

THIS OPINION IS NOT A
PRECEDENT OF THE
TTAB

Mailed: June 23, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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De Boulle Diamond & Jewelry, Inc.

v.

Boulle Ltd.
—

Opposition No. 91219499
—

Travis R. Wimberly, Louis T. Pirkey and Giulio Yaquinto of Pirkey Barber PLLC,
for De Boulle Diamond & Jewelry, Inc.

Dyan M. House of Baker & McKenzie LLP,
for Boulle, Ltd.

—
Before Wolfson, Kuczma and Hudis,
Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Applicant, Boulle Ltd., seeks registration on the Principal Register of the mark ANDRÉ-CHARLES BOULLE (in standard characters) for “Furniture; mirrors” in International Class 20.¹

¹ Application Serial No. 86141196, filed December 11, 2013, based on Applicant’s allegation of a bona fide intent to use the mark in commerce under Section 1(b) of the Trademark Act,

De Boule Diamond & Jewelry, Inc. (“Opposer”) opposes registration of Applicant’s mark under Sections 2(a) and 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(a) and 1052(e)(1), on the grounds that the mark is either deceptive, deceptively misdescriptive, or merely descriptive of the goods, and that it falsely suggests a connection with André-Charles Boule, whom Opposer asserts was “a celebrated 17th-century French furniture maker, well-known for creating ornate pieces featuring intricate marquetry techniques.” Opposer’s Brief, 40 TTABVUE 9. Applicant denied the salient allegations in the Notice of Opposition, but admitted that “André-Charles Boule was an artist and furniture maker who worked in the late 1600s and early 1700s,” 4 TTABVUE 5, and that “works created by André-Charles Boule or his studio remain in the market.” *Id.* Applicant did not raise any affirmative defenses in its answer.²

I. THE RECORD

The record includes the pleadings, and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the subject application. The record also includes the following evidence submitted Opposer. Applicant did not submit evidence.

- Testimony declaration of Denis Boule, Opposer’s founder, CEO, and principal, with accompanying exhibits, 33 TTABVUE;
- Testimony declaration of Judith Gura, retained by Opposer to provide expert testimony, with accompanying exhibits, 34 TTABVUE;

15 U.S.C. § 1051(b), and on a registration from Monaco (registered on June 20, 2013) under Section 44(e), 15 U.S.C. § 1126(e).

² Opposer also pleaded likelihood of confusion under Trademark Act Section 2(d), and dilution under Trademark Act Section 43(c), but did not argue these claims in its brief. Accordingly, we give them no further consideration. *See Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1426 n.3 (TTAB 2013) (claim not argued in brief is considered waived).

- Notice of Reliance, 36 TTABVue, on:
 - Status and title copies of Opposer’s federal trademark registrations for DE BOULLE³ and associated design marks;⁴
 - Applicant’s initial disclosures and discovery responses to Opposer’s interrogatories, requests for admissions and request for production of documents;
 - Pages from Applicant’s website and its allegedly related entities about the historical furniture maker André-Charles Boule; and
 - Pages from third-party websites about André-Charles Boule.

II. BACKGROUND

Applicant originally applied to register the mark ANDRÉ-CHARLES BOULLE for goods in International Class 14 (“jewelry, watches, clocks and timepieces; diamonds, precious and semiprecious stones”) and in International Class 20 (“Furniture; mirrors; works of art of wood, wax, plaster or plastic”). Opposer opposed registration of all goods in both classes. Shortly after Applicant filed its answer, the

³ Opposer pleaded two registrations for the standard character mark DE BOULLE: Reg. No. 3078625 for “jewelry, diamonds, watches and timepieces” in International Class 14; “fine art, namely, paintings” in International Class 16, and “retail jewelry store services; mail order and electronic catalogue services featuring jewelry” in International Class 35; and Reg. No. 4335982 for “retail store services featuring firearms and firearm accessories” in International Class 35.

