

**THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB**

Mailed:  
October 31, 2007

**UNITED STATES PATENT AND TRADEMARK OFFICE**

—————  
**Trademark Trial and Appeal Board**

—————  
Waterford Wedgwood PLC  
v.  
Forma-Kutzscher GmbH

—————  
Opposition No. 91123735  
to application Serial No. 75752866  
filed on July 16, 1999

—————  
Bassam N. Ibrahim of Buchanan Ingersoll & Rooney PC for  
Waterford Wedgwood PLC.

Thaddeus C. Stankowski of Nilles & Nilles, S.C. for Forma-  
Kutzscher GmbH.

—————  
Before Hohein, Holtzman and Bergsman, Administrative  
Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Forma-Kutzscher GmbH, a German corporation, filed an application to register the mark LISA MORI, in standard character format, for goods ultimately identified as "crystal and lead crystal glassware, namely, beverage ware, cups, vases, and bowls, candlesticks, and picture frames, all made of crystal and lead crystal glassware," in Class

21.<sup>1</sup> During the prosecution of the application, applicant stated that LISA MORI does not identify a living individual.

Waterford Wedgwood PLC opposed the registration of LISA MORI on the ground of priority of use and likelihood of confusion and dilution. Opposer alleged ownership of the following four (4) registrations for the mark LISMORE:

Reg. No.	Goods	Reg. Date	Status
0890480	Glassware, namely, tableware, pitchers, tumblers, goblets, bowls, wine glasses, sherbet glasses, and liqueur glasses, in Class 21	May 5, 1970	Affidavits under Sections 8 & 15 accepted and acknowledged; second renewal
2186815	Pens, roller balls, ball-point pens, fountain pens and pencils, in Class 16	September 1, 1998	Affidavits under Sections 8 & 15 accepted and acknowledged

---

<sup>1</sup> Application Serial No. 75752866, filed July 16, 1999, based on applicant's intent to use the mark in commerce pursuant to Section 1(b) of the Trademark Act of 1946, 15 U.S.C. §1051(b), and based on a German application for LISA MORI for "glassware, namely crystal and lead crystal glassware," filed on May 27, 1999, pursuant to Section 44(d) of the Trademark Act of 1946, 15 U.S.C. §1126(d). On May 1, 2000, applicant filed a certified copy of German Registration No. 399 11 361, dated July 1, 1999 that issued from its German application.

Reg. No.	Goods	Reg. Date	Status
2373295	Dinnerware; cut crystal glassware; glassware, namely, stemware, tumblers, iced tea glasses, hi-ball glasses, goblets, champagne glasses, liqueur glasses, brandy glasses, carafes, ice buckets, decanters, finger bowls, bowls, candlesticks, tableware, namely, cake servers, salad bowls, salad serving spoons and forks; vases; perfume bottles and atomizers sold empty, in Class 21	August 1, 2000	Affidavits under Sections 8 & 15 accepted and acknowledged
2379612	Jewelry, in Class 14	August 22, 2000	Registered <sup>2</sup>

Opposer has also alleged that the LISMORE mark is famous and became famous prior to the filing date or any other date of first use that applicant could claim. Accordingly, opposer asserts that applicant's mark LISA MORI, when used in

---

<sup>22</sup> During its testimony period, opposer filed a notice of reliance on a certified copy of Registration No. 2379612 showing that the registration is subsisting and owned by opposer. Subsequently, between August 22, 2005 and August 22, 2006, opposer was required to file an affidavit or declaration of use pursuant to Section 8 of the Trademark Act of 1946, 15 U.S.C. §1058. Because opposer has not filed the required document, the registration will therefore be cancelled in due course. In view thereof, we will not give this registration any further consideration in our likelihood of confusion and dilution analysis.

connection with crystal and lead crystal glassware, so resembles opposer's registered LISMORE marks as to be likely to cause confusion and is likely to cause dilution of the distinctive quality of opposer's LISMORE trademark.

Applicant denied the essential allegations of the notice of opposition. The case has been fully briefed.

