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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Tsavo Gem Imports, Inc.

Serial No. 76641945

Mark Levy of Mark Levy & Associates, PLLC for Tsavo Gem Imports, Inc.

Renee McCray, Trademark Examining Attorney, Law Office 111 (Craig D. Taylor, Managing Attorney).

Before Holtzman, Zervas and Bergsman, Administrative Trademark Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Applicant, Tsavo Gem Imports, Inc., has filed an application to register the mark MANDARIN ICE (in standard character form) for goods which were ultimately identified as "synthetic garnets having an orange tinge" in Class 14.¹

The trademark examining attorney has refused registration under Section 2(d) of the Trademark Act on the ground that

¹ Serial No. 76641945, filed October 13, 2004, asserting dates of first use and first use in commerce of March 2005. The examining attorney's initial requirement for a disclaimer of the word ICE was subsequently withdrawn.

applicant's mark, when applied to applicant's goods, so resembles the mark MANDARIN (in typed form) for "jewelry, namely, pearls" in Class 14 as to be likely to cause confusion.²

When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs.

Our determination under Section 2(d) 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. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, however, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We turn first to the goods. Applicant contends that its "synthetic garnets having an orange tinge" are "completely different" from registrant's "jewelry, namely, pearls," arguing that the stones differ in their formation process, toughness, specific gravity and color. In applicant's view the difference in the two stones is "equivalent to the difference between \$.99 children's wristwatches and antique grandfather clocks." Applicant maintains that while the goods are "technically related," they are not likely to be confused. (Brief, pp. 8-10.)

² Registration No. 2686274, issued February 11, 2003.

It is true that pearls and synthetic garnets are different stones with different attributes. However, the question is not whether purchasers can differentiate the goods themselves but rather whether purchasers are likely to confuse the source of the goods. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). Thus, goods need not be similar or even competitive to support a finding of likelihood of confusion. It is sufficient if the respective goods are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give rise to the mistaken belief that they emanate from or are associated with the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

Registrant's pearl jewelry and applicant's synthetic garnets are inherently related items of finished jewelry with gemstones and loose gemstones. The examining attorney has made of record a number of use-based, third-party registrations showing that the same mark has been registered for finished jewelry, on the one hand, and loose gemstones such as garnets, on the other. For example, Registration No. 3023758 for the mark PUREBEADS lists necklaces, bracelets, rings and earrings, as well as semiprecious beads, pearls, and precious and semiprecious gemstones; Registration No. 3036223 for the mark LANTANA COLLECTION broadly

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lists "jewelry" as well as precious stones including pearls and garnets; Registration No. 3036236 for the mark LULET (and design) lists "jewelry," as well as "gems and stones, namely, pearls, ...garnets,...and the like"; Registration No. 2838465 for the mark LIANG DESIGNS lists "jewelry," as well as pearls and semi-precious gemstones; and Registration No. 2989287 for the mark BEADS AMORE lists "jewelry," such as pearls, necklaces and bracelets, as well as semi-precious gemstones and glass beads. Although the third-party registrations are not evidence of use of the marks in commerce, the registrations have probative value to the extent that they suggest that the respective goods are of a type which may emanate from the same source. See, e.g., *In re Albert Trostel & Sons Co.*, *supra*; and *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467 (TTAB 1988).

In addition, the evidence shows that pearls and garnets are complementary stones that are often used together in the same pieces of jewelry. See, for example, metmuseum.org selling earrings decorated with garnets and river pearls, and also earrings with freshwater pearls and synthetic garnets; tyler-adam.com selling earrings designed with pearls and garnets; mysimon.com selling a pearl and garnet "jewelry set"; cgi.ebay.com auctioning a "bangle bracelet with real pearls and garnets"; and a Nexis excerpt from WWD (February 25, 2002) describing a jewelry designer's "garnet and freshwater-pearl earrings."

Applicant argues that the goods are sold in different channels of trade to different purchasers. In particular, applicant argues that its own goods "travel through channels of commerce for people interested in synthetic garnet stones" who are either attracted to the characteristics of that type of stone or who "are looking for a less expensive alternative to registrant's pearls"; whereas registrant's goods, according to applicant, "travel through channels of commerce for more affluent people interested in pearls." (Brief, p. 10.) Applicant maintains that purchasers of both goods "are sophisticated and conscientious in their purchase and use of the goods." (Brief, p. 11.)