⁴ The design marks were not pleaded, and therefore only may be relied upon for purposes other than the basis of the opposition, i.e., for whatever probative value they may have. An opposer may file a notice of reliance on a registration prepared by the Office showing both the current status and current title to the registration or a current printout of information from Office electronic database records showing the current status and title of the registrations. Trademark Rule 2.122(d)(2), 37 C.F.R. § 2.122(d)(2); *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 94 USPQ2d 1645, 1654 (TTAB 2010), *aff’d*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *cf. FUJIFILM SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1236 (TTAB 2014) (registration resulting from opposer’s unpleaded application akin to third-party registration and may be made of record through notice of reliance for purposes other than the basis of the opposition, i.e., for “whatever probative value” it may have).

parties moved for suspension pending final disposition of civil trademark litigation in which they were engaged. In that action, inter alia, Opposer had counterclaimed that Applicant's ANDRÉ-CHARLES BOULLE mark infringed and diluted Opposer's DE BOULLE mark. The Board suspended proceedings pending resolution of the civil action.⁵

The civil action was resolved in favor of Opposer's counterclaims. The court found Applicant's mark confusingly similar to Opposer's mark and ordered the USPTO to "dismiss with prejudice" Applicant's application for the ANDRÉ-CHARLES BOULLE mark with respect to the Class 14 goods and the goods identified as "works of art of wood, wax, plaster or plastic" in Class 20. 33 TTABVUE 83. "Furniture" and "mirrors" were excluded from the order. Opposer subsequently filed a motion for summary judgment in this Opposition proceeding seeking judgment based on the district court's findings. 16 TTABVUE. The Board confirmed that "the application stands abandoned, with prejudice, as to [the Class 14 goods and the "works of art" in Class 20]." 20 TTABVUE 6. The Board found, however, that the court's determination did not extend to "furniture; mirrors."

The Texas court also found that Applicant's mark diluted Opposer's mark under the Texas Business and Commercial Code. 33 TTABVUE 79-80. The Board found that this determination was limited to use of the mark within Texas. Thus, the Board decided collateral estoppel did not apply and denied Opposer's motion for summary

⁵ Case No. 3:12-cv-01462, *Boullé, Ltd. v. De Boullé Jewelry & Diamonds, Inc.* (N.D. Tex.).

judgment. Opposer's second motion for summary judgment on its substantive claims also was denied.

This case now comes to trial on two issues: (1) whether Applicant's mark ANDRÉ-CHARLES BOULLE in connection with "furniture; mirrors" falsely suggests a connection with the 17th-century French furniture maker André-Charles Boulle, and (2) whether Applicant's mark is either merely descriptive of furniture or mirrors made by André-Charles Boulle or his studio, or is deceptively misdescriptive or deceptive of furniture or mirrors not made by André-Charles Boulle.⁶

III. STANDING

Standing is a threshold issue that must be proven by the plaintiff in every inter partes case. The U.S. Court of Appeals for the Federal Circuit has enunciated a liberal threshold for determining standing, namely that a plaintiff must demonstrate that it possesses a "real interest" in a proceeding beyond that of a mere intermeddler, and "a reasonable basis for his belief of damage." *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Indus., Inc.*

⁶ We hereinafter focus on "furniture" because that term broadly encompasses articles, including mirrors and other movables that are used to ready a room for use or occupancy, and because mirrors and furniture are in the same class. If we find the mark either descriptive, deceptive, deceptively misdescriptive, or falsely suggests a connection with André-Charles Boulle with respect to "furniture," we need not also find the mark does so with respect to mirrors. *See, e.g., In re Chamber of Commerce*, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) ("A descriptiveness refusal is proper 'if the mark is descriptive of any of the [goods or services] for which registration is sought.'") (citing *In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005); *cf. In re White Jasmine LLC*, 106 USPQ2d 1385, 1391 (TTAB 2013) (finding "WHITE JASMINE" deceptive for tea; registration refused as to the entire class, including spices).

v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). A “real interest” is a “direct and personal stake” in the outcome of the proceeding. *Ritchie v. Simpson*, 50 USPQ2d at 1026. A belief in likely damage can be shown by establishing a direct commercial interest. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000).

