

Mailed:
September 30, 2005

This Opinion is Not
Citable As Precedent
of the TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

La Casa Vhernier S.r.l.
v.
7 West Accessories, Inc.

Cancellation No. 92041424

Mark I. Peroff and Darren W. Saunders of Kirkpatrick &
Lockhart LLP for La Casa Vhernier S.R.L.

Ezra Sutton of Ezra Sutton, P.A. for 7 West Accessories,
Inc.

Before Holtzman, Rogers and Drost,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

La Casa Vhernier S.r.l. (petitioner) has filed a
petition to cancel Registration No. 2182306 of 7 West
Accessories, Inc. (respondent). Respondent's registration,
on the Principal Register, is for the mark VERNIER for
"watches" and lists 1991 as the date of first use of the
mark and first use of the mark in commerce.¹

¹ Registration no. 2182306 issued on August 18, 1998, based on an
application filed July 9, 1997

Petitioner, a corporation of Italy, has asserted that it has used the mark "VHERNIER for jewelry in United States commerce continuously since 1988." In addition, petitioner has asserted that it has applied to the United States Patent and Trademark Office [Office] to register its pleaded mark for a wide variety of jewelry and custom jewelry items, as well as for what may be broadly referred to as ornamental items, pens, clocks and watches; that its application has been refused under Section 2(d) of the Trademark Act because of the existing registration of respondent; that the parties' respective goods are related and generally sold in the same channels of trade; and that the similarity of the marks is likely to cause confusion as to the origin, source or sponsorship of respondent's goods.

The petition for cancellation is a sufficient pleading of petitioner's standing, its priority of use and the likelihood that consumers would be confused, mistaken or deceived by contemporaneous use of the marks in the marketplace. See Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), Young v. AGB Corp., 152 F.3d 1377, 47 USPQ2d 1752 (Fed. Cir. 1998) and Martahus v. Video Duplication Services Inc., 3 F.3d 417, 27 USPQ2d 1846 (Fed. Cir. 1993).

In its answer to the petition, respondent asserted that petitioner's use of its mark "is an infringement of"

respondent's registered mark, and admitted the allegations set forth in paragraphs 2, 4, 6 and 7 of the petition. These admissions, as petitioner has correctly noted in its brief, constitute conclusive admissions that jewelry and watches are related goods generally sold in the same channels of trade (paragraph 6) and that the parties' involved marks are "so similar ... as to be likely to cause confusion" (paragraph 7). See Brown Company v. American Stencil Manufacturing Company, Inc., 180 USPQ 344, 345 n.5 (TTAB 1973) (admission during pleading results in estoppel precluding ability to prove anything to contrary).

At trial, petitioner took testimony depositions of four witnesses, both to obtain their testimony and to have them identify and introduce various documents. Specifically, petitioner took the testimony depositions of Angela Camurati, a founder and current Vice President of petitioner; Jean-Francois Michaud, the exclusive distributor of petitioner's products (except in Italy) from 1987 through 1999; Gisela Hammond, a retired former jewelry designer and retailer who sold some of petitioner's products for a period of approximately three years in the United States; and Vivian Crump, an employee responsible for books and record keeping for a retailer that was one of petitioner's first customers in the United States. Counsel for respondent attended each of these depositions and cross-examined each

witness. As respondent did not file a brief on the case, it has failed to maintain the various objections it raised during the depositions and we have no evidentiary issues to resolve. We have, therefore, reviewed all the testimony and exhibits, according it the probative value that it warrants and considering it as a whole.

Standing is a threshold issue that must be proven by a plaintiff in every inter partes case. Ritchie v. Simpson, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999). In this case, however, we find respondent's pleading admissions and its allegation that petitioner's use of the VHERNIER mark "is an infringement of" respondent's registered mark to obviate any need for petitioner to prove its standing. Even if petitioner's responsibility for proving standing had not been obviated by respondent, petitioner has in fact provided evidence of its standing through the testimony of Angela Camurati. Ms. Camurati testified that petitioner's pleaded mark was registered in 1991 but had expired; that petitioner subsequently discovered "a company by the name of 7 West registered that name"; and that petitioner filed the cancellation proceeding because the marks are spelled in a similar way and pronounced exactly the same. Dep. pp. 23-25. Respondent's admissions and allegation of infringement, coupled with petitioner's testimony, clearly establish that petitioner has a reasonable basis for its belief that it

would be damaged by the continued registration of respondent's mark and that petitioner has a real interest in this proceeding. See Ritchie; see also Jewelers Vigilance Committee Inc. v. Ullenberg Corp., 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987).

A petitioner relying on common law rights it claims in an unregistered mark must prove both the distinctiveness of the pleaded mark and priority of use. See Towers v. Advent Software, Inc., 913 F.2d 942, 945, 16 USPQ2d 1039, 1041 (Fed. Cir. 1990) (distinctiveness may be inherent or acquired) and Hydro-Dynamics Inc. v. George Putnam & Company Inc., 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987) ("The common law and the Lanham Act require that trademark ownership be accorded to the first bona fide user.") (citation omitted).

