

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: June 7, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Rolex Watch U.S.A., Inc.
v.
PRL USA Holdings, Inc.

Opposition No. 91170868
to application Serial Nos. 78797200 and 78797255
filed on January 23, 2006

Gary D. Krugman of Sughrue Mion PLLC for Rolex Watch U.S.A.,
Inc.

Scott Gelin of Greenberg Traurig, LLP for PRL USA Holdings,
Inc.

Before Grendel, Kuhlke and Ritchie, Administrative Trademark
Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, PRL USA Holdings, Inc., seeks registration
of the marks RALPH LAUREN RLX and RLX RALPH LAUREN in
standard characters for goods identified in the applications
as "jewelry and watches" in International Class 14.¹

¹ Respectively, Serial Nos. 78797200 and 78797255, both filed on
January 23, 2006, based on allegations of a bona fide intention
to use the marks in commerce under Section 1(b) of the Trademark
Act, 15 U.S.C. §1151(b).

Opposer, Rolex Watch U.S.A., Inc., opposed registration of applicant's marks on the ground that, as used in connection with applicant's goods, the marks so resemble opposer's previously used and registered mark ROLEX for "watches, watch bracelets, and related jewelry products" as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d), 15 U.S.C. §1052(d).

By its answer applicant denied the salient allegations.²

EVIDENCE OF RECORD

The evidence of record consists of: (1) the pleadings; (2) the files of the opposed applications; (3) opposer's notices of reliance on its pleaded registrations, applicant's responses to opposer's interrogatories nos. 9-11, and printed publications; (4) opposer's testimony deposition, with exhibits, of Peter Nicholson, opposer's Vice President and Director of Communications; (5) opposer's declaration with exhibits of Thomas D. Dupont, opposer's survey expert (submitted pursuant to stipulation by the parties);³ (6) applicant's notices of reliance on printed

² We have not considered applicant's inadequately pleaded and untried affirmative defenses of "laches, estoppel and/or acquiescence."

³ Applicant's motion to exclude the declaration and survey evidence attached thereto is denied, as discussed below.

publications,⁴ opposer's responses to certain of applicant's discovery requests, and the discovery deposition, with exhibits, of Thomas D. Dupont; (7) 63 registrations for RALPH LAUREN formative trademarks and one for the mark RLX (submitted pursuant to stipulation by the parties); and (8) applicant's testimony depositions, with exhibits, of Talbot Logan, applicant's Vice President of Wholesale Initiatives and Brand Presentation, and Sasha Kelly, applicant's Senior Vice President of RLX Brand and Outerwear Division.

As noted above, applicant moved to exclude the declaration and accompanying exhibits of opposer's survey expert, Mr. Thomas D. Dupont, on the grounds that "such evidence is not relevant and/or material to the analysis of the issue that is currently before the Board."⁵ Applicant argues that because the survey only measures consumer perception of the term RLX and does not include the marks in issue, RLX RALPH LAUREN and RALPH LAUREN RLX, the survey and Mr. Dupont's analysis is fatally flawed inasmuch as they do not address whether or not there is any likelihood of confusion between the marks in issue and opposer's ROLEX mark. In addition, applicant contends that the survey is

⁴ In footnote 6 of its brief, opposer notes that applicant did not indicate the relevance of these materials in its notice of reliance. However, any objection on this basis is deemed waived inasmuch as it was not raised promptly. *Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 USPQ 881, 883 (TTAB 1979).

