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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.
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**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

REPLY BRIEF OF OPPOSER

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TABLE OF CONTENTS

	Page
I. INTRODUCTION.....	2
II. ARGUMENT	
1. Applicant’s Criticisms of Rolex’s Dilution Survey Are Invalid.....	2
2. Rolex Has Proved That Its ROLEX Trademark Is Famous For The Purpose of Dilution.....	4
3. Applicant Lacked A Bona Fide Intent To Use Its Mark At The Time The Application Was Filed.....	6
III. CONCLUSION.....	7

TABLE OF AUTHORITIES

Cases

Page

Playtex Prod. Inc. v. Georgia-Pacific Corp.,
390 F.3d 158, (2d Cir. 2004)..... 3

Juicy Couture Inc. v. L'Oreal USA, Inc.,
2006 Lexis 20787 (SDNY, Apr. 19, 2006)..... 3

Coach Services Inc. v. Triumph Learning LLC,
96 USPQ2d 1600 (TTAB 2010)..... 4-6

Commodore Electronics Ltd. CBM v. CBM Kabushiki Kaisha,
26 USPQ 2d 1503, 1507 (TTAB 1993)..... 7

Statutes

15 USC § 1125(c)(2)(A)..... 4

15 USC § 1125(c)(1)..... 5

I. INTRODUCTION

There are at least three inaccurate arguments raised by Applicant which warrant the filing of this reply brief. They are: (1) that the Board should not give much weight to Rolex's dilution survey because it fails to replicate market conditions and Rolex, in its brief, misrepresents the results; (2) that Rolex failed to submit adequate evidence to support its claim that its ROLEX trademark is famous for the purpose of dilution; and (3) that Applicant had a bona fide intent to use its mark at the time the application was filed.

Applicant's reasoning in each of these arguments is flawed and for the following reasons should be rejected by the Board.

II. ARGUMENT

1. Applicant's Criticisms of Rolex's Dilution Survey are Invalid.

Applicant first argues that Rolex's survey is flawed because it "does not replicate the market conditions in which individuals would encounter Applicant's ROLL-X mark." This statement is illogical because Applicant has not yet used this mark. This is a registration proceeding involving Applicant's ITU application for ROLL-X. There are no "market conditions" to duplicate because Applicant has no use, no advertising and no promotional activities. Yet, even though Applicant has not used its mark, Rolex's survey did consider the context and market in which Applicant's mark was to be used. The questions in the survey identified how a consumer would encounter Applicant's ROLL-X mark in the marketplace.¹ (Johnson Dec. ¶¶ 15 & 17.)

¹ Survey question 2(a) states in part: "Assume for a moment that you were looking for a new x-ray table and you encountered one that uses this name." After the rest of the question was asked, respondents viewed the mark as shown in Applicant's application drawing.

Also Rolex's survey only interviewed respondents who were potential consumers of Applicant's x-ray tables. (See, Johnson Dec. ¶¶ 5 & 12, See also, Vozick Dep. pp. 19-21).

Applicant's legal argument also fails. The cases Applicant relies on do not support its position that Rolex's survey is flawed. In *Playtex*, the products surveyed were already in the marketplace, the stimulus shown to respondents failed to identify the full name of defendant's product and the finding of no dilution was based on the Court's determination that the marks were not "very" or "substantially similar" as required by the pre-TDRA dilution statute. *Playtex Prod. Inc. v. Georgia-Pacific Corp.*, 390 F.3d 158, (2d Cir. 2004). Similarly in *Juicy*, the products were already in the marketplace and the survey was designed to determine likely confusion, not dilution. *Juicy Couture Inc. v. L'Oreal USA, Inc.*, 2006 Lexis 20787 (SDNY, Apr. 19, 2006). The facts within both *Juicy* and *Playtex* are not analogous to the present Opposition. Those surveys were designed to test products that were directly competitive and already labeled, packaged and being distributed in the marketplace. *Id.* The present opposition is based on an ITU application for a mark nearly identical to Opposer's famous ROLEX trademark on a non-competitive product.

Applicant's second criticism of Rolex's survey is that Rolex misrepresented the results of the survey because it failed to point out in its brief that 32% of respondents reported that "portable/movable/rolling" came to mind and 18% reported that "x-rays" came to mind. However, there is no significance to these responses, it really doesn't matter if 32% or 0% responded that "portable/movable/rolling" or "x-ray" came to mind. Since respondents were told that they would encounter the mark ROLL-X on an "x-ray table," it is totally unremarkable that respondents would reply by either describing a feature of the x-ray table or merely repeating what

the examiner said. What is remarkable is that even though Rolex is not in the x-ray table business--52% responded that there was an association between Rolex, the watch company, and the manufacturer of x-ray tables named ROLL-X. This is exactly the form of dilution by blurring against which the statute was meant to protect.²

Based on the above, Applicant's criticisms of Rolex's survey are misplaced. Rolex's dilution survey was properly designed, constructed and administered and the results should be given substantial weight.

