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Filing date: **08/25/2010**

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

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	Plaintiff's Notice of Reliance
Filer's Name	Beth Frenchman
Filer's e-mail	bfrenchman@gibney.com,gkrugman@sughrue.com
Signature	/Beth Frenchman/
Date	08/25/2010
Attachments	Notice of Reliance I.pdf (5 pages)(151941 bytes) Notice of Reliance II.pdf (17 pages)(598849 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

NOTICE OF RELIANCE

Pursuant to Trademark Rule 2.122 (d), Opposer, hereby relies on a current printout from the TARR electronic database records of the USPTO showing that U.S. Registration No. 101,819 for the mark ROLEX issued on January 12, 1915 is currently valid and subsisting and owned by Opposer, Rolex Watch USA, Inc. Enclosed is a copy of the TARR records.

Respectfully submitted,

Dated: August 25, 2010

ROLEX WATCH U.S.A., INC.

/Beth Frenchman/

Beth Frenchman, Esq.

Peter Cousins, Esq.

GIBNEY, ANTHONY & FLAHERTY LLP

665 Fifth Avenue, 11th Floor

New York, NY 10022

(212) 688-5151

Gary D. Krugman, Esq.

SUGHRUE MION, PLLC

2100 Pennsylvania Ave., N. W.

Washington, DC 20037

Attorneys for Opposer

ROLEX WATCH USA, INC.

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing NOTICE OF RELIANCE has been served on Applicant this 25th day of August, 2010 via first class mail, postage prepaid to:

Norman H. Zivin, Esq.
Hindy Dym, Esq.
Cooper & Dunham LLP
30 Rockefeller Plaza
20th Floor
New York, NY 10112


Vilma Toranzo

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2010-08-25 13:17:47 ET

Serial Number: 71078904 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 101819

Mark

ROLEX

(words only): ROLEX

Standard Character claim: No

Current Status: This registration has been renewed.

Date of Status: 2004-11-16

Filing Date: 1914-06-08

Transformed into a National Application: No

Registration Date: 1915-01-12

Register: Principal

Law Office Assigned: (NOT AVAILABLE)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 40S -Scanning On Demand

Date In Location: 2008-09-30

LAST APPLICANT(S)/OWNER(S) OF RECORD

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

Address:
ROLEX WATCH U.S.A., INC.
665 FIFTH AVENUE

NEW YORK, NY 10022
United States
Legal Entity Type: Corporation
State or Country of Incorporation: New York

GOODS AND/OR SERVICES

U.S. Class: 027 (International Class 014)
Class Status: Active
WATCHES, CLOCKS, PARTS OF WATCHES AND CLOCKS, AND THEIR CASES
Basis: 1(a), 44(e)
First Use Date: 1912-00-00
First Use in Commerce Date: 1912-00-00

ADDITIONAL INFORMATION

Foreign Registration Number: 34251
Foreign Registration Date: 1913-10-07
Country: Switzerland

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

- 2010-08-17 - Notice Of Suit
- 2010-08-03 - Notice Of Suit
- 2010-07-09 - Notice Of Suit
- 2010-03-30 - Notice Of Suit
- 2010-01-28 - Notice Of Suit
- 2009-12-31 - Notice Of Suit
- 2009-12-16 - Notice Of Suit
- 2009-11-02 - Notice Of Suit
- 2009-09-08 - Notice Of Suit
- 2008-09-30 - Case File In TICRS

2008-09-12 - Notice Of Suit
2008-09-05 - Notice Of Suit
2008-09-05 - Notice Of Suit
2008-06-13 - Notice Of Suit
2008-06-13 - Notice Of Suit
2008-05-20 - Notice Of Suit
2008-02-12 - Notice Of Suit
2005-02-10 - Attorney Revoked And/Or Appointed
2005-02-10 - TEAS Revoke/Appoint Attorney Received
2004-11-16 - Fifth renewal 10 year
2004-11-16 - Section 8 (10-year) accepted/ Section 9 granted
2004-09-23 - Combined Section 8 (10-year)/Section 9 filed
2004-09-23 - PAPER RECEIVED
1994-09-26 - Fourth renewal 10 year
1994-08-12 - Section 9 filed/check record for Section 8
1975-01-12 - Third renewal

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Peter Cousins

Correspondent

Peter Cousins

Gibney, Anthony & Flaherty, LLP

665 Fifth Avenue

New York NY 10022

Phone Number: 212 688 5151

Fax Number: 212 688 8315

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Opposer

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Applicant.

