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

Proceeding	91188993
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I. INTRODUCTION

On June 2, 2008, Applicant AFP Imaging Corporation (“Applicant” or “AFP”) filed an intent-to-use application, Application Serial No. 77/492,131, for the mark ROLL-X for x-ray tables for medical and dental use in International Class 10. On February 25, 2009, Opposer Rolex Watch U.S.A, Inc. (hereinafter “Opposer” or “Rolex”), filed a Notice of Opposition against Applicant.

As grounds for the Opposition, Opposer asserted that (1) Applicant’s ROLL-X mark for x-ray equipment so resembles Opposer’s previously registered ROLEX mark for watches so 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)); (2) Applicant’s use of the mark ROLL-X is likely to cause dilution by blurring, by impairing the distinctiveness of Opposer’s ROLEX trademark, in violation of Section 43(c) of the Trademark Act (15 U.S.C. § 1125(c)); and (3) Applicant’s use of the mark ROLL-X is likely to cause dilution by tarnishment, by harming the reputation of Opposer’s ROLEX trademark, in violation of Section 43(c) of the Trademark Act (15 U.S.C. § 1125(c))

Midway through the proceedings, on March 10, 2010, Opposer filed an Amended Notice of Opposition to assert the additional claim that registration should be denied because Applicant lacked a bona-fide intent to use the mark ROLL-X when Applicant filed its application for registration in violation of 15 U.S.C. § 1051(b).

In Opposer’s Brief, Opposer fails to argue that any likelihood of confusion exists between Opposer’s ROLEX mark and Applicant’s ROLL-X mark. Opposer also fails to argue that Applicant’s use of the mark ROLL-X is likely to cause dilution by tarnishment. Opposer argues only that Applicant’s ROLL-X mark is likely to cause dilution by blurring of Opposer’s famous

ROLEX trademark and that Applicant lacked a bona fide intent to use the ROLL-X mark at the time the trademark application was filed. Accordingly, judgment should be entered against Opposer on the first two grounds and only the last two grounds of opposition should be considered.¹

In its brief, Opposer fails to establish the degree of general fame needed to support its dilution claim and further fails to establish that Applicant's mark will dilute the distinctiveness of Opposer's mark. Furthermore, the facts demonstrate that Applicant had a bona fide intent to use the mark at the time it filed its application. This is merely a case of large corporation with deep pockets attempting to over assert its rights against a small company that markets wholly unrelated goods to a specialty market and seeks to use a mark that engenders an entirely different commercial impression. Accordingly, the Board should dismiss Rolex's Opposition to Applicant's application.

II. DESCRIPTION OF THE RECORD

The Record includes Applicant's application file and the pleadings. 37 CFR § 2.122(b).

The Record also comprises the following:

- (1) Notices of Reliance of Opposer dated August 25, 2010 ("Opposer's Notices of Reliance") comprising the following:
 - a. Opposer's U.S. Registration No. 101,819 for the mark ROLEX;
 - b. Applicant's Responses to Opposer's Interrogatory Nos. 2, 3, and 4; and
 - c. Excerpts from the discovery deposition of David Vozick ("Vozick Deposition"),

¹ Opposer failed to argue the ground of likelihood of confusion presumably because its own survey as attached to the Declaration of Philip Johnson showed only 2% likelihood of confusion of Applicant's mark ROLL-X with Rolex. (Declaration of Philip Johnson, Exhibit B, Code Deck, page 6).

with attached exhibits;

- (2) Declaration of Peter Nicholson and Exhibits 1-4 attached thereto;
- (3) Declaration of Philip Johnson and Exhibit B attached thereto;²
- (4) First Notice of Reliance of Applicant dated October 28, 2010, and Exhibits 1-2 attached thereto (“Applicant’s Notice of Reliance”) comprising the following:
 - a. U.S. Trademark Registration No. 2,000,578 for the mark DENT-X; and
 - b. Excerpts from the Vozick Deposition.

