

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing:
December 17, 2014

Mailed:
December 22, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Baccarat, S.A.
v.
Northeastern Distributors, Inc.

—
Opposition No. 91194574

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Stephen G. Janoski and Steven A. Straub of Roylance, Abrams, Berdo & Goodman,
LLP for Baccarat, S.A.

Louis R. Gigliotti of Louis R. Gigliotti, PA for Northeastern Distributors, Inc.

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Before Quinn, Cataldo and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Northeastern Distributors, Inc. (“Applicant”) filed an intent-to-use application for the mark BACCARA, shown below, on the Principal Register for “bottled water,” in Class 32.¹

BACCARA

¹ Serial No. 77655391, filed January 23, 2009. Applicant claims the color blue as a feature of the mark.

Baccarat, S.A. (“Opposer”) filed a notice of opposition against the registration of Applicant’s mark on the grounds of likelihood of confusion pursuant to Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), dilution by blurring and tarnishment under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c), and that Applicant’s mark falsely suggests a connection with Opposer pursuant to Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a). Opposer pleaded ownership of 12 registrations for some variation of the name BACCARAT including the registrations listed below:

1. Registration No. 1406761 for the mark BACCARAT, shown below, for “crystal and glassware, namely glasses, bottles, containers, cups, decanters, and vases,” in Class 21;²



2. Registration No. 1144212 for the mark BACCARAT, in typed drawing form, for “glass service comprising water, wine, champagne and aperitif goblets and glasses, jugs and decanters,” in Class 21.³

² Issued August 26, 1986; renewed.

³ Issued December 23, 1980; second renewal. Prior to November 2, 2003, “standard character” drawings were known as “typed” drawings. A typed mark is the legal equivalent of a standard character mark. TMEP § 807.03(i) (April 2014).

In view of our decision in this case, the details of the other registrations need not be set out because the above-noted registrations are the focus of the testimony and evidence.

Applicant, in its Answer, denied the salient allegations in the Notice of Opposition.

I. Evidentiary Issue

In its brief, Applicant attached evidence not otherwise made of record during Applicant's testimony period. Evidence not filed in compliance with the rules of practice governing opposition proceedings before the Board will not be considered. *See Swiss Watch Int'l Inc. v. Fed'n of the Swiss Watch Indus.*, 101 USPQ2d 1731, 1734-35 (TTAB 2012) (declaration and exhibits submitted with brief not an acceptable way to make evidence of record and materials are not treated as stipulated in view of objection and because defendant would not have stipulated to consideration of the materials if it could not provide information in response to the materials); *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1846 n.8 (TTAB 2004) (materials submitted outside of applicant's assigned testimony period and which failed to comply with the Board's evidentiary rules given no consideration); *The Maytag Co. v. Luskis's, Inc.*, 228 USPQ 747, 748 (TTAB 1986) (twenty-nine registrations listed in appendix to brief not considered because their listing was not in compliance with rules of practice). Because the evidence attached to the brief was not timely filed, we have not given it any consideration. *See* TBMP § 704.05(b) (2014).

II. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant's application file. The parties stipulated that the testimony of witnesses may be introduced by affidavit.⁴ See Trademark Rule 2.123(b), 37 CFR § 2.123(b). The parties introduced the following testimony and evidence:

A. Opposer's testimony and evidence.

1. Opposer's first notice of reliance comprising printouts from the electronic database records of the USPTO showing current status and title of Opposer's pleaded registrations;⁵

2. Opposer's second notice of reliance on copies of third-party registrations for marks identifying both glassware and water and third-party registrations identifying retail store services featuring the sales of glassware and water;⁶

3. Opposer's third notice of reliance on copies of decisions from tribunals involving domain name disputes;⁷

4. Opposer's fourth notice of reliance on copies of newspaper articles;⁸

⁴ 40 TTABVUE. Citations to the record will be to TTABVUE, the docket history system for the Trademark Trial and Appeal Board. See *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

⁵ 46 – 49 and 69 TTABVUE.

⁶ 50 TTABVUE.

⁷ 51 TTABVUE.

⁸ 52 – 54 TTABVUE.

5. Opposer's fifth notice of reliance on information from printed publications, including but not limited to dictionaries and encyclopedias;⁹

6. Opposer's sixth notice of reliance on advertisements published in magazines in general circulation;¹⁰

7. Opposer's seventh notice of reliance on third-party websites, submitted pursuant to *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010) ("if a document obtained from the Internet identifies its date of publication or date that it was accessed and printed, and its source (*e.g.*, the URL), it may be admitted into evidence pursuant to a notice of reliance in the same manner as a printed publication in general circulation in accordance with Trademark Rule 2.122(e).") purportedly to show the history and strength of Opposer's marks, sales and variety of products sold under the marks;¹¹

8. Testimony affidavit of Michelle Klein, President and CEO of Baccarat, Inc., a wholly-owned subsidiary of Opposer, with attached exhibits;¹²

9. Testimony affidavit of Michaela Lerch, Director and Curator of the Baccarat Museum, with attached exhibits;¹³

10. Testimony affidavit of Hervé Camournac, Deputy Managing Director and CFO of Opposer, with attached exhibits;¹⁴

⁹ 55 – 67 and 72 TTABVUE.

