

**THIS OPINION IS NOT A  
PRECEDENT OF  
THE T.T.A.B.**

Oral Hearing: September 22, 2010 Mailed: February 23, 2011

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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Swatch AG  
v.  
Amy T. Bernard and Beehive Wholesale, LLC

—————  
Opposition No. 91169312  
to application Serial No. 78459527

—————  
Jess M. Collen and Thomas P. Gulick of Collen IP for Swatch  
AG.

William J. Utermohlen of Oliff & Berridge, PLC for Amy T.  
Bernard.

—————  
Before Seeherman,<sup>1</sup> Cataldo and Wellington,  
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicants, Amy T. Bernard and Beehive Wholesale, LLC,  
seek to register on the Principal Register the mark  
displayed below:

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<sup>1</sup> Administrative Trademark Judge Ellen Seeherman is substituted  
in place of Administrative Trademark Judge James Walsh, who  
retired from the Trademark Trial and Appeal Board on January 28,  
2011.

Swap

for "watch faces, ribbon watch bands, slide pendants, and beaded watch bands" in International Class 14.<sup>2</sup>

In its amended notice of opposition opposer, Swatch AG, pleaded ownership of the following marks, previously used and registered on the Principal Register:

swatch

for "watches and parts therefor" in International Class 14;<sup>3</sup>

SWATCH

(in typed format) for "watches, clocks and parts therefor" in International Class 14;<sup>4</sup> and

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<sup>2</sup> Application Serial No. 78459527 was filed by Amy T. Bernard on July 30, 2004, based upon her assertion of June 1, 2003 as a date of first use of the mark anywhere and in commerce. The assignment of the application to Beehive Wholesale, LLC was recorded with the Assignment Branch of the United States Patent and Trademark Office (USPTO) subsequent to commencement of this proceeding, and Beehive Wholesale, LLC was joined as party defendant by a Board order issued on December 23, 2008.

<sup>3</sup> Registration No. 1356512 issued on August 27, 1985. Section 8 affidavit accepted; Section 15 affidavit acknowledged. Renewed.

<sup>4</sup> Registration No. 1671076 issued on January 7, 1992. Section 8 affidavit accepted; Section 15 affidavit acknowledged. Renewed.

# swatch

for "books and periodicals, namely a series of books illustrating collectable articles, magazines for watch collectors" in International Class 16.<sup>5</sup>

As grounds for opposition, opposer alleged that applicants' mark, when used in connection with the recited goods, so resembles opposer's famous SWATCH marks, previously used and registered for goods including watches, as to be likely to cause confusion; that applicants' mark is likely to dilute the distinctive character of opposer's SWATCH marks; and that applicants' mark is merely descriptive as applied to the recited goods.

In their answer to the amended notice of opposition, applicants denied the salient allegations thereof.

### **Evidentiary Matters**

We begin by observing that on February 24, 2010, opposer submitted on CD-ROM the testimonial depositions of Patricia Higgins and Daniel Rodriguez, the rebuttal testimonial depositions of Amy T. Bernard and Brent Bernard, and exhibits corresponding thereto. At one time evidence could be made of record in this manner pursuant to Trademark

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<sup>5</sup> Registration No. 2050210 issued on April 8, 1997. Section 8 affidavit accepted; Section 15 affidavit acknowledged. Renewed.

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Rule 2.126(b). However, by amendment effective August 31, 2007 and applicable to all cases pending or commenced on or after that date, Trademark Rule 2.126(b) no longer accords parties the option of making submissions to the Board in CD-ROM form.<sup>6</sup> Thus, because opposer's above-noted testimonial depositions and exhibits were not filed on paper or by electronic means as required under the operative Trademark Rule, they have not be considered in this decision.<sup>7</sup>

In addition, each party has filed objections to certain testimony and exhibits introduced by its adversary. However, we see no compelling reason to discuss the objections in a detailed fashion. Suffice it to say, we have considered all of the testimony and exhibits submitted by the parties with the exception of the testimony and exhibits improperly submitted on CD-ROM and excluded as discussed above. In so doing, we have kept in mind the various objections raised by the parties, and we have accorded whatever probative value the subject testimony and exhibits merit.