A. Opposer’s Declaration of Philip Johnson

Opposer submitted the Declaration of Philip Johnson (“Johnson Declaration”) and an attached survey to support its claim that Applicant’s use of the mark ROLL-X is likely to cause dilution of Opposer’s ROLEX trademark. However, Opposer’s survey design is fundamentally flawed and therefore its survey cannot be given weight as evidence of dilution. The survey is nothing more than a guessing game.

Opposer’s survey employed a test cell exhibit that bore the name ROLL-X and a control cell exhibit. (Johnson Declaration, ¶ 8). Opposer asserts that over 42% of the people surveyed reported that Rolex watches came to mind when they encountered the ROLL-X name for x-ray tables. However, this survey takes the mark out of context and does not replicate the market conditions in which individuals would encounter Applicant’s ROLL-X mark, namely, on rolling x-ray tables. Accordingly, the design of the survey is flawed and should not be given any weight. *Playtex Prods., Inc. v. Georgia-Pacific Corp.*, 390 F.3d 158, 73 USPQ2d 1127 (2d Cir. 2004), *superseded by statute on other grounds*, *Starbucks, Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97, 108 (2d Cir. 2009) (finding that because the stimulus shown to interviewees

²Opposer’s Testimony has been submitted through Declarations of Nicholson and Johnson, pursuant to stipulation by the parties.

did not replicate the marks in context as presented and packaged in the marketplace, the survey results cannot be offered as evidence of dilution); *Juicy ZCouture Inc. v. L'Oreal USA, Inc.*, 2006 WL 1012939 (SDNY, Apr. 19, 2006) (Court found fundamental flaw in survey design on issue of confusion where respondents were shown 8 ½ by 11 inch cards bearing only the accused marks because this did not replicate market conditions in which the accused marks were encountered).

Furthermore, Opposer misrepresents the results of its survey by stating that 42% of respondents reported that Rolex watches came to mind when they encountered the ROLL-X name. Opposer fails to mention that 32% of respondents reported that “portable/moving/rolling” came to mind and that another 18% of respondents reported that x-ray tables/equipment and x-rays came to mind (Johnson Declaration, ¶ 26). Moreover, only 30% of respondents surveyed who said that ROLEX came to mind stated that it was because of the Rolex watch. (Johnson Declaration, ¶ 28). The survey is nothing more than a guessing game in which more people guessed portable/moving/rolling or x-ray than guessed Opposer’s mark.

B. Applicant’s Notice of Reliance

In its Notice of Reliance, Applicant relies on excerpted portions of the Vozick Deposition. Opposer objects to these submissions on the grounds that Applicant did not file the requisite written statement explaining why it needs to rely upon the additional excerpted portions of the Vozick Deposition. To the contrary, and as set out by Opposer in its brief, Applicant submitted clear statements as to why each portion of the transcript which Applicant submitted should be considered.

37 C.F.R. §2.120(j)(4) clearly states that if only part of a discovery deposition is submitted and made part of the record, an adverse party may introduce under a Notice of

Reliance other parts of the deposition which should in fairness be considered so as not to make misleading what was offered by the submitting party. The Notice of Reliance filed by an adverse party must be supported by a written statement explaining why Applicant needs to rely on each additional part submitted. *Id* As set out by Opposer in its brief, Applicant has submitted clear written statements in its Notice of Reliance explaining why Applicant needs to rely on each additional part submitted. Therefore, these additional parts should be considered by the Board.

Opposer cherry-picked excerpts of the Vozick deposition to support its assertion that Applicant lacked a bona fide intent to use the mark ROLL-X when Applicant filed its application. Specifically, Opposer introduced excerpts of the transcript to show that Mr. Vozick testified that no business or marketing plans exist showing how the ROLL-X mark may be used, that there has been no test marketing, that there is no projected date of first use and that Applicant has made no significant monetary investment in the sale, advertising or promotions of products under the ROLL-X mark (pg. 33, line 5 – pg. 37, line 7).

