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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91162370
Party	Plaintiff De Boulle Diamond & Jewelry, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

DE BOULLE DIAMOND & JEWELRY, INC.,

Opposer,

v.

DE BEERS LV LTD.,

Applicant.

Consolidated Opposition No.: 91162370

Opposition No.'s: 91162370

91162469

91164615

91165285

91165465

OPPOSER'S MOTION FOR SUMMARY JUDGMENT

Pursuant to Rule 56 of the Federal Rules of Civil Procedure, and Trademark Trial and Appeal Board Manual of Procedure (TBMP), Section 528.01 (2d ed. rev. 2004), Opposer, De Boule Diamond & Jewelry, Inc. ("Opposer" and/or "De Boule"), hereby files this Motion for Summary Judgment, against Applicant, De Beers LV Ltd.¹ ("Applicant" and/or "De Beers"), and in support of same will respectfully show:

I.

INCORPORATION BY REFERENCE

1. This Motion is made in reliance upon the following Pleading and Affidavits, all of the facts, exhibits, and other evidence contained in which, are incorporated herein by reference as if set forth at length for all purposes (the "Summary Judgment Evidence"):

¹ Opposer is informed that De Beers LV Ltd. has changed its name to De Beers Diamond Jewellers Limited since the initiation of this Proceeding.

(a) Applicant's U.S. Trademark for the stylized Mark "SO DB", Application Serial No. 79/000,478, rendered as follows (the "SO DB Mark"):

So DB

(b) Applicant's application for federal registration of the word Mark "DB STAR", U.S. Trademark Application Serial No. 78/245,795 (the "DB STAR Mark");

(c) Applicant's application for federal registration of the word Mark "DB LOGO", U.S. Trademark Application Serial No. 78/245,219 (the "DB LOGO Mark");

(d) Applicant's application for federal registration of the word Mark "DB SIGNATURE", U.S. Trademark Application Serial No. 78/245,210 (the "DB SIGNATURE Mark");

(e) Applicant's application for federal registration of the word Mark "DB MONOGRAM", U.S. Trademark Application Serial No. 78/245,779 (the "DB MONOGRAM Mark");

(f) Opposer's Opposition to federal registration of the DB LOGO Mark, Opposition No. 91162370, and Applicant's Answer thereto, filed in this Proceeding;

(g) Opposer's Opposition to federal registration of the DB MONOGRAM Mark, Opposition No. 91162469, and Applicant's Answer thereto, filed in this Proceeding;

(h) Opposer's Opposition to federal registration of the DB SIGNATURE Mark, Opposition No. 91164615, and Applicant's Answer thereto, filed in this Proceeding;

(i) Opposer's Opposition to federal registration of the DB STAR Mark, Opposition No. 91165285, and Applicant's Answer thereto, filed in this Proceeding;

(j) Opposer's Opposition to federal registration of the SO DB Mark, Opposition No. 91165465, and Applicant's Answer thereto, filed in this Proceeding;

(k) Opposer's application for federal registration of the Mark "DB", U.S. Trademark Application Serial No. 78/604,056 (the "DB Mark");

(l) Opposer's application for federal registration of the Mark "DE B" and Design, U.S. Trademark Application Serial No. 78/440,907 (the "DE B Mark"), now US Registration No. 3,078,627;

(m) Opposer's application for federal registration of the Mark "DE BOULLE", U.S. Trademark Application Serial No. 78/444,880 (the "DE BOULLE Mark"), now US Registration No. 3,078,625;

(n) The Affidavit of Denis J. Boule in support of Opposer's Motion for Summary Judgment, and attached exhibits, filed simultaneously herewith (the "Boule Affidavit");

(o) The Exhibits attached to and referenced in this Motion;

(p) The authorities cited and referenced in this Motion; and

(q) The record in this Proceeding.

II.

REQUESTED RELIEF

2. The undisputed Summary Judgment Evidence establishes as a matter of law that, given the significant similarities in appearance and commercial impression of the respective marks, the overlap of the goods associated with both the De Beers Marks and the prior De Boule Marks, the similarities in the trade channels, and the significant harm to the goodwill of the De Boule Marks that De Boule could experience as a result of confusion in the marketplace, confusion is likely to arise with the co-existence of the De Boule Marks and the De Beers Marks on the register. De Boule therefore prays that the Board enter an Order granting its Oppositions in all respects, and denying registration of each of the De Beers marks.

III.