⁵ App. Br. p. 1.

over inclusive in that it was not limited to include only consumers of watches that cost "at least \$1,000."⁶

Opposer responds that the survey was properly conducted and introduced into the record. Further, opposer argues that applicant does not contest Mr. Dupont's qualifications or the "methodology in connection with which the survey was designed, administered and analyzed."⁷ Opposer contends that "the issue of the survey's relevance or materiality to the issues presented herein goes only to the weight to be afforded the survey evidence and not to whether it should somehow be excluded."⁸ Opposer explains that the "survey was conducted early in this case, when Applicant also sought to register RLX by itself as a trademark for jewelry and watches. ... [and] was designed to measure consumer perception as to the source of watches sold under the name RLX."⁹

The record establishes Mr. Dupont as a qualified survey expert and the survey was properly conducted, employing the Eveready format. *Union Carbide Corp. v. Ever-Ready, Inc.*, 531 F.2d 366, 188 USPQ 23 (7th Cir. 1976). As to applicant's contention that the universe of consumers in the

⁶ App. Br. p. 5.

⁷ Reply Br. p. 2.

⁸ Id.

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survey is over inclusive, the identification of goods in the applications and opposer's pleaded registrations are not limited by cost, channels of trade or classes of consumers, and, as such, the failure to limit the survey universe by cost is not a flaw. With regard to the survey's relevance, this proceeding had been consolidated with Opposition No. 91169129 wherein opposer opposed applicant's application Serial No. 78528608 for the mark RLX. The survey was conducted prior to applicant's unconsented abandonment of the RLX application. On April 17, 2009, the Board entered judgment against applicant as to Opposition No. 91169129 based on the unconsented abandonment of application Serial No. 78528608. While the survey has less probative value as to the remaining applications, it is not so wholly irrelevant as to warrant exclusion. At a minimum, the survey serves to show consumer perception as to one element of applicant's mark.

In view thereof, applicant's motion to exclude is denied. However, as applicant argues, we must consider the marks in their entirety, which limits the probative value of the survey, in particular under the circumstances of this case, where the additional material consists of an extremely well-known mark.

THE PARTIES AND MARKS IN ISSUE

⁹ Id. at 3.

Opposer is the "exclusive distributor of Rolex Watches in the United States" which are sold through approximately "700 official Rolex jewelers."¹⁰ Only four to six Rolex jewelers sell Rolex watches exclusively, the remaining stores sell multiple brands.¹¹ The trademark ROLEX is on every watch.¹²

Opposer's pleaded registrations are set forth below:

Registration No. 101819, issued on January 12,

1915 (renewed), for the mark **ROLEX** for "watches, clocks, parts of watches and clocks, and their cases," in International Class 14; and

Registration No. 1753843, issued on February 23, 1993 (renewed), for the mark ROLEX (in typed form) for "jewelry" in International Class 14.

Opposer has never used the term RLX on its watches or in its advertising.¹³

Applicant "is a leader in the design, marketing and distribution of premium lifestyle products [which include] a full range of men's, women's and children's fashions, footwear, jewelry, luxury watches, handbags, fragrances, and consumer goods" offered under the RALPH LAUREN house mark.¹⁴ Between 2004 and 2007, applicant sold watches produced by

¹⁰ Nicholson Test. pp. 9-10.

¹¹ Id. p. 19.

¹² Id. at 11.

¹³ Nicholson Test. pp. 71, 81; App. Not. Rel. Exh. 1 Response to Applicant's Requests for Admissions Nos. 2 and 3.

¹⁴ App. Br. p. 7; Logan Test. pp. 10-11, 13, 34-35.

the company Suunto and the watches had both the Suunto and RLX brands on the goods.¹⁵ Applicant has at least 63 registrations for the mark RALPH LAUREN for various clothing and accessory items.¹⁶ Applicant sponsors many athletic events, including Wimbledon and the U.S. Open where the on-court officials, ball boys and ball girls appear in uniforms bearing the RALPH LAUREN marks and the arenas display images of the RALPH LAUREN marks.¹⁷ Applicant has been using the mark RALPH LAUREN RLX on clothing and accessories since 2004. An example of its use of the mark RALPH LAUREN RLX in advertising for its goods related to one of its sponsored athletes, golfer Luke Donald, is shown below.

¹⁵ Kelly Test. p. 22.

