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Filing date: **04/16/2015**

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

Proceeding	91220292
Party	Defendant The Spark Agency, Inc.
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Attachments	Switch Response to Motion for Summary Judgment.pdf(64587 bytes) Spark Exhibits (Final).pdf(969302 bytes)

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

Swatch AG (Swatch SA) (Swatch Ltd))
Opposer,)
v.) Opposition No. 91220292
The Spark Agency, Inc.)
Applicant.)
_____)

**APPLICANT’S RESPONSE TO OPPOSER’S MOTION FOR SUMMARY JUDGMENT
DISMISSING APPLICANT’S COUNTERCLAIM AND TO SUSTAIN THE
OPPOSITION UNDER THE DOCTRINE OF RES JUDICATA**

Applicant hereby files its Response to Opposer’s Motion for Summary Judgment Dismissing Applicant’s Counterclaim and to Sustain the Opposition Under the Doctrine of Res Judicata and respectfully requests that the Board deny Opposer’s Motion in its entirety.

A. Applicant Has Not Waived Its Right to Seek Cancellation of Opposer’s Registration No. 3,799,562 Because It Was Not a Compulsory Counterclaim in the Previous Proceeding.

In its Motion for Summary Judgment, Opposer argues that Applicant waived its right to seek cancellation of Opposer’s Registration No. 3,799,562 in this proceeding because it was an unpleaded compulsory counterclaim in a previous action between the two parties (Opposition No. 91190380). Opposer’s Motion, 4-6. Applicant vigorously denies that its counterclaim is barred in this proceeding. Section 2.106(b)(2)(i) states:

A defense attacking the validity of any one or more of the registrations pleaded in the opposition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed. If grounds for a counterclaim are known to the applicant when the answer to the opposition is filed, the counterclaim shall be pleaded with or as part of the answer. If grounds for a counterclaim are learned during the course

of the opposition proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned.

37 C.F.R. § 2.106(b)(2)(i).

In the previous action, Opposer filed its notice of opposition on May 26, 2009.

TTABVue 1. Opposer did not plead the registration at issue in its notice of opposition because it was only a pending application at the time (Serial No. 78194325). Opposer's trademark application matured into Registration No. 3,799,562 on June 8, 2010.

On April 16, 2012 (almost *two years* after Opposer's registration was issued), Opposer filed a motion for leave to file an amended notice of opposition in order to plead Registration No. 3,799,562. Exhibit A. Contemporaneously with such motion, Opposer filed an amended notice of opposition in which Registration No. 3,799,562 was pleaded. Exhibit B. In Paragraph 11 of Opposer's amended notice of opposition, Opposer *specifically alleged* that it "sells goods and offers services in Classes 14, 16, 25, 35, 41 and 42 and the Applicant intends to offer goods and services in Classes 35, 40, and 42." *Id.*

Although Applicant urged the Board to deny Opposer's motion, the Board nevertheless granted Opposer's motion on October 1, 2012 and provided Applicant until October 31, 2012 to file its answer to Opposer's amended notice of opposition. Exhibit C.

On October 9, 2012, Applicant filed its answer to Opposer's amended notice of opposition. Exhibit D. According to the first sentence of 37 C.F.R. § 2.106(b)(2)(i), in order for Applicant's counterclaim for cancellation of Opposer's registration to be barred in this proceeding, the grounds for Applicant's counterclaim must have existed on October 9, 2012 (the date Applicant's answer was filed). Needless to say, Opposer has not provided a shred of evidence in its Motion for Summary Judgment that the grounds for Applicant's counterclaim

(abandonment and lack of intent to begin or commence use of its mark) existed on October 9, 2012. In fact, Opposer *specifically alleged* in its amended notice of opposition that its mark *was in use* in connection with Class 35 services a mere six months prior to Applicant filing its answer to Opposer's amended notice of opposition. Exhibit B, ¶ 11.

Even assuming the grounds for Applicant's counterclaim existed at the time Applicant filed its answer on October 9, 2012, Opposer has not offered any evidence in its Motion for Summary Judgment that Applicant knew of such grounds at the time Applicant filed its answer. As a matter of fact, in Applicant's answer to Paragraph 11 of Opposer's amended notice of opposition, Applicant responded that it was "without knowledge or information sufficient to form a belief as to whether Opposer actually sells goods and offers services in Classes 14, 16, 25, 35, 41, and 42 and, accordingly, denies the allegation." Exhibit D, ¶ 11. In other words, Applicant did not admit to possessing any specific knowledge or information regarding Opposer's use, non-use, or abandonment of the mark in Registration No. 3,799,562 in connection with any goods or services.

Finally, even assuming the grounds for Applicant's counterclaim existed at the time Applicant filed its answer on October 9, 2012, Opposer has not submitted any evidence with its Motion for Summary Judgment that Applicant learned of the grounds for its counterclaim during the course of the opposition proceeding. When the Board granted Opposer's motion for leave to file an amended notice of opposition, it reset a brief discovery period of 30 days for Applicant alone to conduct discovery regarding the goods/services listed in Registration No. 3,799,562. Exhibit C.

On October 5, 2012, Applicant served upon Opposer its First Set of Requests for Admissions. On November 16, 2012, Opposer served its responses to Applicant's First Set of Requests for Admissions. Exhibit E. In its responses, Opposer stated that "it offers advertising, marketing and/or promotional services in connection with the SWATCH trademark in the United States." *Id.* at 3. Opposer also denied that it does not offer marketing and/or promotional services in the United States under the SWATCH trademark. *Id.* at 4.

On October 5, 2012, Applicant also served upon Opposer its First Set of Interrogatories. On November 16, 2012, Opposer served its responses to Applicant's First Set of Interrogatories. Exhibit F. In its responses, Opposer stated that "it offers advertising, promotional and/or marketing services under the SWATCH trademark in the United States, through its licensee The Swatch Group (U.S.) Inc. located at 1200 Harbor Boulevard, Weehawken, New Jersey 07086, and via its website at www.swatch.com." *Id.* at 3. As the Board can see, Opposer's responses to Applicant's discovery requests did not reveal to Applicant the grounds for its counterclaim (abandonment and lack of intent to begin or commence use of its mark) during the brief reset discovery period provided to Applicant by the Board. In fact, Opposer's responses would lead Applicant to believe that it had no legitimate grounds for counterclaim.

Finally, Opposer attempts to rely on arguments made by Applicant in its trial brief that the evidentiary record did not show use of Opposer's mark in connection with advertising agencies or marketing and advertising services. Opposer's Motion, 4-5. However, these statements are only Applicant's interpretation of the evidentiary record and do not demonstrate that Applicant learned of specific grounds for a counterclaim during Opposer's testimony period. In fact, Opposer interpreted the same evidentiary record differently, stating in its trial brief that

“Opposer, through its licensee, SGUS, provides marketing and advertising services in the United States under the SWATCH mark for several independent and separately owned companies...” and citing to the same testimony deposition transcript of Frank Furlan that Applicant cited to in its trial brief. Exhibit G at 12.

Furthermore, the Court of Appeals for the Federal Circuit has stated that “treating challenges to trademark validity as compulsory counterclaims to infringement actions would violate the well-established policy of freely allowing challenges to the validity claimed intellectual property protection” and it has “recognized that the public policy in favor of allowing challenges to invalid marks weighs in favor of cabining the doctrine of res judicata at the Patent and Trademark Office.” *Nasalok Coating Corp. v. Nylok Corp.*, 86 U.S.P.Q.2d 1369, 1375 (Fed. Cir. 2008). Although the prior proceeding between Applicant and Opposer was not an infringement action, it makes perfect sense that the policy rationale referred to by the Federal Circuit should apply to administrative proceedings before the Board as well.

At the end of the day, Opposer is talking out of both sides of its mouth. On the one hand, Opposer argues that Applicant knew there were grounds to cancel Opposer’s registration in the prior proceeding based on abandonment and lack of intent to begin or commence use of its mark. On the other hand, the statements made by Opposer in its amended notice of opposition, discovery responses, and trial brief all tend to indicate that Applicant never had any grounds to cancel Opposer’s registration whatsoever. Since Opposer has clearly failed to carry its burden of proof that Applicant waived its right to counterclaim for cancellation of Opposer’s registration, the Board should deny Opposer’s Motion for Summary Judgment and allow Applicant’s counterclaim to proceed.

B. Opposer’s Notice of Opposition Should Not Be Sustained Under the Doctrine of Res Judicata Because Applicant’s Marks Do Not Convey the Same Commercial Impression.

In its Motion for Summary Judgment, Opposer argues that its opposition to the registration of Applicant’s SWITCH mark should be sustained under the principles of res judicata. Opposer’s Motion, 6-11. Specifically, Opposer asserts that the Board’s decision in a previous opposition between the Parties finding a likelihood of confusion between Opposer’s SWATCH mark and Applicant’s SW:TCH mark bars this litigation because it would be based on the same set of transactional facts as the previous opposition. Applicant essentially agrees with Opposer that if SWITCH (the subject mark in this proceeding) and SW:TCH (Applicant’s mark in the previous proceeding) convey the *same* commercial impression, then Opposer would be entitled to entry of judgment under the doctrine of res judicata.

Applicant’s SW:TCH mark in the previous action does not convey the *same* commercial impression as Applicant’s SWITCH mark in the present action. Contrary to Opposer’s assertions, the Board did not find that a likely pronunciation of SW:TCH is “switch,” nor did it state in its decision that it would have found a likelihood of confusion between Opposer’s SWATCH mark and Applicant’s SW:TCH mark had the colon actually been the letter “I.” Rather, the Board merely indicated that *if* the colon was interpreted as an “I,” Applicant’s mark would likely be pronounced as “switch.” Exhibit H at 11. This observation likely had no bearing on the Board’s ultimate decision finding a likelihood of confusion because “if the colon is pronounced as an ‘A’ or not pronounced at all, SW:TCH is likely to be pronounced as ‘swatch,’” which would be identical to the pronunciation of Opposer’s mark. *Id.* In other words, the Board did not have to consider whether SWITCH and SWATCH are confusingly similar in order to

reach its decision. It only had to find that some consumers may reasonably substitute an “A” for the colon when pronouncing the mark (an argument Opposer vigorously made in the previous opposition). Moreover, nowhere in the decision did the Board analyze whether SWITCH and SWATCH are similar in appearance, or whether they have similar connotations and commercial impressions, since the mark at issue in the prior proceeding was SW:TCH and not SWITCH.

CONCLUSION

For the reasons set forth above, Applicant respectfully requests that the Board deny Applicant’s Motion for Summary Judgment, deny entry of judgment on Opposer likelihood of confusion claim, and allow Applicant’s counterclaim for cancellation of Registration No. 3,799,562 to proceed to trial.

Respectfully submitted,

THE SPARK AGENCY, INC.

By: _____ /aph72/

Dated: _____ 4/16/2015

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EXHIBIT A

ESTTA Tracking number: **ESTTA467387**

Filing date: **04/16/2012**

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

Proceeding	91190380
Party	Plaintiff Swatch AG (Swatch SA) (Swatch Ltd.)
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Date	04/16/2012
Attachments	H889_Motion for Leave to Amend (FINAL)_120416.PDF (10 pages)(29971 bytes) H889_EXHIBIT A TO MOTION FOR LEAVE TO AMEND_120416.PDF (9 pages)(613679 bytes)

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

SWATCH AG (SWATCH SA)
(SWATCH LTD.),

Opposer,

v.

THE SPARK AGENCY, INC.,

Applicant.

Mark: SW:TCH

Opp. No.: 91190380

Serial No.: 77/505,539

**OPPOSER'S MOTION FOR LEAVE TO FILE AN
AMENDED NOTICE OF OPPOSITION**

Pursuant to TBMP § 507 and Fed. R. Civ. P. 15(a), Opposer Swatch AG (Swatch SA) (Swatch Ltd.) (hereafter, "Opposer") moves for leave to amend the pleaded marks in its Notice of Opposition by removing U.S. Trademark Registration No. 3,291,129, and adding Registration No. 3,799,562. A copy of Opposer's Amended Notice of Opposition is being filed contemporaneously herewith.

BACKGROUND

Opposer is a renowned manufacturer of Swiss watches, and the owner of numerous U.S. Trademark Registrations for the mark SWATCH. In addition to its core businesses of selling watches and jewelry, Opposer's activities extend to a wide array of goods and services spanning numerous classes. Consistent with the broad scope of its business activities, Opposer has obtained registration of its SWATCH marks not only in International Class 14, but also Classes 16, 25, 35, 37, 41 and 42, among others.

On June 23, 2008, Applicant The Spark Agency, Inc. (“Applicant”) filed Trademark Application Serial Number 77/505,539 to register the mark SW:TCH in connection with services in International Classes 35, 40, and 42.