¹⁰ 71 and 74 TTABVUE. These are duplicate entries.

¹¹ 70, 73 and 75 TTABVUE.

¹² 80 TTABVUE.

¹³ 81 TTABVUE.

¹⁴ 82 TTABVUE.

11. Testimony affidavit of Markus Lampe, President and CEO of Opposer, with attached exhibits;¹⁵

12. Rebuttal testimony affidavit of Michelle Klein with attached exhibits;¹⁶ and

13. Opposer's eighth notice of reliance on excerpts from Internet websites including dictionary definitions and third-party websites purportedly to show that water is sold in bottles and the fame and strength of Opposer's marks.¹⁷

B. Applicant's testimony and evidence.

1. Notice of reliance on documents retrieved from the Internet;¹⁸

2. Testimony affidavit of Robert Gielchinsky, Applicant's Director of Operations, with attached exhibits;¹⁹ and

3. Testimony affidavit of Jordan Gielchinsky, President and CEO of Applicant, with attached exhibits.²⁰

III. Standing

Because Opposer has properly made of record its pleaded registrations, Opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

¹⁵ 83 TTABVUE.

¹⁶ 104 TTABVUE.

¹⁷ 105 TTABVUE.

¹⁸ 97 TTABVUE.

¹⁹ 98 TTABVUE 2 – 22.

²⁰ 98 TTABVUE 23 – 43.

IV. Priority

Because Opposer has properly made of record its pleaded registrations, Section 2(d) priority is not an issue in the opposition as to the marks and the goods covered by the pleaded registrations. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

V. Likelihood of Confusion

Our determination 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).

A. The fame of Opposer's marks.

Opposer contends that the BACCARAT marks in its pleaded registrations are famous.²¹ Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

²¹ 81 TTABVUE 7 – 8.

Fame may be measured indirectly by the volume of sales and advertising expenditures of the goods and services identified by the marks at issue, “the length of time those indicia of commercial awareness have been evident,” widespread critical assessments and through notice by independent sources of the products identified by the marks, as well as the general reputation of the products and services. *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1305-1306 and 1309. Although raw numbers of product sales and advertising expenses may have sufficed in the past to prove fame of a mark, raw numbers alone may be misleading. Some context in which to place raw statistics may be necessary (*e.g.*, the substantiality of the sales or advertising figures for comparable types of products or services). *Id.* at 1309.

Finally, because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

Based on the evidence and testimony set forth below, we find that Opposer’s BACCARAT mark is famous for crystal and glassware. The following testimony and evidence establishes the fame of the BACCARAT mark:

1. Opposer began producing glass products at least as early as October 16, 1764 when King Louis XV authorized the Bishop of Metz to create a glassworks in the town of Baccarat, France.²²

2. “Since the early 1800’s, [Opposer’s] crystal wares have been entered and exhibited in national and international expositions, including World’s Fairs to promote the progress of [Opposer’s] craftsmanship and design.”²³ For example, Opposer won the “High Prize” at the 1904 Universal Exposition in St. Louis, Missouri, Opposer was an exhibitor at the 1939 World’s Fair in New York City, Opposer was awarded the 1979 Neiman Marcus Fashion Award, and Opposer was awarded the 1989 International Table Top Award for Design held in Dallas, Texas;²⁴

3. “Based on current and historical data for sales of crystal wares, including tableware, stemware, barware, and crystal products for the home including bottles, perfume bottles, carafes, pitchers, decanters, vases, statues, sculptures, and figurines, [Opposer] has 13% U.S. market share among modestly priced goods.”²⁵ For example, from 2000 through 2010, Opposer’s sales of products identified by Opposer’s marks generated revenues of \$308,954,000 in the United

²² 77 TTABVUE 3.

²³ 77 TTABVUE 7.

²⁴ 77 TTABVUE 9 – 10.

²⁵ 76 TTABVUE 5.