The record shows that both Applicant and Opposer have used “André-Charles Boule” to promote the sale of their jewelry. In addition, Opposer’s founder, CEO, and principal testified that Opposer “sell[s] or has sold jewelry, diamonds and other precious gemstones, furniture, mirrors, watches, clocks, other timepieces, fine art, sculptures, frames, firearms, firearm-related accessories, and giftware.” 33 TTABVue 5. Opposer also made of record its two pleaded U.S. registrations for DE BOULLE by filing a Notice of Reliance on copies of the registration certificates, along with printouts obtained from the USPTO’s TSDR database showing the registrations’ current status and title in Opposer. Trademark Rule 2.122(d)(1); 37 C.F.R. § 2.122(d)(1).

Because one ground upon which Opposer opposes registration of Applicant’s mark is that the mark ANDRÉ-CHARLES BOULLE is merely descriptive of the goods, Opposer need only assert an equal right to use the name in connection with its goods. Proprietary rights owned by Opposer are not required. *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2024 (Fed. Cir. 1987); *Dewalt, Inc. v. Magna Power Tool Corp.*, 289 F.2d 656, 129 USPQ 275, 280 (CCPA 1961). Opposer’s status as a competitor with an interest in using the name “André-Charles

Boullé” in connection with jewelry and other goods establishes its standing. *See, e.g., Miller v. Miller*, 105 USPQ2d 1615, 1618 (TTAB 2013) (competing law firm had standing to oppose competitor’s application); *Honda Motor Co. v. Winkelmann*, 90 USPQ2d 1660, 1662 (TTAB 2009) (competitor has standing); *Eastman Kodak Co. v. Bell & Howell Document Mgmt. Prods. Co.*, 23 USPQ2d 1878, 1879 (TTAB 1992) (where the ground is mere descriptiveness, “the plaintiff may establish its standing by...proving that it is engaged in the manufacture or sale of the same or related products.”), *aff’d* 994 F.2d 1569, 26 USPQ2d 1912 (Fed. Cir. 1993). Applicant did not challenge Opposer’s standing.

Once a plaintiff has shown standing on one ground, it has the right to assert any other legally sufficient ground in an opposition or cancellation. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727-28 (Fed. Cir. 2012) (“[O]nce an opposer meets the requirements for standing, it can rely on any of the statutory grounds for opposition set forth in 15 U.S.C. § 1052.”). Thus, Opposer has standing to challenge Applicant’s attempt to register “ANDRÉ-CHARLES BOULLE” as deceptive or as falsely suggesting a connection with a person under Section 2(a), and as deceptively misdescriptive under Section 2(e)(1).

IV. DESCRIPTIVENESS AND DECEPTIVE MISDESCRIPTIVENESS

Trademark Act Section 2(e)(1) reads as follows:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(e) consists of a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them... .

A mark is “merely descriptive” if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re MBNA Am. Bank, N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003). A mark is “deceptively misdescriptive if it: (1) misrepresents any fact concerning the goods or services; and (2) consumers are likely to believe the misdescription.” 2 McCarthy, Thomas J., MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:55 (5th ed. June 2020); *see also Hoover Co. v. Royal Appliance Mfg. Co.*, 238 F.3d 1357, 57 USPQ2d 1720, 1723 (Fed. Cir. 2001); *In re Moti Shniberg*, 79 USPQ2d 1309, 1311 (TTAB 2006) (finding the mark “SEPTEMBER 11, 2001” deceptively misdescriptive for books and entertainment services that do not concern the events of September 11, 2001).

Opposer introduced the testimony of design historian Judith Gura, who qualifies as an expert on 17th and 18th century French furniture, including specifically the work of André-Charles Boulle. 34 TTABVUE 4-5.⁷ We make the following findings consistent with her testimony:

⁷ Applicant does not challenge Ms. Gura’s status as an expert witness. She holds a master’s degree from the Bard Graduate Center for Studies in the Decorative Arts, Design and Culture in New York City, has taught Design History since 1998, including lectures on French period furniture, has authored or co-authored nine books about design and furnishings, and was in charge of promotion and marketing for a producer of fine reproduction French furniture of the type produced by André-Charles Boulle,

