

1. Extension of time, to and including December 15, 2004, was requested by and duly granted to Opposer pursuant to 37 C.F.R. §2.102.

2. De Beers LV Ltd., a corporation organized under the laws of the United Kingdom (hereinafter “De Beers” or “Applicant”) seeks to register its mark DB LOGO as a trademark for the following goods in International Class 014 (hereinafter “Applicant’s Goods”), as evidenced by publication of said Mark in the Official Gazette on page TM 231 of the August 17, 2004 issue:

In International Class 014 for precious metals and their alloys and goods in precious metals or coated therewith not included in other classes, namely beverage ware and dishes of precious metal, candle snuffers and candlesticks of precious metal, napkins rings of precious metal, vases of precious metal, jewel cases of precious metal, statues of precious metal, rings, necklaces, bracelets, earrings, brooches, diadems made of precious metal or coated therewith, jewelry and imitation jewelry; gemstones; precious stones, semi-precious stones; diamonds; watches, clocks, horological and chronometric instruments, namely chronometers, chronographs for use as watches, watch bracelets, watch cases, pocket watches, wristwatches, watch movements; replacement parts for all the aforesaid goods.

3. Applicant acquired no rights in Applicant’s mark in the United States prior to May 2, 2003, when Applicant filed its Intent to Use application for Applicant’s DB LOGO mark in the United States Patent and Trademark Office with a Section 44(d) claimed priority date from a United Kingdom application filed November 5, 2002.

4. Prior to the filing date for Applicant’s Mark, and any priority date or date of use which Applicant can rely on, Opposer has for many years used “deB” marks for the following goods (hereinafter “Opposer’s Goods”):

In International Class 014 Jewelry, diamonds, watches and timepieces, and fine art.

In International Class 035 Retail jewelry store services via physical store, catalogue sales and web-based sales.

5. Opposer has used a particular stylized version of the “deB” mark, which is a “deB” logo, since at least as early as June 30, 2001. This stylized version of the mark is the subject of a pending trademark application filed July 1, 2004, USPTO Serial No. 78/444,907.

6. Opposer has spent substantial amounts of time, money and effort in developing and marketing Opposer’s Goods under Opposer’s “deB” mark in the United States and sales of Opposer’s Goods under Opposer’s “deB” mark have amounted to many millions of dollars. As a result, members of the general public have come to identify Opposer’s “deB” mark with Opposer’s Goods and to recognize Opposer’s Goods to be of the highest quality and originating from Opposer.

7. Because of Opposer’s marketing efforts and sales, Opposer has established a prominent presence in the retail jewelry marketplace as a leading provider of high quality jewelry and timepieces. Through the distinctiveness of Opposer’s “deB” mark and through widespread and favorable public recognition and acceptance in the retail jewelry market and, in particular, in the area of high quality jewelry, Opposer’s “deB” mark has become uniquely associated with Opposer and is famous, distinctive and well-known.

8. Applicant’s DB LOGO mark is very similar in appearance and commercial impression to Opposer’s “deB” mark, with both marks having the phonetically identical DB or “deB” as the dominant term. Importantly, Applicant’s DB LOGO mark and Opposer’s “deB” mark are for identical goods in International Class 014, namely, jewelry and timepieces. Applicant has, thus, expressed an intent to use Applicant’s DB LOGO mark on goods that are identical to Opposer’s Goods and/or goods that are within Opposer’s natural area of expansion. Any use of its mark by the Applicant which would emphasize the DB part of its mark and/or de-emphasize the LOGO part of its mark would result in near identical marks and cause clear and obvious confusion in the marketplace.

9. On information and belief, it is expected that Applicant’s Goods will be marketed to the same potential purchasers in the same relevant markets as the goods now marketed by Opposer and/or the goods within Opposer’s natural area of expansion. Moreover, it is expected that

Applicant will use similar media to advertise Applicant's Goods under Applicant's DB LOGO mark as used by Opposer to advertise Opposer's Goods under Opposer's "deB" mark. Additionally, it is expected that the goods marketed under Applicant's DB LOGO mark will be distributed through the same channels of distribution and will be purchased and used by many of the same individuals and entities as those of the Opposer's Goods.

10. As a result of the substantial similarities between the marks' respective appearances, underlying goods, relevant markets, advertising, channels of distribution, purchasers, and users, Opposer believes that there is a very strong likelihood of confusion if Applicant is permitted to register Applicant's DB LOGO mark for use in conjunction with Applicant's Goods.