In response, Applicant submitted excerpts of the transcript that should in fairness be considered in light of the misleading nature of the excerpts proffered by Opposer. Specifically, and as clearly set out in Applicant's written statements, Applicant submitted excerpts of the Vozick deposition to explain that Applicant suspended its promotional activities in connection with the ROLL-X mark only because the opposition to the application was filed (pg. 32, lines 7-15), that Applicant promotes and advertises its other imaging products and uses and advertises its DENT-X mark for its human dental x-ray business (pg. 15, line 23 – pg. 17, line 3) and that, in fact, Applicant's predecessor previously used the ROLL-X mark for a portable rolling x-ray table (pg. 26, line 5 – pg. 27, line 5). Contrary to Opposer's assertion, these excerpts clearly clarify the statements in the excerpt put forth by Opposer to support its argument that Applicant

did not have a bona fide intent to use its ROLL-X mark. Thus, as asserted by Applicant in its Notice of Reliance and as explained in the written statements in Applicant's Notice of Reliance, these excerpts should in fairness be considered.

Accordingly, Opposer's arguments are without merit and the Board should consider the additional Vozick Deposition excerpts submitted by Applicant under its Notice of Reliance.

III. STATEMENT OF ISSUES

A. Whether Opposer is entitled to preclude registration of Applicant's mark notwithstanding that Opposer's mark is not famous for the purposes of dilution and that Applicant's mark will not dilute Opposer's mark.

B. Whether Opposer is entitled to preclude registration of Applicant's mark without evidence that Applicant lacked the requisite bona fide intent to use its ROLL-X mark at the time it filed its trademark application.

IV. ARGUMENT

A. There Is No Likelihood That Applicant's ROLL-X Mark Will Dilute Opposer's ROLEX Mark

Opposer asserts that its ROLEX trademark was famous well before Applicant's proposed use of the mark ROLL-X and that Applicant's use of a mark which allegedly resembles the ROLEX trademark is likely to dilute the distinctiveness of Opposer's trademark.

The Trademark Act provide that "the owner of a famous mark that is distinctive...shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark...that is likely to cause dilution by blurring." 15 U.S.C. §1125(c).

Opposer has failed to provide the kind of evidence necessary to establish fame for purposes of dilution. Furthermore, Opposer has failed to show that, even if such fame were established, Applicant's use of its ROLL-X mark would blur Opposer's mark in any way.

1. *The ROLEX Trademark Is Not Famous For The Purposes Of Dilution*

Opposer asserts that its expenses and sales figures are enough to support its claim that its ROLEX trademark is famous. (Opposer's Brief at pg 13). It further proffers hearsay evidence that Rolex has been listed in Business Week's annual article "Best Global Brands" and that the ROLEX trademark and watches have been mentioned in countless unsolicited newspaper and magazine articles. *Id.* However, Opposer's evidence is not sufficient to establish fame for the purposes of dilution. *Coach Services, Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600 (TTAB 2010) (finding COACH mark was not famous for purposes of dilution even with extensive evidence of sales and promotional expenditures which dwarf those of Rolex, unsolicited media advertising and brand awareness survey).

Fame for dilution purposes is very difficult to prove and requires a very stringent showing. *Toro Co. v. ToroHead, Inc.*, 61 USPQ2d 1164, 1180 (TTAB 2001). "With respect to consumer products and services, the fact that a party's mark may have achieved fame for those particular goods and services does not establish that the mark has achieved a general fame. Merely providing evidence that a mark is a top-selling brand is insufficient to show this general fame without evidence of how many persons are purchasers." *Id.* at 1181. Examples of evidence that the Board considers which show the transformation of a term into a truly famous mark include recognition by the other party, intense media attention and surveys. *Id.* at 1180-81. Opposer has not submitted any surveys establishing the general fame of its mark.³ The evidence

³ The survey proffered by Opposer with the Johnson Declaration was conducted for the purposes of establishing dilution and not fame of the ROLEX mark.

submitted by Opposer showing its sales figures, advertising and media attention are not sufficient to establish the kind of fame necessary for the purpose of proving dilution. *Coach Services, Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600 (TTAB 2010). Accordingly, Opposer's ROLEX mark cannot be considered famous for the purpose of establishing dilution.