Applicant’s SW:TCH application was published for opposition on November 25, 2008. After obtaining an extension of time to oppose, Opposer filed a Notice of Opposition on May 26, 2009, alleging that registration of the SW:TCH mark would create a likelihood of confusion with, and dilute the distinctiveness of, Opposer’s SWATCH marks. In support of its claim, Opposer pleaded U.S. Registration Nos. 1,356,512; 1,671,076; 1,799,862; 1,849,657; 2,752,980; 2,050,210; 2,100,605; 3,567,953; 3,554,475; and 3,291,129.

Opposer now wishes to remove U.S. Registration No. 3,291,129 from its pleaded registrations.

In, addition, at the time Opposer commenced this proceeding, Opposer’s Application Serial No. 78/194,325 (“‘325 Application”) for the mark SWATCH was pending before the USPTO. The ‘325 Application has since matured into U.S. Registration No. 3,799,562 (“‘562 Registration”), which Opposer now seeks to add to its pleaded marks in the instant proceeding. Opposer requested Applicant’s consent to amend, which Applicant declined.

STANDARD

Leave to amend a pleading “must be freely given when justice so requires.” TBMP § 507.02 (3d ed. 2011); *see also* Fed. R. Civ. P. 15(a)(2) (“The court should freely give leave when justice so requires.”). Amendments to pleadings in trademark oppositions are governed by the Federal Rules of Civil Procedure, where “[u]nder the more liberal standard of Rule 15(a), the trial court should grant leave to file absent a substantial reason for denial, such as undue delay, bad faith, dilatory motive, repeated failure to cure deficiencies with other amendments, futility of

the amendment, or undue prejudice to the opposing party.” *Pressure Products Med. Supplies, Inc. v. Greatbatch Ltd.*, No. 2008-1602, 2010 U.S. App. LEXIS 6132, *22 (Fed. Cir. Mar. 24, 2010); *Foman v. Davis*, 371 U.S. 178, 182 (1962).

DISCUSSION

Granting leave to amend the Notice of Opposition to add Registration No. 3,799,562 will serve the interests of justice by allowing Opposer to rely on a registration that did not issue until after commencement of this proceeding, thus ensuring that the Board’s ultimate decision on the merits will be based on a record that most accurately and completely reflects the parties’ respective rights. This is precisely the purpose of the Rule: “[T]he thrust of Rule 15 is . . . that cases should be tried on their merits.” *Jet, Inc. v. Sewage Aeration Sys.*, 165 F.3d 419, 425 (6th Cir. 1999); *U.S. v. Hougham*, 364 U.S. 310, 317 (U.S. 1960) (“the purpose of pleading is to facilitate a proper decision on the merits.”). In addition to allowing the Board to decide the merits on a complete record, Opposer’s motion is timely made during the discovery period, and will not prejudice Applicant. Further, as the facts will demonstrate, Opposer’s motion is not futile.

I. APPLICANT WILL SUFFER NO PREJUDICE IF OPPOSER IS GRANTED LEAVE TO AMEND

Of the factors before the Board on a motion for leave to amend, “the consideration of prejudice to the opposing party carries the greatest weight.” *Eminence Capital, LLC v. Aspeon, Inc.*, 316 F.3d 1048, 1052 (9th Cir. 2003). *See also, Howey v. United States*, 481 F.2d 1187, 1190 (9th Cir. 1973) (“the crucial factor is the resulting prejudice to the opposing party”). Indeed, whether the amendment will prejudice the non-moving party “is the ‘touchstone of the inquiry under rule 15(a).’” *Pressure Products*, at *23.

“Timing plays a large role in the Board’s determination of whether an adverse party would be prejudiced by allowance of an amendment and as a result, long, unexplained delays may render the amendment untimely.” *TBC Brands, LLC v. Sullivan*, 2008 TTAB LEXIS 589, *3 (TTAB 2008) (citing *M. Aron Corp. v. Remington Products, Inc.* 222 U.S.P.Q. 93, 96 (TTAB 1984)). However, the prejudice inquiry also considers the *relative* timing of a Motion to Amend. Courts often look to the close of discovery as a reference point in determining whether granting leave to amend will result in undue prejudice. *See FDL, Inc. v. Simmons Co.*, 2003 U.S. Dist. LEXIS 24195, *39-40 (S.D. Ind. Nov. 17, 2003) (no prejudice where discovery remained open, and distinguishing cases where leave is sought after close of discovery or final judgment). As the Board has noted, “[a]ny potential prejudice may be ameliorated by the resetting and extension of discovery and trial dates, particularly where the discovery period was still open when the motion was brought.” *99 [cents] Only Stores v. U.S. Dream, Inc.*, Opposition No. 91116977, 2004 TTAB LEXIS 475, *5-6 (TTAB Aug. 23, 2004).

The Board’s decision in *Anheuser-Busch, Inc. v. G. Heileman Brewing Co., Inc.* is instructive. In that case, the Board held that although the opposer sought leave to amend to assert a registration obtained during proceedings, eighteen months after obtaining that registration, the passage of time was not prejudicial to the applicant. *Anheuser-Busch, Inc. v. G. Heileman Brewing Co., Inc.*, 1998 TTAB LEXIS 6, *2-3 (TTAB Jan. 16, 1998). The Board explained that the applicant would not be prejudiced as “the proceeding is still in the discovery stage and [the applicant] will have the opportunity to assert against the registration any available defense or counterclaim.” *Id.* at *3.

Like the applicant in *Anheuser-Busch*, Applicant will not be not prejudiced by the requested amendment, nor restricted in any manner from defending this opposition. Per the

Board's Order dated April 12, 2012, discovery remains open through April 20, 2012. Thus, discovery need not be re-opened, and Opposer is amenable to extending the current discovery period to allow Applicant to take written discovery, should it now choose to do so.¹ The proposed amendment will not change Applicant's position by requiring it take or respond to additional discovery. or of answering additional discovery propounded by Opposer. Finally, Applicant has had notice of the '562 Registration, which was introduced and discussed at the deposition of Applicant's Rule 30(b)(6) witness without objection. Applicant's witness admitted he was aware of Opposer's ownership of the '562 Registration. Exhibit A.

The requested amendment is not a "game change." Opposer seeks to remove one registration, and add one that did not issue until after Opposer filed its original Notice of Opposition. Despite these changes, Opposer's likelihood of confusion and dilution claims still rest on the strength and scope of its SWATCH marks, and Applicant will have an opportunity to defend and take discovery, should it now choose. Very simply, Applicant will not be prejudiced. Even if Applicant could show some prejudice, "[a]ny potential prejudice may be ameliorated by the resetting and extension of discovery and trial dates," 99 *[cents] Only Stores*, 2004 TTAB LEXIS 475 at *5, which extension Opposer will not contest.

II. OPPOSER HAS NOT UNDULY DELAYED IN SEEKING LEAVE TO AMEND

"[D]elay itself is an insufficient ground to deny amendment." *Datascope Corp. v. SMEC, Inc.*, 962 F.2d 1043, 1045 (Fed. Cir. 1992). Rather, the delay must be "undue," *Foman v. Davis*, 371 U.S. 178, 182 (1962). , The Board has held that "the concept of undue delay is inextricably

¹ To date, Applicant has not undertaken any discovery. It has not propounded any written discovery or deposed any witness of Opposer. Opposer has served written discovery and deposed Applicant's Rule 30(b)(6) witness. Opposer foresees no need for it to conduct additional discovery, though may wish to seek supplementation of Applicant's standing responses.

linked with the concept of prejudice to the non-moving party.” *Marshall Field & Co. v. Mrs. Field’s Cookies*, 17 U.S.P.Q.2d 1652 (TTAB 1990). Courts have similarly recognized the role of prejudice in assessing whether delay has been “undue.” *See Mayeaux v. La. Health Serv. & Indem. Co.*, 376 F.3d 420, 427 (5th Cir. 2004) (“[D]elay alone is an insufficient basis for denial of leave to amend: The delay must be undue, i.e., it must prejudice the nonmoving party or impose unwarranted burdens on the court.”); *Block v. First Blood Assocs.*, 988 F.2d 344, 350 (2d Cir. 1993) (“Mere delay, however, absent a showing of bad faith or undue prejudice, does not provide a basis for a district court to deny the right to amend.”); *Edwards v. City of Goldsboro*, 178 F.3d 231, 242 (4th Cir. 1999) (“Delay alone is an insufficient reason to deny leave to amend. Rather, the delay must be accompanied by prejudice, bad faith, or futility.”).

A review of the history of this matter demonstrates that Opposer has not unduly delayed in requesting amendment, nor will amendment prejudice Applicant. In determining whether the movant has unduly delayed in asserting a new ground for opposition, the Board will take note of periods when the matter is suspended. *See, e.g., Central Mfg. Co. v. Paramount Parks, Inc.*, 2004 TTAB LEXIS 642, *15-16 (TTAB Oct. 29, 2004) (non-precedential) (crediting Opposer’s argument that its “motion was not untimely because the case has been suspended for most of the time.”). Consented extensions of the discovery period may also enter into the Board’s calculus of undue delay. *See, e.g., Boral Limited*, 2000 TTAB LEXIS 186, *9, 59 U.S.P.Q.2d 1701 (TTAB Mar. 29, 2000) (factoring into granting of motion that “the parties have consented to several extensions of the discovery period”).

The ‘562 Registration registered on June 8, 2010. Since that time, a review of the docket for this proceeding shows that parties have filed four consented motions to suspend for settlement negotiations, totaling nine months. D.E. ## 15, 21, 23 & 28. In addition, the docket

shows three consented motions to extend, totaling an additional seven months. D.E. ## 17, 19 & 25. Opposer could not move to amend during the nine months of suspension, and doing so would have been inconsistent with the parties' efforts to settle this matter. Moreover, Applicant cannot be heard to complain of delay when it willingly joined in (and apparently did not believe it would be prejudiced by) these suspensions and extensions. The parties freely chose to suspend/extend proceedings in order to explore settlement and/or conduct discovery. Opposer should be granted leave to amend, as to hold otherwise would in effect penalize Opposer for exploring the possibility of settlement with Applicant.

III. OPPOSER'S PROPOSED AMENDMENT IS NOT FUTILE

“‘Futility’ means that the complaint, as amended, would fail to state a claim upon which relief could be granted.” *Glassman v. Computervision Corp.*, 90 F.3d 617, 623 (1st Cir. 1996). “[W]hether or not the moving party can actually prove the allegation(s) sought to be added to a pleading is a matter to be determined after the introduction of evidence at trial or in connection with a proper motion for summary judgment,” and should not bear on whether the Board should grant leave to amend. TBMP § 507.02.

The ‘562 Registration is, like the majority of registrations pleaded by Opposer, for the mark SWATCH. SWATCH differs from Applicant’s SW:TCH mark by one character, making the two highly similar, and nearly identical. Further, the ‘562 Registration lists services in International Classes 35 and 41 which Applicant’s 30(b)(6) witness admitted during his discovery deposition could include services provided by Applicant. Exhibit A (Quigley Deposition at 147:12 – 150:2). In light of the similarities between Opposer’s SWATCH and Applicant’s SW:TCH marks, and the similarities in the services with which each is used,

Opposer's requested amendment would not be futile, as it states a claim upon which relief may be granted.

IV. NO OTHER GROUNDS EXIST FOR DENYING LEAVE TO AMEND

Opposer's Motion is not for the purposes of delay, and is not a belated attempt to cure a deficiency. Rather, Opposer simply intends to add a registration which did not issue until after Opposer commenced this proceeding. Accordingly, Opposer's actions are timely and are not dilatory.

Finally, Opposer's Motion is made in good faith, and if granted, will ensure that the Board's decision on the merits is made on a complete record which more accurately reflects Opposer's registered trademark rights.

CONCLUSION

Because Opposer's amendment is timely, will not prejudice Applicant, and is not futile, Opposer respectfully requests that its motion to remove Registration No. 3,291,129 and add Registration No. 3,799,562 be GRANTED.

Respectfully Submitted,

Dated: April 16, 2012

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Enclosures: Exhibits A
JMC/JAL/DE

SHOULD ANY OTHER FEE BE REQUIRED, THE PATENT AND TRADEMARK OFFICE IS
HEREBY REQUESTED TO CHARGE SUCH FEE TO OUR DEPOSIT ACCOUNT 03-2465.

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING FILED ELECTRONICALLY
WITH THE UNITED STATES PATENT AND TRADEMARK OFFICE.

Date: April 16, 2012 /David Ewen/

CERTIFICATE OF SERVICE

I, David Ewen, hereby certify I caused a true copy of the foregoing Opposer's Motion for Leave to File an Amended Notice of Opposition to be served upon Applicant's Attorney of Record at the following address, postage pre-paid on this 16th day of April, 2012.