States. In 2011, Opposer's sales in the United States for products identified by Opposer's marks generated revenues of \$22,119,000;²⁶

4. From 2005 through 2010, Opposer spent \$18,430,000 in the United States advertising products identified by its BACCARAT marks.²⁷ In 2011, Opposer spent \$2,777,000 in the United States advertising the products identified by its BACCARAT marks.²⁸ Opposer advertises in newspapers such as the *New York Times* and magazines such as *Vanity Fair*, *Harper's Bazaar*, and *Elle*;²⁹

5. Opposer has received significant unsolicited media attention noting the fame and/or renown of its BACCARAT branded products.³⁰ The following excerpts are representative:

a. *Boston Globe* (October 17, 1982)

A Tale of Rue de Paradis for Shoppers, Browsers
This Paris Street Should Not Be Missed

* * *

CIAT is but the beginning, for Rue de Paradis is both showroom and museum ... the most famous of all being Bacarrat, next door in the Courtyard.

Often called the crystal of kings, Baccarat's respect for beauty of substance and form has gained a clientele consisting of almost all the royal houses of the 19th century, as well as many of the best known political and social figures of the 20th century.

²⁶ 78 TTABVUE 3.

²⁷ 78 TTABVUE 4.

²⁸ 78 TTABVUE 3.

²⁹ 78 TTABVUE 4.

³⁰ 52 – 54 TTABVUE.

* * *

Founded in 1765 at Baccarat, then a small town of some 600 people near Nancy, the company and town continue to grow as one. The company now employs 12,000, 21 of them honored by the president of France as Meilleur de France – the finest in their trade.³¹

b. *Philadelphia Inquirer* (January 27, 1985)

Huge Vase Made in Phila. Is The Object Of A Search

* * *

Spillman hopes to borrow the glass, the work of such famous glass firms as Thomas Webb & Co. of England, Baccarat and St. Louis of France, Lobmeyr of Vienna and Libbey and Tiffany of the United States, from American and European museums and from private collections.³²

c. *Denver Rocky Mountain News* (December 21, 1989)

Last-Minute Gift Ideas Abound Diamonds, Gold Glitter For Christmas

* * *

Collectible ornaments. Crystal and silver tree ornaments in the shapes of festive symbols make excellent stocking stuffers. Available from famous makers, such as Lalique, Baccarat, Orrefors, Daum and Kosta Boda.³³

d. *Palm Beach Post* (June 24, 1990)

Going, Going, Gone: Centrust Treasure Lures Gold Diggers

* * *

Before Saturday's auction, specialists predicted lively interest in Baccarat crystal, with perhaps slightly less

³¹ 52 TTABVUE 9 – 14.

³² 52 TTABVUE 16 – 18.

³³ 52 TTABVUE 35 – 37.

clamor for the Limoges china. That assessment turned out to be about right.

“Baccarat is grade A in the crystal world,” said Ellen Jones, assistant vice president for Christie’s, a London-based auction house with offices in New York and Palm Beach. “It has a lovely weight and beautiful clear quality.”

For more than 200 years, Baccarat (pronounced bah-kah-rah) crystal, produced in the Lorraine region of France, has been associated with royalty and celebrity. Clients have included Louis XVIII of France, the emperor of Japan, Pope Benedict XV, the Aga Kahn and President Kennedy.³⁴

e. *Washington Post* (August 19, 2004)

Razzle-Dazzle ‘Em; In Paris, Baccarat Builds A Crystal Palace

While thousands throng the Eiffel Tower and the Louvre here each summer day, Parisians with a taste for the finer things in life are steering visitors to a less known, more exclusive destination in the swank 16th arrondissement: the new headquarters of French crystal company Baccarat.

Founded in 1764, Baccarat crystal is among France’s most prestigious exports. The crystal is sold at exclusive Baccarat boutiques around the world, as well as at high-end stores such as Neiman Marcus and Bloomingdale’s, where their elegant wine glasses start at about \$60 apiece and go up from there.³⁵

f. *Kansas City Star* (December 26, 2004)

Glass paperweights sell high

Although a heavy rock was surely the first paperweight, France can claim creation of the beautiful glass paperweights that are considered art.

³⁴ 52 TTABVUE 44- 48.

³⁵ 53 TTABVUE 3.

Famous glass houses of France, including Baccarat, Clichy and Saint Louis, started making paperweights in the mid-1800s, according to All About Paperweights (Paperweight Press) by Lawrence H. Selman.

Baccarat is the best-known maker of paperweights.³⁶

g. *Morning Call* (Allentown, PA) (May 27, 2006)

Little Shop of treasures ** Local Favorites ** Insider tips on exploring our area

Gabellini Design LLC, a little shop at the corner of Allen and Lafayette streets in Allentown, may seem modest. But open the door and you enter a world of design that spans centuries and styles.

In one corner is a tilt-top, circa 1830-60 table that Mr. and Mrs. Abraham Lincoln might have gotten as a wedding present. A modernistic Eames Chair, named for mid-20th century designers Charles and Ray Eames, sits comfortably near the front window.

