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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Samantha Thavasa Japan Limited

Serial No. 78309325

David A. Weinstein of David A. Weinstein for Samantha Thavasa Japan Limited.

Nora Buchanan Will, Trademark Examining Attorney, Law Office 116 (M. L. Hershkowitz, Managing Attorney).

Before Hohein, Holtzman and Walsh, Administrative Trademark Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Applicant, Samantha Thavasa Japan Limited, has filed an application to register the mark shown below



Samantha Tiara

Samantha Thavasa

for the following goods, as amended:¹

"Precious metal; nut-crackers of precious metal; pepper pots of precious metal; sugar bowls of precious metal; salt shakers of precious metal; egg stands of precious metal; napkin holders of precious metal; napkin rings of precious metal; bowls of precious metal--[sic] toothpick holders of precious metal; sewing boxes of precious metal; candle extinguishers and candlesticks of precious metal; jewel cases of precious metal; vases and flower bowls of precious metal; trophies of precious metal; commemorative shields of precious metal; trinkets, namely, necklaces, bracelets, pierced earrings, earrings, rings; purses and wallets of precious metal; jewelry and their [sic] imitation; shoe clips of precious metal; clocks and watches; silver; pearls; precious metal imitation coated gold and coated silver" in International Class 14.

"Knitting needles for knitting machines; needles; eyelets for clothes; ribbons; tassels; braids; knitting pins; sewing boxers [sic]; dressmakers' tracing spatulas; sewing thimbles; pin and needle cushions; non-precious metal needle cases; non-precious metal emblems for wear; non-precious metal badges for wear; buckles for clothing; brooches for clothing; non-precious metal bonnet pins; buttons for clothing; artificial flowers; false beards; false moustaches; non-electric hair curlers; non-precious metal shoe clips; shoe eyelets; shoe laces; metal shoe fasteners" in International Class 26.

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

¹ Serial No. 78309325, filed October 3, 2003, based on an allegation of a bona fide intention to use the mark in commerce. The application includes a claim of ownership of Registration No. 2386456 for the mark SAMANTHA THAVASA (in standard character form) for various goods in Class 18; and a statement that "the mark does not identify a particular living individual." The examining attorney's initial requirement for a disclaimer of TIARA was withdrawn upon applicant's subsequent deletion of "crowns" from the identification of goods.

applicant's mark, when applied to applicant's goods, so resembles the registered marks shown below (all in standard character form) as to be likely to cause confusion. The first two registrations listed below are owned by the same entity.

Registration No. 862377:²

TIARA

For: "jewelry made of precious metals and costume jewelry- namely, finger rings, pendants, earrings, bracelets, necklaces, tie tacks, cuff links, and brooch pins" in International Class 14.

Registration No. 1577689:³

TIARA

For: "watches; jewelry made of precious metals; costume jewelry - namely, finger rings; pendants; earrings; bracelets; necklaces; tie tacks; cuff links and brooch pins" in International Class 14.

Registration No. 842514:⁴

TIARA

For: "hair pieces" in International Class 26.

When the refusal was made final, applicant appealed. Briefs have been filed. An oral hearing was not requested.

As a preliminary matter, we note that the examining attorney, in her first Office action, advised applicant that the refusal to

² Issued on December 24, 1968 to Tiara Corporation; renewed.

³ Issued on January 16, 1990 to Tiara Corporation; renewed.

⁴ Issued on January 16, 1968 to Kanegafuchi Kagaku Kogyo Kabushiki Kaisha; renewed.

register would be withdrawn if applicant amended the application to delete "false beards" and "false moustaches" from Class 26, and the following goods from Class 14: "jewel cases of precious metal" and "trinkets, namely, necklaces, bracelets, pierced earrings, earrings, rings; purses and wallets of precious metal; jewelry and their [sic] imitation; shoe clips of precious metal; clocks and watches; silver; pearls; precious metal imitation coated gold and coated silver." According to the examining attorney, these are the only goods which create a conflict with the goods listed in the cited registrations. Applicant declined to amend the application as suggested, contending that there is no likelihood of confusion in this case as to any of the goods identified in the application. The examining attorney continued to maintain, in subsequent Office actions, that the refusal could be overcome by deletion of the specified goods, and ultimately characterized the issue on appeal as whether the specified goods are likely to cause confusion with the goods in the three registrations.

It is unclear why the examining attorney restricted the refusal in this manner.⁵ Ordinarily, a refusal to register under Section 2(d) is made on the basis of the entirety of the class of goods and not merely one or more individual items of goods in the

⁵ As a result of this restriction, the Board will not consider the question of likelihood of confusion as it pertains to "brooches for clothing" which are also listed in applicant's Class 26 goods. However, it is not understood why these goods were not included in the group of goods, i.e., jewelry, for which registration has been refused.

class. That said, as the examining attorney has expressly confined the refusal only to certain goods in each class, the appeal will be decided only on the basis of those specified goods.⁶

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, including the similarities of the marks and the similarities of the goods. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

The specified goods in Class 14 of the application are, in significant part, either identical or legally identical to the goods identified in Registration Nos. 862377 and 1577689. Both the application and the two registrations include necklaces, bracelets, earrings and rings. Watches also are listed in both the application and Registration No. 1577689. In addition, applicant's broadly described "jewelry and their [sic] imitation" would fully encompass registrant's "jewelry made of precious metals" as well as the specific items of jewelry listed in the two registrations such as "brooch pins" and "pendants."