Annette P. Heller
Law Offices of Annette P. Heller
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St. Louis, MO 63017

/David Ewen/

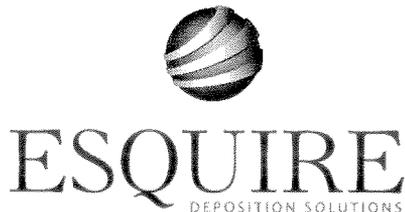
Exhibit A

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

SWATCH AG (SWATCH SA))	
(SWATCH LTD.,))	
)	
OPPOSER,)	
)	
vs.)	MARK: SW:TCH
)	OPP. NO. 91190380
THE SPARK AGENCY, INC.,)	SERIAL NO.: 77/505,539
)	
APPLICANT.)	

DEPOSITION OF KEVIN QUIGLEY
CONTAINS NON-ATTORNEYS' EYES ONLY PORTIONS
TAKEN BY JEFFREY LINDENBAUM, ESQ.
ON BEHALF OF THE OPPOSER
FEBRUARY 1, 2012

REPORTED BY CINDY J. TAYLOR, CCR, CSR, RPR
CCR NO. 552
CSR NO. 084.003874



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1 A. Never.

2 Q. Okay.

3 A. They would charge us for it.

4 Q. Let me show you what's marked as
5 Plaintiff's Exhibit 16 and ask you if you ever have
6 seen this before.

7 In particular I direct you
8 International Class 35 and International Class 41. Do
9 you know what this document is?

10 A. It looks like a trademark electronic
11 search system printout.

12 Q. Okay. This is a printout of a United
13 States Patent and Trademark offices trademark
14 electronics search system. And it reflects a
15 registration that is owned by Swatch for the mark
16 Swatch. And it includes certain services in classes
17 35 and 41.

18 Were you aware that Swatch owned this
19 registration?

20 A. Yes.

21 Q. Do you see in Class 35 it says
22 advertising agencies?

23 A. Yes.

24 Q. And do you see in Class 41 it says,
25 Providing of entertainment; namely, sporting and



1 cultural activities?

2 A. Yes.

3 Q. Do those sound like services that are
4 similar to those offered by Switch?

5 A. I would have to understand what you
6 mean by advertising agencies and providing the
7 entertainment, namely sporting and cultural
8 activities.

9 Q. Based on your understanding of what
10 those terms mean, does that sound like it's similar to
11 the services offered by Switch?

12 A. We don't consider ourselves an
13 advertising agency. So I can't -- you know, unless I
14 see a broader definition of what this means, I can't
15 really comment.

16 Q. Okay. Well, I'm not asking if the
17 service --

18 A. For example, an advertising agency
19 might provide media purchases. An advertising agency
20 might work strategically with a brand and develop a
21 marketing campaign that occurs over the next three or
22 five years. An advertising agency might help the
23 client develop new products and new product concepts,
24 and test those and see how they work.

25 The only part of advertising that we do



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1 if you stretch the definition is point of sale and
2 outdoor. We don't do the strategy. We don't do the
3 three-year strategic relationship with the client.
4 We're not at the table when they're doing their
5 marketing strategy planning. We're driven project by
6 project. We wish we were at the table. But we're
7 not. Because we're a project-driven company.

8 Q. Okay.

9 A. And then when you say providing of
10 entertainment, namely sporting and culture activities.
11 Again, I would have to ask what you mean by that.
12 We'll book entertainment for a client's show; Brian
13 Setzer and Nellie and Chuck Berry. We'll have our --
14 we might have one of our mobile -- our field sampling
15 units show up at a sporting event or a cultural event,
16 but we don't -- we don't sell ourselves as an
17 entertainment broker.

18 We don't sell tickets to entertainment
19 events. We don't sell ourselves as a sporting venue
20 or sporting producer. We don't sell tickets to
21 sporting events. Same thing for cultural activities.
22 We don't -- we're not a -- I don't even know what you
23 would call that.

24 Q. Okay. So these terms are, in your
25 opinion, broad and they could or could not include



1 some of the things that Switch provides?

2 A. Yeah, I think that's fair.

3 Q. All right. Are you aware of any
4 instances where a person or entity has contacted
5 Switch believing that they were reaching Swatch?

6 A. No.

7 Q. Okay. Are you aware of any instates
8 where an individual entity was confused between Switch
9 or Swatch?

10 A. No.

11 Q. Have you ever received any misdirected
12 mail or e-mail by someone who is trying to reach
13 Swatch?

14 A. No.

15 MR. LINDENBAUM: Let's take like five,
16 seven minutes and let me see if I have anything else.

17 THE WITNESS: Okay.

18 (A temporary recess was taken at this
19 time.).

20 MR. LINDENBAUM: Thank you very much
21 Mr. Quigley for your time today. I do not have any
22 further questions.

23 THE WITNESS: Thank you.

24 MS. HELLER: I have no Cross
25 Examination. You want to read and sign?





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Typed Drawing

Word Mark SWATCH

Goods and Services IC 003. US 001 004 006 050 051 052. G & S: PERFUMES; COLOGNES; COSMETICS

IC 008. US 023 028 044. G & S: Razors

IC 009. US 021 023 026 036 038. G & S: Sunglasses; case for spectacles; leather eyeglass cases; spectacle retaining cords, and spectacle retaining chains; multifunction telecommunication apparatus; namely, combination telephone and answering machine, combination watch and computer; apparatus for telecommunication, transmission, reception, recording, and reproduction, namely, radios, telephones, televisions, audio, video, tape and cassette players and recorders; phonograph records and pre-recorded audio compact discs, tapes, and cassettes, all featuring music; pre-recorded video discs, tapes, and cassettes of athletic events, scientific and nautical apparatus, namely, satellite navigational systems, beepers, surveying apparatus, namely, surveying chains; photographic and cinematographic apparatus, namely, photographic cameras, cinematographic film; optical apparatus, namely, optical scanners, weighing apparatus, namely, scales and calibrating equipment; measuring apparatus, namely, lasers and pocket calipers for measuring purposes; signaling apparatus, namely, signal whistles, life saving apparatus, namely, life saving rafts; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, namely, electric converters, electric transformers, voltage regulators for electric power, electric switches; apparatus for recording, transmission or reproduction of sound or image, namely, juke boxes, audio tape recorders, video tape recorders, video monitors

IC 011. US 013 021 023 031 034. G & S: APPARATUS FOR LIGHTING, NAMELY, ELECTRIC LIGHTING FIXTURE, WATER PUMPS FOR SPAS, BATHS, WATER FILTERING UNITS

IC 014. US 002 027 028 050. G & S: WATCH PROTECTORS; WATCHCASES; NECK CHAINS

IC 015. US 002 021 036. G & S: MUSICAL INSTRUMENTS

IC 016. US 002 005 022 023 029 037 038 050. G & S: Paper, namely, bags, envelopes, covers, folders, note paper, art paper, carbon paper; photographs; albums, balls for ball point pens, booklets, books, boxes of cardboard or paper, calendars, cardboard articles and tubes, greeting cards, printed publications, namely, catalogues, magazines, manuals, and periodicals all in the field of horology and jewelry; printed timetables; clips for offices, folders for papers, postcards, notebooks, photograph



stands, posters, prints, rubber erasers, table cloths, table mats, table linen, table napkins of paper, stationery; artist's materials, namely, pastels, pencils, paint brushes, painter's brushes; paper clasps, paper clips, crayons, pen cases, pencil and pen holders, pens and pencils, pencil sharpeners, wrappers, wrapping paper, writing cases, wristbands for retention of writing instruments

IC 018. US 001 002 003 022 041. G & S: Suitcases, travel bags, briefcase-type portfolios, briefcases, wallets, handbags, umbrellas, parasols, canes, backpacks, shoulder bags, cases of leather, namely, leather attache cases, purses, rucksacks, shopping bags

IC 020. US 002 013 022 025 032 050. G & S: FURNITURE; NON-METAL KEY HOLDERS; CHAIRS

IC 021. US 002 013 023 029 030 033 040 050. G & S: HOUSEHOLD OR KITCHEN UTENSILS NOT OF PRECIOUS METAL OR COATED THEREWITH, NAMELY, POT AND PAN SCRAPERS, ROLLING PINS, SPATULAS, TURNERS, WHISKS, HOUSEHOLD OR KITCHEN CONTAINERS NOT OF PRECIOUS METAL OR COATED THEREWITH; HAIR COMBS; SPONGES FOR HOUSEHOLD PURPOSES; HAIR BRUSHES; BRUSH-MAKING MATERIALS; ARTICLES FOR CLEANING PURPOSES, NAMELY, CLEANING RAGS, IMPREGNATED CLEANING, DUSTING OR POLISHING CLOTHS, STEEL WOOL FOR CLEANING; BEVERAGE GLASSWARE; PORCELAIN FIGURINES, PORCELAIN MUGS; EARTHENWARE MUGS

IC 022. US 001 002 007 019 022 042 050. G & S: Ropes, string, tents, awnings not made of metal; tarpaulins, sails, nets, namely, commercial nets, fabric and polyester mesh net used for storing toys and other household items, hammocks

IC 024. US 042 050. G & S: Towels, handkerchiefs, bed blankets, shower curtains, table cloths not of paper, table mats not of paper

IC 025. US 022 039. G & S: DOWN VESTS; WIND RESISTANT JACKETS; SKI BOOTS

IC 028. US 022 023 038 050. G & S: BOARD GAMES, GYMNASTIC AND SPORTS ARTICLES, NAMELY SKIS, SKI POLES, PORTABLE COVERS AND CASES FOR SKIS AND SKI BINDINGS, TENNIS RACKETS, TENNIS BALLS, TENNIS RACKET CASES AND COVERS, KITES, BALLS OF ALL KINDS, TOY FIGURES, SOFT-SCULPTURED DOLLS, AND STUFFED TOYS, TOY VEHICLES, SKATE BOARDS, ROLLER SKATES, BALLOONS, JIGSAW PUZZLES TOY WATCHES, TOY JEWELRY, CHRISTMAS TREE DECORATIONS, YOYOS, AND PLAYING CARDS

IC 029. US 046. G & S: MEATS AND PROCESSED FOODS, NAMELY, MEAT, CHICKEN, PROCESSED FRUITS AND VEGETABLES, CLAM CHOWDER

IC 032. US 045 046 048. G & S: BEVERAGES, NAMELY, FRUIT JUICE, VEGETABLE JUICE, CARBONATED SOFT DRINKS

IC 034. US 002 008 009 017. G & S: CIGARETTE AND CIGAR LIGHTERS NOT OF PRECIOUS METAL

IC 035. US 100 101 102. G & S: MANAGEMENT OF BUSINESS; ADVERTISING AGENCIES; COMPUTER ASSISTED PROCESSING OF DATA DERIVED FROM THE TIMING OF SPORTING ACTIVITIES FOR USE IN EDUCATION, ENTERTAINMENT AND PUBLICITY

IC 038. US 100 101 104. G & S: Electronic transmission of data derived from sporting events; and radio and television broadcast of programs and shows

IC 041. US 100 101 107. G & S: Providing of entertainment, namely, sporting and cultural activities

Mark Drawing
Code

(1) TYPED DRAWING

Serial
Number

78194325

Filing Date

December 13, 2002

Current Filing Basis 44E
Original Filing Basis 1B
Published for Opposition March 23, 2010
Registration Number 3799562
Registration Date June 8, 2010
Owner (REGISTRANT) Swatch AG (Swatch SA) (Swatch Ltd.) CORPORATION SWITZERLAND 94, rue Jacob Stämpfli Bienne SWITZERLAND 2500
Attorney of Record Jess M. Collen
Prior Registrations 1671076;1980517;2217468;AND OTHERS
Type of Mark TRADEMARK. SERVICE MARK
Register PRINCIPAL
Live/Dead Indicator LIVE

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EXHIBIT B

ESTTA Tracking number: **ESTTA467391**

Filing date: **04/16/2012**

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

Proceeding	91190380
Party	Plaintiff Swatch AG (Swatch SA) (Swatch Ltd.)
Correspondence Address	JESS M COLLEN COLLEN IP THE HOLYOKE MANHATTAN BUILDING, 80 SOUTH HIGHLAND AVENUE OSSINING, NY 10562 UNITED STATES jlindenbaum@collenip.com, docket@collenip.com, dewen@collenip.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	David Ewen
Filer's e-mail	dewen@collenip.com, docket@collenip.com
Signature	/David Ewen/
Date	04/16/2012
Attachments	H889_Amended Notice of Opposition (FINAL)_120416.PDF (7 pages)(21597 bytes)

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

SWATCH AG (SWATCH SA)
(SWATCH LTD.),

Opposer,

v.