And, then, there is the Baccarat crystal chandelier. Created in the 19th century by the famous French crystal maker, it was supposed to be hung in an international exhibit. But it was damaged slightly by a workman and was never put on display. Instead of gracing a royal court, (the last Russian czar, Nicholas II, bought hundreds like it for his many palaces), it glitters over a dining room in Gabellini's Allentown shop.³⁷

6. BACCARAT may be found in some dictionaries. For example, WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY OF THE ENGLISH LANGUAGE UNABRIDGED (1993) has the entry for "baccarat glass" set forth below:

³⁶ 53 TTABVUE 11.

³⁷ 53 TTABVUE 46.

[fr. Baccarat, a trademark]: fine blown, molded, and cut glass made at Baccarat, France, from 1765 to the present time.³⁸

See also **THE WORLD BOOK DICTIONARY** (1996) defining “baccarat” as “fine crystal made at Baccarat, France.”³⁹

“When a trademark attains dictionary recognition as part of the language, we take it to be reasonably famous.” *B.V.D. Licensing Corp. v. Body Action Design, Inc.*, 846 F.2d 727, 6 USPQ2d 1719, 1720 (Fed. Cir. 1988).

While having established that Opposer’s mark BACCARAT is famous for crystal and glassware for purposes of likelihood of confusion, this fact alone is not enough to prove likelihood of confusion. As the Board explained in *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d 1811, 1819 (TTAB 2005), *rev’d on other grounds*, Civil Action No. 05-2037 (D.D.C. April 3, 2008):

If that were the case, having a famous mark would entitle the owner to a right in gross, and that is against the principles of trademark law. *See University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505, 507 (Fed. Cir. 1983):

The fame of the [plaintiff’s] name is insufficient in itself to establish likelihood of confusion under § 2(d). “Likely* * * to cause confusion” means more than the likelihood that the public will recall a famous mark on seeing the same mark used by another. It must also be established that there is a reasonable basis for the public to attribute the

³⁸ 56 TTABVUE 7 – 9.

³⁹ 56 TTABVUE 11 – 13. See also **THE WORLD BOOK ENCYCLOPEDIA** (1990) with an entry for “Baccarat glass” as “[t]he glass works at Baccarat, France, produced some of the best cut glass made in Europe in the 1800’s” (56 TTABVUE 15 – 17); and *Encyclopedia.com* (September 9, 2011) (“The name Baccarat has become nearly synonymous with luxury. For more than 200 years, the company has produced and distributed some of the world’s finest luxury crystal.”). 56 TTABVUE 124.

particular product or service of another to the source of the goods or services associated with the famous mark. To hold otherwise would result in recognizing a right in gross, which is contrary to principles of trademark law and to concepts embodied in 15 USC § 1052(d).

See also Recot Inc. v. M.C. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“fame alone cannot overwhelm the other du Pont factors as a matter of law”).

- B. The similarity or dissimilarity of the marks in their entirety in terms of 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 entirety as to appearance, sound, connotation and commercial impression. *In re E.I. du Pont De Nemours & Co.*, 177 USPQ at 567. Each of these characteristics of a mark must be considered. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (appearance, sound, meaning and commercial impression are separate factors bearing on the ultimate conclusion of whether marks are, overall, similar). The similarity of the marks in regard to one of these factors can be critical to a finding of similarity. *See TBC Corp. v. Holsa Inc.*, 126 F.3d 1470, 44 USPQ2d 1315, 1318 (Fed. Cir. 1997) (phonetic similarity may be critical when goods are advertised via radio or when business is done by telephone). *See also In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111, 113 (Fed. Cir. 1983) (“the PTO may reject an application ex parte solely because of similarity in meaning of the mark sought to be registered with a previously registered mark”); *but see Bost Bakery, Inc. v. Roland Industries, Inc.*, 216 USPQ 799, 801 (TTAB 1991) (“the principle that similarity between marks in meaning or commercial significance

alone may be sufficient to create a likelihood of confusion is applicable primarily to situations where marks are coined or arbitrary rather than highly suggestive.”) However, the law does not counsel that similarity in one factor alone automatically results in a finding that the marks are similar. *See Coach Servs. Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600, 1609 (TTAB 2010), *aff’d*, 668 F.3d 1356, 101 USPQ2d 1713 (Fed. Cir. 2012).

In comparing the marks, we are mindful that “[t]he proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1721 (citation omitted). *See also 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 USPQ2d 1735, 1741 (TTAB 1991), *aff’d mem.*, 972 F.2d 1353 (Fed. Cir. June 5, 1992).