1. André-Charles Boulle is a celebrated French cabinetmaker associated with the Baroque period.
2. Boulle is best known for perfecting an elaborate and intricate technique of marquetry. “The technique, applied to cabinets of fine woods like ebony or rosewood, became known as “Boulle work” (or sometimes “boulle work” in lowercase), a term still used today.” 34 TTABVUE 6.
3. “The term ‘Boulle work’ (or ‘boulle work’) has become part of the standard vocabulary used in describing furniture.” *Id.* at 8.
4. The name André-Charles Boulle is known to “anyone with any awareness of French traditional design.” *Id.*
5. Boulle did not sign his furniture, “meaning that his work can be authenticated only through archival inventories, orders, or bills of sale.” *Id.* at 7.
6. “Virtually all fully-documented examples are in museums, and any pieces that come to market bring exceptional prices.”⁸ *Id.*

Opposer contends that if Applicant sells genuine articles of furniture created by André-Charles Boulle or his studio, then ANDRÉ-CHARLES BOULLE is merely descriptive of the goods. On the other hand, if Applicant sells furniture that is not genuine, Opposer contends that the mark will be deceptively misdescriptive. We agree with Opposer that Applicant is unlikely to sell genuine goods created by André-Charles Boulle because Boulle’s workshop has not been active for over one hundred years,⁹ his genuine works are exceedingly rare, and virtually all fully-documented examples are in museums.

⁸ “For example, a large table sold at Christie’s in 2002 for \$5,726,000, and a pair of jewel chests sold in 2009 for £2,617,250.” 34 TTABVUE 7.

⁹ After Boulle’s death in 1732, his workshop “was taken over by two of his sons and remained active for 80 years.” 34 TTABVUE 6.

Nonetheless, although Applicant admitted that it “intend[s] to use Applicant’s ANDRE-CHARLES BOULLE Mark with the goods identified in the Application in order to create an association in the minds of consumers between such goods and Andre-Charles Boule,” 36 TTABVUE 67, Applicant neither denied nor admitted that it would sell genuine André-Charles Boule goods, stating that it “has not decided whether or not it will sell goods created by Andre-Charles Boule.” *Id.* Accordingly, we have considered both possibilities.

Based on the evidence, including Ms. Gura’s testimony, relevant dictionary definitions and Wikipedia entries discussing André-Charles Boule as a well-known furniture maker, together with over twenty articles from third-party websites including museums, auction houses, and media, recognizing the fame and reputation of André-Charles Boule, 36 TTABVUE 134-243, we find that use of the full name ANDRÉ-CHARLES BOULLE as a trademark for a piece of furniture is likely to create the impression among potential buyers that the piece was created by Boule’s original workshop.