As to the goods in Class 26, the false beards and false moustaches listed in the application are closely related to the

⁶ We point out, however, that although the examining attorney's refusal pertains to only certain items of goods in the application, our decision will be determinative as to all of the identified goods.

hair pieces identified in Registration No. 842514 in the sense that they may be used for the same purpose, that is, they all may be worn as complementary parts of a costume or facial disguise.

Because there are no restrictions as to the channels of trade or classes of purchasers in either the application or the cited registrations, the respective identical and closely related goods must be deemed to be sold in the same channels of trade, and directed to the same purchasers. *Genesco Inc. v. Martz*, 66 USPQ2d 1260 (TTAB 2003).

We turn then to a consideration of the marks. Applicant contends that the examining attorney dissected its mark in concluding that the marks are similar instead of considering the overall combination of components that applicant seeks to register. In particular, applicant argues that the registered marks consist of a single word in typed form whereas applicant's mark consists of at least five separate elements including a design; that the shared word TIARA appears as the second part of a two-word portion of the mark; that in view of its position in the mark and as just one of a number of other components, its significance is completely different than the registered marks; that the marks are dissimilar in sound in that the focus in sound would be on the word SAMANTHA because that word appears twice in the mark and is the first word of each two-word group; that the marks are different in appearance in that as a multi-component mark, the word TIARA would not in the

normal course of trade be alone singled out as the means of identifying the source of the goods; and that the marks are different in meaning in that the only meaning associated with TIARA in registrants' marks is "crown" whereas TIARA in applicant's mark might also be viewed as the name of a person or the name of two or more persons having the same given name SAMANTHA.

We find that applicant's mark SAMANTHA TIARA SAMANTHA THAVASA ST and design and registrants' marks TIARA convey similar meanings and create similar commercial impressions. We recognize that there are a number of components other than the word TIARA in applicant's mark. However, the word TIARA is registrants' entire mark. There are no other portions in registrants' marks to distinguish them from the mark in the application.

While marks must be compared in their entireties, one feature of a mark may have more significance than another, and there is nothing improper in giving greater weight to the more significant feature. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); and *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1845 (Fed. Cir. 2000) ("the Board was justified in examining each component of the mark ... and the effect of that component on the issue of likelihood of confusion as between the respective marks in their entireties.").

One of the strongest impressions of applicant's composite mark is conveyed by the term SAMANTHA TIARA. That wording is displayed

in the center of the mark, actually as the focal point of the mark, in lettering that is much larger and bolder than the lettering of SAMANTHA THAVASA which appears, spatially separated from SAMANTHA TIARA, and in very small lettering below it. It is by far the most visually prominent wording in the mark, and is likely to make a greater impression on purchasers and to be remembered by them. The design element and the stylized letters ST, to the extent they are even recognizable as particular letters, are less important than this wording in creating an impression because it is the wording that would be used by purchasers to request the goods. See *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987). See also *In re Electrolyte Laboratories Inc.*, 929 F.2d 645, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) ("A design is viewed, not spoken, and a stylized letter design can not be treated simply as a word mark.").

The additional wording and design elements in applicant's mark do not significantly affect the meaning or the commercial impression created by TIARA alone. The word "tiara" means "crown," as applicant points out, and therefore suggests jewelry as well as an accessory for a costume or disguise. While it is possible that purchasers of applicant's goods may think of TIARA in the context of SAMANTHA TIARA as a surname, there is no evidence that TIARA is in fact a surname. It is far more likely that purchasers would think of the dictionary meaning of the word in relation to jewelry and costume accessories and therefore perceive the meaning of TIARA

in both applicant's and registrants' marks as being the same. The crown design in applicant's mark strengthens the perception of TIARA as an ordinary dictionary word and further detracts from any possible perception of SAMANTHA TIARA as a person's name when viewed in connection with applicant's goods.

We also note that while TIARA may be suggestive of the identified goods, there is no evidence that word is highly suggestive or weak in relation to those goods or entitled to anything less than a normal scope of protection.⁷ The examining attorney points out that there are no other registered marks containing the term TIARA in either the jewelry or costume field.

Purchasers who are familiar with applicant's composite mark that includes the word TIARA for jewelry or costume disguises, upon seeing TIARA, alone, used on the identical and closely related goods, would assume a common source for the goods. They may assume the mark TIARA identifies another line of applicant's goods or they may perceive the term as merely a shortened version of applicant's full mark. See *Big M. Inc. v. The United States Shoe Corp.*, 228 USPQ 614, 616 (TTAB 1985) ("we cannot ignore the propensity of consumers to often shorten trademarks...").

⁷ Applicant's argument, to the extent we can understand it, that the restriction of the refusal to only certain goods in the application somehow limits the scope of protection accorded the registered marks, is not well taken.

Furthermore, purchasers of costume disguises and jewelry, or at least the costume items of jewelry, are ordinary members of the general public who, especially considering the inexpensive nature of these goods, would not be expected to exercise a high degree of care and thus would be more prone to confusion.

In view of the foregoing, we find that a likelihood of confusion exists between applicant's mark SAMANTHA TIARA SAMANTHA THAVASA ST and design and registrants' marks TIARA for identical and closely related goods.

To the extent that there is any doubt on the issue of likelihood of confusion with respect to the cited registrations, it is settled that such doubt must be resolved in favor of the prior registrants. 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.