We find that Applicant’s mark is similar in appearance to both of Opposer’s marks. While Applicant’s mark is presented in a stylized format, one of the marks in Opposer’s pleaded registrations, noted above, is in typed drawing form. Marks presented in typed or standard character form are not limited to any particular depiction. The rights associated with a mark in typed or standard characters reside in the wording and not in any particular display. *In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909-11 (Fed. Cir. 2012); *Squirtco v. Tomy Corp.*, 697 F.2d 1038,

216 USPQ 937, 939 (Fed. Cir. 1983); *In re RSI Systems, LLC*, 88 USPQ2d 1445, 1448 (TTAB 2008); *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988). Thus, we must consider the possibility that Opposer may choose to display its mark in a manner similar to Applicant's mark.

With respect to a comparison of Opposer's stylized BACCARAT mark  and Applicant's mark , neither mark is so highly stylized that, when considering the fame of Opposer's marks, the special form displays do not serve to distinguish the overall visual similarities of the marks because we focus on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks.⁴⁰ See *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012). This is especially true in this case where Opposer's marks are famous and they are accorded a greater scope of protection or exclusivity of use. See *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 218 USPQ 1281, 1284 (Fed. Cir. 1984) (fame important to likelihood of confusion inquiry because public may exercise less care in purchasing product under a famous name).

⁴⁰ Amazon.com advertised the sale of, *inter alia*, BACCARAT crystal tumblers for \$88, a crystal paperweight for \$59 (used), and a crystal brandy glass for \$50 (56 TTABVUE 128 – 130); the BLOOMINGDALES website (bloomingle.com) advertised the sale of different BACCARAT products such as “Intangible Horizon” barware for \$50- \$510, a nut plate for \$60, and an Arabesque bowl for \$80 (56 TTABVUE 132 – 133); and the MACYS website (macys.com) advertised the sale of a BACCARAT crystal bowl for \$90, a diamond-shaped serving platter for \$70, and highball glasses for \$50 (56 TTABVUE 139 – 140). Even though BACCARAT products at the low end of Opposer's product line are relatively expensive, they are not so expensive as to be out of the reach of ordinary consumers who retain only a general rather than a specific impression of trademarks and who are looking to purchase such products as a status symbol or special gift.

Famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark. *See Kenner Parker*, 963 F.2d at 352, 22 USPQ2d at 1455-56. For this reason, this court emphasizes:

When an opposer's trademark is a strong, famous mark, it can never be “of little consequence.” The fame of a trademark may affect the likelihood purchasers will be confused inasmuch as less care may be taken in purchasing a product under a famous name.

Specialty Brands, Inc. v. Coffee Bean Distribs., Inc., 748 F.2d 669, 675, 218 USPQ 1281, 1284 (Fed. Cir. 1984).

Recot Inc. v. M.C. Becton, 54 USPQ2d at 1897.

“In reality ... [w]hat happens is that a purchaser is less likely to *perceive* differences from a famous mark. All that is needed is a suggestion of such mark to trigger a mental perception that it *is* the famous mark. Purchasers simply do not take the time to study the marks and see the differences. Nor are they expected to.” *B.V.D. Licensing Corp. v. Body Action Design, Inc.*, 6 USPQ2d at 1722 (Nies, J., dissenting), *quoted in Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 22 USPQ2d at 1456 (emphasis in the original).

With the exception of Applicant's special form display of its mark, the only other difference between the marks is that Opposer's mark includes the letter “t” at the end: BACCARAT v. BACCARA. Such slight differences in marks do not normally create dissimilar marks. *In re Great Lakes Canning, Inc.*, 227 USPQ 483, 485 (TTAB 1985) (“Moreover, although there are certain differences between the [marks' CAYNA and CANA] appearance, namely, the inclusion of the letter ‘Y’ and the design feature in applicant's mark, there are also obvious similarities between

them. Considering the similarities between the marks in sound and appearance, and taking into account the normal fallibility of human memory over a period of time (a factor that becomes important if a purchaser encounters one of these products and some weeks, months, or even years later comes across the other), we believe that the marks create substantially similar commercial impressions”). *See also United States Mineral Products Co. v. GAF Corp.*, 197 USPQ 301, 306 (TTAB 1977) (“‘AFCO’ and ‘CAFCO,’ which differ only as to the letter ‘C’ in USM’s mark, are substantially similar in appearance and sound”); *In re Bear Brand Hosiery Co.*, 194 USPQ 444, 445 (TTAB 1977) (“The mark of the applicant, ‘KIKS’ and the cited mark ‘KIKI’ differ only in the terminal letter of each mark. While differing in sound, the marks are similar in appearance and have a somewhat similar connotation”). Consumers may misread BACCARA in a quick glance at the mark.

As to sound, it is well established that where, as here, the marks are not common words, there is no correct way for them to be pronounced. *Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1518 (TTAB 2009). *See also In re Microsoft Corp.*, 68 USPQ2d 1195 (TTAB 2003) (it is not possible to control how consumers will vocalize marks). Nevertheless, Opposer’s marks and Applicant’s mark are likely to have similar pronunciations. While Opposer’s BACCARAT mark could be pronounced as bǎk’ ə rat, it could also be pronounced bǎk’ ə rä⁴¹ while Applicant’s mark is likely to be pronounced as bǎk’ kǎ rä.