PROCEDURAL HISTORY

3. De Beers filed four (4) of the five (5) Applications for federal registration of the marks in issue in this Proceeding on the basis of Section 44(e) of the Trademark Act, 15 USC Section 1126(e) (“Section 44(e)”), on the following dates: (i) DB LOGO (Application Serial No. 78/45219), applied May 2, 2003; (ii) DB STAR (Application Serial No. 78/245,795), applied May 5, 2003; (iii) DB SIGNATURE (Application Serial No. 78/245,210), applied May 2, 2003; and (iv) DB MONOGRAM (Application Serial No. 78/245,779), applied November 15, 2002. De Beers filed its Application for federal registration of the SO DB Mark (Reg. No. 2,985,572), based on an extension of protection of an international registration in the United States under Section 66(a) of the Trademark Act, 15 USC Section 1141(f) (“Section 66(a)”), and the Madrid Protocol Implementation Act on August 26, 2003 (the DB LOGO, DB STAR, DB

SIGNATURE, DB MONOGRAM, and SO DB Marks are hereinafter collectively referred to as the “De Beers Marks”).

4. De Boule timely filed five (5) separate oppositions against federal registration the De Beers Marks; namely, Opposition No. 91162370 (DB LOGO), Opposition No. 91162469 (DB MONOGRAM), Opposition No. 91164615 (DB SIGNATURE), Opposition No. 91165285 (DB STAR), and Opposition No. 91165465 (SO DB) (collectively the “Opposition”).

5. On May 2, 2005, by Order entered on that date, the Board *sua sponte* consolidated Opposition No. 91162370, 91162469, and 91164615, under Opposition No. 91162370. On July 20, 2005, the Board further *sua sponte* consolidated Opposition Nos. 91165285 and 91165465 with the earlier Consolidated Opposition No. 91162370, as Consolidated Opposition No. 91165285 (the “Proceeding”).

6. As part of the Trial, Opposer’s Testimony Period in this Proceeding is set for the 30-day period closing on September 15, 2007. Applicant’s Testimony Period in this Proceeding is set for the 30-day period closing on November 14, 2007. Opposer’s rebuttal testimony period is set for the 15-day period closing on December 29, 2007.

IV.

UNDISPUTED SUMMARY JUDGMENT EVIDENCE

(a) History of De Boule

7. De Boule owns and operates a jewelry store in Dallas, Texas under the trade name “De Boule”, and has done so since 1984. *Boule Affidavit*, ¶ 5. De Boule has marketed

and sold diamonds, fine jewelry and timepieces to the general public in Dallas, Texas, and elsewhere in the United States in association with the brand De Boule for almost twenty-five (25) years. *Id.* De Boule markets its brand and products to purchasers of engagement and wedding rings, gifts for special occasions, such as birthdays, anniversaries, and the Holidays, and connoisseurs and consumers of luxury products in general. *Id.* Over the years De Boule has grown to become one of the premier independently owned jewelers in the United States. *Id;* see also Exhibit “A”: *All That Glitters*. Dallas Business Journal. July 1997.

8. Through the years, the De Boule brand has developed a reputation in Dallas, Texas, and elsewhere in the United States, for the fine quality of the exclusive jewelry that the De Boule craftsmen custom design and manufacture, as well as the fine quality of its diamonds and other gems. *Boule Affidavit*, ¶ 6. De Boule’s marketing activities include advertising and promoting its brand and products in local and national media. *Id.* De Boule further promotes its brand and offers its De Boule Collection and other products for sale to general public throughout the United States on its Web site. *Id.*

(b) History of De Beers

9. De Beers LV is a United Kingdom Company. It is a joint venture between the De Beers Group, the world’s premier diamond group, and LVMH Moet Hennessy Louis Vuitton (“LVMH”), the world’s leading luxury products group, to develop the global consumer brand potential of the De Beers Name. See Exhibit “B”: *De Beers Consolidated Mines Limited/De Beers Centenary AG Joint Media Release*; Exhibit “C”: *Technical & Financial Report for the*

Diamond Interests of De Beers and its Partners: Appendix 2 to the Circular to the holders of De Beers Linked Units, posted 10 April 2001 (Exhibit “C”), ¶¶ 1.4.6, 1.6.1, 2.1, 2.4, 8.1. Pursuant to its agreement with LVMH, the De Beers Group transferred the world-wide rights to use the De Beers brand for luxury goods in consumer markets to De Beers LV, in or about 2001. *Id.* De Beers LV opened its first store in London, United Kingdom in December 2002. *See* Exhibit “D”: *de Beers 2003 Annual Review*, pp 17, 39.