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<sup>6</sup> Notice thereof is posted on the Trademark Trial and Appeal Board (TTAB) page of the USPTO internet website at <http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>  
[http://www.uspto.gov/web/offices/com/sol/notices/72fr42242\\_FinalRuleChart.pdf](http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf).

<sup>7</sup> We also note that applicants raised objections to certain testimony and exhibits that were submitted on CD-ROM. Because of our decision to exclude these depositions and exhibits for the reasons discussed above, we need not consider these objections.

**The Record**

By operation of Trademark Rule 2.122, 37 C.F.R. §2.122, the record in this case includes the pleadings and the file of the involved application.

In addition, during its assigned testimony period, opposer submitted notices of reliance upon copies of its pleaded registrations prepared by the USPTO showing current status and title thereto; printed publications and printouts from Internet websites that are available to the general public; dictionary definitions; the discovery depositions of Amy Bernard and Brent Bernard; and opposer's interrogatories to applicants and applicants' responses thereto.

During their assigned testimony period, applicants submitted the testimony depositions, with exhibits, of Amy Bernard, applicant and Beehive Wholesale, LLC's ("Beehive") founder; Brent Bernard, Beehive's President; and Michelle Bernard, Beehive's Chief Operating Officer. Applicants also submitted notices of reliance upon dictionary definitions; opposer's responses to applicants' requests for admission; and excerpts from the discovery deposition of Caroline Faivet, an officer of The Swatch Group (U.S.).

Opposer and applicants filed main briefs on the case, and opposer filed a reply brief.

Both parties have designated portions of their testimony, evidence and briefs as containing "confidential"

information. In this decision we will endeavor to discuss materials deemed confidential only in general terms.

#### **Opposer's Standing**

Because opposer has properly made its pleaded registrations of record, and further has shown that it is not a mere intermeddler, we find that opposer has established its standing to oppose registration of applicants' mark. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

#### **Mere Descriptiveness**

Turning to opposer's claim of mere descriptiveness, a term is deemed to be merely descriptive of goods or services, within the meaning of Trademark Act Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of applicants' goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. See *In re*

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*H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). It further is settled that "[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods and services are will understand the mark to convey information about them." *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002).

In this case, opposer argues that applicants' SWAP mark merely describes the identified goods, namely, "watch faces, ribbon watch bands, slide pendants, and beaded watch bands." In support of its position, opposer relies upon the following statements made by two of applicants' witnesses in their discovery depositions, taken prior to opposer's amendment of its notice of opposition to assert mere descriptiveness as a ground therefor:

Q. Okay. So how was it decided that SWAP was going to be the name?

A. It was the one everyone liked in our office. It was short. It meant interchangeable.

Q. Okay. And when you say interchangeable, is that a function of the product?

A. Correct.

Q. Okay. Can you explain how it's interchangeable?

A. You can change out bands to different watch faces in according [sic] to what color you're wearing that day, so you can have one watch head and wear it multiple ways.

Q. So what you're saying is you swap?

A. Uh-huh (affirmative).

Q. You're swapping the band with the face?

A. Right.

Q. Okay.

A. Yeah.

Q. And so then you're basically describing a function of the watch?

A. Right.<sup>8</sup>

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Q. Okay. Did - let me rephrase it. I'm actually going to go a little bit further back. When you decided that you were going to select SWAP over - I believe before you said Sir Mix-a-Lot, Mix Max. Can you tell me why you chose that name?

A. We were looking for a term that defined interchangeable, and SWAP fit that for us.

Q. Okay. And why was that important to you?

A. Because we - in that product line we sell custom components that are interchangeable.

Q. Okay. When you say that you sell custom components that are interchangeable, what parts, components are you talking about?

A. Watch bands, watch faces.

Q. So just to make sure I'm understanding you right, you have different types of watch faces and different types of watch bands that can be used interchangeably?

A. Correct.

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<sup>8</sup> Opposer's First Notice of Reliance, Exhibit 30, Discovery Deposition of Amy Bernard, p. 12-13.

Q. Okay. So you selected the SWAP name over the other ones - I'm just trying to understand - because it defined what the product was doing, what you can do with the product; is that correct?