The Record

By operation of Trademark Rule 2.122, 37 CFR §2.122, the record includes the pleadings and the application file for applicant's mark. The record also includes the following testimony and evidence:

A. Opposer's evidence.

1. Opposer's notice of reliance on the following items:
  - a. Certified copies showing that opposer's pleaded LISMORE registrations are subsisting and owned by opposer;
  - b. Articles from printed publications for the purpose of showing the asserted fame and strength of the LISMORE mark; and,
  - c. Applicant's answers to opposer's interrogatories and requests for admission;

2. Testimony deposition of Richard C. Babick, the owner of Design Research, LLC, a market research firm, with attached exhibits;

3. Testimony deposition of Moira Gavin, Senior Vice President for Sales for Waterford and Vice President for Wedgwood USA, with attached exhibits; and,

4. Testimony deposition of Robert Cockrum, District Manager of Waterford Wedgwood USA, with attached exhibits.

B. Applicant's evidence.

1. Applicant's notice of reliance on opposer's answers to applicant's interrogatories and requests for admission; and,

2. The testimony deposition on written questions of Gerhard Steinberger, applicant's General Manager, with attached exhibits.

Evidentiary Issues

A. Crystal stemware marketing reports in the Richard Babick deposition.

During his deposition, Richard Babick identified and discussed three of his company's marketing research reports in the field of crystal stemware.<sup>3</sup> Applicant objected to the introduction of the marketing research reports and testimony related thereto on the ground that because opposer

---

<sup>3</sup> Babick Dep., pp. 9-15; Exhibits 1-3.

did not provide the underlying documents, the reports were an improper summary. In its brief, applicant did not renew this objection. Instead, applicant moved to strike the marketing research reports and related testimony on the ground that the reports were not restricted to sales in the United States.<sup>4</sup> While Mr. Babick did not identify the geographic scope of his company's marketing research reports in his direct testimony or upon cross-examination, sections of the marketing research reports indicate that they are limited to sales in the United States. For example, the reports provide data regarding "Rolling Twelve Month National Market Share Trends," "National Market Share Trends - Shares By Product Line," and "National Share of Inventory Trends - Quarterly Share Comparisons." The use of the word "National" implies that the reports are referencing sales in the United States. Thus, we conclude that the marketing research reports are limited to sales of crystal stemware in the United States.

Moreover, had applicant raised its objection to the relevancy of the marketing research because they were not restricted to sales in the United States at the deposition, opposer might have been able to obviate or remove the objection by eliciting explanatory testimony. Fed. R. Civ. P. 32(d)(3)(A) provides the following:

---

<sup>4</sup> Applicant's Brief, p. 6.

Objections to the competency of a witness or to the competency, relevancy, or materiality of testimony are not waived by failure to make them before or during the taking of the deposition, unless the ground of the objection is one which might have been obviated or removed if presented at that time.

See also TMBP §707.03(c) (2<sup>nd</sup> ed. rev. March 12, 2004) ("When an objection of this type [*i.e.*, relevancy] could not have been obviated or removed if presented at the deposition, the Board will consider it even if the objection is raised for the first time in or with a party's brief on the case"). In this instance, applicant waived its objection to the relevancy of the marketing research reports by not asserting it during the deposition.

In view thereof, applicant's motion to strike the marketing reports and testimony related thereto is denied.

B. Sales reports in the Moira Gavin deposition.

Moira Gavin, Senior Vice President for Sales of Waterford and Vice President for Wedgwood USA, is responsible for the sales of LISMORE products in the United States.<sup>5</sup> During her deposition, Ms. Gavin authenticated a combined sales report for fiscal years 2003 and 2004 for Waterford products, including the LISMORE line of products, and a summary of sales revenues and advertising expenditures for the years 1991 through 2002 for LISMORE products.<sup>6</sup>

---

<sup>5</sup> Gavin Dep., pp. 4-5.

<sup>6</sup> Gavin Dep., pp. 10-13; Exhibits 1 and 2.