⁴¹ **Webster’s Third New International Dictionary of the English Language Unabridged** (1993). 56 TTABVUE 7 – 9. *See also The World Book Dictionary* (1996). 56 TTABVUE 11 – 13. The upside down “e” is a “schwa” and is pronounced “uh.” *Dictionary.com* derived from the **RANDOM HOUSE DICTIONARY** (2014). The Board may

As to the connotation of the marks, BACCARAT is a card game played in European casinos.⁴² The baccarat card game is also spelled baccara.⁴³ Thus, Opposer's mark is inherently distinctive when used in connection with Opposer's glassware. Likewise, we find that Applicant's mark calls to mind the baccarat card game because of the alternative spelling for the card game. Thus, we find that the marks have similar meanings and engender similar commercial impressions.

In view thereof, we find that the marks are similar in terms of appearance, sound, connotation and commercial impression.

C. The similarity or dissimilarity and the nature of the goods.

Applicant is seeking to register its mark for bottled water while Opposer has registered its mark for *inter alia* "crystal and glassware, namely glasses, bottles, containers, cups, decanters, and vases."


Opposer introduced copies of seven use-based, third-party registrations comprising both glassware and bottled water. Third-party registrations which individually cover a number of different goods that are based on use in commerce may have some probative value to the extent that they serve to suggest that the listed goods are of a type which may emanate from the same source. *In re Albert*

take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

⁴² **Webster's Third New International Dictionary of the English Language Unabridged** (1993). 56 TTABVUE 7 – 9. See also **The World Book Dictionary** (1996). 56 TTABVUE 11 – 13.

⁴³ *Id.*

Trostel & Sons Co., 29 USPQ2d 1783, 1785-86; *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).⁴⁴

Mark	Reg. No.	Goods
	3479148	Tableware and cutlery, baby bottles, glass or earthenware, namely, dishes, platters, plates, bowls, cups saucers, tumblers and drinking glasses, serving pitchers, water bottles sold empty and bottled water
SEATTLE'S BEST COFFEE	3808575	Beverage glassware; bottled waters
H•BLUE•O	3825811	Bottles sold empty; bottled water
WE ARE	3871613	Beverageware, drinking mugs, drinking glasses, cups, drinking tumblers, water pitchers; bottled water
TINI	3918167	Beverage glassware; bottled water
BLACK HILLS	3955170	Glassware, namely, shot glasses, drinking glasses, drinking cups and drinking mugs; bottled water
GAMEWORKS	3968168	Beverage glassware, shot glasses, beer glasses, cups, water bottles; bottled water

Markus Lampe, Opposer's President and CEO, described Opposer's product line in his testimony affidavit.

18. [Opposer] has a global customer base not just for the tablewares, but also for home including, sculptures, and other artistic designs that are to be displayed for their beauty or utilized for their purpose. Among the Baccarat goods that are collected for both their utility and artistry are stemware and bottles. [Opposer] has produced

⁴⁴ 50 TTABVUE 10 – 36. We did not include the entire description of goods for each registration. We have listed only the goods relevant to this proceeding.

We did not consider Registration No. 3436185 for the mark THE FUN YUM FRIENDS (50 TTABVUE 7) registered under Section 66 of the Trademark Act, 15 U.S.C. § 1141f, or Registration No. 3645460 for the mark comprising a man with a hard hat and checkered shirts (50 TTABVUE 13) and Registration No. 3688564 for the mark BROUGH SUPERIOR (50 TTABVUE 16) both registered under Section 44 of the Trademark Act, 15 U.S.C. § 1126, because none of these marks was registered on the basis of use in commerce under Section 1(a) of the Trademark Act.

hundreds of different shapes for decanters and drinking glasses. [Opposer's] glasses, bottles, pitchers, and decanters are designed for particular beverages, whether it hold [sic] water, wine, or any of the various spirits. ... Since 1900s, [Opposer] collaborates with some great Cognac companies such as HINE, CAMUS, CABASSE, REMY MARTIN, COURVOISIER, and DELAMIN for which [Opposer] has been producing special decanters in crystal to contain Cognac. ...

19. Further, since the 1800s [Opposer] has been producing bottles for perfumes sold by other parties. Some of the more prominent examples include Baccarat bottles for perfume sold by ELIZABETH ARDEN, CHRISTIAN DIOR, CARTIER, GUERLAINE, and VERSACE. ...

A respectable secondary market exists in trade for collectible Baccarat bottles from both the perfume and the spirits mentioned above.

