

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

12/12/01

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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In re Sharon Bossert  
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Serial No. 75/364,899  
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Denise C. Mazour for Sharon Bossert.

Marc J. Leipzig, Trademark Examining Attorney, Law Office  
115 (Thomas B. Vlcek, Managing Attorney).

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Before Seeherman, Hanak and Rogers, Administrative  
Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge.

Sharon Bossert (applicant) seeks to register  
CHERISHED BEADS in typed drawing form for "personalized  
bracelets" in Class 14 and for "rosaries" in Class 16.  
The multiple class application was filed on September 29,  
1997 with a claimed first use date of May 2, 1997 as to  
personalized bracelets and May 7, 1997 as to rosaries.

The Examining Attorney has refused registration  
pursuant to Section 2(d) of the Trademark Act on the  
basis that applicant's mark, as applied to applicant's  
goods, is likely to cause confusion with the mark  
CHERISHED, previously registered in typed drawing form

for "ladies' diamond finger rings." Registration No. 818,647.

When the refusal to register was made final, applicant Ser. No. 75/364,899

appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant requested and later waived an oral hearing.

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.")

Considering first the marks, applicant has adopted the registered mark in its entirety, and merely added to it the descriptive word BEADS. In this regard, we note that the plural form of the word "bead" is defined as meaning the following: "a) string of beads, necklace; b) a rosary." Webster's New World Dictionary (2d ed. 1975).

Moreover, in the first Office Action, the Examining Attorney stated that "the applicant must disclaim the descriptive wording BEADS apart from the mark as shown." Applicant then complied with this disclaimer requirement.

While marks must be compared in their entireties, there

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is nothing improper in giving more weight to the dominant portion of a composite mark. With regard to applicant's mark CHERISHED BEADS, the arbitrary word CHERISHED is the dominant portion of the mark, given the fact that the word BEADS in applicant's mark is, at a minimum, highly descriptive as applied to personalized bracelets and rosaries. 3 J. McCarthy, McCarthy on Trademarks and Unfair Competition Section 23:45 at page 23-99 (4th ed. 2001). Given the clear dominance of the CHERISHED portion of applicant's mark, we find that applicant's mark, in its entirety, is extremely similar to the registered mark CHERISHED.

Turning to a consideration of the goods, because this is a multiple class application, we must first make a comparison of the relationship between ladies' diamond

finger rings and personalized bracelets, and then make a separate comparison of the relationship between ladies' diamond finger rings and rosaries.

At the outset, we note that applicant has conceded at page 5 of her brief that "personalized bracelets and diamond rings are both jewelry." Moreover, the Examining Attorney has made of record third-party advertisements appearing on

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the web in which the third parties advertise and offer for sale both ladies' diamond finger rings and bracelets. Some of these third parties specifically note that they offer personalized jewelry. For example, an advertisement by DaYo Designs states that it "makes custom jewelry, much of it personalized." The advertisement then goes on to give examples of the various types of personalized jewelry offered, including rings and necklaces. While bracelets are not specifically mentioned in this advertisement, we make the reasonable assumption that any firm that could make a personalized necklace could likewise make a personalized bracelet.

Another advertisement made of record by the Examining Attorney was placed by Trio Jewelry, Inc. It emphasizes that all of Trio's jewelry is handmade. This advertisement then pictures specimens of rings and bracelets which have been personalized with various feminine names.

Applicant has made of record no countervailing evidence, such as affidavits, even suggesting that the same firms do not offer to the purchasing public both personalized bracelets and ladies' diamond finger rings, which include personalized ladies' diamond finger rings.

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Instead, without offering any evidence, applicant merely argues at page 6 of her brief that registrant's diamond rings "are expensive, typically costing thousands of dollars," whereas "personalized bracelets, on the other hand, are relatively inexpensive." In contrast, the Examining Attorney has made of record evidence demonstrating that ladies' diamond rings can sell for as little as \$110, and that bracelets can range in price from \$30 to \$385. In short, the Examining Attorney has

proven that ladies' diamond finger rings and bracelets (including personalized bracelets) are offered by the same firms to the same individuals, and that both types of goods can be in the same price range.

Given the fact that applicant's mark CHERISHED BEADS is extremely similar to the registered mark CHERISHED, and the additional fact that there is a close relationship between ladies' diamond finger rings and personalized bracelets, we find that there exists a likelihood of confusion, and accordingly affirm the refusal as to applicant's Class 14 goods (personalized bracelets).

Turning to a comparison of ladies' diamond finger rings

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and rosaries, we are somewhat perplexed by the actions of the Examining Attorney. The Examining Attorney has made of

record absolutely no evidence showing any relationship between ladies' diamond finger rings and rosaries.

Moreover, in his Office Actions and appeal brief, the

Examining Attorney has never even argued that there is any relationship between ladies' diamond finger rings and rosaries. Unlike a diamond ring, a rosary is not a piece of jewelry but rather is "a string of beads used to keep count in saying certain prayers." Webster's New World Dictionary (2d ed. 1975). Given this total failure on the part of the Examining Attorney to articulate much less prove a relationship between diamond rings and rosaries, we find that there exists no likelihood of confusion resulting from the contemporaneous use of applicant's mark CHERISHED BEADS on rosaries and registrant's mark CHERISHED on ladies' diamond finger rings. Accordingly, the refusal to register as to applicant's Class 16 goods (rosaries) is reversed.

Decision: The refusal to register as to applicant's Class 14 goods (personalized bracelets) is affirmed. The refusal to register as to applicant's Class 16 goods