During the deposition, applicant objected to the summary of sales revenues and advertising expenditures on the ground that it was not produced during discovery. Applicant did not object to the 2003 and 2004 sales report. In its brief, applicant did not renew its objection on the ground that the sales summary was not produced during discovery. Rather, applicant objected to both exhibits on the ground that they were not restricted to sales and advertising in the United States. Because Ms. Gavin is responsible for the sales of LISMORE products in the United States, we conclude that the sales reports she authenticated relate to the area for which she is responsible (*i.e.*, the United States). We have no reason to believe that she produced, or that she even had access to sales data, outside of her area of responsibility.

Moreover, as discussed above, had applicant raised its objection during the deposition, opposer might have been able to obviate or remove the objection. Fed. R. Civ. P. 32(d)(3)(A).

In view thereof, applicant's objection to Gavin Exhibits 1 and 2 is overruled.

#### Facts

"Opposer is a designer, manufacturer and distributor of crystal, fine bone china, fine porcelain, fine earthenware products, premium cookware and kitchenware. Opposer also

licenses its name and trademarks for use in connection with products such as jewelry, silverware, and table and bed linen.”<sup>7</sup> Opposer’s LISMORE product line includes, *inter alia*, stemware, vases, bowls, tableware, platters, china, lighting, and chandeliers.<sup>8</sup> Opposer has continuously used the LISMORE mark in connection with these products in the United States since 1952.<sup>9</sup>

Opposer’s core customers are collectors and newly engaged couples who register for wedding gifts.<sup>10</sup> LISMORE products are sold through jewelry stores, department stores, specialty stores, gift shops, and the Internet.<sup>11</sup>

Opposer has sold over \$250 million of LISMORE branded products between 1991 and 2004, including sales of \$14,444,000 and \$11,087,000 for LISMORE stemware in 2003 and 2004, respectively. This comprises in excess of six million units of LISMORE branded products, including approximately 4.5 million units of stemware products.<sup>12</sup> Richard Babick, the principal of Design Research LLC, a market research company that tracks stemware sales, testified that “Lismore has been a perennial best seller, probably a top five pattern, for as long as I’ve been involved in the industry

---

<sup>7</sup> Opposer’s Response to Applicant’s Interrogatory No. 1.

<sup>8</sup> Cockrum Dep., p. 9.

<sup>9</sup> Opposer’s Responses to Applicant’s Interrogatory Nos. 4-6.

<sup>10</sup> Cockrum Dep., pp. 13 and 56.

<sup>11</sup> Cockrum Dep., pp. 18-19; Gavin Dep., p. 16

<sup>12</sup> Gavin Dep., pp. 10-13; Exhibits 1 and 2.

[over 22 years]."<sup>13</sup> According to the market reports compiled by Design Research LLC, LISMORE was the best selling stemware in the United States in 2000, 2001, 2003, and 2004, with approximately an 8% market share.<sup>14</sup>

Between 1991 and 2002, opposer spent in excess of \$3,500,000 advertising and promoting LISMORE products.<sup>15</sup> LISMORE products are advertised in newspapers and magazines, including bridal magazines, *House and Garden*, *Bon Apetit*, *New Yorker*, and *Southern Living*.<sup>16</sup> Opposer exhibits its LISMORE products at national and regional gift and home furnishing trade shows, including bridal shows at major department stores.<sup>17</sup>

LISMORE products have also received media attention extolling the virtues of the products. Representative samples of media reports include the following articles:

Although Lismore, Waterford's most enduring and popular crystal pattern, was designed before Waterford became a big brand name, it can arguably be called the pattern that put the company on the map . . . Lismore is a pattern that defines tradition. It is the most popular crystal pattern at Replacements, a retailer that specializes in old and new china, crystal and silver patterns

---

<sup>13</sup> Babick Dep., p. 9. Mr. Babick also testified that when he started working for Lenox Incorporated in 1982, one of opposer's competitors "Lismore was the number one pattern in stemware." (Babick Dep., pp. 5 and 7).

<sup>14</sup> Babick Dep., pp. 11-15; Exhibits 1-3. The market share was calculated by adding LISMORE and LISMORE TALL sales.