A. Correct.

Q. Okay. So you picked SWAP because it best described, what, a function of the product?

A. Correct.<sup>9</sup>

Opposer argues that, in light of the above statements, "Applicant has even admitted that it adopted the mark because it well described Applicant's goods."<sup>10</sup>

However, applicants' same witnesses made the following statements during their testimony depositions:

Q. This exhibit contains a list of names that you were considering for what is now the Swap Watch product?

A. This list contains a brainstorming session and words that came out of that to help us come up with a name for the Swap brand of products, yes.

Q. Well, obviously before it was the Swap brand of products, correct?

A. Correct.

Q. Included in this list is Switch Watch? Is that correct?

A. Yes.

Q. Mix Match is another name?

A. Mix Match, yes.

Q. Create your own watch?

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<sup>9</sup> Id. at Exhibit 31, Discovery Deposition of Brent Bernard, p. 25-6.

<sup>10</sup> Opposer's Brief, p. 36.

A. Yes.

Q. Part of the reason why these names were considered was because it was to feature a function of the particular product. Is that correct?

A. Yes.

MR. UTERMOHLEN:  
Objection, vague.

A. If you're asking whether it suggests interchangeability, yes.

Q. Does the Swap product contain custom components that allow a customer to choose their own style of watch?

A. Yes.

Q. Did you select Swap as a possible name for your watch because you were looking for a term that defined interchangeability?

MR. UTERMOHLEN:  
Objection, vague.

A. We picked the Swap mark because of the fact that it highlights the feature that you could do that.<sup>11</sup>

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Q. Ms. Bernard, let me show you what's been marked as Exhibit 17. Do you recognize that document?

A. Yes.

Q. What is it?

A. It's a piece of paper where we did a brainstorming session and tried to come up with names for our new product line.

Q. And which of these names were potential, or let me restate that. Which of these words were potential names for the product line?

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<sup>11</sup> Brent Bernard Testimony (cross-examination), p. 84-6.

A. Pretty much all of them. They were all considered. We wrote down just a list of what we were thinking about. Most of them on there are potential names, with the exception of "watch" or "beads," you, know, from just brainstorming.

Q. So "Sir Mix a Lot" was one?

A. Yes.

Q. And "Switch" was another?

A. Yes.

Q. "Mix Match"?

A. Yes.

Q. "Mix Max" as well?

A. Yes.

Q. Did all those names suggest interchangeability?

MR. GULICK:  
Objection, foundation.

A. Yes, they did.

Q. And is that what you thought at the time?

A. Yes.

Q. Of those names, why was Swap chosen?

A. Out of the names we came up with, Swap was the shortest, number one. It was the easiest to remember, and it was catchy.<sup>12</sup>

While opposer argues that the statements made by applicants' officers during their discovery depositions should be construed as admissions that SWAP merely describes the identified goods, these statements are inconsistent with

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<sup>12</sup> Amy Bernard Testimony, p. 8-10.

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the statements of those same witnesses during their testimonial depositions, in which they assert that SWAP suggests a feature - namely interchangeability - of the recited goods. It is clear from the entirety of the testimony that applicants' witnesses are not sophisticated in trademark law or the significance of particular words as they relate to trademark principles, and that they followed the language used by the attorneys who questioned them. Therefore, we construe the statements made in applicants' discovery depositions as simply demonstrating a lack of understanding of the significance of descriptiveness versus suggestiveness as applied to applicants' mark at a time when mere descriptiveness was not a ground for opposition in this proceeding, and the statements fall short of admissions that SWAP merely describes applicants' recited goods. We note in this regard that opposer has not made of record any request for admission in which applicants admit that their applied-for mark is merely descriptive.

In addition, opposer relies upon the dictionary definition of SWAP: "to trade one thing for another; to exchange (one thing) for another; an exchange of one thing for another."<sup>13</sup> Opposer further relies upon the following evidence of two instances of third-party use of SWAP in

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<sup>13</sup> Applicants' Notice of Reliance, Exhibit 34, from The American Heritage College Dictionary (3d ed., 1997).

