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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re ASI Imports, Inc.

Serial No. 76592079

Michael I. Kroll, Esq. for ASI Imports, Inc.

Dominic Ferraiuolo, Trademark Examining Attorney, Law  
Office 102 (Thomas V. Shaw, Managing Attorney).

Before Quinn, Cataldo and Wellington, Administrative  
Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

ASI Imports, Inc. filed an application to register the  
mark CUSTOM MEMORY CHARMS (CHARMS disclaimed) for "jewelry,  
namely, bracelets, necklaces, anklets, waist chains, belly  
chains, modular Italian style charm bracelets, charms,  
pendants and watches" in International Class 14.<sup>1</sup>

The trademark examining attorney refused registration  
on two grounds. Firstly, he refused registration under

<sup>1</sup> Application Serial No. 76592079, filed May 13, 2004, based on a  
bona fide intention to use the mark in commerce.

Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to applicant's goods, so resembles the previously registered mark MEMORY CHARMS (CHARMS disclaimed) for "metallic ornaments made of non-precious metal" in International Class 6<sup>2</sup> as to be likely to cause confusion. Secondly, the examining attorney refused registration based on applicant's failure to comply with the requirement under Section 6 of the Trademark Act to disclaim the word "CUSTOM" apart from the mark.

When the refusals to register were made final, applicant appealed. Applicant and the examining attorney filed briefs.

#### Disclaimer

The examining attorney has required a disclaimer of the term "CUSTOM" (in addition to the already-disclaimed term "CHARMS"), contending that it is merely descriptive of jewelry that is custom or made to order. In support of the disclaimer requirement, the examining attorney submitted a dictionary definition of "custom."

Applicant argues that the term "CUSTOM" in its mark is, at worst, suggestive and, thus, a disclaimer thereof is not warranted. Although applicant concedes that "custom" could mean "made to order," "this term can also mean

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<sup>2</sup> Registration No. 2842564, issued May 18, 2004.

'customary,' so as to suggest something that is 'traditional' within, for example, a particular culture." (Brief, p. 4). According to applicant, the term has more than one meaning in the context of applicant's goods and that, in any event, there is nothing in the record to suggest that applicant's goods are intended as "made to order."

The examining attorney may require applicant to disclaim an unregistrable component of a mark otherwise registrable. Section 6 of the Trademark Act. Merely descriptive terms are unregistrable under Section 2(e)(1) of the Trademark Act, and therefore are subject to disclaimer if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is grounds for refusal of registration. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); and *In re Box Solutions Corp.*, 79 USPQ2d 1953 (TTAB 2006).

A term is merely descriptive if it immediately describes the ingredients, qualities or characteristics of the goods or if it conveys information regarding a function, purpose, or use of the goods. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978). We look at the mark in relation to the goods, and not in the abstract, when we consider whether the mark is

descriptive. In re MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1783 (Fed. Cir. 2003). It is well settled that to be "merely descriptive," a term need only describe a single significant quality or property of the goods. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

The term "custom" is defined, in relevant part, as "made to order." The American Heritage Dictionary of the English Language (4<sup>th</sup> ed. 2000). Applicant's goods are jewelry, and the term "custom," as applied to these goods, immediately describes, without conjecture or speculation, a significant quality or characteristic about them, namely that the jewelry is made to order. That the term "custom" may have different meanings (e.g., a tradition within a particular culture), as argued by applicant, is of little moment given that consumers are unlikely to give this meaning to the term as it is used in connection with jewelry.

The examining attorney's requirement for a disclaimer of the merely descriptive word "custom" is affirmed.

#### **Likelihood of Confusion**

In refusing registration under Section 2(d), the examining attorney maintains that the marks CUSTOM MEMORY CHARMS and MEMORY CHARMS are similar, and that applicant's

jewelry items are related to applicant's metallic ornaments made of non-precious metal. In support of the refusal, the examining attorney introduced excerpts of third-party websites showing that the same on-line retailers sell both jewelry and ornaments.

Applicant argues that the presence of the word "CUSTOM" in its mark serves to sufficiently distinguish the mark from registrant's mark, and that the involved marks are, in any event, relatively weak. Further, applicant contends, the specific nature of registrant's goods is unclear. In addition to the different classifications of the goods, applicant asserts: "The goods of the applied [sic] registration might - or might not be? - Christmas tree ornaments or automobile ornaments, though such ornaments are made of 'non-precious' metals, which would tend to distinguish them from jewelry goods, which are often purchased precisely because they are, or are made from, precious metals, such as gold or silver." (Brief, p. 7). Applicant also points to the purported price difference between applicant's and registrant's goods; applicant posits that jewelry can be expensive and requires a careful purchasing decision whereas non-precious metal goods are likely to be less expensive and purchased with less care.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also: *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also: *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We first turn to compare applicant's mark CUSTOM MEMORY CHARMS with registrant's mark MEMORY CHARMS. In determining the similarity or dissimilarity of the marks, we must compare the marks in their entirety as to appearance, sound, connotation and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). Nevertheless, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the

mark. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ["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. Indeed, this type of analysis appears to be unavoidable."] For example, "that 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..." Id. at 751.

