

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451**

MBA

Mailed: May 20, 2008

Opposition No. 91162370
Opposition No. 91162469
Opposition No. 91164615
Opposition No. 91165285
Opposition No. 91165465

De Boulle Diamond & Jewelry,
Inc.

v.

De Beers LV Ltd.

**Before Hohein, Holtzman and Mermelstein, Administrative
Trademark Judges**

By the Board:

De Beers LV Ltd. ("applicant") seeks to register the marks DB MONOGRAM¹, DB SIGNATURE², DB STAR³, DB LOGO⁴ and the mark shown below

¹ Application Serial No. 78245779, filed May 5, 2003 under Section 44(e), for "Precious metals and their alloys and goods 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 of the aforesaid goods."

² Application Serial No. 78245210, filed May 2, 2003 under Section 44(e), for goods similar, and in some cases identical, to those identified in the application for registration of DB MONOGRAM.

³ Application Serial No. 78245795, filed May 5, 2003 under Section 44(e), for goods similar, and in some cases identical, to those identified in the application for registration of DB MONOGRAM.

So DB⁵

for jewelry and related products ("Applicant's Marks").
Registration is opposed by De Boulle Diamond & Jewelry, Inc.
("opposer").

As grounds for opposition, opposer alleges in each of the above-referenced and consolidated notices of opposition that: (1) use of Applicant's Marks on the identified goods would lead to a likelihood of confusion in view of opposer's registered mark, shown below



which is used and registered for jewelry and related products, and that opposer has priority of use; and (2) use of Applicant's Marks "would cause dilution of the distinctive quality" of opposer's mark. In addition, in

⁴ Application Serial No. 78245219, filed May 2, 2003 under Section 44(e), for goods similar, and in some cases identical, to those identified in the application for registration of DB MONOGRAM.

⁵ Application Serial No. 79000478, filed November 25, 2003 under Section 66(a), for goods similar, and in some cases identical, to those identified in the application for registration of DB MONOGRAM.

⁶ Registration No. 3078627, issued April 11, 2006, based on a date of first use in commerce of June 30, 2001, for "Jewelry, diamonds, watches and timepieces;" "Fine art, namely, paintings;" and "Retail jewelry store services; mail order and electronic catalogue services featuring jewelry."

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Opposition Nos. 91164615, 91165285 and 91165465 (but not Opposition Nos. 91162370 or 91162469), opposer alleges that use of Applicant's Marks on the identified goods would lead to a likelihood of confusion with and is likely to dilute opposer's alleged mark, DB, which opposer claims to have first used in commerce "at least as early as December 31, 2000⁷," and for which opposer owns a pending application.⁸

Applicant, in its answers, denies the salient allegations in the notices of opposition.

This case now comes up for consideration of: (1) opposer's motion, filed August 9, 2007, seeking summary judgment on its likelihood of confusion claims based, in part, on an unpleaded registration for the mark DE BOULLE⁹; (2) applicant's cross-motion, filed January 4, 2008, seeking partial summary judgment in its favor on opposer's likelihood of confusion claims with respect to opposer's pleaded registration and opposer's nonpleaded DE BOULLE registration; (3) applicant's motion, filed January 4, 2008,

⁷ The notices of opposition include this alleged date of first use in Opposition Nos. 91165285 and 91165465, but not Opposition No. 91164615.

⁸ Application Serial No. 78604056, filed April 7, 2005, based on an alleged date of first use in commerce of December 31, 2000, for the same goods identified in Registration No. 3078627, except for "fine art."

⁹ Registration No. 3078625, issued April 11, 2006, based on a date of first use in commerce of December 31, 1989, for goods and services identical to those identified in opposer's pleaded registration. Although opposer did not plead this registration in any of its notices of opposition, it seeks summary judgment based, in part, on this registration.

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to strike portions of the Affidavit of Denis J. Boulle ("Boulle Aff.") submitted in support of opposer's motion; and (4) opposer's motion, filed February 4, 2008, to strike the Declaration of Hamida Belkadi ("Belkadi Dec.") submitted in support of applicant's cross-motion. Each motion is fully briefed and ready for decision.

Summary judgment is only appropriate where there are no genuine issues of material fact in dispute, thus allowing the case to be resolved as a matter of law. Fed. R. Civ. P. 56(c). The party seeking summary judgment bears the initial burden of demonstrating the absence of any genuine issue of material fact. See Celotex Corp. v. Catrett, 477 U.S. 317, 323 (1986); Sweats Fashions, Inc. v. Pannill Knitting Co. Inc., 833 F.2d 1560, 4 USPQ2d 1793, 1796 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. See Opryland USA Inc. v. Great American Music Show Inc., 970 F.2d 847, 850, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); Olde Tyme Foods, Inc. v. Roundy's, Inc., 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

The evidence on summary judgment must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. Lloyd's Food Products, Inc. v. Eli's, Inc., 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); Opryland USA, supra.

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The Board may not resolve issues of material fact; it may only ascertain whether issues of material fact exist. See Lloyd's Food Products, 987 F.2d at 766, 25 USPQ2d at 2029; Olde Tyme Foods, 961 F.2d at 200, 22 USPQ2d at 1542.