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connection with watches. The first is simply in an Internet address of Orange County Creations:

Changeable watch faces can be used on our Changeable watch bands (also known as Build-A-Watch). The Changeable watch faces and bands allow you to order just a few faces and bands and have a large variety of choices. ...  
[http://occreations.net/build\\_a\\_watch\\_swap\\_faces;](http://occreations.net/build_a_watch_swap_faces;)<sup>14</sup>

The second is use of SWAP for PUMA watches:

PUMA SWAP BLACK & WHITE INTERCHANGEABLE STRAP WATCH NIB

Puma Women's Swap Steel Dress Crystal Watch

Women's Puma Black White Swap Band Watch

New PUMA Watch SWAP Stainless Steel Bracelet - Limited

PUMA LADY SWAP WATCH TWO BANDS 50m

PUMA SWAP LADIES WATCH

New Puma Watch SWAP Rose Gold - Special Edition STONES

Women's' Puma Brown & White Swap Watch ...  
<http://shop.ebay.com;><sup>15</sup>

and

Puma Women's Swap Interchangeable Band Watch

Puma Women's Sportslifestyle Collection Swap Interchangeable Band

Puma Swap Ladies Watch ...  
<http://www.google.com.><sup>16</sup>

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<sup>14</sup> Opposer's Notice of Reliance, Exhibits H and I.

<sup>15</sup> Id. at Exhibit J.

<sup>16</sup> Id. at Exhibit K.

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However, the above evidence falls short of establishing that SWAP merely describes a function, feature or use of applicants' goods. The contradictory statements of applicants' officers demonstrate little more than a lack of understanding of the significance of the term comprising their mark. There is nothing in the dictionary definition of SWAP to indicate that the term merely describes watch bands, watch faces or slide pendants. And it is impossible to tell from the Internet address of Orange County Creations how the term SWAP is used therein. Similarly, it is unclear from opposer's evidence whether Puma is using the term SWAP in a descriptive sense, as a trademark, or as part of a trademark, although we note that the term is shown either in all capital letters or with its initial letter capitalized, which is consistent with trademark use.

When viewed in its totality, the evidence of record is insufficient to support a finding that SWAP merely describes a function, feature or characteristic of applicants' goods. Given the uncertainty of the third-party evidence and the lack of clear testimony or other evidence of mere descriptiveness, we find that opposer has failed to meet its burden of proof on this ground. Based upon this record, SWAP does suggest interchangeability, which is a feature of the goods. However, suggestive marks are registrable on the Principal Register without a showing of acquired

distinctiveness. Opposer's evidence simply is insufficient to create a prima facie case of mere descriptiveness such that the burden would shift to applicants to demonstrate that their mark has acquired distinctiveness.

#### **Opposer's Priority**

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

#### **Likelihood of Confusion**

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); and *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

#### Fame of Opposer's Marks

We begin our likelihood of confusion analysis with the fifth *du Pont* factor, which requires us to consider evidence of the fame of opposer's marks, since if fame exists, we must give great weight to this factor. See *Bose Corp. v.*

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*QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot Inc. v. Becton*, 214 F.3d 1322, 54 F.2d 1894 (Fed. Cir. 2000); and *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

In those portions of its briefs<sup>17</sup> directed toward the fame of its SWATCH marks, opposer makes a number of assertions regarding its length of use of the marks; sales and advertising expenditures; examples of its advertising and promotional efforts in various media; and examples of affiliation of goods bearing its SWATCH marks with celebrities and athletic events. However, in light of our determination above excluding opposer's submissions by CD-ROM, there is no testimony or evidence of record to support these assertions.

As a result, the only evidence of the fame of opposer's SWATCH marks is copies of approximately 30 print advertisements and articles from such general circulation newspapers and periodicals as The Wall Street Journal, The New York Times, Smithsonian, Popular Science, Los Angeles Times, Ms., and Women's Wear Daily. This evidence demonstrates that opposer has advertised goods bearing its SWATCH marks in major periodicals and newspapers and further that its promotional efforts have resulted in a degree of

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<sup>17</sup> Opposer's brief, p. 22-25; opposer's reply brief, p. 9-12.

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recognition in such periodicals and newspapers. However, such evidence falls far short of demonstrating that opposer's SWATCH marks are famous for purposes of our likelihood of confusion analysis.