<sup>15</sup> Gavin Dep., p. 13; Exhibit 2.

<sup>16</sup> Cockrum Dep., pp. 9-11.

<sup>17</sup> Opposer's Response to Applicant's Interrogatory No. 24.

. . . The two names - - Waterford and Lismore - - are synonymous with quality.

*HFN The Weekly Newspaper for the Home Furnishing Network* (May 27, 2002).

To celebrate the 50<sup>th</sup> anniversary of Lismore, its most popular stemware pattern on both sides of the Atlantic, Waterford has introduced a series of Lismore centerpiece bowls of Irish crystal.

*Contra Costa Times* (July 14, 2001).

Among Richmond families, Lismore by Waterford is the best-selling crystal pattern. It's also been Waterford's most popular design for three generations of brides. "It's our hottest bridal registry pattern," Holder said. "It's the traditional look. The shape is traditional. The cut is traditional. And there are so many ranges of sizes and shapes" in Lismore, named for a town in Waterford County, Ireland.

"Lismore is the pattern everybody has had - your grandmother had it, your mother had it, everybody recognizes it and it's a comfort zone," Moburn said. With 27 different glasses, it's also Waterford's most expansive pattern.

*Richmond Times Dispatch* (January 16, 2001).

For example, Waterford's Lismore, Cristal d'Arques' Longchamps and Waterford's Marquis' Vintage take up the top three positions in both the stemware and barware rankings.

*HFN The Weekly Newspaper for the Home Furnishing Network* (August 26, 2002).

"The majority of the collection is based upon our Waterford traditional cut

crystal patterns," said Leute. "Some carry names of the most popular Waterford stemware pattern, an interesting aspect of the line, such as Lismore," the firm's top-selling pattern. "It's important to make the tie-in with our Waterford name," Leute noted.

*HFN The Weekly Newspaper for the Home Furnishing Network* (December 30, 1996).

Lismore is Waterford's number-one selling crystal pattern.

*HFN The Weekly Newspaper for the Home Furnishing Network* (September 25, 1995).

Crystal Clarity: Waterford's Lismore cut exerts magical attraction that's lasted since 1952.

Few products designed in 1952 have survived the comings and goings of home trends, but Waterford Crystal's Lismore pattern has sparkled its way around the world for decades - especially on holiday tabletops. As its 50<sup>th</sup> anniversary approaches, it remains the renowned company's most popular design.

\* \* \*

Why the almost universal appeal of this design? Like fine art that never looks dated, Lismore has a timeless quality. It holds its own next to pizza and Pier 1 plates just as it does with smoked salmon and fine china. (Wedgwood, in fact, makes a Lismore china pattern as well).

*Chicago Sun Times* (December 28, 2001).

Although applicant has not yet sold any LISA MORI products in the United States, its MEDEA styled stemware is virtually identical to the LISMORE style stemware.<sup>18</sup>

#### Standing

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

#### Priority

Because opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in this case. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

#### Likelihood Of Confusion

Our determination of likelihood of confusion under Section 2(d) of the Lanham Act is based on an analysis of all the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E. I.*

---

<sup>18</sup> Steinberger Dep., Exhibit 2 (Document A075); Gavin Dep., Exhibits 5 and 7.

*du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). The relevant *du Pont* factors are discussed below.

A. Fame

We turn first to the factor of fame, because this factor plays a dominant role in cases featuring a famous or strong mark. *Kenner Parker Toys Inc. v. Rose Arts Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). 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. *Id.* Indeed, “[a] strong mark . . . casts a long shadow which competitors must avoid.” *Id.* A famous mark is one “with extensive public recognition and renown.” *Id.* See also *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005).

In determining whether a mark is famous, we may consider sales, advertising expenditures, and the length of time the mark has been used. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002); *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d 1811, 1817 (TTAB 2005). This information, however, must be placed in context (e.g., a comparison of advertising figures with competitive products, market share, reputation of the

product, etc.). *Bose Corp. v. QSC Audio Products Inc.*,  
*supra*.

