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Mailed: May 4, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Jewelry Supply Inc.

Serial No. 77475181

Lawrence G. Townsend of Owen Wickersham & Erickson PC for
Jewelry Supply Inc.

Laurie Mayes, Trademark Examining Attorney, Law Office 101
(Ronald R. Sussman, Managing Attorney).

Before Cataldo, Taylor and Wellington,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Jewelry Supply Inc. filed an application to register on the
Principal Register the mark JEWELRYSUPPLY.COM in standard
characters for the following services:

online retail store services featuring jewelry boxes,
jewelry findings, jewelry displays, jewelry repair
kits, tools for making jewelry, beads, magnifiers,
craft kits, crystals, and educational material,
specifically books and various media, including
instructional videos on the subject of jewelry (in
International Class 35).

The application was filed on May 15, 2008 based on an allegation

of January 1999 as a date of first use of the mark in commerce.¹ During prosecution applicant amended its application to seek registration of its mark under Section 2(f) of the Trademark Act.

The trademark examining attorney refused registration under Section 2(e)(1) of the Trademark Act on the ground that applicant's mark is merely descriptive of its services and that applicant's evidence is insufficient to show acquired distinctiveness of the mark under Section 2(f) of the Act.² When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs, and applicant filed a reply brief.

Applicant having filed the application seeking registration under Section 2(f) has conceded that the mark is merely descriptive under Section 2(e)(1). See *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988); and *The Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626 (Fed. Cir. 2009). Thus, the sole issue on appeal is whether applicant has carried its burden of establishing, by a preponderance of the evidence, a prima facie case that its merely descriptive mark

¹ Application Serial No. 77475181.

² The examining attorney also issued and subsequently withdrew a genericness refusal. In addition, the examining attorney issued several requirements with which applicant complied.

has acquired distinctiveness under Section 2(f). See *Yamaha, supra*; and *In re Rogers*, 53 USPQ2d 1741 (TTAB 1999).

First, we must determine the degree of descriptiveness of the JEWELRYSUPPLY.COM mark that applicant seeks to register in relation to its recited services. In this regard, we note that a term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. That a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

We turn then to the evidence made of record by the examining attorney in support of her position that JEWELRYSUPPLY.COM merely describes the recited services. This

evidence includes dictionary definitions of "JEWELRY" as "ornaments for body, items worn as ornaments, e.g. necklaces, bracelets, earrings or rings;"³ and "SUPPLY" as "provide, to give, sell, or make available something that is wanted or needed by somebody or something."⁴ In addition, the examining attorney made of record articles and advertisements from Internet websites in which "JEWELRY SUPPLY" is used by third parties to identify their online jewelry store services. The following examples are illustrative:

Gemshow-Online Jewelry Supply
Swarovski Crystal Beads Bali Beads Jewelry Supply
Sterling Silver Beads Sterling Silver Findings
Sterling Silver Alphabet Beads Bali Bead Caps 14KGF
Beads ...
(gemshow-online.com)

Lotta Displays
Jewelry Supply Super Store
Beads, Findings, Jewelry Displays, Tools, Merchant
Supplies, Gift Bags, Jewelry Boxes, Jewelry Pouches,
Wholesale Jewelry and more!
Our goal is to offer unique, eye-catching jewelry
displays at affordable prices. We directly import
many of our items, and we search the globe for unique
gift packaging ideas. We have a large stock of
inexpensive jewelry making supplies including beads,
findings, bead cord, sterling silver, tools and more
in order to make our store a one-stop jewelry supply
center.
(lottadisplays.com)

American Jewelry Supply is the world's largest full
line distributor of tools and equipment for assayers,
smelters, refiners, jewelers, polishers, casters, and
electroplaters.

³ Encarta World English Dictionary (North American Edition) 2007.

⁴ Id.

(americanjewelrysupply.com)

Welcome to BestBuyBeads.com - your online bead store. We are your source for CRYSTALLIZED - Swarovski Elements, crystal beads, silver & gold beads, jewelry supplies, and jewelry making ideas.
(bestbuybeads.com)

National Jewelers Supplies

Welcome to National Jewelers Supplies where you can find over 1000 quality jewelers tools, equipment and supplies. Our mission is to ensure that every customer's online experience is convenient, easy, and informative. We are distinguished from other jeweler's supplies companies based on our knowledge of jewelry supply products, our friendly service, our competitive prices and our valuable warranties.
(nationaljewelerssupplies.com)

SilverSource - Your Sterling Wholesale Silver Jewelry Supplier

Our quality wholesale jewelry supplies are competitively priced and proven to sell. Sterling silver jewelry has an excellent price point, and more style and design variation than jewelry made of any other precious metal. SilverSource carefully selects a wide variety of silver jewelry ring and earring designs to appeal to diverse customer tastes - all while assuring maximum profitability for our wholesale silver jewelry supply customers.
(silversource.com)

In addition, the examining attorney made of record copies of third-party registrations for various goods and services including services related to those in the involved application in which the terms JEWELRY or SUPPLY is disclaimed.