20. Since the 1800s [Opposer] had been producing light fixtures, from small candlesticks, to elaborate candelabras, and from small table lamps to giant chandeliers. ...

21. Since 1993 [Opposer] has been producing jewelry made of crystal. ...


22. ... In 2008 [Opposer] collaborated with EVIAN, the French company that produces bottled spring water sold worldwide. [Opposer] designed and produced a very limited number of bottles, each bottle a one-of-a-kind shape and design, which contained EVIAN water. In 2009, the bottles were prominently displayed in cities around the globe and auctioned to the public for tens of thousands of dollars. The proceeds benefited a charitable organization.

* * *

24. ... [Opposer's] products are commonly available in secondary sales venues such as auction houses and online auctions, including eBay. ... ⁴⁵

⁴⁵ 79 TTABVUE 6 – 8.

In addition, Opposer has made trophies for sporting events, including the crystal trophy for the Indian Wells Tennis Tournament held annually in California and for races on the Formula 1 Tour.⁴⁶

In light of the fame of Opposer's mark and the above-noted expansion of its product line, the use of a similar mark in connection with bottle water could be perceived as another of Opposer's commercial activities capitalizing on its BACCARAT mark. *See Harley-Davidson Motor Co. v. Pierce Foods Corp.*, 231 USPQ 857, 862 (TTAB 1986). This leads us to consider what, in our view, is the crux of the likelihood of confusion issue in this case, namely, whether persons having knowledge of the long used and extensively promoted BACCARAT mark for glassware, and having encountered the expansion of Opposer's commercial activities as noted above, are apt to assume, erroneously, that  bottled water emanates from the same source.

The goods at issue may be found to be related if the public, being familiar with Opposer's use of its mark, and seeing Applicant's mark on bottled water, is likely to believe that Opposer has expanded its use of its mark, directly or under license, to bottled water. *See, E.g., Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) ("likelihood of confusion must be found if the public, being familiar with [plaintiff's] use of MONOPOLY for board games and seeing the mark on *any item* that comes within the description of goods set forth by [applicant] in its application, is likely to believe that [plaintiff]

⁴⁶ 76 TTABVUE 4.

has expanded its use of the mark, directly or under license.”); *Berghoff Restaurant v. Washington Forge, Inc.*, 225 USPQ 603, 608 (TTAB 1985) (the fame and inherent nature of Opposer’s mark may be important factors in evaluating the relatedness of the goods); *Bridgestone Co. v. Bridgestone Trading Co.*, 221 USPQ 1012, 1014 (TTAB 1984) (“we believe that opposer’s use of the mark on tires, bicycles, tennis and golf balls, and on a wide variety of promotional items including clothing, together with the established renown and long use of this arbitrary mark demonstrate that purchasers, upon encountering applicant’s BRIDGESTONE mark on shoes, are likely to mistakenly believe that this is another product produced, sponsored or otherwise associated with opposer.”); *Broadway Catering Corp. v. Carla Inc.*, 215 USPQ 462, 465 (TTAB 1982) (the renown of opposer’s mark and nature of the products at issue influence the analysis regarding whether the goods and services are related); *Hurst Performance, Inc. v. Torsten Hallman Racing, Inc.*, 207 USPQ 671, 675 (TTAB 1980) (“Thus, the conditions and circumstances surrounding the activities of opposer in relation to the sale and promotion of its automotive products and those normally expected of a party selling, as in applicant's case, racing apparel, are such as to be conducive to creating situations from which confusion or mistake as to the source of those products could arise if the marks of the parties are sufficiently similar so as to foster a misleading association or connection.”).

The Board, in another case, stated the following, which is equally appropriate in this case:

The licensing of commercial trademarks for use on “collateral” products (such as clothing, glassware, linens, etc.), which are unrelated in nature to those goods or services on which the marks are normally used, has become a common practice in recent years. *See: General Mills Fun Group, Inc. v. Tuxedo Monopoly, Inc.*, 204 USPQ 396, 400 [where we stated that such use is a matter of common knowledge and “has become a part of everyday life which we cannot ignore”], *affirmed* 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) [where the Court of Customs and Patent Appeals noted that “‘collateral product’ use is a matter of textbook discussion (see J. Gilson, Trademark Protection and Practice §5.05[10] (1980) and frequent commentary (see Grimes and Battersby, The Protection of Merchandising Properties, 69 T.M. Rep. 431 (1979) and references cited therein)”].

In re Phillips-Van Heusen Corporation, 228 USPQ 949, 951 (TTAB 1986). *See also L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1889 (TTAB 2008) (“It is common knowledge, and a fact of which we can take judicial notice, that the licensing of commercial trademarks on ‘collateral products’ has become a part of everyday life.”); *Turner Entertainment Co. v. Nelson*, 38 USPQ2d 1942, 1945 (TTAB 1996) (“It is common knowledge, and in the present case, undisputed that video games, t-shirts, beach towels, caps and other logo-imprinted products are used as promotional items for a diverse range of goods and services.”). As shown by the record evidence, Opposer’s mark BACCARAT is famous and used in connection with a wide and growing product line. *See Bridgestone Tire Co. v. Bridgestone Trading Co.*, 221 USPQ at 1014.