10. The De Beers Group has a long time business presence in South Africa. *See* Exhibit “E”: Debora Spar and Jennifer Burns. *Forever: De Beers and U.S. Antitrust Law*. Harvard Business Review. Feb 1, 2000 (Revised Sept 6, 2002). The De Beers Group was associated with the apartheid-era regimes in South Africa. *Id.* The De Beers Group has also been notorious for its monopolistic practices in controlling the diamonds markets, and has been the target of investigations by the United States Department of Justice, since 1945. *Id.* Various entities in the De Beers Group have been Defendants in a number of class actions in the United States for human rights abuses by victims of South Africa’s apartheid-era regimes. *Id.* The De Beers Group has also been accused of being associated with trade in “conflict” or “blood” diamonds that financed coups and guerrilla warfare in Africa. *See* Exhibit “F”: Lucinda Saunders. *Rich and Rare are the Gems They War: Holding De Beers Accountable for Trading Conflict Diamonds*. 24 *Fordham Int’l L.J.* 1402.

11. During this time, the De Beers Group has “managed its business so as to avoid any undue legal risk arising out of US antitrust laws in the United States since its business

policies have not required systematic contacts with the United States”. Exhibit “C”, ¶¶ 10.2.1.2, 11.4.2. This meant that the De Beers Group intentionally avoided having any business presence in the United States. *See* Exhibit “E”: Debora Spar and Jennifer Burns. *Forever: De Beers and U.S. Antitrust Law*. Harvard Business Review. Feb 1, 2000 (Revised Sept 6, 2002). In July 2004 De Beers pled guilty in the United States to price fixing. *See* Exhibit “G-1”: Indictment in Case No. CR -2-94-019, United States District Court for the Southern District of Ohio, Eastern Division; Exhibit “G-2”: Plea Agreement in Case No. CR -2-94-019, United States District Court for the Southern District of Ohio, Eastern Division; Exhibit “G-3”: Courtroom Minutes. Guilty Plea and Sentencing Hearing. Case No. CR -2-94-019, United States District Court for the Southern District of Ohio, Eastern Division. Prior to this settlement, De Beers internationally did not conduct business in the United States, and took the position that it was not subject to the jurisdiction of the governmental agencies and courts of the United States. In addition, the De Beers Group settled the remaining Class Actions in November 2005. *See* Exhibit “H”: De Beers Société Anonyme Media Release, dated November 30, 2005. In doing so the De Beers Group recognized the “reputational impact” of its legal troubles in the United States. *Id.*

12. The December 2002 opening of the first De Beers store in London, was accompanied by protest and controversy. *See* Exhibit “I”: Ron Irvin. *Is De Beers forever?* BrandChannel.com. November 22, 2004. De Beers LV opened its first store in the United States in New York in June 2005. *See* Exhibit “J”: *Opposing Words Mark De Beers LV Opening.*

Rapaport News. June 23, 2005. The opening was likewise was accompanied by protest and controversy. *Id.*

(c) The De Boulle Marks

13. De Boulle filed its application for federal registration of its Marks on the basis of Section 1(a) of the Trademark Act, 15 USC Section 1501(a) (“Section 1(a)”), on the following dates: (i) DB Mark (Application Serial No. 78/604,056), applied April 7, 2005 (the “DB Mark”); (ii) DE BOULLE Mark (Application Serial No. 78/444,880), applied July 1, 2004 (the “DE BOULLE Mark”); and (iii) DE B and Design Mark (Application Serial No. 78/444,907), applied July 1, 2004 (the “DE B Mark”) (the DB, DE BOULLE and DE B Marks are hereinafter collectively referred to as the “De Boulle Marks”). De Boulle has directed its Marks to Classes 14 (jewelry, diamonds, watches) and 35 (retail jewelry stores, catalogue sales, and web based sales) (collectively the “De Boulle Goods”). In addition, the DE BOULLE Mark and the DE B Mark are directed to Class 16 (fine art - paintings). On April 11, 2006, De Boulle was awarded United States Registration No. 3,078,625 for the DE BOULLE Mark and on United States Registration No. 3,078,627 for the DE B and Design Mark.

14. Customers have come to identify the De Boulle Marks with fine jewelry, diamonds, and timepieces, which are of the highest quality. *Boullé Affidavit*, ¶ 10. Customers have come to identify the De Boulle Marks with fine jewelry, including diamonds, and timepieces which originate from De Boulle. *Id.* The De Boulle Marks are valuable assets of De Boulle. *Id.* The De Boulle Marks carry considerable goodwill and customer acceptance of the

fine jewelry, diamonds, and timepieces offered under the De Boule Marks. *Id.* De Boule's customers and potential customers have come to recognize the De Boule Marks as representing the quality of De Boule's fine jewelry, diamonds, and timepieces. *Id.*

(d) The De Beers Marks

15. De Beers desires to register the De Beers Marks in Class 14, for use with an extensive list of enumerated products, that include: precious metals and their alloys and goods; jewelry; gemstones; diamonds; and watches (collectively the "De Beers Goods").

