

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Jerome Hutchinson

Serial No. 78794740

Nicole M. Deforge of Van Cott, Bagley, Cornwall & McCarthy
for Jerome Hutchinson.

J. Brendan Reagan, Trademark Examining Attorney, Law Office
113 (Odette Bonnet, Managing Attorney).

Before Drost, Bergsman and Wellington, Administrative
Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Jerome Hutchinson filed an intent-to-use application
for the mark THE SIGNATURE OF YELLOWSTONE, in standard
character format, for goods and services ultimately
identified as follows:

Jewelry, in Class 14;

Beverage glassware, in Class 21;

Gift store and mail order catalog services in the
fields of jewelry and clothing and jewelry- and
clothing-related gifts and jewelry- and clothing-
related accessories, Class 35; and,

Design for others in the field of retail jewelry and
clothing, in Class 42.

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), on the ground that applicant's mark, as applied to the goods and services listed in Classes 14, 35 and 42, are likely to cause confusion with the registered mark YELLOWSTONE for costume jewelry, in Class 14.¹

Our determination of likelihood of confusion 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 issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks").

¹ Registration No. 1721087, issued September 29, 1992; Sections 8 and 15 affidavits accepted and acknowledged; renewed.

A. The similarity or dissimilarity and nature of the goods and services.

Applicant is seeking to register his mark for, *inter alia*, jewelry, in Class 14, gift store and mail order catalogue services in the field of jewelry, in Class 35, and the design of jewelry for others, in Class 42. The registered mark is for costume jewelry. Because there are no restrictions or limitations in applicant's description of goods and services, his jewelry, sales of jewelry, and design of jewelry may encompass costume jewelry. We find, therefore, that with respect to jewelry, the goods are identical, and with respect to the applicant's retail store, mail order catalog and design services, all involving jewelry, his services are closely related to jewelry.

B. The similarity or dissimilarity of established, likely-to-continue channels of trade and classes of consumers.

Because there are no restrictions as to trade channels and classes of consumers in either the application or the cited registration, we presume that the goods and services move in all normal trade channels for such goods and to all normal classes of purchasers for such goods and services. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). *See also In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994)

("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers"). Because we have found that the goods are identical and that applicant's services are closely related to the registrant's jewelry, we find that applicant's goods and services and the registrant's jewelry move in the same channels of trade and will be bought by the same classes of purchasers.

C. The strength of the registered mark.

Applicant argued that the term "Yellowstone" is primarily geographically descriptive "or, at best suggestive." Applicant's contention that "Yellowstone" is primarily geographically descriptive may not be considered because it comprises an attack on the validity of a registered mark which is not permitted in an *ex parte* appeal. *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n.5 (TTAB 1992); *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2014-2015 (TTAB 1988). Accordingly, we may only consider whether the registered mark is suggestive or arbitrary.

There is nothing in the record to indicate that the term "Yellowstone" has any recognized meaning in connection with jewelry. "Yellowstone" is defined as "a dark grayish yellow that is redder, stronger, and slightly lighter than California green or olive-sheen and very slightly greener

than honey."² There is no definition specifically related to jewelry.

On the other hand, Yellowstone National Park is "a park in NW Wyoming and adjacent parts of Montana and Idaho: geysers, hot springs, falls, canyon."³ Its name is often abbreviated to "Yellowstone."⁴ *Accord Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321 (1333 (TTAB 1992) ("companies are frequently called by shortened names, such as, Penney's for J.C. Penney's, Sears for Sears and Roebuck (even before it officially changed its name to Sears alone), Ward's for Montgomery Ward's, and Bloomies for Bloomingdale's"). Moreover, it is a well-known park.⁵

² Webster's Third New International Dictionary of the English Language (Unabridged), p. 2650 (1993). The Board may take judicial notice of dictionary evidence. *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).

³ The Random House Dictionary of the English Language (Unabridged), p. 2202 (2nd ed. 1987).

⁴ "Yellowstone National Park," Encyclopedia Britannica (2008); "Yellowstone National Park," Grolier Multimedia Encyclopedia (2008); The Oxford Dictionary of the World, p. 657 (1996); Chambers World Gazetteer p. 719 (1988); The Cambridge Gazetteer of the United States and Canada, p. 736 (1995). The Board may also take judicial notice of other standard reference works. *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1514 n.4 (TTAB 2001); *Sprague Electric Co. v. Electrical Utilities Co.* 209 USPQ 88, 95 n.3 (TTAB 1980).