THE SPARK AGENCY, INC.,

Applicant.

Mark: SW:TCH

Opp. No.: 91190380

Serial No.: 77/505,539

AMENDED NOTICE OF OPPOSITION

The Opposer, Swatch AG (Swatch SA) (Swatch Ltd.), a corporation duly organized and existing under the laws of Switzerland, located at Jakob-Stämpfli-Strasse 94 Biel/Bienne Switzerland (referred to as “Opposer”) believes it would be damaged by the mark shown in the above-identified application, and hereby opposes same, pursuant to 15 U.S.C. § 1063 and 37 C.F.R. § 2.104.

As grounds for opposition, it is alleged that:

(1) SWATCH is and has been engaged in the sale and marketing of goods under the SWATCH trademark since a time long prior to the date of first use alleged by Applicant in its application for registration.

(2) SWATCH is and has been engaged in the sale and marketing in commerce since 1982 of a variety of goods and services including retail store services, publications illustrating collectible articles, watches, watch bands, clocks, electronic apparatus, clothing, and a range of other goods and services all under the trademark SWATCH. SWATCH has sold goods under its SWATCH trademark continuously since that time. As a result, SWATCH has acquired rights in the SWATCH mark.

(3) SWATCH is also the owner of numerous valid United States Trademark registrations including, but not limited to:

SWATCH	Reg. 1356512
SWATCH	Reg. 1671076
SWATCH	Reg. 1799862
SWATCH	Reg. 1849657
SWATCH	Reg. 2752980
SWATCH	Reg. 2050210
SWATCH	Reg. 2100605
ISWATCH	Reg. 3567953
ESWATCH	Reg. 3554475
SWATCH	Reg. 3799562

and others (all referred to in the opposition as the SWATCH Marks).

(4) Opposer's registrations are *prima facie* proof of ownership and use of the mark from the original date of filing of the application, pursuant to 15 USC 1057(b), and of the exclusive right to use the registered mark in commerce. Registrations 1,356,512, 1,671,076, 1,252,863, 1,799,862, 1,849,657, 2,100,605 and 2,050,210 are incontestable, pursuant to section 15 of the Trademark Act.

(5) SWATCH has used its mark in commerce extensively and has acquired a considerable and valuable goodwill and wide-scale recognition for its mark. The public has come to associate the SWATCH Marks with Opposer and Opposer's goods and services. The SWATCH Marks have acquired distinctiveness.

(6) SWATCH is an innovative company which has associated its SWATCH mark with a range of goods and services. Apart from being a pre-eminent watch seller, its mark is integrally related to timekeeping resulting in part from its enormous U.S. and worldwide visibility, resulting from its status as official timekeeper for several Olympic games. SWATCH also applies its mark to a line of jewelry. SWATCH is the owner of many retail establishments, operating under the SWATCH trademark throughout the United States.

(7) Applicant's mark is confusingly similar to Opposer's trademark SWATCH and is likely, when applied to the services of the Applicant, to cause confusion, or to cause mistake or to deceive.

(8) Consumers encountering the Applicant's mark and services are likely to believe that such services originate from or are authorized or sponsored by the Opposer, in view of the wide scale fame of the Opposer's mark and the indistinguishable differences between Opposer's marks and services and the Applicant's mark and goods and services.

(9) Use of the mark SW:TCH will be likely to lead consumers and potential consumers of the Applicant's goods and services to believe that the mark is an addition to the SWATCH family of marks. To the consumer, the mark SW:TCH will be recognizable as a mark SWATCH. The replacement of the letter "A" with the punctuation character ":" will do nothing to lessen the confusion. The Consumer will mistake the Applicant's mark for the mark SWATCH. Alternatively, consumers will perceive the goods and services sold under the Applicant's trademark as the natural result of a continuation or expansion of the SWATCH mark, and will believe that the Applicant's goods and services emanate from SWATCH.

(10) Consumers hearing the Applicant's mark will likely confuse it with the Opposer's SWATCH trademark.

(11) The Opposer sells goods and offers services in Classes 14, 16, 25, 35, 41 and 42 and the Applicant intends to offer goods and services in Classes 35, 40, and 42. The Opposer's mark is registered for, among other things, goods and services in Classes 35, 41 and 42, and the Applicant's mark is pending for similar or highly related goods and services in Classes 35, 40, and 42. Consumers would be likely to believe that the Opposer is the source of Applicant's goods and

services, or that Applicant's use of the SW:TCH mark would designate the Opposer as the source of those goods and services.

(12) The Applicant has appropriated the Opposer's trademark in its entirety, and has varied from Opposer's mark only by replacing a letter with a punctuation character. This alteration of the Opposer's mark does not serve to change that mark in a way to make confusion unlikely. The mark SW:TCH is confusingly similar to SWATCH.

(13) Consumers will likely believe that the Applicant's goods services are sold by, affiliated with, or sponsored or endorsed by the Opposer, which they are not.

(14) On information and belief, both the services bearing Applicant's mark and the goods and services bearing Opposer's marks may be advertised and sold through the same or similar channels of distribution

(15) On information and belief, the Applicant has adopted its SW:TCH trademark with full knowledge of the Opposer's SWATCH trademark.

(16) The Opposer's SWATCH mark is a famous trademark.

(17) On information and belief, the Applicant's mark is also likely to diminish and dilute the value and distinctive character of the Opposer's mark, to the great detriment of the Opposer's famous SWATCH Marks, thus irreparably damaging the Opposer.

(18) Applicant's mark so resembles SWATCH, the Opposer's mark, as used in the United States and not abandoned, as to be likely to cause confusion, or to cause mistake or to deceive.

WHEREFORE, Opposer prays that this application Serial No. 77/505,539 be refused, that no registration be issued thereon to Applicant and that this Opposition be sustained in favor of Opposer.

Respectfully submitted,

Dated: April 16, 2012

By: /Jess M. Collen/
Jess M. Collen
David Ewen
COLLEN IP
The Holyoke-Manhattan Building
80 South Highland Avenue
Ossining, NY 10562
914-941-5668
*Attorneys for Opposer Swatch AG
(Swatch SA) (Swatch Ltd.)*

JMC/DE

SHOULD ANY OTHER FEE BE REQUIRED, THE PATENT AND TRADEMARK OFFICE IS HEREBY REQUESTED TO CHARGE SUCH FEE TO OUR DEPOSIT ACCOUNT 03-2465.

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING FILED ELECTRONICALLY WITH THE UNITED STATES PATENT AND TRADEMARK OFFICE.

COLLEN IP

By: /David Ewen/

Date: April 16, 2012

CERTIFICATE OF SERVICE

I, David Ewen, hereby certify that on April 16, 2012, I caused true and correct copy of the following Notice of Opposition to be served upon Applicant's Attorney of Record via first class mail, postage pre-paid, at the address shown below:

Annette P. Heller
Law Offices of Annette P. Heller
400 Chesterfield Center
Suite 400
St. Louis, MO 63017

/David Ewen/

EXHIBIT C

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

DUNN

Mailed: October 1, 2012

Opposition No. 91190380

Swatch AG (Swatch SA) (Swatch
Ltd.)

v.

The Spark Agency, Inc.

Elizabeth A. Dunn, Attorney (571-272-4267):

This case comes up on opposer's motion, filed April 16, 2012, to amend the notice of opposition to delete one pleaded registration and to add one registration which issued after commencement of this proceeding. The motion is contested. The delay in acting upon this matter is regretted.

The notice of opposition filed May 26, 2009 pleads priority of use and likelihood of confusion, and dilution, with respect to applicant's mark SW:TCH¹ and opposer's SWATCH

¹ Opposed Application Serial No. 77505539 lists:
International Class 35

Marketing and promotional services, namely, planning, conducting, and organizing mobile marketing exhibits, trade show exhibits, point of sale exhibits, and marketing displays for business meetings and business events for advertising purposes; Design of advertising multimedia presentations and themed graphics for use in marketing campaigns for others for trade shows, business meetings, and business to business events

mark, the subject of ten pleaded registrations. With its amended notice of opposition, Swatch AG seeks to substitute its Registration No. 3799562², which issued June 10, 2010 from

International Class 40

Custom manufacture of mobile marketing exhibits and trade show exhibits

International Class 42

Design and development of websites for others

² Newly-issued **Registration No. 3291129** lists:

International Class 3

perfumes; colognes; cosmetics

International Class 8

razors

International Class 9

Sunglasses; case for spectacles; leather eyeglass cases; spectacle retaining cords, and spectacle retaining chains; multifunction telecommunication apparatus; namely, combination telephone and answering machine, combination watch and computer; apparatus for telecommunication, transmission, reception, recording, and reproduction, namely, radios, telephones, televisions, audio, video, tape and cassette players and recorders; phonograph records and pre-recorded audio compact discs, tapes, and cassettes, all featuring music; pre-recorded video discs, tapes, and cassettes of athletic events, scientific and nautical apparatus, namely, satellite navigational systems, beepers, surveying apparatus, namely, surveying chains; photographic and cinematographic apparatus, namely, photographic cameras, cinematographic film; optical apparatus, namely, optical scanners, weighing apparatus, namely, scales and calibrating equipment; measuring apparatus, namely, lasers and pocket calipers for measuring purposes; signaling apparatus, namely, signal whistles, life saving apparatus, namely, life saving rafts; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, namely, electric converters, electric transformers, voltage regulators for electric power, electric switches; apparatus for recording, transmission or reproduction of sound or image, namely, juke boxes, audio tape recorders, video tape recorders, video monitors

International Class 11

apparatus for lighting, namely, electric lighting fixture, water pumps for spas, baths, water filtering units

International Class 14

watch protectors; watchcases; neck chains

International Class 15

musical instruments

International Class 16

paper, namely, bags, envelopes, covers, folders, note paper, art paper, carbon paper; photographs; albums, balls for ball

point pens, booklets, books, boxes of cardboard or paper, calendars, cardboard articles and tubes, greeting cards, printed publications, namely, catalogues, magazines, manuals, and periodicals all in the field of horology and jewelry; printed timetables; clips for offices, folders for papers, postcards, notebooks, photograph stands, posters, prints, rubber erasers, table cloths, table mats, table linen, table napkins of paper, stationery; artist's materials, namely, pastels, pencils, paint brushes, painter's brushes; paper clasps, paper clips, crayons, pen cases, pencil and pen holders, pens and pencils, pencil sharpeners, wrappers, wrapping paper, writing cases, wristbands for retention of writing instruments

International Class 18

suitcases, travel bags, briefcase-type portfolios, briefcases, wallets, handbags, umbrellas, parasols, canes, backpacks, shoulder bags, cases of leather, namely, leather attache cases, purses, rucksacks, shopping bags

International Class 20

furniture; non-metal key holders; chairs

International Class 21

household or kitchen utensils not of precious metal or coated therewith, namely, pot and pan scrapers, rolling pins, spatulas, turners, whisks, household or kitchen containers not of precious metal or coated therewith; hair combs; sponges for household purposes; hair brushes; brush-making materials; articles for cleaning purposes, namely, cleaning rags, impregnated cleaning, dusting or polishing cloths, steel wool for cleaning; beverage glassware; porcelain figurines, porcelain mugs; earthenware mugs

International Class 22

ropes, string, tents, awnings not made of metal; tarpaulins, sails, nets, namely, commercial nets, fabric and polyester mesh net used for storing toys and other household items, hammocks

International Class 24

Towels, handkerchiefs, bed blankets, shower curtains, table cloths not of paper, table mats not of paper

International Class 25

down vests; wind resistant jackets; ski boots

International Class 28

board games, gymnastic and sports articles, namely skis, ski poles, portable covers and cases for skis and ski bindings, tennis rackets, tennis balls, tennis racket cases and covers, kites, balls of all kinds, toy figures, soft-sculptured dolls, and stuffed toys, toy vehicles, skate boards, roller skates, balloons, jigsaw puzzles toy watches, toy jewelry, christmas tree decorations, yoyos, and playing cards

International Class 29

meats and processed foods, namely, meat, chicken, processed fruits and vegetables, clam chowder

International Class 32

beverages, namely, fruit juice, vegetable juice, carbonated soft drinks

International Class 34

cigarette and cigar lighters not of precious metal

a Section 44(e) application filed December 14, 2002, and covers twenty classes of goods and services, for Registration No. 3291129, which issued September 11, 2007 and covers one class of services³. The proposed amended notice of opposition would differ from the original with respect to Paragraph 3, where the pleaded registrations are listed, and Paragraph 11, where opposer alleges that the parties offer goods and services in competing classes.