16. Just like De Boule, De Beers markets its products to purchasers of engagement and wedding rings, gifts for special occasions, such as birthdays, anniversaries, and the Holidays, and connoisseurs and consumers of luxury products in general. *Boule Affidavit*, ¶ 12. Diamonds and fine jewelry bearing the De Beers' brand and diamonds, and fine jewelry bearing the De Boule Marks may be sought out and bought by the same consumer. *Id.* Just like De Boule, De Beers LV markets its products under the De Beers brand through public advertising in national luxury goods and lifestyle media and the internet. *Boule Affidavit*, ¶ 13. The De Beers and De Boule marketing and advertising campaigns are likely to reach the same consumer. *Id.*

17. The De Beers LV marketing strategy involves selling its products to the general public through its company-owned stores in New York, Beverly Hills, Las Vegas, and elsewhere, and to offer De Beers branded diamonds and fine jewelry through a select network of reputable jewelry stores (such as de Boule) in parts of the United States, where there are no company-owned stores, such as Texas. *Boule Affidavit*, ¶ 14.

18. Because of the semantic similarity in the two brand names and their abbreviations, whether DB or De B, Potential consumers of diamonds and fine jewelry marketed by De Boule are likely to assume that the De Beers products offered for sale under the De Beers brand are actually the diamonds and fine jewelry offered by De Boule. *Id.*

(e) Respective Priority of the Marks

19. De Boule's applications for registration of the De Boule Marks are all based on actual use of the De Boule Marks in interstate trade and commerce, on the basis of Section 1(a), with the following priority claims: (i) DB Mark (Application Serial No. 78/604,056), in use since December 31, 2000; (ii) the De Boule Mark (Application Serial No. 78/444,880), in use since December 31, 1989; and (iii) DE B Mark (Application Serial No. 78/444,907), in use since June 30, 2001. *Boule Affidavit*, ¶¶ 5, 7, 8, 9.

20. De Beers made its applications for registration of the four (4) De Beers Marks, based on an intent to use, pursuant to Section 44(e) on the following dates: (i) DB LOGO (78/45219), application date May 2, 2003 (the Foreign Filing Date and Foreign Registration Date are listed as November 5, 2002); (ii) DB STAR (Application Serial No. 78/245795), application date May 5, 2003 (the Foreign Filing Date and Foreign Registration Date are listed as November 15, 2002); (iii) DB SIGNATURE (Application Serial No. 78/245210), application date May 2, 2003 (the Foreign Filing Date and Foreign Registration Date are listed as November 5, 2002); and (iv) DB MONOGRAM (Application Serial No. 78/245779), application date May 5, 2003 (the Foreign Filing Date and Foreign Registration Date are listed as November 15, 2002). Only

one affidavit or declaration of use has been filed for any of these Marks pursuant to Sections 1(a) and 1(b) of the Trademark Act, 15 USC Sections 1501(a) & (b).

21. De Beers filed its Application for federal registration of the SO DB Mark (Reg. No. 2,985,572) on the basis of Section 66(a), on August 26, 2003. It claims prior use of the SO DB Mark, under Section 67 of the Trademark Act, 15 USC Section 1567 (“Section 67”), as of August 26, 2003.

22. Prior to June 2004, De Beers internationally did not conduct business in the United States. Although De Beers was formed in 2001, it did not operate in the US until opening its store in New York, in June 2005.

23. The undisputed Summary Judgment Evidence therefore shows that De Boule has used all of the De Boule Marks in interstate trade and commerce prior to the filing of an application for federal registration of any of the De Beers Marks.

(e) Irreparable Harm to De Boule by Any Confusion

24. Any confusion between the De Boule brand and the De Beers brand may cause De Boule irreparable harm. In the market for diamonds and fine jewelry, the De Beers name has long been associated with the apartheid-era regimes in South Africa and its monopolistic practices to control diamond prices and the diamond market. De Boule has devoted more than 20 years in building its brand in the United States. The De Boule brand and the De Boule Marks are valuable assets of De Boule. *Boule Affidavit*, ¶ 15. De Boule would suffer irreparable harm if potential consumers of diamonds and fine jewelry assume that the diamonds

and fine jewelry marketed by De Boulle in association with the De Boulle Marks are actually products offered by De Beers. *Id.*

V.