¹⁶ Applicant asserts that two of its registrations, Reg. Nos. 1835393 and 1972538 for "jewelry" cover watches as a subset of jewelry. This is not the case as watches are not a "subset" of jewelry and, in addition, based on the record these registrations issued on May 10, 1994 and May 7, 1996, respectively, prior to applicant's use of any of its marks on watches.

¹⁷ Logan Test. pp. 19-24.



Opposer and applicant advertise in the same magazines¹⁹ (e.g., GQ, VOGUE, Golf Digest), sponsor the same sporting events (e.g., Wimbledon, the U.S. Open and the American Junior Golf Association (AJGA))²⁰ and, in some cases, even sponsor the same athlete (e.g., Luke Donald).²¹ With regard to the AJGA, the parties are the two major sponsors and opposer's ROLEX mark appears next to applicant's RALPH LAUREN mark in promotional materials, as shown below, and on

¹⁸ App. Not. Rel. Exh. 12 www.aspenpeak-magazine.com (page one of a two page advertisement of RLX Ralph Lauren golf men's outerwear).

¹⁹ Nicholson Test. p. 25; Logan Test. pp. 14-15.

²⁰ Nicholson Test. pp. 30-35; Logan Test. p. 19.

²¹ Nicholson Test. p. 49; Logan Test. p. 21.

the same items of golf apparel (e.g., golf shirts and vests).²²



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PRIORITY/STANDING

Because opposer's pleaded registrations are of record, are valid and subsisting, and owned by opposer, opposer's standing to oppose registration of applicant's marks is established and its priority is not in issue. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Accordingly, we turn to the issue of likelihood of confusion under Section 2(d).

LIKELIHOOD OF CONFUSION

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ

²² Nicholson Test. pp. 35-48, Exh. 12-17.

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563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

Further, "[a]lthough confusion, mistake or deception about source or origin is the usual issue posed under Section 2(d), any confusion made likely by a junior user's mark is cause for refusal; likelihood of confusion encompasses confusion of sponsorship, affiliation or connection."

Hilson Research, Inc. v. Society for Human Resource Management, 27 USPQ2d 1423, 1429 (TTAB 1993); *Federal Bureau of Investigation v. Societe: "M. Bril & Co."*, 172 USPQ 310, 315 (TTAB 1971) (under Section 2(d) party must show purchasing public would mistakenly assume that the applicant's goods or services originate with, are sponsored by, or are in some way associated with it"). See also *Majestic*, 65 USPQ2d at 1205 ("...mistaken belief that [a good] is manufactured or sponsored by the same entity ... is precisely the mistake that Section 2(d) of the Lanham Act seeks to prevent"); *In re Save Venice New York, Inc.*, 259 F.3d 1346, 59 USPQ2d 1778, 1784 (Fed. Cir. 2001) ("The related goods test measures whether a reasonably prudent consumer would believe that non-competitive but related goods sold under similar marks derive from the same source, or are affiliated with, connected with, or sponsored by the same trademark owner").

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Because fame plays a dominant role in the likelihood of confusion analysis, we first address opposer's assertion that its mark is famous. *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). See also *Recot Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). "[T]he fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident." *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002). Finally, "[b]ecause of the extreme deference that we accord 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 the party asserting that its mark is famous to clearly prove it." *Lacoste Alligator S.A. v. Maxoly Inc.*, 91 USPQ2d 1594, 1597 (TTAB 2009).