In addition, opposer relies upon statements made by applicants' principals in their discovery depositions in which they acknowledge that they have heard of or otherwise are aware of the SWATCH brand as applied to watches.<sup>18</sup> However, these statements fall far short of admissions by applicants or its principals that opposer's SWATCH marks are famous. Thus, we find that applicants did not admit that opposer's SWATCH marks are famous.

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, it is the duty of a party attempting to establish the fame of a mark to clearly prove it. *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007). In this case, as discussed above, there is insufficient evidence of record in support of opposer's assertions regarding the fame of the marks in its pleaded registrations. In the absence of compelling evidence properly made of record, or clear

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<sup>18</sup> Opposer's First Notice of Reliance, Exhibit 30 (Discovery Deposition of Amy Bernard, p. 50-52), and Exhibit 31 (Discovery Deposition of Brent Bernard, p. 72-75).

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admissions by applicants that opposer's marks are famous, we are left with little more than the mere assertions of fame in opposer's briefs.

Accordingly, we find on this record that the evidence falls short of establishing that any of opposer's pleaded SWATCH marks is famous for purposes of our likelihood of confusion determination. Nonetheless, there is no evidence of record that opposer's marks are weak, to the extent opposer has presented evidence of examples of its advertising and there is no evidence of third-party uses.

Opposer's Registration No. 1671076

We have determined that opposer has failed to demonstrate that the marks in its pleaded registrations are famous. Furthermore, we note that opposer has neither pleaded nor proven that it owns a family of marks. In considering its three pleaded registrations, we note that by virtue of being presented in typed format (which gives opposer rights in the mark without limitation to any particular stylization), the mark in opposer's Registration No. 1671076 is more similar to the mark in the involved application than the mark in either of its other pleaded registrations. We further note that Registration No. 1671076 recites goods that are most similar to the goods in the involved application.

Accordingly, we will concentrate our discussion of the issue of likelihood of confusion on opposer's Registration No. 1671076 for the mark SWATCH in typed characters for "watches, clocks and parts thereof" (hereinafter, the '076 Registration). This is because if we find a likelihood of confusion between this registration and applicants' mark, there is no need to consider the question with regard to the other registrations, and if we find no likelihood of confusion between this registration and applicants' mark, there will be no likelihood of confusion with the marks in opposer's other pleaded registrations.

The Goods and Trade Channels

The goods in the involved application are identified as "watch faces, ribbon watch bands, slide pendants, and beaded watch bands." "Watch faces," "ribbon watch bands" and "beaded watch bands" are component parts comprising watches. The testimony of applicants' officers, excerpted above, confirms that the watch faces and bands are interchangeable and intended to be combined into different styles of watches to match different styles of clothing.<sup>19</sup> Thus, we find it appropriate to construe applicants' goods not merely as parts for watches, but as watches themselves. Applicants' goods thus are identical to the "watches and parts therefor"

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<sup>19</sup> See, for example, opposer's First Notice of Reliance, Exhibit 30, Discovery Deposition of Amy Bernard, p. 12-13.

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identified in opposer's '076 Registration. As a result, the goods in the involved application and '076 Registration are identical in part.

Because the goods are identical in part and there are no restrictions as to their channels of trade or classes of purchasers, we must assume that the goods are, or will be, sold in all the normal channels of trade to all the usual purchasers for such goods, and that the channels of trade and the purchasers for applicants' and opposer's goods would be the same. *See Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910 (TTAB 2000). Indeed, applicants acknowledge that

"[b]ecause Applicant's application includes watch faces and watch bands and because Opposer's registrations of record are primarily for watches, there is overlap in the recited goods (which does not extend to jewelry) and the Board presumes that the 'goods are marketed in all normal trade channels for such goods.'" (internal cites omitted).<sup>20</sup>

It is clear that if these identical and closely related goods are offered under similar marks there would be a likelihood of confusion.

Thus, we turn to the marks, keeping in mind that when marks would appear on identical goods, as they do here, the degree of similarity between the marks necessary to support a finding of likely confusion declines. *See Century 21 Real*

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<sup>20</sup> Applicants' brief, p. 13.

*Estate v. Century Life*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

The Marks

We turn then to the first *du Pont* factor, i.e., whether applicants' mark and opposer's mark in its '076 Registration are similar or dissimilar when viewed in their entirety in terms of appearance, sound, connotation and overall commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot, supra*.