The evidence supporting the fame of opposer's LISMORE trademark includes its use since 1952, the extensive sales of LISMORE products, its 8% market share making it the leading pattern of crystal stemware, and the general renown of the LISMORE crystal stemware pattern as evidenced by the news and magazine articles. On the other hand, substantially every reference to the LISMORE products in the sample advertising introduced by opposer also includes the WATERFORD house mark (although not necessarily in tandem with the LISMORE product mark).<sup>19</sup> All of the news and magazine articles also reference the WATERFORD house mark. In fact, in one article, Jeffrey Leute, "market manager, general giftware, Waterford," is quoted as saying the following:

Some [Waterford traditional cut crystal patterns] carry names of the most popular Waterford stemware pattern, an interesting aspect of the line, such as Lismore . . . It's important to make the tie-in with our Waterford name.<sup>20</sup>

Thus, the extent of the public recognition and renown of the LISMORE mark separate and apart from the WATERFORD house mark is not clear. *See Bose Corp. v. QSC Audio Products*

---

<sup>19</sup> Gavin Dep., Exhibits 3 and 5-7; Cockrum Dep., Exhibits 1-7.

<sup>20</sup> Opposer's notice of reliance, *HFN The Weekly Newspaper for the Home Furnishing Network* (December 30, 1996).

*Inc.*, 63 USPQ2d at 1308 (“we think those who claim fame for product marks that are used in tandem with a famous house mark can properly be put to tests to assure their entitlement to the benefits of fame for the product marks”).

“In view of the extreme deference that is accorded to 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, we think that it is the duty of a plaintiff asserting that its mark is famous to clearly prove it.” *Blue Man Productions Inc. v. Tarmann*, *supra* at 1819. Although opposer has shown that its mark has achieved a high degree of recognition, the evidence is insufficient to support a finding that the mark is famous. Thus, although we find that LISMORE is a strong mark, entitled to broad scope of protection or exclusivity of use, it is not a famous mark entitled the extensive breadth of protection accorded a truly famous mark.<sup>21</sup>

---

<sup>21</sup> Applicant’s argument that the term “Lismore” is geographically descriptive does not dissuade us from finding that LISMORE is a strong mark. (Applicant’s Brief, p. 9). First, to the extent that applicant is making a collateral attack on the validity of opposer’s pleaded registrations, we will not entertain such a claim without a counterclaim to cancel opposer’s pleaded registrations. We note that because three of the pleaded registrations are more than five years old, applicant is time barred from seeking to cancel opposer’s pleaded registrations. Second, the only evidence that the term “Lismore” has geographic significance is the Cockrum Dep. Exhibit 7 (“Lismore takes its name from an ancient village that dates back to the early 7<sup>th</sup> century”) and two articles in opposer’s notice of reliance: (i) Heart of Glass in Ireland of the Welcomes magazine (July-August 2002) (“The pattern was called Lismore after the Waterford town, chosen by Henry II’s son John, then Lord of Ireland, for his

B. The similarity or dissimilarity and nature of the goods as described in the application and opposer's registrations.

It is well settled that likelihood of confusion is determined on the basis of the goods as they are identified in the application and in the pleaded registrations. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002). The description of goods in the LISA MORI application is "crystal and lead crystal glassware, namely, beverage ware, cups, vases, and bowls, candlesticks, and picture frames, all made of crystal and lead crystal glassware." Opposer's LISMORE marks are registered for, *inter alia*, crystal glassware, glassware, namely, vases, bowls, candlesticks, tumblers and glasses. In addition, as noted above, applicant's MEDEA styled stemware is virtually identical to the LISMORE styled stemware.<sup>22</sup> Thus, at least some of the goods of the parties are identical.

Despite the identity in part of the goods as identified, applicant argues that "[t]he cost of the parties' goods differentiates them in the market place. The

---

castle in 1185"); and (ii) Crash Course In Choosing Crystal: Selecting Patterns, Sets Can Be Daunting, *Richmond Times Dispatch* (January 16, 2001) ("And there are so many ranges of sizes and shapes in Lismore, named for a town in Waterford County, Ireland"). There is no evidence that Lismore is noted for its crystal industry or that consumers in the United States are generally aware that Lismore is a geographic location.

