

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Mailed: August 17, 2004
csl

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Glaze, Inc.

Serial No. 76440933

Myron Amer of Myron Amer, P.C. for Glaze, Inc.

Gene V.J. Maciol II, Trademark Examining Attorney, Law
Office 103 (Michael Hamilton, Managing Attorney).

Before Simms, Walters and Bottorff, Administrative
Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Glaze, Inc. ("applicant"), a New Jersey corporation,
has appealed from the final refusal of the Trademark
Examining Attorney to register the mark VALENCIA for
wristwatches.¹ The Examining Attorney has refused
registration under Section 2(d) of the Act, 15 USC
§1052(d), on the basis of two registrations held by
different entities: Registration No. 1,308,894, issued

¹ Serial No. 76440933, filed August 8, 2002, based upon
allegations of use since July 18, 2002.

Serial No. 76440933

December 11, 1984, Section 8 affidavit accepted, for the mark VALENCIA for "pearl necklaces and other jewelry," issued to The Napier Co.; and Registration No. 2,456,359, issued May 29, 2001, to Midwest Diamond Distributors Inc., for the mark VALENZIA COLLECTION for "diamond and gold jewelry, namely, tennis bracelets, earrings, necklaces ring, charm slides and pendants."²

Applicant and the Examining Attorney have submitted briefs but no oral hearing was requested.

Briefly, the Examining Attorney argues that applicant's mark and the mark in the '894 registration are identical, while applicant's mark and the mark in the '359 registration are similar in sound, appearance and commercial impression because the word "VALENZIA" is the dominant portion of the VALENZIA COLLECTION mark, inasmuch as the word "COLLECTION" is generic or descriptive and has been disclaimed. The Examining Attorney, pointing to evidence of record from the Nexis database, the Internet, magazine advertisements and third-party registrations, argues that applicant's wristwatches and the registrants' pearl necklaces and other jewelry as well as diamond and gold jewelry such as tennis bracelets, earrings and

² While it is not clear, it appears that the term "necklaces ring" in this registration should read "necklaces, rings."

pendants are all closely related goods which may be sold side-by-side in jewelry stores.

Applicant, on the other hand, maintains that the mark VALENCIA is "in common use in the trade for various categories of merchandise." Brief, p. 2. In this regard, applicant points to a number of registrations which the Examining Attorney had previously cited against applicant, for such goods as clothing, cigars, hollowware and flatware made of precious metal, and candy.³ Applicant also argues that the fact that different entities own the two cited registrations demonstrates that the buying public will not perceive that applicant's wristwatches originate from the source as these jewelry products. Applicant's attorney does admit, however, Response, p. 2, filed September 29, 2003, that there is evidence which shows that wristwatches and jewelry may be sold by the same retailer establishments. However, applicant maintains that the evidence of record showing that the same source may produce both wristwatches and jewelry is limited.

³ The Examining Attorney originally refused registration on the basis of these other registrations because, as the Examining Attorney later explained in his brief, applicant's original description of goods broadly stated "wristwatches and other gift items." When applicant subsequently amended its identification of goods to simply "wristwatches," the Examining Attorney withdrew the refusal on the basis of these registrations.

Our determination of likelihood of confusion under Section 2(d) of the Act is based on 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 Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Two key considerations are the marks and the goods or services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The means of distribution and sale, although certainly relevant, are areas of peripheral inquiry. 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.").

Upon careful consideration of this record and the arguments of the attorneys, we believe that the use and registration of applicant's mark VALENCIA for wristwatches is likely to cause confusion with both registered marks VALENCIA and VALENZIA COLLECTION for the respective jewelry items.

First, with respect to the marks, one of the registered marks is identical to applicant's mark. The other registered mark--VALENZIA COLLECTION--is

Serial No. 76440933

substantially similar in sound, appearance and commercial impression, especially when one gives less weight to the descriptive and disclaimed word "COLLECTION" in that registered mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("On the other hand, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, 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 consideration of the marks in their entireties.")

With respect to the goods in the application and the two cited registrations, as the Examining Attorney has argued, it is not necessary that the goods of the parties be similar or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion (although, in this case, there is evidence that the goods do travel in the same channels of trade and are sold in some of the same retail stores). It is sufficient that the respective goods are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to

Serial No. 76440933

the mistaken belief that they originate from the same producer. *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). Moreover, the greater the degree of similarity between the applicant's mark and the cited registered marks, the lesser the degree of similarity between the applicant's goods and the registrant's (or registrants') goods that is required to support a finding of likelihood of confusion. *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001).

Here, Nexis and other evidence show that the same company has made both watches and various jewelry items. Those companies include Omega, Clio Blue, Piaget and Mont Blanc. Other evidence shows that jewelry stores sell both watches and jewelry, that various facilities repair both wristwatches and jewelry, that wristwatches and jewelry are offered for sale at the same Web sites on the Internet, and that magazine advertisements of retailers promote both wristwatches and jewelry, often on the same page. There is also evidence that there is a watch and jewelry trade show. Finally, numerous third-party registrations show that various entities make or sell wristwatches and various items of jewelry under the same marks. Third-party registrations which individually cover a number of different items and which are based on use in commerce

Serial No. 76440933

serve to suggest that the listed goods are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). This evidence adequately demonstrates that applicant's VALENCIA wristwatches and registrant's VALENCIA pearl necklaces and other jewelry are so commercially related that the average purchaser, aware of the registered mark for pearl necklaces and other jewelry who then encounters applicant's VALENCIA wristwatches is likely to believe that these goods come from the same source or are sponsored or licensed by the same entity. Likewise, we find that applicant's mark for wristwatches so resembles the registered mark VALENZIA COLLECTION for various items of diamond and gold jewelry that confusion is likely with respect to this registered mark as well. If we had any doubt about these conclusions, in accordance with precedent that doubt must be resolved in favor of the registrants. See, e.g., *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988)

Decision: The refusal of registration on the basis of both of the cited registrations is affirmed.