In this case, we observe that applicants' mark

The word "Swap" is written in a large, elegant, black cursive font. The letter 'S' is particularly large and ornate, with a thick stroke and a decorative flourish. The 'W' and 'A' are also stylized, with the 'A' having a small loop at the top. The 'P' is tall and thin, with a long, thin descender that ends in a small dot. The overall appearance is that of a classic, decorative script.

and the SWATCH mark in opposer's '076 Registration share the first three letters in common, namely SWA-. This results in some similarity in sound, especially if the marks are not articulated clearly so that the differences in the final consonants are not noted. However, the marks are dissimilar in appearance in that applicants' mark also contains the fourth letter -P while opposer's mark contains the additional three letters -TCH. Overall, there are clear differences in how the marks look.

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Most importantly, the marks are distinctly different in meaning. The term SWAP comprising applicants' mark, as set forth previously, is defined as follows: "to trade one thing for another; to exchange (one thing) for another; an exchange of one thing for another."<sup>21</sup> Consumers are likely to note and understand the meaning of this common term because, as discussed above, SWAP suggests that applicants' watch faces and watch bands are interchangeable and may be used to combine different colors and styles of watches. Inasmuch as SWAP has significance relating to applicants' goods, consumers are likely to remember the meaning of SWAP as applied to those goods. The term "swatch," on the other hand, is defined as follows: "a sample strip or piece of material."<sup>22</sup> In addition, opposer's SWATCH mark may be perceived as the term WATCH, to which the letter "S" has been added. However, regardless of whether opposer's mark is perceived as referencing a watch or a sample piece of material, those meanings are different from the meaning of applicants' mark, namely, a trade or exchange of one thing for another. Thus, the plain meaning of applicants' mark is clearly different from any meaning that may be ascribed to opposer's mark. As a result, the marks are highly dissimilar in connotation.

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<sup>21</sup> Applicants' Notice of Reliance, Exhibit 34, from The American Heritage College Dictionary (3d ed., 1997).

<sup>22</sup> Id.

Overall, the significant dissimilarity in the meanings of the marks outweighs the fact that the marks begin with the same three letters. The marks convey dissimilar commercial impressions.

We are not persuaded by opposer's arguments that the "similarity of the marks is further compounded when considering how the marks are used in commerce."<sup>23</sup> Opposer asserts that applicants often use the word "watch" with their mark, and points to another version of the SWAP mark in which the "S" is replaced by the face of a clock. We see nothing inappropriate in a party using a generic term with its mark. On the contrary, it is a basic tenet of trademark practice that one way to prevent one's mark from becoming generic is to use a generic term with it. As for opposer's second point, the question we must decide is likelihood of confusion between the mark in the challenged application and pleaded registration(s), not other marks that applicant may use.<sup>24</sup>

In view of the foregoing, the *du Pont* factor of the similarity of the marks favors applicant.

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<sup>23</sup> Opposer's brief, p. 10.

<sup>24</sup> Because applicants' other mark is not the subject of this proceeding, our comment should not be taken as a suggestion that we would or would not find confusion with respect to it.

Conditions of Sale

The next *du Pont* factor discussed by the parties is that of the conditions of sale. As identified, neither applicants' nor opposer's goods are limited to expensive, "high end" products. As such, we must presume that opposer's watches and parts therefor as well as applicants' watch faces and bands are of all types and price ranges common thereto. These would include inexpensive products that normally would be purchased without a great deal of thought in addition to more highly specialized and expensive items. We find this fourth *du Pont* factor to favor opposer.

Actual Confusion

Another *du Pont* factor discussed by the parties is the lack of instances of actual confusion despite over six years of use by the parties, at time of trial, of their respective marks. Applicants assert that the absence of actual confusion suggests no likelihood of confusion. We note, however, that it is often difficult to adduce reliable evidence of actual confusion. Furthermore, it is not necessary to show actual confusion in order to establish likelihood of confusion. See *Weiss Associates Inc. v. HRL Associates Inc.* 902 F.2d 1546, 223 USPQ 1025 (Fed. Cir. 1990).

Accordingly, this *du Pont* factor must be considered to be neutral or to only slightly favor applicants.