Opposition No.: 91188993

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NOTICE OF RELIANCE

Pursuant to Trademark Rule 2.120(j), Opposer, Rolex Watch USA, Inc., will be relying on the Applicant's interrogatory responses numbered 2, 3 & 4. Copies of Opposer's Interrogatories numbers 2, 3 & 4 and Applicant's responses are enclosed herewith.

Pursuant to Trademark Rule 2.120(j) Opposer will also rely on, and enclose herewith, the following portions of the discovery deposition testimony of David J. Vozick taken March 3, 2010, as follows:

- p. 8, lines 17-21;
- p. 19, line 13 – p.21, line 4;
- p. 27, lines 6-19;
- p. 33, line 5 – p. 37, line 7 (which includes Vozick Deposition Exhibit 4).

Respectfully submitted,

Dated: August 25, 2010

ROLEX WATCH U.S.A., INC.

/Beth Frenchman/

Beth Frenchman, Esq.

Peter Cousins, Esq.

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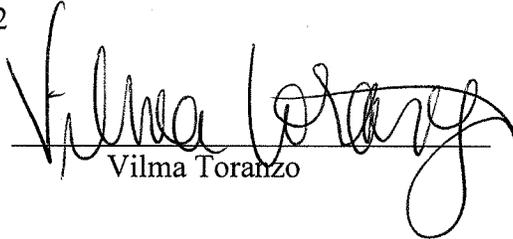
2100 Pennsylvania Ave., N. W.
Washington, DC 20037

Attorneys for Opposer
ROLEX WATCH USA, INC.

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing NOTICE OF RELIANCE has been served on Applicant this 25th day of August, 2010 via first class mail, postage prepaid to:

Norman H. Zivin, Esq.
Hindy Dym, Esq.
Cooper & Dunham LLP
30 Rockefeller Plaza
20th Floor
New York, NY 10112



Vilma Toranzo

Mark. David Vozick has knowledge of Applicant's Mark.

INTERROGATORY NO. 2

Identify the person(s) most knowledgeable about the selection, adoption and application for registration of Applicant's Mark and identify all documents which are relevant to Applicant's selection, adoption, use, intention to use and application for registration of Applicant's Mark.

RESPONSE TO INTERROGATORY NO. 2

David Vozick is most knowledgeable about the selection and application for registration of Applicant's Mark. Applicant objects to this interrogatory to the extent that it seeks documents within the scope of attorney-client privilege. Subject to and without waiving the foregoing privilege, non-privileged documents relevant to Applicant's selection, intention to use and application for registration of Applicant's Mark will be produced.

INTERROGATORY NO. 3

Identify the person(s) most knowledgeable about Applicant's use and/or plans to use Applicant's Mark in advertising and promotion thereof.

RESPONSE TO INTERROGATORY NO. 3

David Vozick is most knowledgeable about Applicant's plans to use Applicant's Mark in the advertising and promotion thereof.

INTERROGATORY NO. 4

For each person listed in Interrogatory 2 & 3, please state what relevant information each person possesses.

RESPONSE TO INTERROGATORY NO. 4

David Vozick possesses information relevant to Applicant's selection, intent to use, application for registration of Applicant's Mark and plans to use Applicant's Mark in advertising and promotion thereof.

INTERROGATORY NO. 5

State whether Applicant has ever received an opinion from legal counsel or any other person concerning a possible trademark conflict with Opposer, or the absence thereof, arising out of Applicant's adoption, use or application to register Applicant's Mark.

RESPONSE TO INTERROGATORY NO. 5

Applicant has not received an opinion from legal counsel or any other person concerning a possible trademark conflict with Opposer, or the absence thereof, arising out of Applicant's adoption, use or application to register Applicant's Mark.

INTERROGATORY NO. 6

If the answer to the preceding interrogatory is anything other than an unqualified negative, identify: (a) the date on which such an opinion was provided; (b) the person or persons who provided each opinion; (c) all persons to whom the opinion was provided; and (d) all documents in the possession, custody or control or otherwise known to Applicant which were relevant to the formulation of each opinion.

RESPONSE TO INTERROGATORY NO. 6

N/A.

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Vozick

that you might have had, can you just briefly take me through your employment history up to and including your present position at AFP and let me know the time periods and what your jobs were?

