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Filing date: **03/10/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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|------------------------|---|
| Proceeding | 91188993 |
| Party | Plaintiff Rolex Watch U.S.A., Inc. |
| Correspondence Address | Peter Cousins Gibney, Anthony & Flaherty, LLP 665 Fifth Avenue New York, NY 10022 UNITED STATES bfrenchman@gibney.com,pcousins@gibney.com,gkrugman@sughrue.com |
| Submission | Motion to Amend Pleading/Amended Pleading |
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| Signature | /beth frenchman/ |
| Date | 03/10/2010 |
| Attachments | Motion to Amend the Notice of Opposition.pdf (6 pages)(507651 bytes) |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

ROLEX WATCH U.S.A., INC.,

Opposer

vs.

AFP IMAGING CORPORATION

Applicant.

Opposition No.: 91188993

Serial No.: 77/492,131

MOTION TO AMEND THE NOTICE OF OPPOSITION

Pursuant to Rule 15 of the Federal Rules of Civil Procedure (“FRCP”), Opposer (“Rolex”) hereby moves this Court to allow Rolex to amend its Notice of Opposition to include the ground of Applicant’s lack of bona fide intent.

Rule 15 (a)(2) of the FRCP allows a party, to seek to amend its pleading “with the court’s leave.” It further requires that the “court should freely give leave when justice so requires.” See, FRCP, Rule 15(a)(2). In this matter Rolex is seeking to amend its Notice of Opposition to include a claim that Applicant, at the time the application was filed, did not have a bona fide intent to use the mark sought to be registered. This claim could not have been pled at the time of filing the Notice because at that time Rolex did not have a sufficient factual basis to assert a claim on that ground. It is only now, after Rolex has recently completed discovery, that Rolex learned of the factual basis to support this new ground for opposition.

In this case, initial disclosures were exchanged in June of 2009. Responses to written discovery requests were received by Rolex in July and September of 2009. Soon after that Rolex sought to take the deposition of Applicant’s CEO (in October, Rolex wrote to Applicant’s counsel asking for convenient dates). Because of various impediments, the deposition was not completed until March 3, 2010. After taking Applicant’s CEO’s deposition, Rolex confirmed that there is no documentary evidence to support Applicant’s assertion that it had a bona fide intention to use the mark at the time the application was filed.

Since Rolex has only recently confirmed the factual basis to support this new

ground, it is clear that Rolex has not delayed in seeking to raise this claim against Applicant. Further Applicant cannot claim it has been prejudiced by the filing of an amended Notice of Opposition since the case is still in the discovery period and moreover, there is no need for Applicant to take any additional discovery on this issue since the burden is on Rolex to prove Applicant's lack of bona fide intention to use the mark.

For all of the above-stated reasons, Rolex moves the Board for leave to file the Amended Notice of Opposition in the form attached hereto as Exhibit 1, and to order the Applicant to answer the Amended Notice of Opposition.

Respectfully submitted,

ROLEX WATCH U.S.A., INC.

Dated: March 10, 2010

/Beth Frenchman/

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EXHIBIT 1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 77492131
Mark opposed: ROLL-X
Filing Date: June 5, 2008
Published in the Official Gazette on: November 4, 2008

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ROLEX WATCH U.S.A., INC., :
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 Opposer, :
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 v. :
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 AFP IMAGING CORPORATION, :
 :
 Applicant :
-----X

AMENDED NOTICE OF OPPOSITION

Rolex Watch U.S.A., Inc. (“Rolex” or “Opposer”), a New York corporation with a business address of 665 Fifth Avenue, New York, New York 10022, hereby opposes registration of the trademark ROLL-X which is the subject matter of Application Serial No. 77492131, in Int. CL. 10.

As grounds in support of this opposition, Opposer alleges as follows:

1. Opposer (including its predecessors in interest) is now and for many years has been engaged in the business of marketing and selling high-quality watches in the United States under the mark ROLEX (“Rolex Mark”).
2. Opposer is the owner of the following United States Principal Register registration which is valid, subsisting, unrevoked, uncancelled and incontestable:

| Trademark | Registration No. | Registration Date | Goods |
|------------------|-------------------------|--------------------------|--|
| ROLEX | 0101819 | 01/12/1915 | Watches, clocks, parts of watches and clocks, and their cases. |

3. The ROLEX Mark is distinctive
4. Opposer has promoted its ROLEX Mark extensively in its advertising and promotional materials.
5. By virtue of Opposer's extensive distribution, sale, promotion, and advertising of products under its ROLEX Mark, and the high quality of the products sold under the mark, the ROLEX Mark has become famous and widely recognized in the United States as designating high quality products originating exclusively from Opposer.
6. Applicant, on June 5, 2008, filed an application to register ROLL-X in International Class 10, Serial No. 77492131.
7. Opposer's ROLEX Mark became famous long prior to Applicant's attempt to register the ROLL-X mark.
8. The ROLL-X and ROLEX marks are very similar in appearance.
9. The ROLL-X and ROLEX marks are identical in sound.
10. The ROLEX mark is a coined term and has no meaning other than as a trademark.
11. The ROLL-X mark is a coined term and has no meaning other than as a trademark.
12. Applicant's ROLL-X mark so resembles Opposer's previously used and registered ROLEX Mark as to be likely to cause confusion, mistake, or deception in violation of Section 2(d) of the Trademark Act (15 U.S.C. §1052(d)).
13. Applicant's use of the ROLL-X mark is likely to cause dilution by blurring, impairing the distinctiveness of the ROLEX Mark in violation of Section 43(c) of the Trademark Act (15 U.S.C. §1125(c)).
14. Applicant's use of the ROLL-X mark is likely to cause dilution by tarnishment, harming the reputation of the ROLEX Mark in violation of Section 43(c) of the Trademark Act (15 U.S.C. §1125(c)).

15. Applicant has made no significant monetary investment in the sale, promotion or advertising of its mark.
16. Applicant was aware of Opposer's rights before the filing date of the subject application.
17. The registration of Applicant's mark will improperly give to Applicant the appearance of exclusive statutory ownership rights in a mark that is confusingly similar to the ROLEX Mark in violation and derogation of the prior and superior rights of Opposer.
18. By reason of the foregoing, Opposer believes that it shall be irreparably damaged by the registration of Applicant's mark.
19. Applicant lacked the requisite bona fide intent to use its mark when filing its application for registration of the mark ROLL-X.
20. Because of Applicant's lack of bona fide intent, Applicant's application should be held invalid.

WHEREFORE, it is respectfully requested that this Opposition be sustained and that registration to Applicant be refused.

Respectfully submitted,

ROLEX WATCH U.S.A., INC.

Dated: March , 2010

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ROLEX WATCH USA, INC.

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing MOTION TO AMEND THE NOTICE OF OPPOSITION and the AMENDED NOTICE OF OPPOSITION has been served on Applicant this 10th day of March, 2010 via first class mail, postage prepaid to:

Norman H. Zivin, Esq.
Cooper & Dunham LLP
30 Rockefeller Plaza
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New York, NY 10112



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