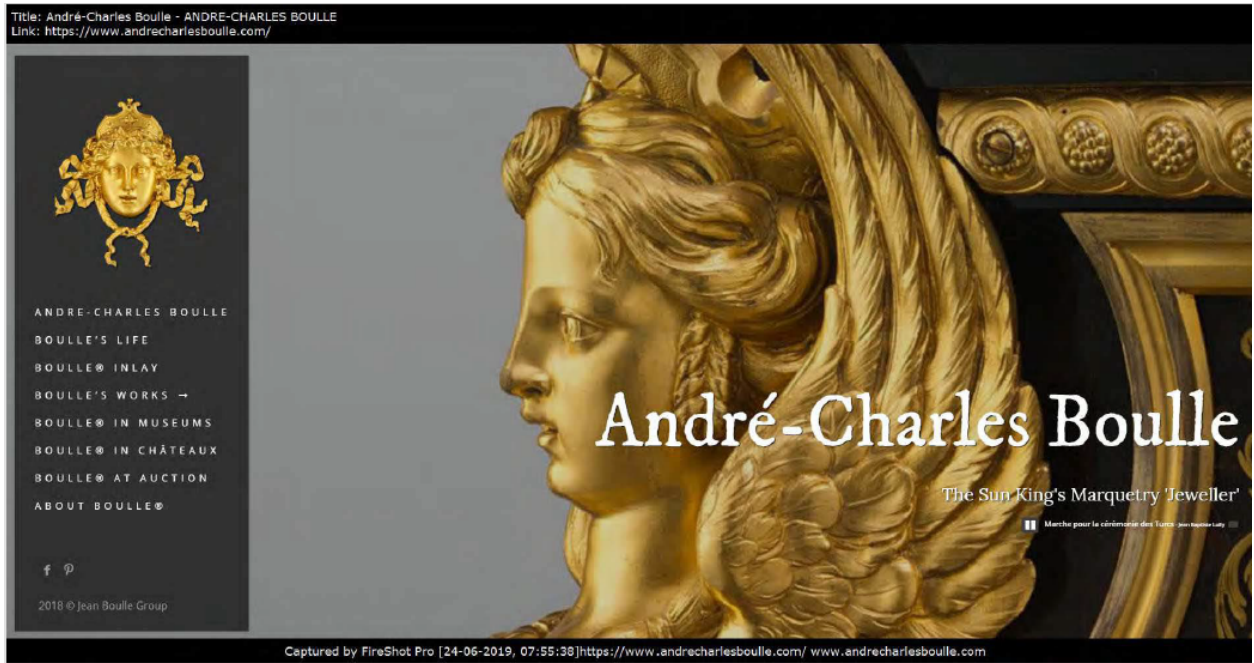
If used on furniture not made by André-Charles Boule or his descendants, the mark would be deceptively misdescriptive. It will evoke the specific perception among relevant consumers that André-Charles Boule is associated with the goods. If, on the other hand, the mark is used on genuine goods, it would merely describe that fact. *See, e.g., Ox-Yoke Originals*, 222 USPQ 352, 354 (TTAB 1983) (noting after refusal for deceptive misdescriptiveness that, if the gun-cleaning equipment offered under the G.I. mark had “in fact [been] government issue, then the term would be merely

descriptive and unregistrable” for that reason); *cf. In re Carlson Dolls Co.*, 31 USPQ2d 1319, 1320 (TTAB) (finding MARTHA WASHINGTON merely descriptive of a doll intended to represent her).

Applicant argues that its mark is only “suggestive of the quality of craftsmanship and detail associated with André-Charles Boulle work and legacy,” 41 TTABVUE 5, and that its goods “would be of a high quality and highly skilled craftsmanship along the lines of André-Charles Boulle.” *Id.* at 6. We find this assertion belied by Applicant’s use of the proposed mark on its affiliated company’s website. As can be seen, on the home page, the name André-Charles Boulle appears prominently, in a trademark manner,¹⁰ and that on the last page of the website,¹¹ Applicant implies its Sun-King Diamond Coating inlay was a further development of the work of André-Charles Boulle:

¹⁰ 36 TTABVUE 92.

¹¹ 36 TTABVUE 133.



The last page reads:

This site has been created by the Jean Boule Group (Mining, Medtech, Agriculture, Luxury) and Jean Boule Luxury to encourage research into the life and works of Andre-Charles Boule and to propagate knowledge about the Boule Inlay process, also known as “Boule® Work”, which has been further developed by Jean Boule Luxury into Sun King® Diamond Coating, a refined diamond inlay for supercars, executive jets and superyachts.

Applicant also created a Pinterest board that uses the proposed ANDRÉ-CHARLES BOULLE mark to suggest Applicant sells genuine goods created by André-Charles Boule:



Jean Boule Luxury Group

41 Followers • 36 Following • www.boulleluxury.com

luxembourg

The Jean Boule Group crafts the rarest rough and polished diamonds into truly bespoke Haute Joaillerie in the legacy of André-Charles Boule (1642 - 1732).

Jean Boule Luxury Group's best boards



Prospective consumers, viewing the board labeled “André-Charles Boule/Jean Boule Luxury Group,” will believe that Applicant sells genuine André-Charles Boule goods. If true, the proposed mark is merely descriptive. If false, the designation is deceptively misdescriptive.

In sum, Applicant’s proposed mark is not entitled to registration under Section 2(e)(1). Accordingly, we need not reach Opposer’s additional claims under Section 2(a) or address Opposer’s alternate request for a restricted registration excluding the state of Texas.

Decision: The opposition is sustained under Trademark Act Section 2(e)(1).