Trademark Rule 2.115 and Fed. R. Civ. P. 15(a) encourage the Board to look favorably on motions to amend, stating that "leave shall be freely given when justice so requires." In deciding whether to grant leave to amend, the Board may consider undue delay, prejudice to the opposing party, bad faith or dilatory motive, futility of the amendment, and whether the party has previously amended its pleadings. *Foman v. Davis*, 371 U.S. 178, 182 (1962); *American Express Marketing*

International Class 35

management of business; advertising agencies; computer assisted processing of data derived from the timing of sporting activities for use in education, entertainment and publicity

International Class 38

electronic transmission of data derived from sporting events; and radio and television broadcast of programs and shows

International Class 41

providing of entertainment, namely, sporting and cultural activities

³ **Registration No. 3291129** lists:

International Class 35

Retail store services featuring jewelry and horological instruments and parts thereof

& Development Corp. v. Gilad Development Corp., 94 USPQ2d 1294, 1297 (TTAB 2010).

Here, opposer points out that the registration issued after commencement of this proceeding, that it is relevant to the issues pleaded in this proceeding, that it would be inappropriate to file the motion to amend while proceedings were suspended for settlement, and that any potential prejudice to applicant may be ameliorated by allowing discovery related to the new registration.⁴

Applicant opposes amendment as untimely and prejudicial inasmuch as, notwithstanding some suspension for settlement, there was ample opportunity for opposer to bring this motion earlier in the proceeding, and the registration to be added "lists dozens of products/services that are not covered by any of Opposer's other registrations", making the proposed amendment "a game change."

The Board agrees that the scope of goods and services in the pleaded registrations will be greatly expanded by the addition of the recently-issued registration. While proceedings were suspended for some part of the more than two years since the registration issued, opposer has been aware

⁴ With reference to opposer's deposition of applicant alluded to by both parties, opposer is correct in asserting that it may depose applicant about its knowledge of opposer's SWATCH marks, including those which are the subject of unpleaded registrations, and applicant is correct in asserting that this is no substitute for the necessary amendment of the notice of opposition to plead the registration.

since the commencement of this proceeding that the underlying application was pending, and did not promptly move to add the registration after it issued. Moreover, the Board disagrees with opposer's argument that only registrations, and not applications, should be pleaded. Registrations, of course, have an evidentiary value which applications do not. However, the purpose of the pleadings is to provide notice of the issues to be decided, and pleading a pending application is a common practice. See *UMG Recordings Inc. v. O'Rourke*, 92 USPQ2d 1042, 1045 n.12 (TTAB 2009) ("The pleading of the application ... provided sufficient notice to the applicant that the opposer would rely on a registration from the application for its likelihood of confusion claim.").

Nonetheless, while the Board sees the amendment to add the registration as a significant change which was unduly delayed, the Board will not deny the amendment. To hold otherwise is to risk a duplicative proceeding in which opposer pleads the new registration. It is better to address all claims at once, while exercising our authority to ensure that this proceeding goes forward as expeditiously as possible. See *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1217 n.1 (TTAB 1990) ("The Board, while recognizing opposer's delay in asserting the amendment, nevertheless granted the motion to amend on the ground that the interests of justice and judicial

economy would best be served by permitting all claims, including counterclaims, between the parties to be adjudicated in one proceeding and since any prejudice suffered by applicant could be mitigated by a reopening of discovery solely for applicant's benefit."). Accordingly, opposer's motion to amend the notice of opposition is GRANTED. The amended notice of opposition now is the operative pleading.

Applicant is allowed until THITY DAYS from the mailing date of this order to file its answer to the amended notice of opposition.

The Board resets a brief discovery period for applicant alone to conduct discovery. Opposer is advised that the Board will take a dim view of anything less than the full cooperation which the Board expects from the parties during discovery, or any recalcitrance in producing information regarding the goods listed in the recently issued registration.

Proceedings herein are resumed, and dates are reset below.

Discovery (applicant only) Closes	10/31/2012
Plaintiff's Pretrial Disclosures	12/15/2012
Plaintiff's 30-day Trial Period	1/29/2013
Ends	
Defendant's Pretrial Disclosures	2/13/2013
Defendant's 30-day Trial Period	3/30/2013
Ends	
Plaintiff's Rebuttal Disclosures	4/14/2013
Plaintiff's 15-day Rebuttal Period	5/14/2013
Ends	

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

ⓈⓈⓈⓈⓈ

EXHIBIT D

ESTTA Tracking number: **ESTTA499004**

Filing date: **10/09/2012**

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

Proceeding	91190380
Party	Defendant The Spark Agency, Inc.
Correspondence Address	ANNETTE P HELLER HELLER AND ASSOCIATES 400 CHESTERFIELD CENTER, SUITE 400 CHESTERFIELD, MO 63017 5734 UNITED STATES Tmattorneyheller@aol.com
Submission	Motion to Amend/Amended Answer or Counterclaim
Filer's Name	Annette P. Heller
Filer's e-mail	tmattorneyheller@aol.com,tmattorneyturek@aol.com
Signature	/aph72met/
Date	10/09/2012
Attachments	Spark Agency Answer to Amended Opposition.pdf (4 pages)(36202 bytes)

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

Swatch AG)
Opposer,)
v.) Opposition No. 91190380
The Spark Agency, Inc.)
Applicant.)
_____)

**APPLICANT’S ANSWER TO OPPOSER’S
AMENDED NOTICE OF OPPOSITION**

In answer to the Amended Notice of Opposition filed by Opposer Swatch AG, Applicant The Spark Agency, Inc. states the following:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 1 of the Notice of Opposition and, accordingly, denies each and every allegation set forth therein.
2. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 2 of the Notice of Opposition and, accordingly, denies each and every allegation set forth therein.
3. Applicant admits that the records of the United States Patent and Trademark Office indicate that Opposer is the owner of the registrations listed in Paragraph 3 of the Notice of Opposition.

4. Applicant admits that the records of the United States Patent and Trademark Office indicate that the registrations listed in Paragraph 4 of the Notice of Opposition are incontestable, except for Registration No. 1,252,863 which is cancelled.

5. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 5 of the Notice of Opposition and, accordingly, denies each and every allegation set forth therein.

6. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 6 of the Notice of Opposition and, accordingly, denies each and every allegation set forth therein.

7. Applicant denies each and every allegation set forth in Paragraph 7 of the Notice of Opposition.

8. Applicant denies each and every allegation set forth in Paragraph 8 of the Notice of Opposition.

9. Applicant denies each and every allegation set forth in Paragraph 9 of the Notice of Opposition.

10. Applicant denies each and every allegation set forth in Paragraph 10 of the Notice of Opposition.

11. Applicant is without knowledge or information sufficient to form a belief as to whether Opposer actually sells goods and offers services in Classes 14, 16, 25, 35, 41, and 42 and, accordingly denies the allegation. Applicant admits that it intends to offer services in Classes 35, 40, and 42 and that its mark is pending for services in Classes 35, 40, and 42.

Applicant admits that the records of the United States Patent and Trademark Office indicate that

Opposer is the owner of registrations for marks in Classes 35, 41, and 42. Applicant denies each and every remaining allegation set forth in Paragraph 11 of the Notice of Opposition.

12. Applicant denies each and every allegation set forth in Paragraph 12 of the Notice of Opposition.

13. Applicant denies each and every allegation set forth in Paragraph 13 of the Notice of Opposition.

14. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 14 of the Notice of Opposition and, accordingly, denies each and every allegation set forth therein.

15. Applicant denies each and every allegation set forth in Paragraph 15 of the Notice of Opposition.

16. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 16 of the Notice of Opposition and, accordingly, denies each and every allegation set forth therein.

17. Applicant denies each and every allegation set forth in Paragraph 17 of the Notice of Opposition.

18. Applicant denies each and every allegation set forth in Paragraph 18 of the Notice of Opposition.

DENIAL OF PRAYER FOR RELIEF

Applicant denies that Opposer is entitled to any of the relief sought in its prayer for relief against Applicant.

Respectfully submitted,

THE SPARK AGENCY, INC.

By: /aph72/

Dated: 10/9/2012

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing has been served by mailing said copy on 10/9/2012 via U.S. Mail, postage pre-paid, to:

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 /aph72/
Annette P. Heller, Attorney for Applicant

EXHIBIT E

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

SWATCH AG (SWATCH SA)
(SWATCH LTD.),

Opposer,

v.

THE SPARK AGENCY, INC.,

Applicant.

Mark: SW:TCH

Opp. No.: 91190380

Serial No.: 77/505,539

**OPPOSER’S RESPONSES TO APPLICANT’S FIRST SET OF REQUESTS FOR
ADMISSIONS**

Opposer, Swatch AG (Swatch SA) (Swatch Ltd.) (“Swatch” or “Opposer”), hereby serves its Responses to Applicant’s First Request for Admission pursuant to Rules 26 and 36 of the Federal Rules of Civil Procedure.

GENERAL OBJECTIONS

1. Opposer objects to each and every request in its entirety on the ground that Opposer is responding on the basis of its current knowledge and information. Opposer reserves the right to supplement each response to these requests.
2. Opposer objects to each and every request insofar as and to the extent that it seeks information protected by the attorney-client privilege, the work product doctrine, or any

other applicable privilege or immunity, and will not produce such information. Any inadvertent disclosure of such information shall not be a waiver of the attorney-client privilege, the work product doctrine, or any other applicable privilege or immunity.

3. Opposer objects to each and every request insofar as and to the extent it seeks divulgence of trade secrets, confidential or proprietary information of any third-party, such information will not be disclosed. To the extent each and every request seeks divulgence of such information of Opposer, such information will be disclosed subject to an appropriate protective order.
4. Opposer objects to each and every request to the extent it seeks production of information relating to or revealing proprietary development and marketing activities for Opposer products not yet manufactured or not yet on sale or otherwise employed. The slight relevance, if any, of such highly confidential trade secret information is vastly outweighed by the severe prejudice that would result to Opposer was it to be disclosed or available to competitors of Opposer. Opposer will not provide such information.
5. Opposer objects to each and every request to the extent it calls for information neither relevant to the subject matter of this Action nor reasonably calculated to lead to the discovery of admissible evidence.
6. Opposer objects to Opposer's definitions in their entirety to the extent same seek to impose obligations on Opposer beyond those permitted by the Federal Rules of Civil Procedure or the Local Rules applicable to this matter.
7. Opposer objects to each and every request to the extent it calls for information that exceeds a reasonable durational scope.

8. Opposer objects to each and every request to the extent it calls for information not yet available as these responses are made during the discovery process. Opposer reserves the right to supplement responses when the information becomes available.
9. Opposer objects to each and every request to the extent it is overly broad, vague and ambiguous, unduly burdensome or not reasonably calculated to lead to the discovery of admissible evidence.
10. Opposer objects to each and every request to the extent it improperly seeks conclusions of law.
11. Opposer objects to each and every request to the extent it is duplicative.
12. Opposer objects to each and every request to the extent that it is not limited in temporal or geographic scope.

SPECIFIC OBJECTIONS AND RESPONSES

1. Opposer does not operate any advertising agencies in the United States under the SWATCH trademark.

RESPONSE: Opposer hereby incorporates all of its General Objections. Opposer further objects to this Request as vague because Applicant has not defined the term “advertising agencies.” Subject to and without waiving the foregoing objections, Opposer states that it offers advertising, marketing and/or promotional services in connection with the SWATCH trademark in the United States.

2. Opposer does not operate any marketing agencies in the United States under the SWATCH trademark.

RESPONSE: Opposer hereby incorporates all of its General Objections. Opposer further objects to this Request as vague because Applicant has not defined the term “marketing agencies.” Subject to and without waiving the foregoing objections, Opposer states that it offers advertising, marketing and/or promotional services in connection with the SWATCH trademark in the United States.

3. Opposer does not offer marketing and/or promotional services in the United States under the SWATCH trademark.

RESPONSE: Opposer hereby incorporates all of its General Objections. Subject to and without waiving the foregoing objections, Opposer denies this request.

4. Opposer does not offer marketing and/or promotional services in the United States under the SWATCH trademark to businesses that are not associated with Opposer.

RESPONSE: Opposer hereby incorporates all of its General Objections. Subject to and without waiving the foregoing objections, Opposer admits that it does not offer marketing and/or promotional services in the United States to “businesses that are not associated with Opposer,” as that term is very narrowly defined by Applicant and would exclude the rendering of services for, among others, businesses that ever supplied Opposer with any products or services, businesses that ever offered, sold, or distributed Opposer’s products or services, businesses that are legally related to Opposer, and businesses that are subsidiaries, affiliates, wholly owned by Opposer, or partially owned by Opposer. Nevertheless, Opposer states that it offers marketing and promotional services in connection with the SWATCH trademark in the United States to third parties, including third parties, which have no corporate affiliation with Opposer.