Applicant concedes that ROLEX is famous and, based on this record, opposer has clearly established that its mark is famous. Cf. *Rolex Watch U.S.A. Inc. v. AFP Imaging Corp.*, 101 USPQ2d 1188, 1193 (TTAB 2011) (ROLEX famous for dilution purposes). Opposer has sold watches under the ROLEX mark for approximately one hundred years in the United

States.²³ Over the past few years its sales and advertising expenditures have been substantial. Opposer is the largest advertiser of watches in the United States.²⁴ In addition to exposing consumers to its mark in all types of media, television, outdoor billboard, radio, internet, widely-distributed national magazines and newspapers, opposer sponsors many well-known and viewed sporting events, including Wimbledon, where its mark is displayed on the courtside clocks on both ends of the court and during television replays referred to as a "Rolex replay."²⁵ Opposer also sponsors the Masters, U.S. Open, British Open, the PGA Championship, the Solheim Cup, the President's Cup, and the Ryder Cup which are all nationally televised and the ROLEX mark is visible in advertising at these events.²⁶

We turn now to consider the similarities between opposer's and applicant's goods, channels of trade and classes of purchasers. We must make our determinations under these factors based on the goods as they are recited in the application and registration, respectively. See *Octocom Systems Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The

²³ Nicholson Test. pp. 14-15.

²⁴ Id. at 58-59.

²⁵ Id. at 24-31.

²⁶ Id. at 32-33.

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authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed."); and *In re Elbaum*, 211 USPQ 636 (TTAB 1981).

Opposer's registrations cover watches and jewelry which are identical to applicant's listed goods, namely, jewelry and watches. Further, inasmuch as the identifications of goods are identical, in part, and given the lack of restrictions in the identifications of goods, we must presume for purposes of the likelihood of confusion analysis, that the trade channels and classes of purchasers overlap. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002) and *Octocom*, 16 USPQ2d at 1783.

The evidence shows that the ordinary channels of trade for watches and jewelry includes department stores and retail watch and jewelry stores. The purchasers of such goods include ordinary, as well as, discriminating consumers. Applicant's arguments centered on the high price of the parties' respective goods, ignore well established case law requiring that the analysis be based on how the

goods are identified in the involved applications and opposer's registrations. As noted above, because there are no limitations, we must consider all ordinary classes of purchasers for watches and jewelry, regardless of price. Further, we make our determination on the least sophisticated within that class. Thus, we cannot limit our analysis to the conditions of sale of watches priced at several thousand dollars. In re Thomas, 79 USPQ2d 1021, 1024 (TTAB 2006) citing J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991) (Board must consider jewelry as encompassing all kinds and styles of jewelry regardless of what the evidence might show as to the actual nature of the jewelry). Moreover, if we were to limit our analysis to a high price range, even a discriminating purchaser of expensive watches or jewelry could be confused as to source or sponsorship where identical goods are sold under similar marks. See Weiss Associates Inc. v HRL Associates Inc., 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990).

Thus, we turn to consider the parties' respective marks, ROLEX on the one hand, and RLX RALPH LAUREN and RALPH LAUREN RLX on the other. We examine the similarities and dissimilarities of the marks in their appearance, sound, meaning, and commercial impression. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d

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1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods offered under the respective marks is likely to result.

We first note that because applicant seeks registration in standard characters, its mark is not limited to any particular depiction. The rights associated with a mark in standard characters reside in the wording and not in any particular display. In re RSI Systems, LLC, 88 USPQ2d 1445 (TTAB 2008); In re Pollio Dairy Products Corp., 8 USPQ2d 2012, 2015 (TTAB 1988); TMEP 1207.01(c)(iii) (7th ed. rev. 2010). Thus, applicant's possible portrayal of the X in a different color or the minimal stylization in registrant's mark in Reg. No. 101819 cannot serve to distinguish the marks, inasmuch as we must consider applicant's mark "regardless of font style, size, or color." Citigroup Inc. v. Capital City Bank Group Inc., 98 USPQ2d 1253, 1258-59 (Fed. Cir. 2011). Further, we must consider possible displays that may emphasize a particular portion of the marks, e.g., applicant's use of RLX RALPH LAUREN in connection with its clothing items shown supra, wherein RLX is in a larger typeface.