ARGUMENT AND AUTHORITIES

(a) Summary Judgment Standard

25. The purpose of summary judgment is to avoid an unnecessary trial where additional evidence would not reasonably be expected to change the outcome. *See Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 730 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984); *see also* TBMP section 528.01 (2d ed. rev. 2004) and cases cited therein. Summary judgment is appropriate in cases where the moving party establishes that there is no genuine issue of material fact which requires resolution at trial and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(c). An issue is material when its resolution would affect the outcome of the proceeding under governing law. *See Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 106 S. Ct. 2505 (1986); *Octocom Systems Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1786 (Fed. Cir.1990).

26. A fact is genuinely in dispute if the evidence of record is such that a reasonable fact finder could return a verdict in favor of the nonmoving party. *Id* However, a dispute over a fact that would not alter the Board's decision on the legal issue will not prevent entry of summary judgment. *See Kellogg Co. v. Pack 'Em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

- (b) A review of the Applicant's marks in light of Opposer's marks reveals that no genuine issue of material fact remains that De Boule is entitled to a ruling of a likelihood of confusion as a matter of law.

27. Ultimate conclusions about confusing similarity of two marks is a question of law. *See Sweats Fashion, Inc. v. Pannill Knitting Company, Inc.*, 833 F.2d 1560 (Fed. Cir. 1987);

28. There is no material issue of fact that De Boule is the prior user and senior user having prior use of the De Boule Marks over the De Beers Marks. *See* ¶¶ 19-23, *supra*.

29. An analysis of similarities between the De Beers Marks and the prior De Boule Marks in light of the relevant factors set forth by the U.S. Court of Customs and Patent Appeals in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973), also indicates that there is a likelihood of confusion arising if the marks were permitted to co-exist.

- (i) Similarity of the marks in their entirety as to appearance, sound, connotation, and commercial impression

30. Registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), should be refused when the applicant's mark, when used on or in connection with the identified goods and services, so resembles a pre-existing mark, as to be likely to cause confusion, or to cause mistake, or to deceive. TMEP Section 1207. A similarity in any one of the elements of sound, appearance, meaning or connotation attaching to two marks is sufficient to find a likelihood of confusion. *In re Mack*, 197 USPQ 755 (TTAB 1977; *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). "DB" of De Boule's DB mark is

identical to the prominent component of all five De Beers marks. In addition, De Boulle’s DE B Mark is prominently comprised of a “D” and “B” and, similarly, De Boulle’s DE BOULLE Mark conspicuously includes a strong “DB” sound at the beginning as expressed by the “DE B” prefix as shown in *Comparison of De Boulle Marks to De Beers Marks (Table I)*:

Table I: Comparison of De Boulle Marks to De Beers Marks

Mark	Appearance, Sound, & Connotation
De Boulle Diamond & Jewelry, Inc.	
DB	DB
DE B (Stylized)	Prominently comprised of “D” and “B”
DE BOULLE	“DB sound” in “DE B” prefix
De Beers LV Ltd.	
DB LOGO	DB plus word “Logo”
DB MONOGRAM	DB
(no claim is made to the exclusive right to use “MONOGRAM” apart from the mark as shown)	
DB SIGNATURE	DB plus word “Signature”
DB STAR	DB plus word “Star”
So DB (Word Mark: SO DB)	DB plus word “So”

“It is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered.” *Presto Products, Inc. v. Nice-Pak Products, Inc.* 9 USPQ2d 1895 (TTAB 1988) (finding KID-WIPES to be confusingly similar to KID STUFF for baby wipes). “Although it is not proper to dissect a mark, one feature of a mark may be more significant and it is proper to give greater force and effect to that dominant feature.” McCarthy § 23:44 “If the ‘dominant’ portion of both marks is the same, then confusion may be more likely, notwithstanding peripheral differences.” McCarthy § 23:44.

31. Letter combination marks are typically afforded broader protection: “Arbitrary arrangements of letters have generally been given a wide scope of protection, based on the premise that it is more difficult to remember a series of arbitrarily arranged letters than it is to remember words, figures phrases or syllables. The difficulty of remembering multiple-letter marks makes the likelihood of confusion between such marks, when similar, more probable.” McCarthy § 23:33 “It is a well-established principle of our trademark law that confusion is more likely between arbitrarily arranged letters than between other types of marks.” *Edison Bros. Stores, Inc. v. Brutting E.B. Sport-International GmbH*, 230 USPQ 530 (TTAB 1986); *Hilson Research, Inc. v. Society for Human Resources Management*, 27 U.S.P.Q.2d 1423 (TTAB 1993) (finding two “HR” logos confusingly similar and stating: “The fact that the marks comprise letters adds to the likelihood that the marks will be confused”).