5. Opposer does not operate any advertising and/or marketing agencies under the SWATCH trademark that provide services to individuals and/or businesses located in the United States.

RESPONSE: Opposer hereby incorporates all of its General Objections. Opposer further objects to this Request as vague because Applicant has not defined the term “advertising and/or marketing agencies.” Subject to and without waiving the foregoing objections, Opposer states that it offers advertising and/or marketing services to individuals and businesses located in the United States in connection with the SWATCH trademark.

6. Opposer is not in the business of offering marketing and/or promotional services to others.

RESPONSE: Opposer hereby incorporates all of its General Objections. Opposer further objects to this Request as vague because Applicant has not defined the term “in the business of.” Subject to and without waiving the foregoing objections, Opposer denies this request.

7. Opposer is not in the business of offering marketing and/or promotional services to businesses that are not associated with Opposer.

RESPONSE: Opposer hereby incorporates all of its General Objections. Opposer further objects to this Request as vague because Applicant has not defined the term “in the business of.” Subject to and without waiving the foregoing objections, Opposer admits that it does not offer marketing and/or promotional services in the United States to “businesses that are not associated with Opposer,” as that term is very narrowly defined by Applicant and would exclude the rendering of services for, among others, businesses that ever supplied Opposer with any products or services, businesses that ever offered, sold, or distributed Opposer’s products or services,

businesses that are legally related to Opposer, and businesses that are subsidiaries, affiliates, wholly owned by Opposer, or partially owned by Opposer. Nevertheless, Opposer states that it offers marketing and promotional services in connection with the SWATCH trademark in the United States to third parties, including third parties, which have no corporate affiliation with Opposer.

8. Opposer does not plan, conduct, or organize mobile marketing exhibits, trade show exhibits, point of sale exhibits, or marketing displays for businesses.

RESPONSE: Opposer hereby incorporates all of its General Objections. Subject to and without waiving the foregoing objections, Opposer denies this request.

9. Opposer does not plan, conduct, or organize mobile marketing exhibits, trade show exhibits, point of sale exhibits, or marketing displays for businesses that are not associated with Opposer.

RESPONSE: Opposer hereby incorporates all of its General Objections. Subject to and without waiving the foregoing objections, Opposer admits that it does not plan, conduct, or organize mobile marketing exhibits, trade show exhibits, or point of sale exhibits, or marketing displays for “businesses that are not associated with Opposer,” as that term is very narrowly defined by Applicant and would exclude the rendering of services for, among others, businesses that ever supplied Opposer with any products or services, businesses that ever offered, sold, or distributed Opposer’s products or services, businesses that are legally related to Opposer, and businesses that are subsidiaries, affiliates, wholly owned by Opposer, or partially owned by Opposer. Nevertheless, Opposer states that it offers such services in connection with the

SWATCH trademark in the United States to third parties, including third parties, which have no corporate affiliation with Opposer.

10. Opposer does not design advertising multimedia presentations and themed graphics for use in marketing campaigns by businesses.

RESPONSE: Opposer hereby incorporates all of its General Objections. Subject to and without waiving the foregoing objections, Opposer denies this request.

11. Opposer does not design advertising multimedia presentations and themed graphics for use in marketing campaigns by businesses that are not associated with Opposer.

RESPONSE: Opposer hereby incorporates all of its General Objections. Subject to and without waiving the foregoing objections, Opposer admits that it does not design advertising multimedia presentations and themed graphics for use in marketing campaigns by “businesses that are not associated with Opposer,” as that term is very narrowly defined by Applicant and would exclude the rendering of services for, among others, businesses that ever supplied Opposer with any products or services, businesses that ever offered, sold, or distributed Opposer’s products or services, businesses that are legally related to Opposer, and businesses that are subsidiaries, affiliates, wholly owned by Opposer, or partially owned by Opposer. Nevertheless, Opposer states that it offers such services in connection with the SWATCH trademark in the United States to third parties, including third parties, which have no corporate affiliation with Opposer.

12. Opposer does not custom manufacture mobile marketing exhibits and trade show exhibits for businesses.

RESPONSE: Opposer hereby incorporates all of its General Objections. Opposer further objects to this Request as vague because Applicant has not defined the terms “mobile marketing exhibits” and “trade show exhibits.” Subject to and without waiving the foregoing objections, Opposer admits this request.

13. Opposer does not custom manufacture mobile marketing exhibits and trade show exhibits for businesses that are not associated with Opposer.

RESPONSE: Opposer hereby incorporates all of its General Objections. Opposer further objects to this Request as vague because Applicant has not defined the terms “mobile marketing exhibits” and “trade show exhibits.” Subject to and without waiving the foregoing objections, Opposer admits this request.

14. Opposer does not design and develop websites for businesses.

RESPONSE: Opposer hereby incorporates all of its General Objections. Subject to and without waiving the foregoing objections, Opposer admits this request.

15. Opposer does not design and develop websites for businesses that are not associated with Opposer.

RESPONSE: Opposer hereby incorporates all of its General Objections. Subject to and without waiving the foregoing objections, Opposer admits that it does not design and develop websites for “businesses that are not associated with Opposer,” as that term is very narrowly defined by Applicant.

16. U.S. Registration No. 3,799,562 owned by Opposer is based on Section 44(e).

RESPONSE: Opposer hereby incorporates all of its General Objections. Subject to and without waiving the foregoing objections, Opposer admits this request.

17. U.S. Registration No. 3,799,562 owned by Opposer is based on a Swiss trademark registration.

RESPONSE: Opposer hereby incorporates all of its General Objections. Subject to and without waiving the foregoing objections, Opposer admits this request.

18. Opposer was not required to show use of the SWATCH mark in order to obtain the Swiss trademark registration on which U.S. Registration No. 3,799,562 is based.

RESPONSE: Opposer hereby incorporates all of its General Objections. Subject to and without waiving the foregoing objections, Opposer admits this request.

19. Opposer did not show use of the SWATCH mark to the Trademark Office in order to obtain U.S. Registration No. 3,799,562.

RESPONSE: Opposer hereby incorporates all of its General Objections. Subject to and without waiving the foregoing objections, Opposer admits this request.

Respectfully Submitted,

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Attorneys for Opposer

Dated: November 16, 2012

CERTIFICATE OF SERVICE

I, Govinda M. Davis hereby certify that a true and complete copy of the foregoing **Opposer's Responses to Applicant's First Set of Requests for Admissions** was served on November 16, 2012 via Federal Express, postage pre-paid and via e- mail to Applicant's attorney of record at the following address:

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/Govinda M. Davis/

EXHIBIT F

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

SWATCH AG (SWATCH SA)
(SWATCH LTD.),

Opposer,

v.

THE SPARK AGENCY, INC.,

Applicant.

Mark: SW:TCH

Opp. No.: 91190380

Serial No.: 77/505,539

OPPOSER'S RESPONSES TO APPLICANT'S FIRST SET OF INTERROGATORIES

Opposer Swatch AG (Swatch SA) (Swatch Ltd.), (“Swatch” or “Opposer”), hereby serves its Objections and Responses to Applicant’s First Set of Interrogatories pursuant to Rules 26 and 33 of the Federal Rules of Civil Procedure.

GENERAL OBJECTIONS

1. Opposer objects to each and every interrogatory in its entirety on the ground that Opposer is responding on the basis of its current knowledge and information. Opposer reserves the right to supplement each of its interrogatories.
2. Opposer objects to each and every request insofar as and to the extent it seeks information protected by the attorney-client privilege, the work product doctrine, or any other applicable privilege or immunity, and will not produce such information. Any inadvertent disclosure of such information shall not be a waiver of the attorney-client privilege, the work product doctrine, or any other applicable privilege or immunity.

3. Opposer objects to each and every request insofar as and to the extent it seeks divulgence of trade secrets, confidential or proprietary information of any third-party, such information will not be disclosed. To the extent each and every request seeks divulgence of such information of Opposer; such information will not be disclosed without an appropriate protective order.
4. Opposer objects to each and every request to the extent it seeks production of information relating to or revealing proprietary development activities for Opposer products not yet manufactured or not yet on sale or otherwise available to the public. The slight relevance, if any, of such highly confidential trade secret information is vastly outweighed by the severe prejudice that would result to Opposer were it to be disclosed or available to competitors of Opposer. Opposer will not provide such information.
5. Opposer objects to each and every request to the extent it calls for information neither relevant to the subject matter of this Action nor reasonably calculated to lead to the discovery of admissible evidence.
6. Opposer objects to Applicant's definitions in their entirety to the extent same seeks to impose obligations on Applicant beyond those permitted by the Federal Rules of Civil Procedure of the Local Rules applicable to this matter.
7. Opposer objects to each and every request to the extent it calls for information that exceeds a reasonable durational scope.
8. Opposer objects to each and every document production request to the extent it calls for information not yet available as these responses are made during the discovery process. Opposer reserves the right to supplement responses when the information becomes available.

9. Opposer objects to each and every interrogatory to the extent it is overly broad, vague and ambiguous, unduly burdensome or not reasonably calculated to lead to the discovery of admissible evidence.
10. Opposer objects to each and every interrogatory and request for production to the extent it is duplicative.
11. Opposer objects to each and every interrogatory to the extent that it is not limited in geographic scope.

OBJECTIONS AND RESPONSES

1. Please provide the names, addresses, and phone numbers of all advertising and/or marketing agencies that Opposer operates in the United States under the trademark SWATCH. Also include the name of the contact person at each location.

RESPONSE: Opposer hereby incorporates by reference all of its General Objections. Opposer further objects to this Interrogatory as vague because Applicant has not defined the term “advertising and/or marketing agencies.” Notwithstanding and without waiving said objections, Opposer states that it offers advertising, promotional and/or marketing services under the SWATCH trademark in the United States, through its licensee The Swatch Group (U.S.) Inc., located at 1200 Harbor Boulevard, Weehawken, New Jersey 07086, and via its website at www.swatch.com.

2. Please provide the addresses and phone numbers of all advertising and/or marketing agencies that Opposer operates outside of the United States under the trademark SWATCH. Also include the name of the contact person at each location.

RESPONSE: Opposer hereby incorporates by reference all of its General Objections. Opposer further objects to this Interrogatory as vague because Applicant has not defined the term “advertising and/or marketing agencies.” Opposer further objects to this Interrogatory because its activities outside of the United States are not relevant to this dispute.

3. For 2001 through 2012, please provide the annual gross revenues earned by each of the advertising and/or marketing agencies that Opposer operates in the United States under the trademark SWATCH for each year listed.

RESPONSE: Opposer hereby incorporates by reference all of its General Objections. Opposer objects that this Interrogatory is overly broad and unduly burdensome and not reasonably tailored to lead to the discovery of admissible evidence and as vague because Applicant has not defined the term “advertising and/or marketing agencies.” Notwithstanding and without waiving said objections, Opposer states that it has not earned gross revenue from the operation of any advertising and/or marketing agencies in the United States between 2001 and 2012.

4. For 2001 through 2012, please provide the annual gross revenues earned by each of the advertising and/or marketing agencies that Opposer operates outside of the United States under the trademark SWATCH for each year listed.

RESPONSE: Opposer hereby incorporates by reference all of its General Objections. Opposer objects that this Interrogatory is overly broad and unduly burdensome and not reasonably tailored to lead to the discovery of admissible evidence and vague because Applicant has not defined the term “advertising and/or marketing agencies.” Opposer further objects to this Interrogatory because its activities outside of the United States are not relevant to this dispute.

5. Please provide the names, addresses, and phone numbers of all individuals and businesses located in the United States to which Opposer provided identical or similar services as those listed in Applicant's application for SW:TCH (Serial No. 77505539) from 2001 through 2012.

RESPONSE: Opposer hereby incorporates by reference all of its General Objections. Notwithstanding and without waiving said objections, Opposer states that by license, The Swatch Group (U.S.) Inc., located at 1200 Harbor Boulevard, Weehawken, New Jersey 07086, has provided identical or similar services on behalf of Opposer in the United States. Opposer further states that it has provided identical or similar services to third parties in the United States such as: Courtney Conlogue, Coco Ho, Jeremy Jones, Kassia Meador, Cody Townsend, Moby, Tara Mcpherson, MAD, Jeremy Scott, Gary Baseman, Joe Ledbetter, Jeremyville, Billy The Artist, Matthew Langille, and Blue Man Group.

6. Please provide the names, addresses, and phone numbers of all individuals and businesses located outside of the United States to which Opposer has provided identical or similar services as those listed in Applicant's application for SW:TCH (Serial No. 77505539) from 2001 through 2012.

RESPONSE: Opposer hereby incorporates by reference all of its General Objections. Opposer further objects to this Interrogatory because its activities outside of the United States are not relevant to this dispute.