11. Opposer's marketing efforts have caused Opposer and Opposer's "deB" mark to be well-known and well-regarded in the community of consumers who are likely to consider purchasing Applicant's Goods. Therefore, it is likely that some members of the relevant consumer market would be confused by the marketing of Applicant's Goods under Applicant's DB LOGO mark and would believe that Applicant's Goods were associated with, endorsed by, related to, or actually the goods of Opposer. Any fault or defect in Applicant's Goods would reflect upon and seriously injure Opposer's reputation. Furthermore, individuals or entities who are familiar with Opposer's "deB" mark would confuse the same with Applicant's DB LOGO mark and might purchase Applicant's Goods in the mistaken belief that they are purchasing the goods of Opposer.

12. If Applicant is granted the registration herein opposed, Applicant would be placed in a position to deceive or mislead the public, as the registration would give Applicant certain rights to Applicant's DB LOGO mark and all confusingly similar marks, thereby causing damage and injury to Opposer.

13. As a result of the substantial similarities between the marks' respective appearances, underlying goods, relevant markets, advertising, channels of distribution, purchasers, and users, registration of Applicant's DB LOGO mark would cause damage and injury to Opposer.

14. Because Applicant's DB LOGO mark consists of a mark which closely resembles a senior mark of Opposer, Applicant's DB LOGO mark is likely, when used in connection with the goods of Applicant, to cause confusion, to cause mistake, or to deceive, and registration of Applicant's DB LOGO mark is therefore barred under 15 U.S.C. § 1052(d).

15. Further, Opposers' "deB" mark is a distinctive and famous mark within the meaning of same set forth in 15 U.S.C. § 1125(c). The use of Applicant's DB LOGO mark by Applicant as stated in its intent to use application is for a commercial use in interstate commerce beginning after Opposer's "deB" mark has become famous, and, given the similarities of the marks, such use by Applicant would cause dilution of the distinctive quality of Opposer's "deB" mark by lessening the capacity of Opposer's "deB" mark to identify and distinguish goods or services.

16. Given that Applicant's use of Applicant's DB LOGO mark by Applicant as stated in its intent to use application is for a commercial use in interstate commerce and that such use would dilute the distinctive quality of Opposer's famous "deB" mark, registration of Applicant's DB LOGO mark would cause damage and injury to Opposer.

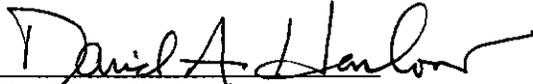
17. Because Applicant's DB LOGO mark consists of a mark which would cause dilution of the distinctive quality of Opposer's "deB" mark, registration of Applicant's DB LOGO mark is therefore also barred as a matter of equity under 15 U.S.C. § 1125(c) and should be refused under 15 U.S.C. § and 1063(a).

18. Accordingly, Opposer prays that said Application Serial Number 78/245,219 is rejected and the registration of the mark therein shown for the goods therein specified be refused and denied.

This Notice of Opposition is herewith submitted in triplicate, together with the filing fee in the amount of \$300. If the fees enclosed are not sufficient, or if any additional fees are

required, the Patent and Trademark Office is hereby authorized to charge our USPTO Deposit Account Number 502843 in the name of Nelson Mullins Riley & Scarborough LLP.

Respectfully submitted this 27th day of September, 2004.



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September 27, 2004

Via Express Mail

BOX TTAB FEE

Assistant Commissioner For Trademarks

2900 Crystal Drive

Arlington, Virginia 22202-3513

**Re: Notice Of Opposition
De Boule Diamond & Jewelry, Inc., Opposers, v. De Beers LV Ltd, Applicant
Trademark Application for DB LOGO, Serial No. 78/245,219
Publication Date: August 17, 2004**

Dear Sir/Madam:

We are enclosing the following:

1. Notice of Opposition to the DB LOGO trademark application, Serial No. 78/245,219 (original plus two copies);
2. Check No. 21362 in the amount of \$300 in payment of the opposition fee; and
3. Post card acknowledgment of the filed Notice of Opposition.

Thank you for your attention in this matter.

Yours very truly,

NELSON MULLINS RILEY & SCARBOROUGH LLP

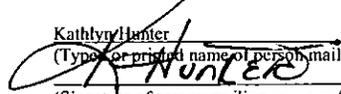


David A. Harlow

CERTIFICATE OF MAILING BY "EXPRESS MAIL"
"Express Mail" mailing label number EV409767878US

I hereby certify that this correspondence is addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, BOX TTAB - FEE, and is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date noted below.

Kathlyn Hunter
(Type or printed name of person mailing paper or fee)


(Signature of person mailing paper or fee)

September 27, 2004

(Date of signature)



09-27-2004

U.S. Patent & TMO/TM Mail Rept Dt. #22