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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Champagne Louis Roederer, S.A.
v.
Delicato Vineyards

Opposition No. 80,932
to application Serial No. 73/701,485
filed on December 17, 1987

Perla M. Kuhn and Julius Rabinowitz of Kuhn and Muller for
opposer.

I. Steven Siglin, Esq. for applicant.

Before Sams, Rice, and Seeherman, Administrative Trademark
Judges.

Opinion by Rice, Administrative Trademark Judge:

An application has been filed by Somerset Vintage
Cellars, Inc., and subsequently assigned to New World Wines
Acquisition Corporation and then to Delicato Vineyards,¹ to
register the mark CRYSTAL CREEK for wines.²

¹ The assignment from New World Wines Acquisition Corporation to Delicato Vineyards occurred after the commencement of this proceeding, but prior to the opening of the testimony periods. In accordance with the Board's customary practice in such instances (see §512.01 of the *Trademark Trial and Appeal Board Manual of Procedure* ("TBMP")), Delicato Vineyards was joined, rather than substituted, as a party defendant. Inasmuch as the

Registration has been opposed by Champagne Louis Roederer, S.A., a French joint stock company, under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), on the ground that applicant's mark, as applied to its goods, so resembles the marks CRISTAL and CRISTAL CHAMPAGNE, previously used by opposer in the United States for champagne, as to be likely to cause confusion, or to cause mistake, or to deceive. Opposer also pleaded ownership of a registration of its mark CRISTAL CHAMPAGNE,³ and that the mark has become famous in the United States.

Applicant, in its answer to the notice of opposition, has denied the salient allegations thereof.⁴

The record consists of the pleadings; the file of applicant's subject application; copies of two registrations owned by opposer;⁵ the testimony upon written questions of

discovery and testimony periods have now closed, Delicato Vineyards is hereby substituted as party defendant.

² Application Serial No. 73/701,485, filed December 17, 1987, asserting first use and first use in commerce on April 16, 1987.

³ Registration No. 1,163,998 issued August 4, 1981, under the provisions of Section 2(f) of the Act, 15 U.S.C. §1052(f), with a disclaimer of CHAMPAGNE, from an application filed August 28, 1978 claiming first use anywhere on May 13, 1876 and first use in commerce on March 25, 1937; affidavit Sec. 8 accepted; affidavit Sec. 15 received.

⁴ Applicant also pleaded 10 "affirmative defenses," all of which are lacking in that they are not true affirmative defenses, or are legally insufficient, and/or constitute a collateral attack upon opposer's pleaded registration and, as such, cannot be entertained in the absence of a counterclaim to cancel the registration. "Shotgun pleading" of this nature is strongly disfavored by the Board, and counsel for applicant would be wise to avoid such pleading in future cases before the Board.

⁵ The registrations were made of record as an exhibit to the testimony of opposer's witness, who testified as to their current status and title. One of the registrations so made of record by opposer was the registration pleaded in the notice of

opposer's vice president, Fabrice Rosset; the testimony declarations of Patricia Towers and Beth Brown in behalf of applicant; and the rebuttal testimony declaration of opposer's witness Fabrice Rosset.⁶ Both parties briefed the case; neither requested an oral hearing.

Opposer's evidence indicates that the mark CRISTAL was first adopted and used by opposer (outside of the United States) in 1876, when opposer developed a special champagne for the Russian czar and bottled it in genuine crystal. Opposer has used the marks CRISTAL and CRISTAL CHAMPAGNE in the United States in connection with champagne continuously since 1937, except for a period of disrupted use during

opposition. The second registration was Registration No. 662,343 for the mark CRISTAL CHAMPAGNE and design (CRISTAL CHAMPAGNE disclaimed), issued May 27, 1958 from an application filed October 29, 1956, claiming first use anywhere on May 13, 1876 and first use in commerce on March 25, 1937; affidavit Sec. 8 accepted; once renewed. Although this registration was not pleaded by opposer, applicant did not object to it as unpleaded, and thus this objection is deemed waived.

Applicant did assert in its brief that because opposer made the certificate of its pleaded registration of record, the entire file of the registration should be considered to be of record in this case. However, it is only the registration certificate, with the presumptions flowing therefrom, that is of record herein. If applicant wanted us to consider the entire file of the registration, it was incumbent upon applicant to make a copy of the file contents properly of record during its testimony period, such as by filing, during that period, a copy of the file contents together with a notice of reliance thereon. See TBMP §703.02(a) (last paragraph). Although applicant attached parts of the registration file to its brief on the case, exhibits and other evidentiary materials attached to a party's brief on the case can be given no consideration unless they were properly made of record during the time for taking testimony. See TBMP §705.02, and cases cited therein.