A. June -- October of 1966 I joined a family-owned business in the medical x-ray equipment business, stayed with them till 1975 when the family business was sold to Raytheon, stayed as an employee, an executive employee at Raytheon in that division until August or September of 1978, was the co-founder of AFP Imaging at that time with my first cousin, and I've been employed ever since.

Q. So you've been as the founder since 1978.

A. That's correct.

Q. About 32 years.

A. 32 years.

Q. Okay. And your current position is what?

A. Chief Executive Officer.

Q. And what are your main



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Vozick

1
2 Q. Go ahead, finish your answer.

3 MR. ZIVIN: Let him finish his
4 questions.

5 Q. Go ahead, finish your answer.

6 A. A dentist typically buys a
7 wall-mounted x-ray source that's adjacent to
8 the examination chair or other pieces of
9 equipment, panoramic viewing of the whole
10 tooth structure from ear to ear (indicating),
11 and there's no basic table for general
12 purpose examination.

13 Q. Okay, so an x-ray table. You sell
14 x-ray tables; is that correct?

15 A. We do.

16 Q. And they are used for general
17 medical human use or animal use or both?

18 A. That's correct.

19 Q. Can you give me a sense of I mean
20 with respect to the x-ray tables, would most
21 of the ones you sell be for veterinary use or
22 human use?

23 A. Veterinary use.

24 Q. 80 percent? 90 percent?

25 I mean is it a great majority of



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Vozick

1
2 your business?

3 A. Of the x-ray table portion.

4 Q. Just tables, yeah.

5 A. Of the x-ray table portion, I would
6 say 80 or 90 percent is veterinary.

7 Q. And the x-ray tables that you
8 currently sell, what brands are they sold
9 under, what trademarks or names?

10 A. Under our own trademarks.

11 Q. Yeah, but what are they?

12 A. I don't remember all of them off
13 the top of my head.

14 Q. Do you remember any of them?

15 A. Vet Tek is one of them.

16 Q. Vet Tek is an x-ray table?

17 A. It's an x-ray table system.

18 Q. Um-hm. The x-ray tables, you said
19 the majority are for vets, so those, just so
20 I can be comfortable in knowing the answer to
21 this, I assume -- and I'm not putting words
22 in your mouth -- that of the ones that are
23 for veterinary use, they would be sold just
24 like these other imaging products to vets and
25 vet schools and things like that, correct?



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Vozick

A. Dealer organization, that is correct.

Q. Right.

How long have you sold x-ray tables under these different trademarks?

A. 30 odd years. 30 years.

Q. Okay. And, again, do you promote and advertise these x-ray tables the way you indicated you promote your other products, through trade publications and trade shows?

A. We do.

Q. Okay. Website?

A. We do.

Q. Mr. Vozick, you on behalf -- not you, but AFP, they have filed an application to register the mark of Roll-X, R-o-l-l hyphen X, as a trademark to obtain a federal registration; is that correct?

A. That's correct.

MR. KRUGMAN: I'm going to ask the court reporter to mark this as Exhibit 1.

([Vozick] Exhibit 1, excerpt from application to PTO, marked for



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Vozick

A. That's correct. This is a predecessor, a family-owned business at one time.

Q. Yes.

The intended product to be sold under the Roll hyphen X mark, you had said it's going to be a portable, movable stretcher. Just elaborate on what that product is. Is that going to be primarily for veterinary use?

A. Primarily it's intended for veterinary use, although obviously other objects can be placed on the table, and what makes it x-ray adaptable is the tabletop surface that the patient or object would be placed on is a clear Lucite Plexiglas surface that x-rays can penetrate without disturbing the image.

Q. And is that product going to be promoted and advertised sort of in the way that you advertise other imaging products through your website?

A. It would be intended to.

Q. Through the trade publications?



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Vozick

Roll-X trademark up to the present time; is that correct?

A. That's correct.

MR. KRUGMAN: Okay. I'm going to have the court reporter mark the next document as [Vozick] Exhibit 4.

([Vozick] Exhibit 4, Responses to a Second Request for Production of Documents served by Cooper & Dunham LLP, marked for identification, as of this date.)

Q. Take a look at that. When you're done, tell me.

A. (Reading) Okay.

Q. Okay. I'll represent these are the Responses to a Second Request for Production of Documents that was served on us by your counsel, and I'd like you to look at document request number one and the response to number one on page one and tell me if that response is accurate.