32. The most distinguishable and prominent feature of each of the De Beers Marks is their use of the “DB” letter combination. The non-DB parts of the De Beers Marks are less distinctive. *See Table I.*

33. De Boule has requested registration of its DB Mark in typed or standard character form. Upon registration, this Mark may be displayed in any lettering style. 37 C.F.R. §2.52(a). In addition, the initials “D B” are dominant, visually and phonetically, in the DE B and Design Mark. *See Table I.*

34. Furthermore, the marks De Beers and De Boule, from which the DB brands are derived, are not only not only phonetically alike, but could be difficult to distinguish visually, upon a cursory glance, particularly when used in the same manner of display, in association with any DB or DE B branded jewelry. Moreover, the fact that the abbreviations of the De Beers and De Boule trade names used in their respective brands are identical (DB and/or DE B), increases the likelihood of confusion. *See Table I.*

35. The presentation of the De Beers Marks in special form will therefore not avoid likelihood of confusion with the De Boule Marks. *See In re Melville Corp.*, 18 USPQ2d 1386, 1387-88 (TTAB 1991); *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988); *Sunnen Prods. Co. v. Sunex Int'l Inc.*, 1 USPQ2d 1744, 1747 (TTAB 1987); *In re Hester Indus., Inc.*, 231 USPQ 881, 882, n.6 (TTAB 1986); *United Rum Merchants, Ltd. v. Fregal, Inc.*, 216 USPQ 217, 220 (TTAB 1982); *Frances Denney, Inc. v. Vive Parfums, Ltd.*, 190 USPQ 302, 303-04 (TTAB 1976); TMEP §1207.01(c)(iii).

(ii) Similarity and nature of the goods or services
as described in application

36. If the marks of the respective parties are identical or highly similar, the commercial relationship between the goods or services of the respective parties must then be considered carefully, to determine whether there is a likelihood of confusion. *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983). “As the degree of similarity of the goods of the parties increases, ‘the degree of similarity [of the marks] necessary to support a conclusion of likelihood of confusion declines.’” *Fossil Inc. v. Fossil Group*, 49 USPQ2d 1451 (TTAB 1998). See also *Hard Rock Café International (USA), Inc. v. Elsea*, 56 USPQ2d 1504 (TTAB 2000) (“When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines.”).

37. The De Beers Marks and the prior De Boule Marks are very similar. The goods of the parties need therefore not be identical or directly competitive to find a likelihood of confusion, they need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. *In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

38. De Beers Marks are to be used in connection with class 14 jewelry and related items. De Boule marks are used in connection with Class 14 jewelry and related items and Class 36 jewelry retail stores. There is essentially a complete overlap with the associated goods of the De Beers Marks and the De Boule Marks. *See, e.g.*, respective catalogs of De Boule at the domain <deboulle.com> and De Beers at the domain <debeers.com>.² Each of the De Beers Marks resides in International Class 014 and is directed to jewelry, diamonds, watches, clocks, chronographs for use as watches, watch bracelets, watch cases, pocket watches, wristwatches, watch movements. Similarly, each of the De Boule Marks resides in International Class 014 and is directed to jewelry, diamonds, watches and related goods and services as shown on *Comparison of Goods and Services of De Boule Marks to De Beers Marks (Table II)*:

Table II: Comparison of Goods and Services of De Boule Marks to De Beers Marks

Mark	Description of Goods/Services
De Boule Diamond & Jewelry, Inc.	
DB	IC 014: Jewelry, diamonds, watches and timepieces, all for women.
DE B (Stylized)	IC 014: Jewelry, diamonds, watches and timepieces.
DE BOULLE	IC 014: Jewelry, diamonds, watches and timepieces.
De Beers LV Ltd.	
DB LOGO	IC 014: Precious metals and their alloys and goods in precious