2. Rolex Has Proved That Its ROLEX Trademark Is Famous For The Purpose of Dilution.

As proof of its fame, Rolex submitted its advertising expenses (hundreds of millions of dollars spent) and sales figures (billions of dollars of products sold) in the United States dating back over 25 years. (Nicholson Dec. ¶¶ 10 & 11) Also Rolex submitted proof of national media coverage, including television, as well as third party publications in a variety of genres. *Id.* at ¶¶ 12 & 13. However, Applicant states that this evidence is "not sufficient to establish fame for the purposes of dilution." (Appl. Br. p.7.) In support of this statement Applicant cites to the case *Coach v. Triumph* wherein the TTAB ruled that the evidence submitted by Coach falls far short from proving that Coach's mark was famous for the purpose of dilution. *See, Coach Services Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600 (TTAB 2010). For multiple reasons the Coach case is inapposite to the present case. First, the Board criticized Coach for submitting evidence of sales and advertising expenditures for only one year, 2008, "and these figures represent its

² Dilution by blurring arises "from the similarity between a mark...and a famous mark that impairs the distinctiveness of the famous mark." 15 USC § 1125(c)(2)(A).

activities worldwide without breaking down the figures to sales and advertising in the United States.” Id. In contrast, Rolex submitted its sales and advertising expenditures occurring only in the United States for the past 25 years. Furthermore the TTAB ruled that even assuming the COACH mark was famous, Coach’s failure to submit prior years sales and advertising figures, made it impossible for the Board to determine if the mark became famous prior to Triumph’s use in December of 2004.³ Id.

Second, the TTAB determined that Coach failed to submit media evidence that showed recognition of Coach’s mark to the general population. Id. Coach’s media evidence was limited to “different fashion buys or trends.” Id. Coach does not advertise on television or radio. Also Coach submitted a website originating in the U.K., to which the TTAB gave no consideration because Coach did not explain why consumers in the U.S. would access this website. Id. Rolex, on the other hand, submitted a variety of media evidence. The record in this case shows that ROLEX products are advertised in over 46 national publications in a variety of fields of interests, including sports, arts, science, world news and fashion. (Nicholson Dec. ¶¶ 12 & 13.) Just as varied are the third party publications which mention the ROLEX trademark as a symbol of “status,” “quality,” and “fame.” Id. Rolex also extensively advertises on national television. The media evidence submitted by Rolex, in this proceeding, far surpasses that submitted by Coach.

Third, in another attempt to prove fame, Coach submitted an internal brand awareness study, which the TTAB deemed to have “dubious probative value.” *Coach*, 96 USPQ2d 1600. Coach’s study was limited to women ages 13-24 and provided no evidence of brand awareness among women and men in general. Id. Coach also failed to proffer a witness with first hand knowledge of how the study was conducted or its significance. Id. Again, Rolex’s extensive

³ The dilution statute requires proof that the mark was famous prior to the applicant’s use of the mark. 15 USC § 1125(c)(1).

media evidence, previously submitted, proves widespread recognition of the ROLEX trademark to the general population.

Finally, there are significant differences between the marks COACH and ROLEX. COACH is an ordinary word with several recognized meanings. ROLEX is a coined term with no meaning. Similarly the record in this case fails to show that there are any third party similar marks in existence either registered or in use.

For all of the above reasons, Applicant's reliance on *Coach v. Triumph* to support its claim that Rolex failed to submit sufficient evidence to prove that the ROLEX trademark is famous is erroneous. The evidence previously submitted by Rolex clearly proves that the ROLEX trademark is famous and has been long before Applicant filed its ROLL-X application.

3. Applicant Lacked A Bona Fide Intent To Use Its Mark At The Time The Application Was Filed.

The record shows that Applicant lacked a bona fide intent to use its mark at the time the application was filed. Applicant argues that it was a "prudent business decision" to suspend its "business plans" in light of this Opposition. (Appl. Br. p.11.) However, this does not explain Applicant's total absence of documents and activities to support its bona fide intent to use the ROLL-X mark at the time the application was filed. Even if Applicant did cease its business plans, there were nine months between Applicant's filing of the application (June 5, 2008) and the filing of this Opposition (February 25, 2009). Applicant has offered no objective proof to show that it had any type of "business plans" to suspend in regard to its use of the ROLL-X mark.

Similarly it is irrelevant, and insufficient objective evidence, for Applicant to merely state it promotes other products under other registered marks, such as “Dent-X”. (Appl. Br. p. 11.) Also it is irrelevant that over 30 years ago Applicant’s CEO was involved with a company that allegedly used the mark ROLL-X for a portable x-ray table. *Id.* These unsupported statements do not explain or outweigh Applicant’s lack of objective documentary evidence to support its claim that Applicant had a bona fide intent to use the mark when the application was filed. *See, Commodore Electronics Ltd. CBM v. CBM Kabushiki Kaisha*, 26 USPQ 2d 1503, 1507 (TTAB 1993) (the Board held that “absent other facts which adequately explain or outweigh the failure of an applicant to have any documents.....the absence of any documentary evidence on the part of an applicant regarding such intent is sufficient to prove the applicant lacks a bona fide intention to use its mark...”).

III. CONCLUSION

For all of the foregoing reasons, the Board should find that Rolex has submitted sufficient evidence to prove that there is widespread recognition of the ROLEX trademark among the general population and therefore the ROLEX trademark is famous in accordance with the dilution statute. Similarly the Board should disregard Applicant’s baseless criticisms of Rolex’s dilution survey and should give substantial weight to the survey results which found that a majority of respondents surveyed found that use of a ROLL-X mark on an x-ray table brought to mind an association with Opposer, Rolex. Finally the Board should also rule that Applicant, at the time it filed the application, did not have a bona fide intent to use the ROLL-X mark for the goods described in the application.

Respectfully submitted,

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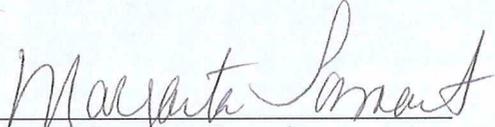
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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing BRIEF OF OPPOSER has been served on Applicant this 28th day of March, 2011 via first class mail, postage prepaid to:

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