Ms. Camurati testified that the inspiration for petitioner's mark was a Venetian military commander "known for everything beautiful"; that the commander's name was "Venier"; but that "because the Venier family still exists, we decided to take only the spirit and to complicate the name by adding an H." Dep. pp. 53, 58-59. We therefore find petitioner to have met its burden of establishing that its mark is inherently distinctive, insofar as it appears to have been created and there is nothing in the record to

indicate that it is non-distinctive, as it would be if the record revealed the term to be descriptive or a surname.

The only remaining issue then is whether petitioner has proven its priority.² Petitioner must prove its priority by a preponderance of the evidence. Hydro-Dynamics, 1 USPQ2d at 1773 ("In the usual case the decision as to priority is made in accordance with the preponderance of the evidence."). Moreover, petitioner's evidence of priority is not to be considered piece by piece but "[r]ather, one should look at the evidence as a whole, as if each piece of evidence were part of a puzzle which, when fitted together, establishes prior use." West Florida Seafood Inc. v. Jet Restaurants Inc., 31 F.3d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994). Further, as respondent did not take any testimony regarding the date of first use listed in its involved registration (1991), it is therefore restricted, for purposes of determining priority, to the filing date (July 9, 1997) of the application that resulted in issuance of its registration. See Lone Star Manufacturing Co., Inc. v. Bill Beasley, Inc., 498 F.2d 906, 182 USPQ 368, 369 (CCPA 1974), Intersat Corp. v. International Telecommunications

² Respondent asserted in its answer, as affirmative defenses, that petitioner had "no proof of use of the mark VHERNIER in the U.S. prior to Registrant's use of VERNIER in the U.S. on watches" and that because "Registrant has earlier rights in the U.S., and since the marks are confusingly similar, Petitioner has no right to use VHERNIER in the U.S." These are not affirmative defenses, per se, and are considered merely to elaborate on respondent's denial of petitioner's priority.

Satellite Organization, 226 USPQ 154 (TTAB 1985), and American Standard Inc. v. AQM Corporation, 208 USPQ 840 (TTAB 1980).

Ms. Camurati testified that petitioner began selling jewelry to a United States retailer of jewelry, Bryan & Scott, in 1985. Dep. p. 10. The testimony of Vivian Crump, a 22-year employee of Bryan & Scott, and exhibits thereto, corroborates the testimony of Ms. Camurati. Ms. Crump testified as to the system of record keeping at Bryan & Scott and as to particular records she retrieved which corroborated sales by petitioner to Bryan & Scott as early as 1985; and copies of the records were introduced as exhibits.

Jean-Francois Michaud testified that he was the sole distributor for petitioner's jewelry collection, except in Italy, from 1987 through 1999. Mr. Michaud marketed and took orders for petitioner's products in the United States through direct visits to clients, "trunk shows" at U.S. retailers, and through trade shows. He also testified that the VHERNIER mark would be displayed along with petitioner's goods at these shows: "Q. What did these signs look like? Can you describe them for example? A. "We have very nice signs. Rock crystals, plain sterling silver signs. Fine display with the Vhernier name, yes. Also the boxes, the presentation, leather boxes with the Vhernier name, the

trays with the Vhernier name." Dep. p. 8. Mr. Michaud also testified that he regularly visited petitioner's customers in the United States, beginning in 1989, for each year he was petitioner's distributor. Dep. p. 30. During trunk shows at retailers, the same signage as that used at the trade shows would be employed in the displays of petitioner's products. Dep. p. 31. Mr. Michaud's testimony is supported by dozens of exhibits, including many invoices establishing sales well prior to the filing date of the application that resulted in respondent's registration which, again, is the earliest date on which respondent may rely for priority.

Ms. Camurati and Mr. Michaud both testified that petitioner actually stamped or marked petitioner's items of jewelry with petitioner's mark. Camurati dep. p. 20; Michaud dep. p. 69. Ms. Camurati testified that petitioner's products continue to bear petitioner's mark, as of the date of her testimony. Dep. p. 23.

As to the continuing nature of petitioner's sales, Mr. Michaud testified that sales of petitioner's products in the United States were continuous throughout the period of 1987 to 1999 when he was petitioner's distributor. Dep. p. 42. Ms. Camurati identified by name some "present customers" of petitioner, e.g., Bergdorf and Goodman in New York, and introduced a confidential list of other retailers of

petitioner's products in the United States. Dep. p. 15 and exh. 1.

The testimony of Ms. Camurati, Mr. Michaud, Ms. Crump and Gisela Hammond, when "fitted together," clearly establishes, by a preponderance of the evidence, petitioner's use of its mark as a trademark well prior to any date on which respondent may rely. Further, the testimony of Mr. Michaud is unequivocal that use continued through the time he served as petitioner's distributor and the testimony of Ms. Camurati establishes that petitioner continues to mark its jewelry with its mark and to sell its jewelry to retailers in the United States for resale. Accordingly, we find petitioner has established the prior and continuous use necessary for its claim under Section 2(d). Because petitioner's standing also has been established and because respondent has admitted likelihood of confusion, judgment is entered in favor of petitioner.

Decision: The petition for cancellation is granted and respondent's registration shall be cancelled in due course.