⁶ The parties stipulated to the introduction of the testimony of Patricia Towers and Beth Brown, and the rebuttal testimony of Fabrice Rosset, in declaration form.

World War II.⁷ Opposer's champagne bearing these marks is sold throughout the United States in prestige retail outlets, hotel restaurants, and supermarkets. It is carried in this country by more than 80 distributors and about 4,000 retailers, restaurants, etc. Opposer's annual advertising expenditures for the product in the United States amounted to more than \$100,000 for each of the five years preceding February 28, 1994 (the date of Mr. Rosset's testimony deposition). In addition, the product has frequently been featured in articles appearing in such publications as Wine Enthusiast, Wine & Spirits, Gourmet, Wine News, Bon Appétit, The Wine Spectator, The Press-Enterprise, Miami Herald, Sun-Tattler (Hollywood, Florida), and Chicago Sun-Times.

Sales of opposer's champagne bearing the marks CRISTAL and CRISTAL CHAMPAGNE in the United States amounted to approximately 150,000 bottles, having a wholesale value of more than \$40 million, and a retail value of more than \$80 million, for each of the five years preceding Mr. Rosset's testimony. The champagne sells in the United States for between \$90 and \$120 per bottle; it is one of the most expensive champagnes sold in this country.

Opposer's witness Mr. Rosset is not aware of any instances of actual confusion arising from the use of opposer's mark CRISTAL for champagne and applicant's mark

⁷ There is testimony that the mark CRISTAL was licensed for use on cavier in 1983. However, there is no evidence as to the extent of the use, if any, made under this license.

CRYSTAL CREEK for wine. Opposer first became aware of applicant's use of the mark CRYSTAL CREEK on May 25, 1989, and has never objected to that use.⁸

In response to a question by applicant as to whether opposer has ever raised any objection to the use or registration of certain specified marks (identified in the question only by mark and a registration number or application serial number, without any information as to the goods)⁹ in the United States, Mr. Rosset stated that opposer had objected to three of the marks, CRYSTAL OAK CELLARS, CALIFORNIA CRYSTAL, and CRYSTAL COMFORT, and that in all three cases, opposer has been successful "in persuading the owner of the registration or the user of the marks to stop using the mark or persuaded it or him to give up to [sic] the registration."

Applicant's witnesses, Patricia Towers and Beth Brown, testified concerning third-party uses of marks containing the term CRYSTAL or variations thereof for beverages.¹⁰

⁸ This opposition, however, was filed on August 7, 1989.

⁹ As noted by opposer in its reply brief, applicant's mere reference in its question to these marks and their asserted registration numbers or application serial numbers does not suffice to make the registrations or applications of record. For information concerning the proper method for making third-party registrations or applications of record, see TBMP §§703.02(b) and 703.03.

¹⁰ Opposer objected to some of applicant's third-party use evidence on the ground that the uses in question were not identified in applicant's responses to opposer's interrogatories, including interrogatory 17. However, opposer failed to file a copy of its interrogatories in support of the objection, so we cannot determine whether the objection is well-taken. Moreover, opposer failed to preserve the objection in its brief on the case. Under the circumstances, the objection cannot be sustained.

Specifically, Patricia Towers testified that on August 21, 1995 she visited Central Liquors, a retail liquor store in Washington, D.C., and found there AGUARDIENTE CRISTAL, a (liquor) product of Columbia; CRYSTAL Lager Beer and CRYSTAL Diplomat Dark Beer, both distributed by a company of the Czech Republic; and CRYSTAL PALACE GIN, manufactured by Barton Distilling.

Beth Brown's testimony establishes that in early June 1995, she visited certain establishments and found there certain third-party beverage products, namely, at Hi-Time Cellars, a retail liquor, tobacco, etc., store located in Costa Mesa, California, she found CRYSTAL GEYSER sparkling mineral water, AGUARDIENTE CRISTAL liquor, and STOLICHNAYA CRISTALL vodka; at each of four different Von's supermarket stores (1 in Costa Mesa, California, 1 in Anaheim, California, and 2 in Santa Ana, California), she found CRYSTAL GEYSER sparkling mineral water, CRYSTAL LIGHT soft drinks, and STOLICHNAYA CRISTALL vodka; at Trader Joe's grocery store in Costa Mesa, California, she found CRYSTAL GEYSER alpine spring water; at Cost Plus Imports store in Santa Ana, California, she found CRISTALINO sparkling water; at Tony's Sea Landing restaurant in Tustin, California, she found CRYSTAL LAKE wines; at Felix Continental Cafe restaurant in Orange, California she found CRYSTAL LAKE wines, sparkling wine, and California champagne; at Back Bay Cafe in Newport Beach, California, she found CRYSTAL LAKE

California champagne; and at The Wine Exchange in Orange, California, she found STOLICHNAYA CRISTAL vodka.