Before addressing the parties' motions for summary judgment, we must first address their motions to strike.

Motions to Strike

The parties' motions to strike are both denied. Applicant moves to strike Paragraphs 12-14 of Mr. Boulle's affidavit, which contain conclusions on the ultimate issue to be decided, i.e. likelihood of confusion. The Board must reach this decision based on the evidence submitted, regardless of the opinions of either party. Accordingly, these statements have not been considered although striking them is unnecessary.

Opposer moves to strike the entire Belkadi Declaration, but opposer's objections thereto, to the extent the Declaration has been considered, go to the weight, rather than admissibility, of the evidence. Opposer's motion to strike applicant's cross-motion because applicant does not "have any claims for affirmative relief on file" is also denied, because applicant is seeking judgment on opposer's claims, not its own.

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Motions for Summary Judgment

Turning first to opposer's motion for summary judgment on its likelihood of confusion claims, on the record presented we find that there are genuine issues of material fact remaining for trial. Specifically, with respect to opposer's registrations, pleaded and unpleaded, we find that at a minimum, genuine issues of material fact exist as to the similarity of the marks in opposer's registrations and applicant's applications, and as to their overall commercial impression.

With respect to opposer's alleged mark DB, we find, at a minimum, that genuine issues of material fact exist as to whether opposer has priority. In support of its claim of trademark rights in the mark DB, opposer submitted an affidavit which states:

In or about December 2000, as part of the design of its Web site, [opposer] designed the mark "DB" Since that time, [opposer] has used the DB Mark in association with the fine jewelry, diamonds, and timepieces sold to the general public throughout the United States on the Web site. The DB Mark is also contained on packaging delivered and shipped with [opposer's] products to clients in Dallas, Texas and elsewhere in the United States.

Boulle Aff. ¶ 8. Opposer does not claim, however, and there is no evidence, that the mark DB has been used on opposer's jewelry or related products, or on the packaging for jewelry or related products.

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Most importantly, there is no evidence (such as bills of sale, shipping manifests, or the like) of the date on which opposer alleges the mark DB was first used on jewelry or related products. Because we must consider opposer's affidavit in the light most favorable to applicant, we cannot find, on summary judgment, that opposer's vague and unsupported statement demonstrates that opposer has priority with respect to the alleged mark DB.¹⁰ Opposer's evidence seems to be an attempt to establish "use analogous to trademark use," but does not meet the requirements thereof, i.e. by establishing that, although the mark is not technically used as a trademark, the alleged use "is of such a nature and extent as to create public identification of the target term with the opposer's product or service." T.A.B. Systems v. PacTel Teletrac, 77 F.3d 1372, 37 USPQ2d 1879, 1881-84 (Fed. Cir. 1996).

Turning next to applicant's cross-motion for partial summary judgment that there is no likelihood of confusion between the marks in opposer's pleaded and unpleaded registrations and applicant's marks, on the record presented we find that there are genuine issues of material fact remaining for trial. At a minimum, genuine issues of

¹⁰ We note also that the specimens of use of the mark DB originally submitted with opposer's application for registration of this mark were found to be "unacceptable as evidence of actual trademark use," in an office action issued November 3, 2005.

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material fact exist as to whether the marks in opposer's registrations and applicant's applications are so similar in overall commercial impression that their use would give rise to a likelihood of confusion.¹¹

Other Issues

The parties' motions raise two subsidiary issues. First, it appears that opposer is the plaintiff in a civil action seeking partial cancellation of a third party registration.¹² It appears that the civil action could be relevant to these proceedings, and accordingly opposer is ordered to notify the Board within thirty days of any claim, disposition or resolution of the civil action which may have a bearing on these proceedings.

Second, to the extent opposer seeks to rely in any of these consolidated opposition proceedings on its unpleaded DE BOULLE registration, or on its alleged mark DB, it must seek leave to amend any of its notices of opposition in

¹¹ The parties should note that the evidence submitted in connection with the motions for summary judgment is of record only for consideration of those motions. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. See, Levi Strauss & Co. v. R. Josephs Sportswear Inc., 28 USPQ2d 1464 (TTAB 1993); Pet Inc. v. Bassetti, 219 USPQ 911 (TTAB (1993); American Meat Institute v. Horace W. Longacre, Inc., 211 USPQ 712 (TTAB 1981). Furthermore, the fact that we have identified certain genuine issues of material fact sufficient to deny the parties' motions should not be construed as a finding that these are necessarily the only issues which remain for trial.

¹² De Boulle Diamond & Jewelry, Inc. v. Colibri Corp., Civil Action No. 3:06-CV-00794-M, pending in the U.S. District Court for the Northern District of Texas.

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which these marks are not currently pled. Judgment may not be entered on an unpleaded claim. See TBMP § 314 (2d ed. rev. 2004).

Conclusion

The parties motions for summary judgment and motions to strike are all **DENIED**. Proceedings herein are resumed, and discovery and trial dates are reset as follows:

Discovery Period to Close:	CLOSED
30-day testimony period for party in position of plaintiff to close:	July 16, 2008
30-day testimony period for party in position of defendant to close:	September 14, 2008
15-day rebuttal testimony period to close:	October 29, 2008

News from the TTAB

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>

http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to

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supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>