In any event, even if Opposer had proven that its mark is famous, it has failed to show that the registration of the ROLL-X mark presents a likelihood of blurring the distinctiveness of the ROLEX mark.

2. *Applicant's ROLL-X Mark Will Not Cause Dilution*

This Board has stated that dilution is an "extraordinary remedy." *Toro Co. v. ToroHead, Inc.*, 61 USPQ2d at 1173 (TTAB 2001). The Board considers a number of factors to determine whether blurring is likely to occur. A balancing of the most pertinent factors demonstrates that dilution is not likely to occur here.

(i) Degree of similarity

Opposer asserts that the similarity of the marks weighs heavily in favor of a finding of dilution. Opposer argues that the marks are essentially identical and that there is no distinction when the marks are spoken. Opposer further contends that its dilution survey shows that more than 50% of the survey respondents associate Applicant's ROLL-X mark with ROLEX which indicates that a sizable portion of Applicant's target population see the two marks as highly similar. (Opposer's Brief at pg. 14).

Contrary to Opposer's assertion, this factor does not weigh in its favor, and indeed, is a compelling factor in support of Opposer's assertion that its ROLL-X mark will not cause dilution. The marks are dissimilar because of their vastly different commercial impressions. *7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1729 (TTAB 2007) (GULPY for animal water

dishes dissimilar from BIG GULP for fountain drinks for purposes of dilution); *Toro Co. v. ToroHead, Inc.*, 61 USPQ2d at 1183 (TORO and ToroMR are not substantially similar for purposes of dilution). Applicant's ROLL-X mark for use on portable, rolling x-ray tables engenders a completely different commercial impression from Opposer's ROLEX mark. Given the vastly different commercial impressions that are created by the marks and the radically different character of the products each sells, concern over consumers associating the ROLEX mark with Applicant's mark is unfounded. Furthermore, as argued *supra*, Applicant's survey was flawed and should not be given any weight.

Accordingly, the dissimilarity of the marks heavily favors Applicant.

(ii) Degree of recognition of the famous mark

The degree of recognition of the famous mark requires the Board to determine the level of fame acquired by the famous mark. *7-Eleven, Inc.* at 1729-30. "[O]nce the mark is determined to be famous as a prerequisite for dilution protection, we must apply a sliding scale to determine the extent of that protection (i.e., the more famous the mark, the more likely there will be an association between the famous mark and the defendant's mark)." *Id.*

As previously argued in Section IV.A.1, Opposer's ROLEX mark is not famous for dilution purposes. Accordingly, this factor does not weigh in favor of Opposer. *See Id.* at 1730 (TTAB 2007) (finding that even though the Board previously found that the mark was famous for dilution purposes, there was insufficient evidence to demonstrate that the mark had acquired an extraordinary degree of recognition relative to other famous marks).

(iii) Whether Applicant intended to create an association with ROLEX

Opposer failed to present any evidence demonstrating that Applicant intended to create an association with Opposer's ROLEX mark. In this regard, Mr. Vozick testified that Applicant

owns and used the registered mark DENT-X for its human dental x-ray business. (Vozick Deposition, pg 15, line 23 – pg 17, line 3). Applicant’s intent to use the mark ROLL-X for its veterinary dental x-ray business is thus consistent with its overall business practice and demonstrates that Applicant clearly did not intend to create an association with ROLEX.

(iv) Actual association between ROLL-X and ROLEX

Opposer contends that its survey evidence shows that over 50% of respondents associate Applicant’s mark with Opposer’s ROLEX mark and that this demonstrates that there is a strong association between the marks. As discussed *supra* in Section II.A, Opposer’s survey design was flawed and therefore should not be given weight.

The factors analyzed above clearly demonstrate that Applicant’s mark is not likely to cause dilution of Opposer’s ROLEX mark. Opposer has not adequately demonstrated that the registration of Applicant’s ROLL-X mark will dilute its mark by blurring and Opposer’s dilution claim should be dismissed.