In his rebuttal testimony declaration, dated December 12, 1995, Mr. Rosset stated that in August 1995, opposer learned that applicant claimed a company was selling wine products in the Orange County, California area under the mark CRYSTAL LAKE; that opposer had never heard of this use before; that subsequently, opposer learned that the company in question was San Antonio Winery, Inc.; that on October 23, 1995, opposer sent that company a cease and desist letter; and that the company responded by asking if it could resolve the matter through negotiation of a license agreement.¹¹

Aside from the fact that opposer owns a registration of its mark CRISTAL CHAMPAGNE for champagne, so that the issue of priority does not arise as to the mark,¹² the record clearly establishes opposer's long-prior use of its marks CRISTAL and CRISTAL CHAMPAGNE. Thus, the only issue to be determined herein is the issue of likelihood of confusion.

Turning first to the goods of the parties, wine and champagne are very closely related. Indeed, as indicated by the cross-examination testimony of Mr. Rosset (pages 21-22

¹¹ Applicant has objected to this declaration on the ground of hearsay. However, we are not persuaded that the objection is well-taken.

¹² See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

of the deposition), champagne is a type of wine.¹³ Applicant's brief is replete with arguments based on asserted differences between the respective goods of the parties as to price, channels of trade, classes of purchaser, etc. However, applicant offered no evidence as to the price range, channels of trade, classes of purchaser, etc. for its goods. Moreover, the issue of likelihood of confusion must be determined on the basis of the identification of goods in applicant's application and the goods specified in opposer's registration (as well as the goods on which opposer has proved prior use of its mark). Inasmuch as the parties' identifications of goods contain no restrictions as to these matters, they must be considered to include wines (in applicant's case) and champagne (in opposer's case) sold in all of the usual price ranges, through all of the customary trade channels, to all of the normal classes of purchasers, for goods of the type identified. That is, for purposes herein, we can draw no distinctions between the goods of the parties as to price, channels of trade, or classes of purchasers. Under the circumstances, we have no doubt that the contemporaneous

¹³ Specifically, Mr. Rosset testified that technically speaking, "champagne" means sparkling wine produced in the Champagne appellation zone of France in accordance with strict regulations concerning all aspects of production, planting, the choice of grape varieties, harvesting, wine making, etc., but that people in the United States generally use "champagne" for any category of sparkling, effervescent wines. Similarly, in Webster's New World College Dictionary (3rd ed. 1997), "champagne" is defined as, inter alia, "1 orig., any of various wines produced in Champagne, France 2 a) now, any effervescent white wine made there or elsewhere...."

marketing by applicant and opposer of wine and champagne, respectively, under the same or similar marks would be likely to cause confusion.

This brings us to the marks. We note at the outset that applicant's assertion, on page 9 of its appeal brief, that opposer's mark "is purely descriptive, and has come to serve as a generic reference to a pure, high quality product", and other similar assertions in the brief and in applicant's pleading, constitute collateral attacks upon the validity of opposer's pleaded registration and as such cannot be entertained in the absence of a counterclaim or separate petition to cancel the same. See *Contour Chair-Lounge Co., Inc. v. Englander Co., Inc.*, 324 F.2d 186, 139 USPQ 285 (CCPA 1963), and *Clorox Co. v. State Chemical Manufacturing Co.*, 197 USPQ 840 (TTAB 1977). Moreover, it is clear that, as a result of opposer's long and extensive use of its mark over the years, with resulting recognition, any weakness which the mark may have had initially has long since been overcome, and the mark has come to serve as a very strong indication of origin for opposer's champagne.

Similarly unpersuasive are applicant's arguments based on differences in the labels used by the parties. Aside from the fact that the specimens in an application do not constitute evidence in applicant's behalf unless they are identified and introduced in evidence as exhibits during the period for taking testimony [Trademark Rule 2.122(b)(2), 37 CFR §2.122(b)(2)], which applicant here did not do, it is

well settled that the issue of likelihood of confusion in a proceeding such as this must be determined on the basis of the mark sought to be registered, as shown in the application drawing, vis-a-vis the mark shown in opposer's registration,¹⁴ without consideration for other matter which may be used therewith. See, for example, *Kimberly-Clark Corp. v. H. Douglas Enterprises, Ltd.*, 774 F.2d 1144, 227 USPQ 541 (Fed. Cir. 1985); *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445 (TTAB 1986); *Purex Corp., Ltd. v. Thompson-Hayward Chemical Co.*, 179 USPQ 190 (TTAB 1973).