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Opposer argues that the RLX portion of the mark is similar to its ROLEX mark based on: (1) the prior judgment in Opposition No. 91169129 wherein applicant abandoned its application for the mark RLX; (2) the Dupont survey wherein 61 percent of the survey respondent believed that opposer was the source of watches sold under the RLX brand; and (3) third-party use of RLX to refer to opposer.

With regard to the first point, while Opposition No. 91169129 does have preclusive effect for what was at issue in that particular proceeding, i.e., the mark RLX for jewelry and watches, the judgment is not similarly binding as to the marks involved in this proceeding. First, claim preclusion does not apply because the marks, i.e., the transactional facts, are not identical. *Chromalloy American Corp. v. Kenneth Gordon (New Orleans), Ltd.*, 736 F.2d 694, 222 USPQ 187 (Fed. Cir. 1984). Second, issue preclusion, or collateral estoppel, does not apply because the prior proceeding ended in default judgment and, therefore, the issues were not fully litigated. *Sharp Kabushiki Kaisha v. ThinkSharp Inc.*, 448 F.3d 1568, 79 USPQ2d 1376 (Fed. Cir. 2006); *In re Anderson*, 101 USPQ2d 1912, 1917-1918 (TTAB 2012).

With regard to the asserted third-party use of RLX, public use of a term may create "a protectable property right in the term' if the public has come to associate the

term with the company or its goods or services." Big Blue Products, Inc. v. International Business Machines Corp., 19 USPQ2d 1072, 1074 (TTAB 1991). By its argument, it appears opposer is not asserting such a protectable interest in RLX but simply using third-party use as evidence of consumer perception.

The evidence of third-party use of RLX in connection with opposer's watches is minimal, consisting of printouts from only four websites and search results displayed by the Google search engine. The first one, tradekey.com, describes itself as "one of the leading B2B Marketplace that helps rlx watches buyers to instantly connect with quality rlx watches manufacturers & suppliers from all over the world including rlx watches from China, USA, Turkey and other countries."²⁷ The abbreviation is used infrequently on this site and most notably simply as part of the internet address extension (tradekey.com/ks-rlx-watches/). The next example is someone offering a free application for the window phone titled "Rlx Watch Guide" providing information on Rolex watches. The final two examples are from German websites,²⁸ www.watch-tool.de and www.rlx-slaes.com "the official sales corner of www.r-.-x-de." To the extent these examples have any relevance to U.S. consumer perception,

²⁷ Opp. Not. of Rel.

²⁸ The .de TLD indicates a German website.

they have limited probative value. Finally, opposer submitted the image results from a search on the Google search engine of the phrase "rlx watch." The image display shows various Rolex watches. In all of these examples, the mark ROLEX also appears on the webpage.

This evidence only shows four entities using the term rlx to refer to Rolex and one search engine using the abbreviation rlx to find and display Rolex watches. In addition, there is no information as to how many U.S. consumers have been exposed to this usage. Based on this evidence of third-party usage, we cannot find that U.S. consumers would view RLX as identifying opposer as the source of the goods.

Finally, the survey, reporting consumer perception of opposer as the source of RLX watches at 61 percent, is certainly strong evidence as to the term RLX by itself, but in the context of the entirety of the marks in issue, we find it to be of minimal probative value.²⁹

Conceding that applicant's mark RALPH LAUREN is well known, opposer frames the issue as follows:

Of course, consumers encountering RLX RALPH LAUREN or RALPH LAUREN RLX watches will believe that the watches emanate from or are in some way connected to Applicant. Opposer concedes that point but

²⁹ We do not, as applicant requests, make an adverse inference based on opposer's failure to proffer a survey for the marks in issue. *Hilson Research, Inc. v. Society for Human Resources Mgmt.*, 27 USPQ2d 1423, 1435-36 (TTAB 1993).

that concession does not resolve the issue. The equally critical question is whether, because of the prominent depiction of the RLX term, consumers would also make an association between the watches and Opposer. Would consumers believe that watches sold under the RLX RALPH LAUREN or RALPH LAUREN RLX marks have some connection with Opposer in terms of whether such watches are manufactured by, sponsored by, endorsed by or otherwise approved by Rolex when such is not the case?