Based upon the evidence of record, we find that JEWELRY SUPPLY is, at best, highly descriptive of applicant's online retail store services featuring jewelry and jewelry-related products. Furthermore, although applicant does not appear to

dispute the point, we note for completeness that the ".com" element in the JEWELRYSUPPLY.COM mark is not distinctive, nor does it render the mark, when viewed in its entirety, distinctive. See *In re Oppendahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004); *In re Reed Elsevier Properties Inc.*, 77 USPQ2d 1649 (TTAB 2005). We find, therefore, that JEWELRYSUPPLY.COM is a highly descriptive mark as used in connection with applicant's services and, as a result, applicant needs a commensurate high degree of evidence to show that its mark has acquired distinctiveness for its services. See *Yamaha*, 6 USPQ2d at 1008 ("in general, the greater the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning.")

We turn next to the evidence submitted by applicant in support of its Section 2(f) claim of acquired distinctiveness. As noted above, it is applicant's burden to prove acquired distinctiveness. See *Yamaha*, 6 USPQ2d at 1006; and *In re Hollywood Brands, Inc.*, 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954) ("[T]here is no doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant"). "[L]ogically that standard becomes more difficult as the mark's descriptiveness increases." *Yamaha*, 6 USPQ2d at 1008. A claim that applicant has been using the subject matter for a long period of substantially exclusive use may not be

sufficient to demonstrate that the mark has acquired distinctiveness. See *In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1952 (TTAB 2001) (66 years of use). The amount and character of evidence required to establish acquired distinctiveness depends on the facts of each case, *Roux Laboratories, Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34 (CCPA 1970), and more evidence is required where a mark is so highly descriptive that purchasers seeing the matter in relation to the services would be less likely to believe that it indicates source in any one party. See *In re Bongrain International Corp.*, 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990). Evidence of acquired distinctiveness can include the length of use of the mark, advertising expenditures, sales, survey evidence, and affidavits asserting source-indicating recognition. However, a successful advertising campaign is not in itself necessarily enough to prove secondary meaning. *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (claim based on annual sales under the mark of approximately eighty-five million dollars, and annual advertising expenditures in excess of ten million dollars, not sufficient to establish acquired distinctiveness in view of highly descriptive nature of mark).

In this case, as proof of acquired distinctiveness, applicant submitted a claim of ownership of Registration No. 3260055 for the mark displayed below, with a disclaimer of

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"JEWELRY SUPPLY" for "costume jewelry parts and findings, finished jewelry, jewelry boxes not of metal, jewelry boxes of precious metal" in Class 14; and "jewelry display cases" in Class 20.⁵



Applicant "concedes that its prior registration does not constitute *prima facie* evidence of its acquired distinctiveness in its JEWELRYSUPPLY.COM mark."⁶ However, applicant asserts that its applied-for JEWELRYSUPPLY.COM mark and the mark in its prior registration are legal equivalents.

In addition, applicant submitted the declaration of its president, Kenneth W. Roberts, attesting that the mark has been in substantially exclusive and continuous use in commerce in connection with the identified services for more than five years preceding the date of the declaration. Mr. Roberts declares that (1) applicant has been using the mark "at least as early as January 1999," and since then "has invested a total of approximately \$3.35 million in advertising for its JEWELRYSUPPLY.COM services" which are "primarily spent on

⁵ Issued on the Principal Register on July 10, 2007 with the following description of the mark: "The mark consists of JEWELRY SUPPLY and design of triangle including beads, spool of wire, tools and findings."

⁶ Applicant's brief, p. 12-13.

internet marketing and magazine features;"⁷ (2) applicant further has "invested an additional \$1.5 million on its 270 page color catalog and related flyers;"⁸ (3) in 2007, applicant delivered its catalog to 60,000 customers;⁹ (4) "the www.jewelrystore.com site, which prominently features the Mark, reaches approximately 240,000 people per month and receives a daily page view of approximately 104,000;"¹⁰ (5) applicant's mark "has been promoted to consumers nationwide through various online sources, including, but not limited to: www.kaboodle.com, www.beadjewelryblog.com, www.thisnext.com, and www.aboutus.org;"¹¹ (6) applicant's instructional videos featuring its mark are displayed on online video streaming services including You Tube, MySpace, and MetaCafe;¹² (7) applicant's sales through its "online retail store average approximately \$7 million per year" and "total approximately \$45 million;"¹³ and (8) applicant has sold 5 million products bearing the JEWELRYSUPPLY.COM mark on their packaging.¹⁴

Applicant submitted a copy of its prior registration printed from the Office's Trademark Electronic Search System

⁷ Roberts Declaration, paras. 1-3, 8.

⁸ Id. at para. 9.

⁹ Id.

¹⁰ Id. at para. 5.

¹¹ Id. at para. 6.

¹² Id. at para. 7.

¹³ Id. at para. 10.

¹⁴ Id. at 11.

(TESS); printed copies of screenshots from its internet website as well as the above-noted third-party websites featuring advertisements and instructional videos regarding applicant's services; and an example of its catalog and packaging labels for goods available under its services.