Applicants' Intent in Adopting the SWAP Mark

Next, opposer argues that applicants were "aware of the SWATCH mark in association with watches at a time prior to Applicant's adoption of the SWAP mark for watches."<sup>25</sup>

Opposer further argues that despite this prior knowledge, "Applicant did not conduct a trademark search to determine the availability of its SWAP mark."<sup>26</sup> Opposer asserts that "Applicant did not conduct a search because it knew it was able to capitalize on Opposer's goodwill in its SWATCH mark."<sup>27</sup>

To the extent that opposer is arguing that applicants adopted their mark in bad faith, there is insufficient evidence to show or from which we can infer this. As noted by opposer, applicants acknowledge that they were aware of opposer's SWATCH marks prior to their adoption of the SWAP mark. However, mere knowledge of the existence of opposer's marks does not, in and of itself, constitute bad faith. See *Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d

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<sup>25</sup> Opposer's brief, p. 29, citing to opposer's First Notice of Reliance, Exhibit 30, Discovery Deposition of Amy Bernard, p. 50-2, and Exhibit 31, Discovery Deposition of Brent Bernard, p. 72-5; Testimonial Deposition of Brent Bernard, p. 84.

<sup>26</sup> *Id.* at 30, citing to Opposer's First Notice of Reliance, Exhibit 5, Applicants' Response to Opposer's First Set of Interrogatories.

<sup>27</sup> Id.

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1563, 10 USPQ 1307 (Fed. Cir 1989); and *Ava Enterprises, Inc. V. Audio Boss USA, Inc.*, 77 USPQ2d 1783 (TTAB 2006). Opposer points to no evidence or testimony to support its rather conclusory statement that because applicants were aware of opposer's marks and did not perform a trademark search prior to selection of their mark, applicants sought to trade on the goodwill of opposer. In short, the record in this case simply does not support such a finding.

We have concentrated our discussion on the *du Pont* factors discussed by the parties and for which the parties properly introduced testimony and evidence. To the extent other *du Pont* factors are applicable, we find them to be neutral. In accordance with the above analysis, we acknowledge that many of the *du Pont* factors discussed above favor opposer. However, it is settled that from case to case, different *du Pont* factors may play prominent roles, and that even a single *du Pont* factor may be sufficient to find for one party or another. *See Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) ("We know of no reason why, in a particular case, a single *duPont* factor may not be dispositive"). In this case, the factor of the similarity or dissimilarity of the marks plays that dominant role. Because of the significant differences between the parties' marks, even members of the general public exercising only ordinary care will recognize

that the marks are different, and are not likely to believe that applicants' stylized SWAP mark, used on watch faces and bands that can be used to create watches, emanate from the same source as opposer's watches and parts therefor sold under the mark SWATCH. Accordingly, we find that opposer has failed to prove that a likelihood of confusion exists between its pleaded SWATCH marks and the mark in the involved application as applied to the identified goods.

**Dilution**

Turning next to opposer's claim of dilution, an essential element for proving dilution is proving fame, and fame for dilution purposes requires a more stringent showing than fame for likelihood of confusion purposes. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005); and *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1170 (TTAB 2001).

Because, as discussed above, opposer has not shown on this record that its marks have achieved fame for purposes of likelihood of confusion, it follows that opposer has not shown the requisite level of fame for purposes of dilution.

**Conclusion**

We have carefully considered all of the evidence pertaining to opposer's claims of priority of use and likelihood of confusion, dilution and mere descriptiveness,

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as well as all of the parties' arguments with respect thereto, including any evidence and arguments not specifically discussed in this opinion.

We conclude that opposer has established its standing and priority of use. However, we also conclude opposer has failed to make a prima facie case that SWAP merely describes the goods identified in the subject application. We further conclude that the marks in opposer's pleaded registrations are simply too dissimilar from applicants' mark to support a finding of likelihood of confusion. In addition, because opposer failed to establish that its marks are famous for purposes of likelihood of confusion, opposer cannot prevail upon its claim of dilution which requires a more stringent showing of fame.

**DECISION:** The opposition is dismissed as to the claim of mere descriptiveness, the claim of priority and likelihood of confusion, and the claim of dilution.