In cases where, as here, an application and registration do not contain limitations describing a particular channel of trade or class of customer, the goods are presumed to travel in all normal channels of trade to all usual purchasers. See *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1492, 1 USPQ2d 1813, 1814-15 (Fed. Cir. 1987). It can be presumed that these closely related goods are marketed through at least some of the same channels of trade, and that the purchasers for both types of products would include ordinary purchasers. See *Venture Out Properties LLC v. Wynn Resorts Holdings LLC*, 81 USPQ2d 1887 (TTAB 2007). The examining attorney has submitted printouts of several third-party registrations covering retail stores or other retail outlets that sell both jewelry and gemstones. See, for example,

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Registration No. 3067964 for the mark JEWELRY CENTRAL for "mail order catalog services and telephone order services featuring jewelry, jewelry supplies, diamonds, gemstones, pearls, [etc.]"; and Registration No. 2979955 for the mark LEGEND BLUE for on-line retail store services in the field of "jewelry" and gemstones and pearls. At least one website, idasgems.com, sells both finished jewelry as well as loose gemstones, including garnets and pearls. However, it is not particularly significant whether or not applicant's and registrant's goods may typically be purchased through the same outlets since the two items may not even be purchased at the same time. Consumers who had previously purchased registrant's pearl jewelry, upon encountering applicant's synthetic garnets, if offered under a similar mark, regardless of where or when they found it, are likely to believe because the goods are closely related, that they come from or are in some way associated with the same company.

Applicant's argument that pearls are expensive and are purchased only by "affluent" customers is unpersuasive. The evidence shows that pearls may be, but are not necessarily expensive items of jewelry, and that pearls and garnets may both fall within same inexpensive to moderate price range. For example, target.com offers pearl bracelets for \$25.49 and garnet earrings for \$33.99; mysimon.com offers pearl necklaces "from \$35"; silver-insanity.com offers "genuine" pearl earrings for \$16.99 and garnet

earrings for \$16.91; cherishedtimedesigns.com sells synthetic pearl earrings for \$25.00 and simulated garnet earrings for \$25.00, and it also sells synthetic pearl bracelets and synthetic garnet bracelets, both for \$40.00.³ In addition, the previously mentioned Nexis excerpt from WWD refers to "garnet and freshwater-pearl earrings" that sell for \$26. Ordinary purchasers of these relatively low cost items of jewelry and gemstones are not necessarily sophisticated, and they may purchase these goods casually and on impulse, thus increasing the risk of confusion. See *Kimberly-Clark Corp. v. H. Douglas Enterprises, Ltd.*, 774 F.2d 1144, 227 USPQ 541 (Fed. Cir. 1985); and *In re Thomas*, 79 USPQ2d 1021 (TTAB 2006).

We turn next to the marks. Applicant argues that MANDARIN and MANDARIN ICE are not similar in sound or appearance because of the different number of words and syllables in the two marks; and that the addition of the word ICE to MANDARIN distinguishes the meaning and commercial impression of the two marks. Applicant points to the definitions of "ice" in *Merriam Webster's OnLine Dictionary* (m-w.com) which include the following: "1. a) Frozen water,... 2. a

³ It is clear from the evidence that pearls, like garnets and other gemstones, can be "natural" or "synthetic" and that the stones may vary widely in price and quality. See, generally, gemsociety.org and diamondgiveaway.com; and also, e.g., Registration No. 3083658 for the mark REAL PEACE (and design) for necklaces made of "synthetic, and/or genuine pearls...and/or simulated, synthetic and/or genuine gemstones...". Registrant's broadly worded identification is presumed to encompass pearls of all types and levels of quality.

substance resembling ice... 3. a state of coldness... 4. a) a frozen dessert containing a flavoring... 5. *slang*: diamonds; *broadly*: jewelry." (Italics in original.) Applicant also relies on definitions of "mandarin" in its noun form meaning, "1. a) A public official in the Chinese Empire...; 2. a) a form of spoken Chinese used by the court and the official classes of the Empire...; 3. [Swedish *mandarin* (*apelsin*) mandarin (orange),... perhaps from the color of a mandarin's robes] a) a small spiny orange tree...of southeastern Asia with yellow to reddish-orange loose-rinded fruits;... b) the fruit of a mandarin"; and as an adjective, meaning, "... 2. marked by polished ornate complexity of language <*mandarin* prose>." (*Merriam Webster's*, *supra*; italics in original.)

Based on these definitions, applicant argues that MANDARIN standing alone suggests a public official, a form of spoken Chinese, a tree, or ornate complexity, but that MANDARIN followed by ICE functions as an adjective modifying ICE and "could mean, for example, a frozen dessert derived from a Mandarin tree." (Brief, p. 8.)

When applicant's mark MANDARIN ICE and registrant's mark MANDARIN are compared in their entirety, we find that the marks are similar in sound, appearance, meaning and commercial impression. The word MANDARIN is registrant's entire mark, and that word is aurally and visually a significant component of

applicant's mark. There is only one short, single syllable word difference in the two marks and that difference is not sufficient to distinguish one mark from the other either in sound or in appearance. Moreover, the word MANDARIN is the first word purchasers will see or hear when encountering either mark and it is therefore more likely to have a greater impact on purchasers and be remembered by them when they encounter the two marks at different times. See *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895 (TTAB 1988).

