

This Opinion is Not  
Citable as Precedent  
of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Gino's Jewelers

Serial No. 76354413

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108 (David Shallant, Managing Attorney).

Before Hairston, Rogers and Drost,  
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Gino's Jewelers, an Ohio corporation [applicant], has applied to register the mark set forth below for "goods in precious metals, namely, rings, bracelets, watches, earrings, necklaces, pins being jewelry, precious and non-precious gemstones," in International Class 14.

*Gino's*  
JEWELERS

As the record reveals, applicant previously had registered the term GINO'S alone, for similar goods<sup>1</sup>, but the registration inadvertently was allowed to expire. Both the prior registration and the current application claim a date of first use of any type as of September 1950. The prior registration claims first use of the mark GINO'S in commerce as of January 1961; and the current application claims first use of the stylized GINO'S JEWELERS mark in commerce as of May 1996. The Office listed the prior registration as expired on October 31, 1994. The current application was filed January 3, 2002. The application includes a disclaimer of JEWELERS.

The examining attorney refused registration of the current application under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), in view of the existence of a registration for the mark GINO M for goods identified as "jewelry made of precious metals and/or semi-precious or precious stones," in International Class 14.<sup>2</sup> As the record reveals, the application resulting in issuance of the cited

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<sup>1</sup> Applicant's prior registration issued January 22, 1974, and covered "jewelry—namely rings, bracelets, pendants, earrings and broaches," in International Class 14 and "awards in the form of engraved plaques, and trophies in the form of engraved cups and engraved statuettes," in International Class 20.

<sup>2</sup> Registration No. 2274996 issued August 31, 1999 to H.K. Schaeffer & Co., a corporation of Florida.

registration was filed more than three years after applicant's prior registration expired and the cited registration issued more than two years prior to the filing of applicant's current application.

When the refusal of registration was made final, applicant appealed. Applicant and the examining attorney have filed briefs, but applicant did not request an oral hearing. We affirm the refusal of registration.

Applicant and the examining attorney agree that the *Du Pont* factors govern our analysis of likelihood of confusion in this case. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). For a recent restatement of these factors, see In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods or services. 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 services] and differences in the marks"). Further, when, as in this case, the goods in the application and the

cited registration are virtually identical, it has been held that the marks need not be as close as they might otherwise have to be to support a finding of likelihood of confusion. Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Applicant argues that it is particularly significant that it uses a stylized font for the term GINO'S in its GINO'S JEWELERS mark, while the registered mark is in "block form." However, the examining attorney is entirely correct in observing that when a mark is registered in typed form, as is the GINO M mark in the cited registration, the registration of the typed mark is not limited to any particular font and we must consider all reasonable forms of display in which the mark may be presented. Phillips Petroleum Co. v. C. J. Webb, Inc., 442 F.2d 1376, 170 USPQ 35 (CCPA 1971). We find that the font used in applicant's stylized presentation of the term GINO'S would be a reasonable form of display for the registered mark GINO M. Accordingly, in our analysis of likelihood of confusion, we consider that the marks may look very similar. We are not persuaded otherwise by applicant's argument (Reply Brief, p. 2), that the stylized form of its mark "is a unique design which is subject to

patent protection" and that the registrant would not be able to present its GINO M mark in the same or similar form as the term GINO'S in GINO'S JEWELERS.

As to the sound of the marks, to the extent that each of the marks would be fully articulated, they would sound different. However, in practice, the respective marks may not be fully articulated. Applicant has disclaimed rights in the term JEWELERS, which is, of course, a generic term for a purveyor of jewelry. It is not unlikely that many customers of applicant would simply refer to applicant and its jewelry store as GINO'S, without bothering to utilize the generic term JEWELERS. Likewise, while the mark in the cited registration is GINO M, customers of registrant may be inclined to simply refer to registrant as GINO.

While we believe that the marks, when in actual use, may be shortened by customers and have a resulting similarity in sound, we do not rely on this to find the marks similar for likelihood of confusion purposes. Rather, we rely on the presumptive similarity in forms of display and the virtually identical connotations of the marks. In re Sarkli, Ltd., 721 F.2d 353, 220 USPQ 111, 113 (Fed. Cir. 1983) ("the [USPTO] may reject an application ex parte solely because of similarity in meaning of the mark

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sought to be registered with a previously registered mark").

Applicant's mark obviously will have the connotation of a jewelry store owned or run by an individual named "Gino." While the application seeks registration of GINO'S JEWELERS as a trademark for goods, rather than as a service mark for a jewelry store, the record reveals (specifically, a specimen submitted by applicant and its reply brief) that applicant does, in fact, run an establishment identified by the GINO'S JEWELERS name, and prospective purchasers of applicant's products will consider them to be products of a jeweler named "Gino." Likewise, the mark in the cited registration has the connotation of the name of a jeweler and the jewelry items in the cited registration will be perceived as emanating from a jeweler named GINO M. Because applicant does not utilize a last name, or an initial from a last name, in its mark, there would be no way for customers familiar with the registered mark, when they encounter applicant's mark for identical products, to know that GINO'S JEWELERS denotes a different "Gino" than that denoted by the mark GINO M.

Applicant argues, "the Examiner should have considered that there has been a long period of contemporaneous use (over 60 years) without any actual confusion." Brief, p.

4. The argument overlooks the fact that the cited registration issued based on an intent-to-use application and the cited mark was not even in use when the application for its registration was filed on December 23, 1997. Later, when an allegation of use was filed, the eventual registrant asserted September 11, 1998 as the date of first use of the GINO M mark, and as the date of first use of that mark in commerce. Thus, the marks have only been in contemporaneous use for a fraction of the 60 years claimed by applicant. Moreover, because applicant is an Ohio corporation and, according to its specimen<sup>3</sup> and brief, is based in Ohio, while the registrant is a corporation of Florida and lists a Florida address, it is not clear that the applicant's and registrant's respective businesses have been conducted in such a way as to bring them into the same territories or channels of trade. In short, the asserted absence of any instances of actual confusion is not particularly probative that there would be no likelihood of confusion if applicant and registrant actually were doing business in the same territories.<sup>4</sup>

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<sup>3</sup> One of the specimens is a postcard announcing 2001 holiday hours for applicant's "new location" and bears a return address of Cleveland, Ohio.

<sup>4</sup> In addition, in this ex parte case, we have had no opportunity to hear from the registrant as to its knowledge of any instances of actual confusion.

Finally, we decline applicant's implicit invitation (Reply Brief, p. 3), to publish its mark for opposition so as to "give the registrant an opportunity to file an opposition, if there is any question of confusion." Such an approach to examination and review of pending applications has been rejected. In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1535 (Fed. Cir. 1997):

Dixie argues alternatively that the PTO should pass the mark to publication and allow the registrant to oppose the applicant's mark, if it chooses. But it is the duty of the PTO and this court to determine whether there is a likelihood of confusion between two marks. In re Apparel, Inc., 366 F.2d 1022, 1023, 151 USPQ 353, 354 (CCPA 1966). It is also our duty "to afford rights to registrants without constantly subjecting them to the financial and other burdens of opposition proceedings." Id.; see also In re The Clorox Co., 578 F.2d 305, 308, 198 USPQ 337, 341 (CCPA 1978); McCarthy, *supra*, Section 23.24[1] [d] (where PTO rejects an application under section 1052(d), "it is no answer for the applicant to ask that the application be passed to publication to see whether the owner of the cited mark will oppose the registration"). Otherwise protecting their rights under the Lanham Act would be an onerous burden for registrants.

Decision: The refusal of registration under Section 2(d) of the Trademark Act is affirmed.