Opposer presented various examples where opposer and applicant are both sponsors of an event or an athlete and their marks are simultaneously displayed. For example, as noted above, both parties sponsor the American Junior Golf Association. In the AJGA handbook opposer's Rolex mark appears on the same page as applicant's other marks, i.e., POLO, RALPH LAUREN and the horse and rider design.³⁰ Another example is at Wimbledon where ROLEX is displayed, inter alia, on the courtside clocks and the RALPH LAUREN name is featured on court signage and on the ball boys and umpires clothing.³¹ This type of overlap would also occur at the U.S. Open where applicant is the official outfitter and opposer also sponsors and prominently displays its ROLEX mark.³² In addition, opposer's ROLEX mark appears on the outside of applicant's polo shirts with the name RALPH

³⁰ Nicholson Test. p. 39, Exh. 12 and 13.

³¹ Logan Test. p. 20.

³² Logan Test. p. 20; Nicholson Test. p. 32.

LAUREN on the labels given out at various events.³³

Finally, both parties sponsor some of the same athletes, for example, Luke Donald who wears Ralph Lauren clothing when he plays and once finished with his round of golf puts on his ROLEX branded watch.³⁴ Based on this record, there is no question that the parties target similar consumers and offer a similar lifestyle product and, to that end, overlap in their marketing positioning by sponsoring similar types of sporting events, e.g., tennis, golf, sailing.

Applicant argues that the addition of its well-known house mark alleviates any possible likelihood of confusion. Opposer responds that in general the addition of a house mark does not mitigate confusion unless the common element is weak or merely descriptive. See *Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313 (TTAB 2005) (NORTON MCNAUGHTON ESSENTIALS not confusingly similar with ESSENTIALS).

Opposer is correct that generally the addition of a house mark will not avoid confusion and, in fact, may serve to increase likely confusion. In *re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260-61 (Fed. Cir. 2010) (applicant's mark ML is likely to be received as a shortened version of registrant's mark, ML MARK LEES (stylized), when

³³ Nicholson Test. p. 47, Exh. 16.

³⁴ Id. p. 49.

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used on the same or closely related skin-care products); In re Chica, Inc., 84 USPQ2d 1845, 1848-49 (TTAB 2007) (CORAZON BY CHICA with design, and CORAZON with design, both for jewelry, likely to cause confusion, noting that, "to many consumers, applicant's mark for the identical word 'Corazon' followed by the phrase 'BY CHICA' will simply be viewed as the identification of the previously anonymous source of the goods sold under the mark CORAZON"). However, there is one other exception where the addition of a house mark or other matter may obviate confusion. When the additional matter, including house marks, conveys a significantly different commercial impression considering the marks in their entirety, this may avoid likely confusion. Shen Mfg. Co. v. Ritz Hotel Ltd., 393 F.3d 1238, 1245, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004) (reversing TTAB's holding that contemporaneous use of THE RITZ KIDS for clothing items (including gloves) and RITZ for various kitchen textiles (including barbeque mitts) is likely to cause confusion, because, inter alia, THE RITZ KIDS creates a different commercial impression).

We agree that RLX and ROLEX are not merely descriptive or suggestive terms. However, to the extent any portion of applicant's marks is dominant, it would have to be the name RALPH LAUREN which opposer concedes is a well-known strong mark. This fact is also supported by the record.