<sup>22</sup> Steinberger Dep., Exhibit 2 (Document A075); Gavin Dep., Exhibits 5 and 7.

price of a LISMORE item is approximately \$60.00. (Citation omitted). Whereas the average selling price for Applicant's products is \$5.45. (Citation omitted)."<sup>23</sup> However, we cannot resort to such extrinsic evidence to restrict the prices of applicant's or registrant's goods. See *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986) (evidence that relevant goods are expensive wines sold to discriminating purchasers must be disregarded given the absence of any such restrictions in the application or registration). We must presume that both applicant's and registrant's crystal glassware would be sold at all the usual prices for such goods, which based on this record, can range from \$5.45 to \$60.

C. The similarity or dissimilarity of established, likely-to-continue trade channels and buyers to whom sales are made.

Because there is no limitation or restriction in the description of goods in the application or opposer's registrations, the goods are presumed to travel in the same channels of trade to the same class of purchasers. *Id.* at 62 USPQ2d at 1005. See also *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Moreover, applicant conceded that the products listed in both applicant's and opposer's

---

<sup>23</sup> Applicant's Brief, p. 14.

description of goods may be promoted in the same channels of trade and to the same class of consumers.<sup>24</sup>

Nevertheless, as noted above, because opposer's crystal and glassware is expensive, applicant argues that consumers exercise a high degree of care in purchasing these products.<sup>25</sup> However, we are restricted to deciding the issue of likelihood of confusion based on the goods as identified in the application and registrations. Absent any restrictions in the description of goods, applicant's products and registrant's products are identical at least for some of the products. *In re Bercut-Vandervoort & Co., supra.*

In view of the foregoing, our consideration of the goods must include expensive and inexpensive products sold to discriminating and sophisticated purchasers and to ordinary consumers. *Id.* Even assuming, arguendo, that customers for opposer's products exercise a high degree of care, applicant does not provide any evidence regarding the decision process used by these careful and sophisticated purchasers, the role trademarks play in their decision making process, or how observant and discriminating they are in practice. On the other hand, applicant also fails to present evidence regarding how applicant's presumably

---

<sup>24</sup> Applicant's Responses to Opposer's Requests for Admission Nos. 44 and 45.

<sup>25</sup> Applicant's Brief, pp. 14-16.

ordinary consumers will react to the LISA MORI mark used in connection with crystal glassware, especially in light of the strength of the LISMORE mark. Accordingly, the problem with applicant's "degree of consumer care" argument is that there is no corroborating evidence and it is inconsistent with the description of goods in the application and registrations (*i.e.*, not all crystal glassware is expensive and not all of the potential consumers for crystal glassware are sophisticated consumers).

In view thereof, the channels of trade and classes of consumers are factors that favor a finding of likelihood of confusion.

D. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.

We now turn to the *du Pont* 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., supra.* Where, as in this case, the marks appear on identical goods, the degree of similarity between the marks that is necessary to support a finding of likelihood of confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

In this case, we find that the marks are similar in appearance. LISMORE and LISA MORI both begin with the

letters "L-I-S" and are followed by the letters "M-O-R." While there are differences in the appearance of the marks, we find the similarities in the appearance are greater than the differences.

We find that there are phonetic differences between the marks. LISMORE likely would be pronounced as LĪS MŌR or LĪZ MŌR and LISA MORI likely would be pronounced LĒ SĀ MŌR Ē or LĒ SĀ MŌ RĒ. On the other hand, there is not necessarily one, correct pronunciation for a mark or way of gauging how a mark will sound. *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 n.3 (TTAB 1988). Robert Cockrum testified that he has heard "all sorts of variations," including "Lizemore," "Lizmore," and "Leezmore."<sup>26</sup> Thus, the marks may be susceptible to similar pronunciations. While there are some phonetic similarities, we conclude that the differences in the sound of the marks slightly outweighs the similarities.