Further, the lack of evidence of actual confusion is of little significance in a case such as this, where there is no evidence as to the nature and extent of applicant's use. That is, we cannot determine whether there has been any real opportunity for confusion to arise. In any event, the standard under Section 2(d) is likelihood of confusion, not actual confusion.

Finally, applicant's argument that CRISTAL and CRYSTAL have different pronunciations is not well taken. As noted by opposer, there is no correct pronunciation of a trademark [*Kabushiki Kaisha Hattori Seiko v. Satellite International Ltd.*, 29 USPQ2d 1317 (TTAB 1991); *Jockey International Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233 (TTAB 1992); and *Yamaha International Corp. v. Stevenson*, 196 USPQ 701 (TTAB

¹⁴ Opposer is also entitled to rely, of course, on any other mark as to which it has shown prior use.

1977)]], and we have no doubt that a substantial segment of the purchasing public for goods of the type involved here would pronounce CRISTAL and CRYSTAL in a similar manner.

Notwithstanding all of the foregoing, we find that there is no likelihood of confusion in this case because of the differences in the marks CRISTAL and CRISTAL CHAMPAGNE, on the one hand, and CRYSTAL CREEK, on the other. Comparing applicant's mark CRYSTAL CREEK, considered in its entirety, to opposer's mark CRISTAL (the mark of opposer which is most similar to applicant's mark), it is clear that the two marks differ substantially in significance. We note, in this regard, that the noun "crystal" is defined in Webster's New World College Dictionary, supra, as, inter alia, "a clear, transparent quartz"; "a very clear, brilliant glass"; "articles made of this glass, such as goblets, bowls, or other ware"; and "anything clear and transparent like crystal", while the adjective form of the word is defined as, inter alia, "of or composed of crystal" and "like crystal; clear and transparent." Opposer's mark CRISTAL is likely to be recognized by purchasers as the French language equivalent of the English word "crystal"¹⁵ or, to those

¹⁵ Attached to applicant's brief on the case was a page from Cassell's French Dictionary showing that the French word "cristal" is defined as "Crystal, fine glass, crystal ware, cut glass; (*fig.*) limpidity." The dictionary definition evidence was offered by applicant in support of its arguments concerning the pronunciation of the marks. Opposer has objected to our consideration of this evidence, on the grounds that it was not properly submitted during applicant's testimony period, and that it is improper for the Board to take judicial notice of the dictionary definition of a foreign word. For the reasons indicated earlier in this opinion, applicant's arguments

unfamiliar with the French language, as a phonetic misspelling of the word "crystal." In either case, CRISTAL would likely signify to purchasers (in addition to its acquired significance as a trademark for opposer's champagne) the clear or transparent nature of opposer's champagne,¹⁶ and/or the crystal bottles in which the product was originally sold. Applicant's mark CRYSTAL CREEK, in contrast, conjures up the image of a very clear (and hence probably remote from civilization) creek or stream.¹⁷ Moreover, there are differences between the marks in sound and appearance. Because of the differences in the marks in significance, sound, and appearance, they create distinctly different commercial impressions.

Opposer argues that CRYSTAL is the dominant part of applicant's mark because it is the first word thereof, and that where the dominant portions of two marks are the same

concerning the proper pronunciations of the marks are not well taken, and we have not considered the dictionary entry for pronunciation purposes. On the other hand, it is well settled that the Board may take judicial notice of the definitions of words in dictionaries. See *B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719 (Fed. Cir. 1988); *In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111 (Fed. Cir. 1983); and *In re Anania Associates, Inc.*, 223 USPQ 740 (TTAB 1984). Opposer's objection that we cannot take judicial notice of the meanings of words in foreign dictionaries is not convincing. Here, we take judicial notice of the French dictionary definition of "cristal" to show its significance to those in the United States who are familiar with the French language.

¹⁶ Opposer's witness Mr. Rosset testified, at pages 24-25 of his testimony deposition, that opposer has never sold, under the mark CRISTAL, any champagne that was opaque in appearance.

¹⁷ The noun "creek" is defined in Webster's New World College Dictionary, supra, as "a small stream, somewhat larger than a brook."

or highly similar, likelihood of confusion is more readily found. Inasmuch as CRYSTAL is an adjective modifying the word CREEK, however, we cannot agree with this analysis. Nor does the fact that CREEK is a topographical designation mean that it is in any way lacking in trademark significance as applied to wines.

For the reasons set forth above, we conclude that applicant's mark CRYSTAL CREEK, when applied to wines, does not so resemble opposer's marks CRISTAL and CRISTAL CHAMPAGNE as to be likely to cause confusion.

Decision: The opposition is dismissed.

J. D. Sams

J. E. Rice

E. J. Seeherman
Administrative Trademark
Judges, Trademark Trial
and Appeal Board