Further, although the letters RLX have no meaning in a vacuum, when joined with the well-known name RALPH LAUREN the letters serve as his initials RL combined with X, indicating an expansion of his product line. Through the testimony of Sasha Kelly, applicant's Senior Vice President of the RLX brand, the concept of the mark RLX derives from RALPH LAUREN EXTREME.³⁵ The X refers to products designed "specifically for a sport end use ... for real athletes, tested by athletes."³⁶

Certainly the mark ROLEX is famous and should be afforded a broad scope of protection. In addition, these parties substantially overlap in their channels of trade, even to the point of being displayed in the same venue and on the same person. However, given the different connotation and commercial impression engendered by the presence of the well-known mark RALPH LAUREN, when viewing the mark in its entirety, consumers will perceive RLX as Mr. Lauren's initials and not an abbreviation of ROLEX. Even in the case where the RLX is emphasized as shown supra, in view of the strength of the RALPH LAUREN mark it still creates the commercial impression of Mr. Lauren's initials when displayed alongside the well-known RALPH LAUREN house mark.

³⁵ Kelly Test. p. 11.

³⁶ Id. pp. 11-12.

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This case is distinguished from *In re Christian Dior, S.A.*, 225 USPQ 533 (TTAB 1985) where the Board found applicant's mark LE CACHET DE DIOR to be confusingly similar to registrant's mark CACHET. In that case, the Board found that the addition of the house mark DIOR did not obviate likely confusion and to the extent the DIOR name was well-known that "would only serve to aggravate the likelihood of confusion that would arise from the contemporaneous use of the marks on the respective goods." *Id.* at 535. In that case, the common element did not create a different connotation and commercial impression when used in connection with the house mark.

Although not a "house mark" case, we find the case before us more similar to *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459 (Fed. Cir. 1998) where the Court affirmed the Board's decision, that despite the fact that the goods and channels of trade were the same and plaintiff's mark had "come to serve as a very strong indication of origin for [its] champagne," the marks CRISTAL and CRYSTAL CREEK evoked very different images in the minds of consumers sufficient to obviate a likelihood of confusion. *Id.* at 1460, quoting, slip op. Opposition No. 91080932 at p. 9 (TTAB June 25, 1997). Here, as noted above, the difference in connotation resulting from the connection between the letters RL and the RALPH LAUREN name,

create a different commercial impression than that of the ROLEX marks.

With regard to the factor of actual confusion, applicant asserts that it "has been selling a full line of apparel under its RALPH LAUREN RLX brand since 1998 [and] [s]ince that time, Applicant has marketed and sold its RALPH LAUREN RLX branded apparel and accessories in major department and fine retail stores, many of which also sell Opposer's Rolex watches [and] [o]pposer has not provided a single instance of actual consumer confusion."³⁷ Further, applicant notes that the record does not contain any examples of actual confusion and it is not aware of any instances of actual confusion.³⁸

Opposer responds that the "fact that there is no evidence of actual confusion is of no relevance to this opposition brought against Applicant's two marks for goods described as jewelry and watches."³⁹ Further opposer notes that the subject applications are based on intent to use and there is no evidence in the record of use of either mark in connection with watches and no evidence of an opportunity for any confusion to have occurred.

³⁷ App. Br. p. 25.

³⁸ Kelly Test. p. 22.

³⁹ Reply Br. p. 9.

We find this factor to be neutral. As noted by opposer, there is no evidence in the record of applicant's use of the subject marks on watches or jewelry.⁴⁰

Because the marks are sufficiently different, the du Pont factor of the dissimilarities of the marks outweighs the other relevant du Pont factors discussed above. In view thereof, we conclude that there is no likelihood of confusion between applicant's marks RLX RALPH LAUREN and RALPH LAUREN RLX and opposer's ROLEX marks. 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 du Pont factor may not be dispositive"). See also, In re E.I. du Pont de Nemours & Co., USPQ at 567 ("[E]ach [of the thirteen elements] may from case to case play a dominant role").

Decision: The opposition is dismissed.

⁴⁰ While there is testimony regarding the use of the mark RLX with the mark SUUNTO on watches, this not the mark in issue here and the testimony limits the trade channels of those watches to applicant's website and applicant's stores. Kelly Test. p. 22.