Both LISMORE and LISA MORI are arbitrary terms as applied to crystal glassware. While LISA MORI would be perceived as a personal name, it is not clear what meaning LISMORE would convey other than, perhaps, a surname. In analyzing the marks, however, we must keep in mind that a side-by-side comparison is not the test. Rather, it is whether the marks are sufficiently similar in terms of their

---

<sup>26</sup> Cockrum Dep., p. 15. Richard Babick testified that people routinely mispronounce the names of new crystal offerings, especially the French names. (Babick Dep., p. 20).

overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The "focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of the trademarks." *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1848 (TTAB 2004). See also, *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1740 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). Accordingly, given the market strength and arbitrary nature of opposer's mark, the identity of the goods, and the fact that both marks have the same general appearance, the marks engender a similar commercial impression.

In view of the foregoing, we find that the marks, while obviously not identical, are similar, and that the similarities outweigh their differences. *In re Lamson Oil Co.*, *supra* at 1042 n.4 ("the rule is that taking into account all of the relevant facts of a particular case, similarity as to one factor (sight, sound or meaning) alone "may be sufficient to support a holding that marks are confusingly similar") (emphasis in the original). See also *In re White Swan Ltd.*, 8 UPSQ2d 1534, 1535 (TTAB 1988).

E. Balancing the factors.

In weighing all of the likelihood of confusion factors present in this case, we find that opposer's LISMORE mark is a strong mark, that the goods at issue are identical in part, that the goods move in the same channels of trade and are sold to the same consumers, and that the marks are similar. Accordingly, applicant's mark, LISA MORI, when used in connection with "crystal and lead crystal glassware, namely, beverage ware, cups, vases, and bowls, candlesticks, and picture frames, all made of crystal and lead crystal glassware," so resembles opposer's mark, LISMORE, used in connection with crystal glassware, glassware, namely, vases, bowls, candlesticks, tumblers and glasses, as to be likely to cause confusion.

While this conclusion is not without doubt, this is a case where the junior party was well aware of the LISMORE mark and its prominence in the field of crystal stemware.<sup>27</sup> Under such circumstances, applicant is under a duty to select a mark sufficiently different from that of opposer to avoid any likelihood of confusion, and having failed to do so, any doubt must be resolved in favor of the prior user. *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPA 1281, 1285 (Fed. Cir. 1984), *quoting*,

---

<sup>27</sup> Applicant's Responses to Opposer's Requests for Admission Nos. 20-23, 34, 50, 51; Applicant's Response to Interrogatory No. 15; Steinberger Dep., p. 11.

*Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983); *Carlisle Chemical Works v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 11, 112 (CCPA 1970). See also, *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433, 437 (TTAB 1983).

#### Dilution

In addition to its Section 2(d) claim, opposer has asserted a dilution claim. The Lanham Act provides for a cause of action for the dilution of famous marks. Sections 13 and 43(c) of the Lanham Act, 15 U.S.C. §§1063 and 1125(c).

The Lanham Act provides as follows (emphasis added):<sup>28</sup>

Subject to the principles of equity, **the owner of a famous mark** that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment **of the famous mark**, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

Since we have already determined that opposer's mark is not famous for purposes of likelihood of confusion, and

---

<sup>28</sup> Section 43(c) as it pertains to dilution has been amended effective October 6, 2006.

because the requirements for proving fame for dilution are more stringent than the requirements for proving "fame" for likelihood of confusion, opposer's dilution claim must fail. *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1170 (TTAB 2001); *NASDAQ Stock Market Inc. v. Antarctica S.r.l.*, 69 USPQ2d 1718, 1736-1737 (TTAB 1998). Therefore, based on the record before us, opposer has not demonstrated the fame element necessary to establish a claim of dilution.

Decision: The opposition is dismissed as to opposer's dilution claim.

The opposition is sustained as to opposer's claim of priority of use and likelihood of confusion, and therefore registration to applicant is refused.