This is particularly likely considering that both marks convey similar suggestive meanings, and that the additional word ICE in applicant's mark does not significantly change the meaning or commercial impression created by MANDARIN alone.⁴ We disagree with applicant that MANDARIN in registrant's mark would suggest a form of spoken Chinese and that MANDARIN ICE would suggest a frozen dessert. The significance of a mark must be determined not in the abstract but rather in relation to the goods to which it is

⁴ Applicant argues that "many registrations include ICE as part of the mark, even though the companion words in the mark are separately registered" (Brief, p. 5), and applicant has listed three "sets" of such third-party registrations. The examining attorney did not object to the list as being unsupported by copies of the registrations. Accordingly, this evidence has been treated as if properly of record and considered for whatever probative value it may have. That said, however, this evidence is of no probative value. Applicant has only listed the marks and the registration numbers without specifying the identification of goods and/or services therein or providing any other information contained in the registrations. In any event, the fact that ICE has been registered as a component of other marks has no bearing on the question of whether the mark involved in this case, MANDARIN ICE, is registrable.

applied. See Presto Products Inc., supra at 1897. Applicant's goods are synthetic garnets and applicant has identified these stones as "having an orange tinge." Further, applicant states that the mark was selected in part to suggest the orange tinge of the stone. (Response dated January 23, 2006, p. 3.) Thus, in the context of applicant's goods, the word MANDARIN in MANDARIN ICE is likely to suggest the color of the stones rather than a food product.

Registrant's mark, MANDARIN, is likewise suggestive of color. It can be seen from the evidence submitted by the examining attorney that pearls can come in a variety of colors and shades. The entry from the American Heritage Dictionary of the English Language (Fourth Edition)⁵ defines "pearl" as "1. A smooth, lustrous, *variously colored* deposit...". (Italics added.) The website cgi.ebay.com sells black as well as lavender colored pearls; target.com sells white pearls; mysimon.com sells "natural golden," pearls as well as blue, pink and "black rose" colored pearls; and silver-insanity.com sells "creamy white" pearl earrings as well as peach or pink colored pearl earrings.

Further, the word ICE in applicant's mark is highly suggestive of gemstones. One meaning of "ice" as shown in the dictionary

⁵ From dictionary.com.

entries relied on by applicant is as a slang term for "jewelry."⁶ The term is at least suggestive of the ice-like or glass-like quality of gemstones. Applicant states that it chose the mark MANDARIN ICE for synthetic garnets, not only for its orange tinge as we noted earlier, but also to suggest "the ice-like..., translucent quality of its goods." (Response dated July 10, 2006, pp. 5, 8.) We also note that "ice" or "glass" is used to refer to transparent gemstones. For example, thecraftkit.com website sells "White Ice Glass Gems mix", "Blue Ice Glass Gems mix" and a variety of other different colored "glass" gems. In the context of applicant's goods, the word ICE does not impart a new meaning to MANDARIN. Instead, the term MANDARIN combined with ICE retains its suggestive meaning as a color of the gemstones, and does not change the meaning of the mark as a whole into "a frozen dessert derived from a Mandarin tree" as applicant claims. The mark MANDARIN ICE is likely to suggest a line of MANDARIN gemstones or jewelry from the same source as MANDARIN pearls.

Applicant argues that the shared term MANDARIN is weak and entitled only to a narrow scope of protection given, according to applicant "its widespread use by third parties within the field." (Response dated July 10, 2006, p. 11.) In support of this contention, applicant submitted a website directory listing for "Mandarin Jewelry" on kellysearch.com; a listing for "Mandarin

⁶ *Merriam-Webster OnLine Dictionary, supra.*

Jewelry Wholesalers" on goliath.ecnext.com; and an auction on gds.org for a piece of jewelry from "Mandarin Jewelry Box." In addition, applicant submitted a page from answers.com advertising the sale "Mandarin Orange Topaz Jewelry" and from cgi.ebay.com advertising the sale of a "Mandarin Red Nugget Freshwater Pearl" as well as several listings on ebay.com for jewelry with "Mandarin Orange" gemstones.

At best, this evidence shows only a few instances of use of the term "MANDARIN" by other companies in the jewelry field. The evidence fails to show sufficiently widespread use of MANDARIN to demonstrate that registrant's mark is weak in relation to the identified goods. Furthermore, in most of the listings, such as those for "Mandarin Orange Topaz Jewelry" and "Mandarin Red Nugget Freshwater Pearl," "Mandarin" is used to suggest the color of gemstones including pearls. These uses serve to reinforce the finding that the word MANDARIN in both applicant's and registrant's marks suggests the color of their gemstones and that the meaning and overall commercial impression of the two marks, as a whole, are essentially the same.

We recognize that MANDARIN, as a suggestive mark, is not entitled to the broadest scope of protection. However, the mere fact that the shared term is suggestive, or even "weak," does not automatically mean that confusion is not likely. Even weak marks are entitled to protection against the registration of a similar

mark for closely related goods. See King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974) (likelihood of confusion is to be avoided as much between weak marks as between strong marks).

We find that consumers familiar with registrant's pearl jewelry sold under its MANDARIN mark would be likely to believe, upon encountering applicant's mark MANDARIN ICE for closely related goods, that the goods originated with or are associated with the same entity.

Applicant's argument that doubt as to likelihood of confusion is resolved in its favor is incorrect. To the extent that there is any doubt on the issue of likelihood of confusion, it is settled that such doubt must be resolved in favor of the prior registrant. In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993).

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