² Web site information is appropriate for judicial notice pursuant to Rule 201, Fed. R.Evid. *Renaissance Greeting Cards v. Dollar Tree Stores*, 405 F.Supp.2d 680, 684 n. 9 (E.D. Va. 2005) (citations omitted)

	metals or coated therewith not included in other classes; namely beverage ware and dishes of precious metal, candle snuffers and candlesticks of precious metal, napkin 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 metals 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.
DB MONOGRAM (no claim is made to the exclusive right to use “MONOGRAM” apart from the mark as shown)	IC 014: Precious metals and their alloys and goods in precious metals or coated therewith not included in other classes, namely, jewelry and imitation jewelry; precious stones; semi-precious stones; diamonds; watches; clocks; chronometers and chronoscopes; replacement parts for all the aforesaid goods.
DB SIGNATURE	IC 014: Precious metals and their alloys, namely, jewelry, imitation jewelry, gemstones; precious stones; semi-precious stones, diamonds, horological and chronometric instruments, namely, watches and clocks and parts thereof for all the aforementioned goods.
DB STAR	IC 014: Precious metals and their alloys and goods in precious metals or coated therewith, namely, beverage glassware and dishes of precious metal, candle snuffers and candlesticks of precious metal, napkin 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 metals 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.
So DB	IC 014: Precious metals and their alloys and goods in precious metals or coated therewith, namely, beverage glassware and dishes of precious metal, candle snuffers and candlesticks of precious metal, napkin rings of precious metal, vases of precious metal, jewel cases of precious metal, statues of precious metal, rings,

(Word Mark: SO DB)

necklaces, bracelets, earrings, brooches, diadems made of precious metals or coated therewith, jewelry and imitation jewelry, gemstones, precious stones, semi-precious stones, diamonds, watches, clocks, horologic 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.

(iii) Similarity of established, likely-to-continue trade channels

39. De Beers and De Boulle both sell their DB branded jewelry at high-end retail stores. De Beers and De Boulle both advertise in national luxury goods and lifestyle media and the Internet. In addition, there is essentially complete overlap with the jewelry goods of the De Beers Marks and the De Boulle Marks. They pass through the same trade channels. Consumers are therefore likely to be confused by the use of similar marks on or in connection with goods and with services featuring or related to those goods. *See In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (BIGG’S for retail grocery and general merchandise store services held confusingly similar to BIGGS for furniture); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE (stylized) for retail women’s clothing store services and clothing held likely to be confused with CREST CAREER IMAGES (stylized) for uniforms); *In re United Service Distributors, Inc.*, 229 USPQ 237 (TTAB 1986) (design for distributorship services in the field of health and beauty aids held likely to be confused with design for skin cream); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB for various items of men’s, boys’, girls’ and women’s clothing held likely to be confused with THE “21” CLUB (stylized) for restaurant services and towels); *Steelcase Inc. v. Steelcare*

Inc., 219 USPQ 433 (TTAB 1983) (STEELCARE INC. for refinishing of furniture, office furniture, and machinery held likely to be confused with STEELCASE for office furniture and accessories); *Mack Trucks, Inc. v. Huskie Freightways, Inc.*, 177 USPQ 32 (TTAB 1972) (use of similar marks for trucking services and on motor trucks and busses is likely to cause confusion).

(iv) Conditions under which and buyers to whom sales are made,
i.e. “impulse” vs. careful sophisticated purchasing

40. Case law deemphasizes significance of sophistication of consumers when marks and associated goods are highly similar/identical. *Source Serv. Cop. V. Source Telecomputing*, 635 F. Supp. 600, 616 (N.D. Ill. 1986) (“Where marks are identical, of course, sophistication as a factor in determining likelihood of confusion is less significant”).

41. Moreover, a trademark violation occurs with initial interest confusion even if sophisticated customers eventually discover that the applicant is not related to the opposer. *Porsche Cars North America, Inc. v. Manny’s Porshop, Inc.*, 972 F. Supp. 1128 (N.D. Ill. 1997).

42. The DB branded jewelry is being purchased by customers with concern and knowledge of the value, grade, and quality of the actual goods. To these customers, trust and brand identification is also an important part of the buying decision. *Boulle Affidavit* ¶ 5.

43. Given that trust and brand identification is so important to the purchaser, a likelihood of confusion with regard to the De Beers Marks and the prior De Boulle Marks could be significantly harmful to De Boulle if potential confusion exists as to an affiliation, sponsorship, or relation of the De Boulle Marks to De Beers.

(v) Fame of the prior mark (sales, advertising, length of use)

44. De Boule has marketed and sold diamonds, fine jewelry and timepieces to the general public in Dallas, Texas, and elsewhere in the United States in association with the brand De Boule for almost twenty-five (25) years. Over the years De Boule has grown to become one of the premier independently owned jewelers in the United States.

45. In light of the prior legal troubles of The De Beers Group in the United States, there is a degree of infamy and, in some sectors, significant ill will associated with De Beers and its brand.