Respectfully Submitted,

/Govinda M. Davis/
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Attorneys for Opposer

Dated: November 16, 2012

CERTIFICATE OF SERVICE

I, Govinda M. Davis hereby certify that a true and complete copy of the foregoing **Opposer's Responses to Applicant's First Set of Interrogatories** was served on November 16, 2012 via Federal Express, postage pre-paid and via e-mail to Applicant's attorney of record at the following address:

Annette P. Heller
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EXHIBIT G

ESTTA Tracking number: **ESTTA565856**

Filing date: **10/18/2013**

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

Proceeding	91190380
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Signature	/Jeffrey A. Lindenbaum/
Date	10/18/2013
Attachments	H889 FINAL NON-CONFIDENTIAL BRIEF.pdf(220323 bytes)

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

SWATCH AG (SWATCH SA)
(SWATCH LTD.),

Opposer,

v.

THE SPARK AGENCY, INC.,

Applicant.

Mark: SW:TCH

Opp. No.: 91190380

Serial No.: 77/505,539

OPPOSER'S (NON-CONFIDENTIAL) TRIAL BRIEF

Opposer Swatch AG (Swatch SA) (Swatch Ltd.), hereby files this brief in support of its opposition to Applicant The Spark Agency, Inc.'s Application No. 77/505,539 for the mark SW:TCH.

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I. **PRELIMINARY STATEMENT**

With prior knowledge of Opposer's trademark SWATCH, Applicant sought registration of the confusingly similar mark SW:TCH for identical and highly similar services. After considering the *du Pont* factors, all that distinguishes Applicant's mark, its applied-for services, and channels of trade from Opposer's mark, services, and channels of trade, is a difference of a single ambiguous character, which allows the mark to be viewed or spoken in several ways, including in an identical manner to SWATCH:

SWATCH

VS.

SW:TCH

None of the *du Pont* factors favor Applicant. Given the strength, distinctiveness and fame of Opposer's SWATCH mark and the similarities of the two marks and their respective use in connection with identical and highly similar services, a likelihood of confusion is inevitable, and the application should be refused.

II. ISSUES PRESENTED FOR REVIEW

- (a) Whether the Applicant’s SW:TCH trademark is likely to cause confusion with the Opposer’s registered and incontestable SWATCH trademarks?
- (b) Whether registration to the Applicant should therefore be refused?

III. DESCRIPTION OF THE RECORD

The evidence of record consists of:

- (1) The pleadings and the file history of the subject application;
- (2) Opposer’s U.S. Trademark Registrations:
 - SWATCH Reg. 1356512
 - SWATCH Reg. 1671076
 - SWATCH Reg. 1799862
 - SWATCH Reg. 1849657
 - SWATCH Reg. 2752980
 - SWATCH Reg. 2050210
 - SWATCH Reg. 2100605
 - ISWATCH Reg. 3567953
 - ESWATCH Reg. 3554475
 - SWATCH Reg. 3799562
- (3) The April 5, 2013 Trial Testimony of Opposer’s witness, Frank Furlan (“Furlan Tr.”) and all Exhibits thereto;

(4) Portions of the February 1, 2012 Rule 30(b)(6) discovery deposition of Applicant's corporate representative, Kevin Quigley ("Quigley Disc. Tr.") and exhibits 1, 13, 14 and 15 thereto;

(5) The May 10, 2013 Trial Testimony of Applicant's witness Kevin Quigley ("Quigley Trial Tr.") and all Exhibits thereto;

(6) Applicant's responses to certain Interrogatories and Admissions;

(7) Printed publications submitted with Opposer's Notice of Reliance;

(8) Internet materials submitted with Opposer's Notice of Reliance.

IV. STATEMENT OF THE CASE

Opposer is the owner of several pleaded U.S. Federal Registrations for the mark SWATCH, including for advertising services (advertising agencies) in Class 035. For approximately thirty years, Opposer has been using its SWATCH mark in association with its offering of advertising and marketing services.

On June 23, 2008, Applicant filed an intent to use application, Serial No. 77/505,539, for the mark SW:TCH in the classes 035, 040, and 042 for the following services:

Class 035: Marketing and promotional services, namely planning, conducting, and organizing mobile marketing exhibits, trade show exhibits, point of sale exhibits, and marketing displays for business meetings and business events for advertising purposes; design of advertising multimedia presentations and themed graphics for use in marketing campaigns for others for trade shows, business meetings, and business to business events;

Class 040: Custom manufacture of mobile marketing exhibits and trade show exhibits;

Class 042; Design and development of websites for others.

On May 26, 2009, Opposer filed a Notice of Opposition against the subject application claiming a likelihood of confusion with Opposer's registered and famous mark SWATCH. On April 16, 2012, Opposer moved the Board to amend the Notice of Opposition to add U.S. Trademark Registration No. 3,799,562 and remove U.S. Trademark Registration No. 3,291,129. The Board granted Opposer's motion. Opposer now seeks refusal of the SW:TCH application because it creates a likelihood of confusion with Opposer's trademarks.

V. **ARGUMENT**

A. **Likelihood of Confusion**

The Trademark Act prohibits registration of confusingly similar marks. The Applicant's trademark SW:TCH is confusingly similar to Opposer's SWATCH trademarks and will cause confusion.

In accordance with § 2(d) of the Lanham Act, the Patent and Trademark Office (PTO) may refuse to register a trademark if it "so resembles" a trademark previously used in the United States by another "as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1052(d). In determining likelihood of confusion, the United States Patent and Trademark Office Trademark Trial and Appeal Board (TTAB) focuses on whether consumers would mistakenly assume that the applicant's goods emanate from the same source as, or are associated with, the goods in the cited registration. This determination is made on a case-specific basis, by analyzing all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). *In re Miriam Jacob and Norma Sawdy*, Serial No. 75624180, 2004 TTAB LEXIS 725, at *7 (TTAB Dec. 17, 2004).

These factors include: (1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression; (2) the similarity or dissimilarity and nature of the goods; (3) the similarity or dissimilarity of established, likely-to-continue trade channels; (4) the conditions under which and buyers to whom sales are made, i.e. “impulse” v. careful, sophisticated purchasing; (5) the fame of the prior mark; (6) the number and nature of similar marks in use on similar goods; (7) the nature and extent of any actual confusion; (8) the length of time during and the conditions under which there has been concurrent use without evidence of actual confusion; (9) the variety of goods on which a mark is or is not used; (10) the market interface between the applicant and the owner of a prior mark; (11) the extent to which applicant has a right to exclude others from use of its mark on its goods; (12) the extent of potential confusion; and (13) any other established fact probative of the effect of use. *See DuPont*, 476 F.2d at 1361.

No single factor of the likelihood of confusion test is dispositive and a varying range of significance may be attributed to each of the factors depending on the facts presented. *CAE, Inc. v. Clean Air Engineering, Inc.*, 267 F.3d 660, 678 (7th Cir. 2001). Furthermore, the TTAB is not required to analyze each of the thirteen *DuPont* factors in every case. *In re Dixie Restaurants*, 105 F.3d 1405, 1406-07 (Fed. Cir. 1997). Rather, it need only consider a factor when there is evidence of record on the issue and any one factor may control a particular case. *Id.*

All doubt must be resolved against the second comer, as “[o]ne who adopts a mark similar to another already established in the marketplace does so at his peril...” *Sally Beauty Co. v. Beautyco., Inc.*, 304 F.3d 964, 973 (10th Cir. 2002) (quoting *Beer Nuts, Inc. v. Clover Club Foods Co.*, 711 F.2d 934, 941 (10th Cir. 1983)) (citations and quotation omitted).

1. Opposer Has Priority

In order to succeed in this opposition, Opposer must establish prior rights in its trademark. *See Herbko Intern., Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1162 (Fed. Cir. 2002). These rights may arise from a prior registration, prior trademark or service mark use, prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights. *Id.*

The record in this case clearly establishes Opposer's priority. Opposer is the owner of Registration No. 1,356,512 which was filed on November 2, 1984 and registered on August 27, 1985 and Registration No. 1,671,076, filed on July 17, 1990 and registered on January 7, 1992. (NOR Ex. 1). Registration Nos. 1,671,076 and 1,356,512 establish Opposer's rights in its SWATCH mark at least as early as 1981. *Carl Karcher Enters. Inc. v. Stars Rests. Corp.*, 35 USPQ2d 1125, (TTAB 1995).

Opposer is also the owner of Registration No. 3,799,562, which was filed on December 13, 2002 and registered on June 8, 2010 for advertising services ("advertising agencies") in Class 035, among others. NOR Ex. 1. Registration No. 3,799,562 was originally filed under Section 1(b), 15 U.S.C. § 1051(b), and was later converted to Section 44(e). Since Opposer had a continuing, valid basis for registration since the filing date, Opposer is entitled to maintain its original filing date as its date of priority. *See* TMEP § 806.03(h) (citing 37 C.F.R. 2.35(b)(3)); *Kraft Group LLC v. Harpole*, 90 USPQ2d 1837 (TTAB 2009); *Karsten Mfg. Corp. v. Editoy AG*, 79 USPQ2d 1783 (TTAB 2006)).

Moreover, as Opposer's witness Franklin Furlan has testified, Opposer, through its licensee The Swatch Group (U.S.), Inc. (hereinafter "SGUS"), has been using the SWATCH mark in commerce for services in Class 035 – specifically marketing and advertising – in the

United States since prior to the filing date of the subject application.¹ Furlan Tr. at 7-12; 15 U.S.C. § 1055; *see also Quality Candy Shoppes/Buddy Squirrel of Wisconsin, Inc. v. Grande Foods*, 90 USPQ2d 1393, 2007 TTAB LEXIS 85, *10 (TTAB 2007) ("years of precedent make it very clear that proper use of a mark by a trademark owner's licensee or related company constitutes 'use' of that mark attributable to the trademark owner"). Further, Applicant has testified, through its corporate representative, Kevin Quigley, that Applicant does not challenge Opposer's priority. Quigley Disc. Tr. 88:7-15, 88:19-89:9. His testimony shows that Applicant did not begin using the SW:TCH mark until 2007. *Id.*

Accordingly, Opposer has established priority.

2. The Marks are Confusingly Similar

The similarity or dissimilarity of marks is analyzed by comparing the marks, in their entireties, as to appearance, sound, connotation and commercial impression. *See DuPont*, 476 F.2d at 1361; *Palm Bay Imports, Inc. v. Venue Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). The test, under the first *DuPont* factor, "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 terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result." *In re Alex Angelino*, 2009 TTAB LEXIS 676, at *6 (TTAB Dec. 1, 2009); *In re Jack B. Binion*, 2009 TTAB LEXIS 701, 93 USPQ2d 1531, 1534 (TTAB 2009).

¹ Opposer and a company located in the State of New Jersey called The Swatch Group (U.S.), Inc. (SGUS) are subsidiaries of a separate legal Swiss entity called The Swatch Group Limited. Furlan Tr. at 6, 9-10, 99-102. SGUS is licensed by Opposer to use Opposer's SWATCH mark. Furlan Tr. 12, 99, 101. Apart from the terms and conditions of the license, Opposer does not control SGUS. Opposer also has no ownership interest in SGUS (or vice versa).

The “focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks.” *Id.*

Furthermore, “in cases such as this, where the applicant's goods are identical (in part) to the goods identified in the cited registration, the degree of similarity between the marks which is required to support a finding of likelihood of confusion is less than it would be if the goods were not identical.” *See Alex Angelino*, 2009 TTAB LEXIS 676, at *6-7; *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 877 (Fed. Cir. 1992).

It is evident that the Applicant’s SW:TCH mark is confusingly similar to Opposer’s SWATCH mark. This conclusion is particularly evident when one considers that the punctuation mark used in Applicant’s mark is intended to be construed as a vowel. Without a vowel in this location, there would be no word. *See*, <http://www.phonicsontheweb.com/words.php> (“Every word must have at least one vowel”).

It is undeniable that Opposer’s mark SWATCH is highly similar to Applicant’s mark “SW:TCH,” which is capable of numerous pronunciations. Both marks use the same number of characters – six, differing by only one. The marks are also very similar in sound and appearance because the first two and last three letters of the marks, “SW-” and “-TCH,” respectively, are identical and found in the same character space within the word. The only difference is one ambiguous, non-alphabet character in the middle of the mark, which is insufficient to distinguish the marks in either appearance or sound.

