referencing a person with a first initial "T" preceding the given name, "Mark." Similarly, Registrant's mark has the initials "TJ," also followed by the first name, "Marc." In this regard, we have considered the Wikipedia and eBabyNames internet evidence submitted by Applicant showing that "TJ" may be used as a nickname used by individuals whose first name begins with "T" and middle name begins with "J."⁹ While TJ may be a common or recognized set of initials, we do not find it so different from the single initial "T."

The online articles regarding "markings" placed on jewelry have little, if any, relevance when comparing the overall similarity of the marks. Rather, the articles describe the significance of certain engravings on jewelry and how some manufacturers may imprint their trademark (or "mark") on the jewelry or other markings to indicate the quality and the material content of the jewelry.

Ultimately, considering the marks in their entireties, as we must, we find that Applicant's T MARK is similar to the stylized, registered mark, TJ MARC and design. The term MARK and its phonetic (and near visual) equivalent, MARC, are featured prominently in both marks. When spoken, the marks will sound almost alike. The

⁸ In this respect, we do not necessarily agree with the Examining Attorney's contention that MARK, as used in Applicant's mark, would be understood as a surname. ⁹ TTABVUE 5. The Examining Attorney does not cite to evidence showing any popularity as to "Mark" being a surname, whereas "Mark" is a common and popular first name.

⁹ 6 TTABVUE 13-14.

marks also convey similar meanings. These similarities in the marks outweigh their differences. This factor weighs in favor of a finding that confusion is likely.

E. Other Factors

Applicant submitted copies of registrations for the following marks:

 (Reg. No. 4319504, owned by Registrant) for “jewelry”;¹⁰
and

 (Reg. No. 4256479) for “jewelry.”¹¹

Applicant argues that these registrations show that “the USPTO has previously determined that a registration for MARK for jewelry can co-exist with MARC for jewelry.”¹² However, as we often point out and it is well-settled, in an ex parte proceeding involving a particular application, neither the examining attorney nor the Board is bound by the decisions of other examining attorneys made in connection with other applications. *See In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“even if some prior registrations had some characteristics similar to [applicant’s] application, the PTO’s allowance of such prior registrations does not bind the Board or this court.”); and *In re Merrill Lynch, Pierce, Fenner & Smith Inc.*, 828

¹⁰ Registration issued on April 16, 2013.

¹¹ Registration issued on December 11, 2012.

¹² 7 TTABVUE 6.

F.2d 1567, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987). Here, as discussed above, we find the specific involved marks to be confusingly similar.

We have considered all of the arguments and evidence of record, including those not specifically discussed, as they pertain to the relevant *du Pont* likelihood of confusion factors. To the extent that any other *du Pont* factors for which no evidence was presented by Applicant or the Examining Attorney may nonetheless be applicable, we treat them as neutral.

II. Conclusion

In this case, Applicant's and Registrant's goods - jewelry - are identical and will be found in the same trade channels and encountered by the same classes of consumers. Because Applicant's and Registrant's jewelry may include inexpensive jewelry, we cannot assume a high degree of care in purchase selection. With these factors in mind and because Applicant's mark, T MARK, is similar to Registrant's stylized TJ MARC and design mark, we find that confusion is likely.

Decision: The refusal to register Applicant's mark as to Class 14 is affirmed.