46. Accordingly, to the extent confusion were to arise, the confusion would be particularly harmful to De Boule. The significant goodwill associated with De Boule and its marks could be significantly harmed by potential confusion as to an affiliation, sponsorship, or relation to De Beers generated by the De Beers Marks.

(vi) The extent of potential confusion, i.e., whether *de minimis* or substantial.

47. Brand identity is a significant component of the value of expensive, luxury items such as the jewelry items and retail services at issue. Accordingly, to the extent confusion will be created by the marks, it is likely to significantly affect De Boule's ability to continue to generate goodwill in the De Boule Marks. Even if just initial interest confusion arises that can be negated by further research by purchasers, such confusion may be enough to influence consumer decisions about jewelry purchases. *See Porsche Cars North America, Inc. v. Manny's Porshop, Inc.*, 972 F. Supp. 1128 (N.D. Ill. 1997) ("Even if sophisticated consumers eventually

discover that defendant is not related to plaintiffs, a trademark violation can exist simply from the initial confusion.”); *Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons*, 365 F. Supp 707 (2d Cir. 1975) (finding initial interest confusion actionable between “GROTRIAN-STEINWEG” and “STEINWAY” marks).

48. Accordingly, the effect of the potential confusion, regardless of how widespread, is likely to be substantial.

(c) Conclusion

49. The foregoing analysis of the undisputed Summary Judgment Evidence establishes as a matter of law that, given the significant similarities in the respective marks’ appearances and commercial impression, the overlap of the goods associated with both the De Beers Marks and the prior De Boule Marks, the similarities in the trade channels, and the significant harm to the goodwill of the De Boule Marks that De Boule could experience as a result of confusion in the marketplace, confusion is likely to arise with the co-existence of the De Boule Marks and the De Beers Marks on the register, under the factors prescribed in *In re E.I. du Pont de Nemours & Co.*

Summary judgment is accordingly appropriate and De Boule’s opposition should be granted.

VI.

PRAYER

De Boule Diamond & Jewelry, Inc., Opposer, prays that, upon consideration of the facts and authorities set forth herein, the Board enter an Order granting its Oppositions in all respects, denying registration of each of the De Beers Marks, and granting it such other and further relief at law and in equity to which Opposer may show himself justly entitled

This the 7th day of August, 2007.

Respectfully submitted,



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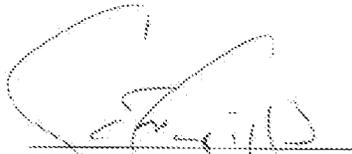
CERTIFICATE OF SERVICE

The undersigned hereby certifies that he has served a copy of the foregoing document upon counsel of record by electronic mail on this the 9th day of August, 2007, and by mailing a true copy thereof with the Exhibits referenced herein, through the United States Mail, first class, postage prepaid, on the 10th day of August, 2007, and addressed as follows:

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Scott T. Griggs

Exhibits

- Exhibit “A” All That Glitters. Dallas Business Journal. July 1997
- Exhibit “B” De Beers Consolidated Mines Limited/ De Beers Centenary AG Joint Media Release, dated 16 January 2001
- Exhibit “C” Abstracts from: Technical & Financial Report for the Diamond Interests of De Beers and its Partners: Appendix 2 to the Circular to the holders of De Beers Linked Units, posted 10 April 2001
- Exhibit “D” De Beers 2003 Annual Review.
- Exhibit “E” Debora Spar and Jennifer Burns. Forever: De Beers and U.S. Antitrust Law. Harvard Business Review. Feb 1, 2000 (Revised Sept 6, 2002).
- Exhibit “F” Lucinda Saunders. Rich and Rare are the Gems They War: Holding De Beers Accountable for Trading Conflict Diamonds. 24 Fordham Int’l L.J. 1402.
- Exhibit “G-1” Indictment in Case No. CR -2-94-019, United States District Court for the Southern District of Ohio, Eastern Division.
- Exhibit “G-2” Plea Agreement in Case No. CR -2-94-019, United States District Court for the Southern District of Ohio, Eastern Division.
- Exhibit “G-3” Courtroom Minutes. Guilty Plea and Sentencing Hearing. Case No. CR -2-94-019, United States District Court for the Southern District of Ohio, Eastern Division.
- Exhibit “H” De Beers Société Anonyme Media Release dated November 30, 2005
- Exhibit “I” Ron Irvin. Is De Beers forever? BrandChannel.com. November 22, 2004.
- Exhibit “J” Opposing Words Mark De Beers LV Opening. Rapaport News. June 23, 2005.
- Exhibit “K” Examples of De Boule National Advertising