With regard to applicant's prior registration, Trademark Rule 2.41(b) provides that ownership of a registration of "the same mark" on the Principal Register may be accepted as prima facie evidence of acquired distinctiveness. In relying on this rule, an applicant is essentially seeking to "tack" the use of the registered mark to its use of the present mark for purposes of transferring distinctiveness to the new mark. See *In re Flex-O-Glass, Inc.*, 194 USPQ 203 (TTAB 1977). Thus, the analysis used to determine whether applicant's present mark is "the same mark" as its previously registered mark, for purposes of the rule, is the analysis used in tacking cases, i.e., whether the marks are legal equivalents. See *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 USPQ2d 1866 (Fed. Cir. 1991). See also *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001). To meet the legal equivalents test, the marks must be indistinguishable from one another or create the same, continuing commercial impression such that the consumer would consider both as the same mark. See *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, *supra*; and *In re*

Dial-A-Mattress Operating Corp., supra. Aside from the identity of the marks in the registration and the application, applicant is also required to establish, through submission of relevant evidence rather than mere conjecture, a sufficient relationship between the goods and services in the prior registration and the goods and services identified in the application to warrant the conclusion that the distinctiveness of the mark associated with the goods and services in the registration will "transfer" to the goods and services listed in the application. *See In re Rogers, supra.*

In this case, we find that



while perhaps confusingly similar to, is clearly not the legal equivalent of the applied-for mark, JEWELRYSUPPLY.COM. The only similarity between the marks is the common term JEWELRY SUPPLY, wording to which applicant disclaimed any exclusive rights when seeking registration of that mark. Otherwise, the mark in applicant's prior registration contains a triangular design depicting jewelry beads, tools, spools of wire and findings, all of which is notably absent from the applied-for mark. Such design clearly is not the equivalent of the top level domain indicator .COM. As a result, the two marks are distinguishable from one another, create somewhat different commercial

impressions, and cannot be considered "the same" for purposes of Trademark Rule 2.41(b). Because the marks are not the same, Trademark Rule 2.41(b) cannot be used to establish that JEWELRYSUPPLY.COM has acquired distinctiveness as a mark for any goods or services, let alone the services for which registration is now sought. Thus, it is unnecessary to consider the relationship between the goods for which the mark has been registered and the services identified in the application.

We do not disregard applicant's prior registration, but consider it for such probative value as it may have in the context of the rest of applicant's evidence of acquired distinctiveness. In this regard, however, we keep in mind that the registration contains a disclaimer of the wording JEWELRY SUPPLY and, perhaps more importantly, the examining attorney's evidence demonstrates that said wording is used by several others in describing retail jewelry services.

With regard to the sales and advertising figures recited in the declaration of applicant's president, we observe that applicant has provided no context for the industry by which we may determine applicant's share of the online jewelry supply market or where such sales and advertising expenditures place applicant among others in the same and related fields. In other words these figures, without context, tell us very little about whether consumers of applicant's online jewelry supply services

have come to recognize JEWELRYSUPPLY.COM as a source indicator. Therefore this evidence has very limited probative value.

Similarly, while Mr. Roberts states in his declaration that applicant's website is viewed by 104,000 people per day and 240,000 people per month, such figures suggest that applicant's website is repeatedly viewed by the same individuals rather than supporting a finding that large numbers of new individuals are exposed to applicant's mark on its web site each month. In addition, there is no indication of the number of individuals viewing the promotions of applicant's services under the JEWELRYSUPPLY.COM mark on the third-party websites beadjewelryblog.com, thisnext.com, or kaboodle.com, while the number of page views listed for JEWELRYSUPPLY.COM on the aboutus.org site is a very modest 237 views. Furthermore, the viewership of streaming videos featuring applicant's mark range from 33,500 on YouTube to approximately 300 to 1,000 on other video services. Again, there is no indication as to the number of individuals who have repeatedly viewed these videos.

In short, the evidence submitted by applicant suggests that it has enjoyed some commercial success in marketing its jewelry-related services under its JEWELRYSUPPLY.COM mark. However, the evidence falls rather short of demonstrating that JEWELRYSUPPLY.COM, as used in connection with such services, has acquired distinctiveness under Section 2(f). There is neither

context for the sales and advertising figures, marketing materials, and internet website impressions, Jewe... nor direct evidence in the form of, for instance, surveys or affidavits asserting source-indicating recognition by which we may determine that JEWELRYSUPPLY.COM has come to indicate source in applicant.

Finally, we note that applicant and the examining attorney argue at length in their briefs regarding whether applicant's evidence that displays the applied-for mark with the triangular design from its prior registration in place of the "dot" as displayed below on its specimen of record, is sufficient to support a finding of acquired distinctiveness as to the word mark JEWELRYSUPPLY.COM.



However, even setting aside the question of whether these marks

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are legal equivalents and considering all of the evidence submitted by applicant as supporting its Section 2(f) claim as to JEWELRYSUPPLY.COM, we find that with this highly descriptive mark, applicant has not met its burden of showing acquired distinctiveness. *See Yamaha Int'l Corp. v. Hoshino Gakki Co., Ltd., supra*, 6 USPQ2d at 1008.

Decision: The refusal to register under Trademark Act Section 2(e)(1) without acquired distinctiveness under Section 2(f) is affirmed.