Finally, there is no evidence in the record which suggests that Opposer would not or could not use or license its BACCARAT mark in connection with bottled water.

In view of the foregoing, we find that the goods of the parties are related.

D. Established, likely to continue channels of trade and classes of consumers.

Opposer's products are available through Opposer's "flagship stores," and online through baccarat.com.⁴⁷ Opposer also sells its products in department stores, specialty shops, and online.⁴⁸ "[Opposer's] crystal products are sold on a limited basis through Costco."⁴⁹ Opposer's products are also available through online retailers such as Amazon.com and Sears.com.⁵⁰ "As of 2012, [Opposer's] goods were sold in 174 independent retailers across the United States. A secondary market exists in sales venues such as auction houses and online auctions, including eBay."⁵¹

Applicant sells its bottled water "in many small retail locations including, but not limited to, grocery stores, catering companies, restaurants, mini marts, health food stores, and convenience stores as well as various distribution companies."⁵²

However, because there are no limitations as to channels of trade or classes of purchasers in the description of goods in Opposer's registrations or Applicant's application, it is presumed that Opposer's goods and Applicant's goods move in all channels of trade normal for those goods, and that they are available to all classes of purchasers for those goods. *See Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973); *Kalart Co. v. Camera-Mart, Inc.*,

⁴⁷ 79 TTABVUE 7.

⁴⁸ 76 TTABVUE 3.

⁴⁹ 76 TTABVUE 3.

⁵⁰ 76 TTABVUE 3.

⁵¹ 79 TTABVUE 7 and 76 TTABVUE 3.

⁵² 98 TTABVUE 3 and 24.

258 F.2d 956, 119 USPQ 139 (CCPA 1958); *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1437 (TTAB 2014). In other words, we must give full sweep to the description of goods and the modes of distribution.

In this regard, Opposer introduced six use-based, third-party registrations owned by four entities for marks used to identify retailers selling both glassware and bottled water (*e.g.*, retail store services featuring *inter alia* glassware and bottled water).⁵³ These third-party registrations serve to suggest that the same retailers may sell both glassware and bottled water.

Also, it is unquestionable that bottled water is generally available almost everywhere and may be encountered by consumers in virtually any marketing milieu.

E. The conditions under which and buyers to whom sales are made, *i.e.* “impulse” vs. careful, sophisticated purchasing.

Applicant argues that the consumer degree of care weighs against finding that there is a likelihood of confusion because Opposer’s products are relatively expensive and singularly unique products for which consumers will exercise a high degree of care. Also, Applicant asserts that bottled water is so different than Opposer’s products that even consumers who encounter the products at the same time would not associate them as emanating from a single source.⁵⁴


Applicant’s argument does not address the fame of Opposer’s mark and the role fame may play in the degree of consumer care. As we indicated above, fame is

⁵³ 50 TTABVUE 43 – 54.

⁵⁴ 116 TTABVUE 15 – 17.

important in the likelihood of confusion inquiry because the public may exercise less care in purchasing products with a famous name. *See Specialty Brands*, 223 USPQ at 1284. In other words, when a consumer encounters a product that is being sold under a mark that is similar to a famous mark, especially an impulse purchase such as bottled water, he/she may exercise less care in purchasing the bottled water because of the trust engendered by the famous mark. For this reason, the tolerance for similarity between marks is inversely proportional to the fame of the prior mark. *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 22 USPQ2d at 1456 (“there is “no excuse for even approaching the well-known trademark of a competitor.”).

F. Balancing the factors.

Because Opposer’s marks are famous, the marks of the parties are similar, the goods are related and are encountered by the same consumers, we find that Applicant’s mark  for “bottled water” is likely to cause confusion with Opposer’s BACCARAT marks for *inter alia* “crystal and glassware, namely glasses, bottles, containers, cups, decanters, and vases” and “glass service comprising water, wine, champagne and aperitif goblets and glasses, jugs and decanters.” That is to say, purchasers familiar with Opposer’s goods sold under its famous mark would be likely to mistakenly believe, upon encountering Applicant’s mark for bottled water, that the goods originated from or are associated with or sponsored by the same entity.

Because we have found that there is a likelihood of confusion between Opposer’s marks and Applicant’s mark, we do not need to decide Opposer’s dilution

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claim or its claim that Applicant's mark creates a false association of a connection with Opposer.

Decision: The opposition is sustained and registration to Applicant is refused.