When considering applicant's mark, the generic word "CHARMS" has been disclaimed, and we have determined, as discussed above, that the merely descriptive term "CUSTOM" must be disclaimed as well. In registrant's mark, the term "CHARMS" has been disclaimed. The disclaimed terms in the respective marks CUSTOM MEMORY CHARMS and MEMORY CHARMS are subordinate to the remaining feature in each of the marks, namely "MEMORY." This dominant, distinctive feature of each mark, the term "MEMORY," is identical. This term is the one term in each of the marks that is most likely to be remembered by consumers.

In terms of appearance and sound, the marks look and sound similar. The only difference between the marks is the addition of the merely descriptive term "CUSTOM" in

applicant's mark. In other words, applicant has appropriated the entirety of registrant's mark and merely added the descriptive term "CUSTOM" to it. See *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ 1944 (Fed. Cir. 2004); and *In re The U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985). The addition of the descriptive term "CUSTOM" simply is insufficient to distinguish the marks.

Although the addition of the term "CUSTOM" gives a more specific meaning to the "MEMORY CHARMS" portion of applicant's mark, this minor difference is insufficient to distinguish the marks in any meaningful manner. Even if the marks are viewed as suggestive, they convey similar suggestions.<sup>3</sup> Consumers would be likely to believe that the mark CUSTOM MEMORY CHARMS identifies a custom or made-to-order product extension of the MEMORY CHARMS line.

In sum, the marks CUSTOM MEMORY CHARMS and MEMORY CHARMS are similar in sound, appearance, meaning and overall commercial impression that, if similar goods were marketed under such marks, confusion is likely to occur among consumers. The similarity of the marks weighs in favor of a finding of likelihood of confusion.

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<sup>3</sup> Although applicant contends that the marks are weak, there is no evidence (e.g., third-party uses or registrations of the same or similar marks) to support this contention.

We next turn to a consideration of the goods. It is not necessary that the respective goods be competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. 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 the mistaken belief that they originated from the same producer. In re Melville Corp., 18 USPQ2d 1386 (TTAB 1991).

Although the goods are specifically different, we find that they are sufficiently similar for purposes of the likelihood of confusion analysis. The term "ornament" means "something that lends grace or beauty." Webster's Third New International Dictionary (unabridged ed. 1993).<sup>4</sup> Thus, "ornament" is a relatively broad term that may include jewelry (as an item that lends grace or beauty), as well as items such as Christmas ornaments. In either case,

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<sup>4</sup> We take judicial notice of this dictionary definition. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

consumers are likely to be confused when such goods are sold under substantially similar marks. Further, as shown by the website excerpts submitted by the examining attorney, ornaments and jewelry may be sold by the same entities through the same trade channels. The same classes of purchasers would purchase these goods. These factors pertaining to the similarities between the goods weigh in favor of affirming the refusal.

The identifications of goods do not include any limitation as to price, so we must assume that the goods may include inexpensive jewelry and ornaments that would be bought by ordinary consumers. However, even assuming arguendo that purchases of applicant's goods would involve a careful decision, this does not mean that the purchasers are immune from confusion as to the origin of the respective goods and services, especially when, as we view the present case, the substantial similarity of the marks and the similarity between the goods clearly outweigh any sophisticated purchasing decision. See *HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd*, *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) [similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods]. See also *In re*

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Research Trading Corp., 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), citing Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd., 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) ["Human memories even of discriminating purchasers...are not infallible."].

Applicant's argument based on the different classification of the goods is ill founded. The classification has no bearing on the likelihood of confusion determination. *Jean Patou Inc. v. Theon Inc.*, 9 F.3d 971, 29 USPQ2d 1771 (Fed. Cir. 1993); and *National Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212, 1216 n.5 (TTAB 1990).

We conclude that consumers familiar with registrant's metallic ornaments made of non-precious metal sold under the mark MEMORY CHARMS would be likely to believe, upon encountering applicant's mark CUSTOM MEMORY CHARMS for jewelry, that the goods originate from or are associated with or sponsored by the same source.

Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. In *re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

**Decision:** The refusals to register are affirmed.