B. Applicant Had A Bona Fide Intent To Use the Mark

Opposer’s second ground for opposition, that Applicant lacked a bona fide intent to use the mark ROLL-X at the time the application was filed, similarly is unpersuasive. Opposer contends that its claim is based on the lack of documentary evidence offered by Applicant to support Applicant’s claim that it had a bona fide intent to use the mark at the time it filed its application. (Opposer’s Brief at pg. 18). Opposer argues that Applicant merely states that it put its plans on hold after Opposer filed its Opposition and that this is insufficient to objectively demonstrate that Applicant had a bona fide intent to use the mark.

Section 1(b) of the Trademark Act requires a bona fide intent to use the mark in

commerce at the time the intent-to-use trademark application is filed. A determination of whether the Applicant has a bona fide intention to use the mark in commerce is an objective determination based on all the circumstances. *Lane Ltd. v. Jackson International Trading Co.*, 33 USPQ2d 1351, 1355 (TTAB 1994).

A lack of documents alone is not sufficient to prove a lack of bona fide intent in a case where there are no other facts that explain or outweigh the lack of documentary evidence. *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1507 (TTAB 1993). Here, the facts adequately explain and outweigh the lack of documentary evidence.

David Vozick testified that Applicant generally promotes, markets and advertises its imaging products through trade journals, brochures, mailings and websites. (Vozick Deposition, pg. 15, line 23 – pg. 16, line 4). Mr. Vozick explained that there is no documentary evidence reflecting promotional expenditures relating to this specific mark because Opposer suspended its business plans in light of the subject proceeding. (Vozick Deposition, pg. 32, lines 7-15). This prudent business decision cannot alone be indicative of a lack of the requisite bona fide intent.

Furthermore, Applicant's intent to use the mark ROLL-X is consistent with its overall business practice. Applicant owns and uses registered mark DENT-X for its human dental x-ray business. (Vozick Deposition, pg. 15, line 23 – pg. 17, line 3; Applicant's Notice of Reliance, Exhibit 1). Applicant's intent to use the mark ROLL-X for its product in the existing veterinary dental x-ray business is clearly in line with Applicant's overall business practice.

In this case the channels of trade and prospective purchasers have been defined. Additionally, Applicant has the capacity to market and manufacture the goods at issue and, in fact, previously has manufactured a portable rolling x-ray table on which it intends to use the ROLL-X mark. (Vozick Deposition, page 26, line 5 – page 27, line 5). These are further

indications that Applicant had a bona fide intention to use the mark for the goods listed in its intent-to-use application. *Commodore Electronics Ltd.* at 1507 (TTAB 1993) (noting that Applicant's capacity to produce or otherwise market the goods for which it is seeking registration is an indication that Applicant was acting in good faith and not merely trying to reserve rights in the mark).

Opposer's contention that Applicant filed the intent-to-use application without the requisite intent to use the mark at the time it filed its application thus is without foundation in fact. While "applicant's mere statement of subjective intention, without more, would be insufficient to establish applicant's bona fide intention to use the mark in commerce," *Lane Ltd.*, 33 USPQ2d at 1355 (TTAB 1994) (emphasis added), this record clearly demonstrates more than a mere hope or desire to use the mark in the future. Accordingly, Opposer's reliance on the lack of documentary evidence is insufficient to prove Applicant's lack of bona fide intent and Opposer's opposition should be dismissed.

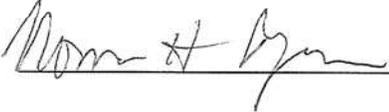
V. CONCLUSION

Opposer has failed to meet its burden of showing that its mark is famous for the purposes of dilution and that dilution of its mark is likely. Furthermore, Applicant has demonstrated that it had the requisite bona fide intent to use its mark in commerce when it filed its application. Accordingly, judgment should be entered for Applicant and the Opposition should be dismissed.

Dated: March 14th, 2011

Respectfully,

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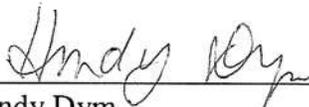
CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing APPLICANT'S BRIEF was served on this 14th day of March, 2011, by first class mail, addressed as follows:

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