⁵ "Yellowstone National Park," Encyclopedia Britannica (2008) ("the oldest, one of the largest, and probably the best-known national park in the United States"); The Oxford Dictionary of the World, p. 657 (1996) ("it is famous for its scenery, geysers and wildlife and was the first national park to be designated in the USA"). Moreover, because "Yellowstone" is listed in dictionaries and encyclopedias we presume that the park has achieved a high degree of renown. See *B.V.D. Licensing v. Body*

Although the term "Yellowstone" will call to mind Yellowstone National Park, there is no evidence that the registrant's goods originate in or around Yellowstone National Park or that consumers are likely to believe that registrant's costume jewelry originate in or around Yellowstone National Park.⁶ Based on the record, because

Action Design, 846 F.2d 727 6 USPQ2d 1719, 1720 (Fed. Cir. 1985) ("When a trademark attains dictionary recognition as part of the language, we take it to be reasonably famous").

⁶ In his brief, the applicant sought to submit evidence not previously made of record. In his brief, the Examining Attorney objected to the applicant's evidence as untimely. Trademark Rule 2.142(d), 37 CFR §2.142(d), provides, so far as pertinent, that "[t]he record in the application should be complete prior to the filing of the appeal." See *In re Norfolk Wallpaper, Inc.*, 216 USPQ 903, 904 (TTAB 1983); *In re Royal Viking Line A/S*, 216 USPQ 795, 797 n.3 (TTAB 1983). In view thereof, the Examining Attorney's objection to applicant's late-filed evidence is granted, and we have not given that evidence any consideration. For the same reason, we have not given any consideration to the evidence applicant sought to submit with his reply brief. Nevertheless, we note that even had we considered applicant's late-filed evidence, it would not have changed our decision in this appeal. For example, applicant submitted a hit list from a search conducted in Trademark Office database for "Yellowstone," but did not include copies of the registrations or otherwise provide goods and services data. Incomplete excerpts of registrations from Trademark Office records are not sufficient to make the registrations of record. *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994). Applicant also submitted copies of Trademark Office Actions from other applications refusing registration on the ground that "Yellowstone" is geographically descriptive. However, the Board decides each case on its own merits, and not based on prior decisions by Examining Attorneys. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1567, 1568 (Fed. Cir. 2000). Finally, applicant submitted excerpts from websites by two jewelers in the Yellowstone geographic territory that use Yellowstone as part of their name. However, because the cited registration has been registered for more than five years, it may not be canceled on the ground that it is primarily geographically descriptive. Accordingly, all applicant may argue is that YELLOWSTONE is suggestive; however, suggestive marks are entitled to protection.

there is no evidence that "Yellowstone" has any meaning when it is used in connection with jewelry or jewelry-related services, we must presume that the mark YELLOWSTONE is an arbitrary mark when used in connection with costume jewelry.

D. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont de Nemours & Co., supra*. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 9 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). In comparing the marks, we are mindful that where, as here, the goods are in part identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Real Estate One, Inc. v. Real Estate 100 Enterprises Corporation*, 212 USPQ 957, 959 (TTAB 1981);

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ECI Division of E-Systems, Inc. v. Environmental Communications Incorporated, 207 USPQ 443, 449 (TTAB 1980).

In addition, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

The marks are similar in appearance and sound because applicant's mark (THE SIGNATURE OF YELLOWSTONE) incorporates the entire registered mark (YELLOWSTONE). With respect to the connotation and commercial impression engendered by the marks, applicant's prefatory use of THE SIGNATURE OF fails to distinguish the marks because it

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serves to suggest that that applicant's mark may be a new or special line or variation of registrant's jewelry (e.g., applicant's signature piece of jewelry or applicant's signature line of jewelry). See *Johnson Publishing Co. v. International Development Ltd.*, 221 USPQ 155, 156 (TTAB 1982) ("likelihood of confusion has frequently been found where contested marks used on related products involve one mark which consists of a single word and another which is comprised of that same word followed by a second term"). On balance, we find that the similarities of the marks outweigh the differences.

E. Balancing the factors.

Having found that applicant's goods and services are in part identical and otherwise closely related to registrant's goods, that the goods and services of the partes move in the same channels of trade and are sold to the same classes of consumers, and that the marks are similar, we conclude that applicant's mark THE SIGNATURE OF YELLOWSTONE for the goods and services set forth in classes 14, 35, and 42, is likely to cause confusion with the mark YELLOWSTONE for jewelry.

Decision: The refusal to register applicant's mark in Classes 14, 35 and 42 is affirmed.

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The application will be forwarded for publication in
Class 21.