A. (Reading) That is correct.

Q. Okay. Aside from the actual trademark application that you have there as



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Vozick

Exhibit 1, are you aware of any documents that support the statement in the application that AFP has a bona fide intent to use the Roll-X mark for the x-ray tables?

A. Could you please state the opening part of that again, please?

Q. Sure.

Aside from the trademark application where you state in there that you have a bona fide intent to use the mark, are there any other documents supporting or documenting the statement that you had a bona fide intent to use the mark Roll-X for x-ray tables?

A. None that I know of.

Q. Okay. Do you have any business plans or marketing plans in existence showing plans on how the Roll-X mark may be used?

A. Not in writing.

Q. Is there any projected date of first use for the Roll-X mark for x-ray tables?

A. Not at this time.

Q. Any determination as to the



Vozick

1
2 targeted geographical areas of sales or
3 demographics of potential users of Rolex
4 products?

5 A. Canada and the United States.

6 Q. Have you done any test marketing of
7 the Roll-X product or any focus groups?

8 A. Not normal to our business.

9 Q. The answer is no?

10 A. No.

11 Q. Any presentations to customers or
12 potential customers of the Roll-X x-ray
13 tables?

14 A. One such prototype has been built
15 and installed.

16 Q. When you say "built and installed,"
17 I'm not understanding your answer.

18 A. One such table without the mark
19 Roll-X on it but that demonstrates the
20 concept of a movable table with an x-ray
21 detector was manufactured, installed in a
22 veterinary clinic and is in use, but no name
23 is on it.

24 Q. When was that manufactured,
25 approximately?



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Vozick

A. I think about a year and a half ago.

Q. And where was it installed?

A. Massachusetts.

Q. At a vet?

A. In a veterinary clinic.

Q. Okay. And so that's in use since then?

A. That's correct.

Q. Okay. Any correspondence or other communications have you had with potential distributors or suppliers or your reps with respect to the Roll-X --

A. No.

Q. -- x-ray table?

And you had said before, just to make sure I understand, there has been no -- there's no marketing or promotional materials in existence with respect to the Roll-X brand.

A. No such formal documents.

Q. And other informal documents?

A. In my mind or in discussions internal to our organization as to what we



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1 Vozick

2 might call a product, how it gets sold or
3 what's the application, all the general
4 premarket introduction things that one goes
5 through.

6 Q. I'm talking about documents.

7 A. No, documents. I said before.

8 Q. Okay. Is this a true statement,
9 that AFP has not made any significant
10 monetary investment in the sale of products
11 under the Roll-X mark? Is that true?

12 A. That's true.

13 Q. And is it a true statement that AFP
14 has not made any significant monetary
15 investment in the advertising or promotion of
16 the Roll-X mark?

17 A. That's true.

18 Q. Okay. Are you aware of watches
19 that are sold under the Rolex mark, R-o-l-e-x
20 mark?

21 A. I'm aware of it, yes.

22 Q. And do you have any idea of when
23 you first became aware of Rolex watches?

24 A. No idea whatever, the date. I
25 don't wear a watch, so I can't tell you that.

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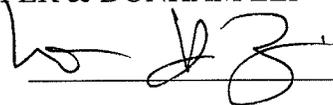
ROLEX, or any mark similar thereto.

Response to Document Request No. 2

Applicant objects to this request to the extent that it is vague, overly broad and seeks documents that are not relevant to any claim or defense in this proceeding because of the term "similar." Without concession of any "similarity," Applicant has produced documents relating to a search made of TrademarkScan® U.S. Federal and State databases. No other non-privileged documents exist.

Respectfully,

COOPER & DUNHAM LLP

By:  _____

Norman H. Zivin
30 Rockefeller Plaza
New York, New York 10012
(212) 278-0400
Attorney for Applicant
AFP IMAGING CORPORATION

Dated: September 29, 2009

Vozick Exhibit 4

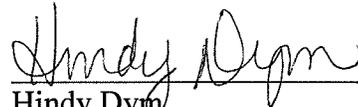
CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing APPLICANT'S ANSWERS TO OPPOSER'S SECOND REQUEST OF APPLICANT FOR PRODUCTION OF DOCUMENTS AND THINGS was served on this 29th day of September, 2009, by first class mail, addressed as follows:

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Peter Cousins
Brian W. Brokate
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