In *AMF, Inc. v. Sleekcraft Boats*, the Ninth Circuit found the marks SLEEKCRAFT and SLICKCRAFT to be visually similar because they are “the same except for two inconspicuous letters.” 599 F.2d 341, 351 (9th Cir. 1979) (citing *Commc’ns Satellite Corp. v. Comcet, Inc.*, 429 F.2d 1245, 1249 (4th Cir. 1970) (finding that there is only a slight visual difference between

Comsat and Comcet); *Polaroid Corp. v. Polaroid, Inc.*, 319 F.2d 830, 833 (7th Cir. 1963) (Polaroid cameras and lenses and Polaroid heating and refrigeration systems)). The Ninth Circuit also noted that although the sounds “can be distinguished, the difference is only a small part of one syllable.” *Sleekcraft*, 599 F.2d at 352. As a result, the Court concluded that the two marks are also similar in sound. *Id.*

In *Meffre v. Maria y Adelina S.A.*, the Board found that the applied-for mark SAURUS was confusingly similar to the registered mark LAURUS for similar goods. *See Meffre v. Maria y Adelina S.A.*, Opposition No. 91164878, 2007 TTAB LEXIS 160 (TTAB Jun. 1, 2007). In *Meffre*, the Board noted that although the marks could be pronounced differently, the marks still sounded very similar, contained the same number of letters (six letters, the same as SWATCH and SW:TCH) and *differed by only one letter*, hence “the striking, overall similarities [were] much more critical than . . . the difference[s].” *Id.* at *9.

The fact that a punctuation mark (“:”) is used in the SW:TCH mark as a place holder for a missing letter only further increases the likelihood of confusion. This missing character is just as likely to be replaced with the letter “A” to form the mark SWATCH as it is to imply the letter “I.” Given the strength and fame of the SWATCH mark, the similarity of the parties services, and Opposer’s Registration for highly related services, it is inevitable that a consumer will read and pronounce the mark SW:TCH as SWATCH.

The marks at issue in this opposition differ by only a single character, rendering them highly similar in terms of visual appearance and sound. Because of the pronounced similarities between the marks, this factor strongly favors a likelihood of confusion.

3. The Parties' Services are Identical

“The rights of an owner of a . . . trademark extend to any goods related in the minds of consumers in the sense that a single producer is likely to put out both goods.” *Keystone Consol. Indus. v. Mid-States Distrib. Co.*, 235 F. Supp. 2d 901, 909 (C.D. Ill. 2002) (quoting *E.Remy & Martin Co. S.A. v. Shaw-Ross Int’l Imps., Inc.*, 756 F.2d 1525, 1530 (11th Cir. 1985)). Thus, an inquiry pertaining to product similarity, within the context of the likelihood of confusion analysis, turns upon “whether products are the kind that the public attributes to a single source.” *Ty, Inc. v. Jones Group, Inc.*, 237 F.3d 891, 899 (7th Cir. 2001) (quoting *McGraw-Edison Co. v. Walt Disney Productions*, 787 F.2d 1163, 1169 (7th Cir. 1986)).

A likelihood of confusion exists as long as the goods or services are closely related. *CAE, Inc.*, 267 F.3d at 679. Generally, goods and services are deemed “closely related” and thus cause confusion if consumers would reasonably think that they emanate from the same source, or are somehow affiliated with, or sponsored by, the trademark owner. *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 958 (7th Cir. 1992); *Seiko Kabushiki Kaisha v. Swiss Watch Intern., Inc.* 188 F. Supp. 2d 1350, 1354 (S.D. Fla. 2002); *AutoZone, Inc. v. Tandy Corp.*, 174 F. Supp. 2d 718, 729 (M.D. Tenn. 2001).

In this instance, the services listed in the parties respective registrations and application are essentially identical with respect to the services in Class 035; they are also highly similar with respect to the Class 040 and 042 services listed in the subject application. It is well-settled that the issue of likelihood of confusion between applied-for and registered marks must be determined on the basis of the goods and services as they are identified in the involved application and registrations. *In re BCS Bus. Consulting Servs. Pte Ltd.*, Serial No. 85336672, 2013 TTAB LEXIS 307, at *4 (TTAB May 31, 2013) (internal citations omitted).

Opposer's pleaded registrations include advertising agencies in Class 035. The description of the services offered by Opposer in Class 035 is broad, giving rise to a presumption "that the registration encompasses all goods or services of the type described." *In re Box Solutions Corp.*, 79 USPQ2d 1953 (TTAB 2006). Therefore, Opposer's registration encompasses all advertising activities which would properly fall under Class 035.

The subject application is for

marketing and promotional services, namely planning, conducting, and organizing mobile marketing exhibits, trade show exhibits, point of sale exhibits, and marketing displays for business meetings and business events *for advertising purposes*; design of *advertising* multimedia presentations and themed graphics for use in marketing campaigns for others for trade shows, business meetings, and business to business events

in Class 035 (emphasis added). This description, by its very wording, specifies that the services identified therein are advertising services. The Board has also found that marketing and promotional activities within Class 035 are properly limited to activities falling within that class (i.e., advertising and selling). *In re Takasago Int'l Corp.*, Serial No. 77404011, 2011 TTAB LEXIS 17, *8-9 (TTAB Jan. 13, 2011); *see also In re Elena Potoupa*, Serial No. 78770813, 2009 TTAB LEXIS 527, *8-9 (TTAB Aug. 6, 2009). The services specified in the subject application for Class 035 fall within the broad scope of the advertising services encompassed by Opposer's pleaded registration. Therefore the parties' services in Class 035 are identical.

Applicant further seeks registration for the "custom manufacture of mobile marketing exhibits and trade show exhibits" in class 040 and for the "design and development of websites for others" in class 042. Applicant admits that these services and advertising are interrelated, as all of the services offered by Applicant "are focused on getting brands connected to their consumers." *See Quigley Test*. Tr. 8:23-9:5. As such, the services identified in the subject

application in Classes 040 and 042 are highly similar, if not identical, to the Class 035 services encompassed by Opposer's registrations.

Opposer's valid, pleaded registrations are prima facie evidence of both ownership and continuous use of the mark. 15 U.S.C. § 1057(b); *Tri-Valley Growers v. Maple Island, Inc.*, 360 F.2d 248, 149 USPQ 675 (C.C.P.A. 1966); *Gillette Co. v. Kempel*, 254 F.2d 402, 117 USPQ 356 (C.C.P.A. 1958); *May Dept. Stores Co. v. Schloss Bros. & Co.*, 234 F.2d 879, 110 USPQ 282 (C.C.P.A. 1956); *May Dep't Stores Co. v. Kenya Corp.*, 234 F.2d 870, 110 USPQ 276 (C.C.P.A. 1956). The presumption of use applies to all goods set forth in the registration. *General Shoe Corp. v. Lerner Bros. Mfg. Co.*, 254 F.2d 154, 157 (C.C.P.A. 1958). As Applicant has not sought to cancel Opposer's pleaded marks, the presumption of use stands unchallenged and the validity of such marks is not an issue in this proceeding. See 37 CFR § 2.106(b)(2)(ii); *Giant Food Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 1986 TTAB LEXIS 96, *24-25 (TTAB 1986) ("it is well settled that no attack on the validity of a registration pleaded by a plaintiff can be considered in the absence of a counterclaim (or separate petition) to cancel such registration") (citing *The All England Lawn Tennis Club (Wimbledon) Limited v. Creations Aromatiques, Inc.*, 220 US.PQ 1069, 1070 (TTAB 1983)).

Additionally, the record indicates that Opposer, through its licensee, SGUS, provides marketing and advertising services in the United States under the SWATCH mark for several independent and separately owned companies such as Omega SA, Tissot SA, Rado Uhren AG, Compagnie des Montres Longines, Francillon S.A., and EM Microelectronics, among others. See Furlan Tr. 177-180. Such services often include organizing promotional events, similar in nature to those Applicant organizes for its clients. Quigley Disc. Tr. 20:17-21:3, 31:19-25; Furlan Tr. 57-60. SGUS is financially compensated under its license with Opposer for providing

marketing and advertising services. Furlan Tr. 180-81. This licensed use inures to the benefit of the licensor, Opposer. 15 U.S.C. § 1055; *see also Quality Candy Shoppes/Buddy Squirrel of Wisconsin, Inc. v. Grande Foods*, 90 USPQ2d 1393 (TTAB 2007).

Swatch also promotes athletes and artists, both in the United States and worldwide. For example, Swatch promotes professional surfers Courtney Cologne and Coco Ho and professional snowboarder Jeremy Jones. These athletes are featured prominently on the Swatch website and often appear at Swatch events to increase the athlete's exposure. Furlan Tr. at 72:10-11, 74:25-80:16 and Ex. 16; NOR Ex. 10. Swatch also publishes the magazine called *The Voice*, which it uses to feature and promote athletes and artists. Furlan Tr. at 85-88 and Ex. 17. In addition, Swatch's website features a collection of watches designed in collaboration with other artists, and the webpage for each of those watches prominently displays a biography of the contributing artist. Furlan Tr. at 88:13-19, 91:9-16 and Ex. 18. Swatch has even featured one of these artists, Jeremy Scott, on its coveted Times Square Billboard. Furlan Tr. at 92. As Mr. Furlan explained, this relationship between Swatch and these athletes and artists is primarily more beneficial to the artists and athletes in terms of exposure and public relations than it is to Swatch. Furlan Tr. at 161.

The services listed in class 035 for Opposer's pleaded registrations and the subject application are essentially identical. The scope of Opposer's registration for advertising services in Class 035 encompasses the services listed in the subject application. Further, the services listed in the subject application in Classes 040 and 042 are highly related to advertising, if not considered advertising services themselves. This factor weighs strongly in Opposer's favor.

Having established that the marks are very similar and the services are identical, in part, and highly similar, the Board may find a likelihood of confusion as a matter of law. *See In re*

Miriam Jacob, Serial No. 75624180, 2004 TTAB LEXIS 725 (TTAB Dec. 17, 2004).

Notwithstanding, the remaining relevant *DuPont* factors favor Opposer as well.

4. Opposer's Mark is Famous

Opposer's SWATCH mark is renowned and famous. Opposer's SWATCH mark is a worldwide fashion brand, started in the early 1980's. For the past thirty years Swatch has invested millions of dollars in advertising and promotion of the SWATCH mark. Millions of SWATCH brand products have been sold. SWATCH has appeared in countless publications, television advertisements and promotions, and on the internet. Swatch has been an Official Timekeeper and Official Sponsor of the Olympic Games. The brand has been affiliated with numerous celebrities. Even Applicant's own officers have recognized that the SWATCH brand is well-known in the United States. *Quigley Disc. Tr.* 82:12-16, 86:3-5.

The record establishes that in 2011 alone, Swatch sold in the United States approximately [REDACTED] SWATCH branded watches, generating an astounding [REDACTED] in sales. *Furlan Tr.* at 20-30 and Ex. 2. Apart from its sales of watches, Swatch also sold in the United States in 2011 over [REDACTED] pieces of SWATCH branded jewelry. *Id.* As reflected in the chart below, between 2002 and 2012, Swatch sold in the United States an incredible [REDACTED] SWATCH branded watches (plus an additional [REDACTED] units of SWATCH branded jewelry), generating a remarkable \$ [REDACTED] in sales:

Year	sales in \$(US)	# watches sold	# of jewelry sold
2002	[REDACTED]	[REDACTED]	[REDACTED]
2003	[REDACTED]	[REDACTED]	[REDACTED]
2004	[REDACTED]	[REDACTED]	[REDACTED]

location, in terms of visibility to consumers, this one billboard, alone, costs approximately [REDACTED] per year. Furlan Tr. at 29.

Additionally, Swatch runs numerous large-scale outdoor advertising campaigns, several of which tie in to their print advertising. See Furlan Tr. at 34-37 and Ex. 4. Some of Swatch's more prominent outdoor advertising includes branding telephone kiosks, billboards, banners, taxi screens, along with creating dioramas in New York's City's highly-trafficked Grand Central Train Terminal. Furlan Tr. at 34-41 and Ex. 4-5.

In 2011, Swatch promoted one of its collections of SWATCH watches by completely covering the interior *and exterior* of 10 subway cars on the 6-line subway in New York City with advertisements. See Furlan Tr. at 42:16-43:15 and Ex. 6. The exterior "wrap" of the subway cars made this particular advertising effort particularly notable. See Furlan Tr. at 153:9-17, 154:11-24. This successful promotion ran for three months and was seen by an estimated 20 million riders. See Furlan Tr. at 42:16-43:15 and Ex. 6.

Swatch has been advertising on television for a decade, if not longer, and advertisements for SWATCH products have run on major cable channels such as MTV, VH1, ESPN, Fox News, MSNBC and E!, as well as regional ABC, NBC and FOX channels. See Furlan Tr. at 30-32 and Ex. 3.

In addition to stores in well over a hundred locations throughout the United States, Swatch has retail locations in some of the nation's highest traffic destinations which are known to draw visitors from every corner of the country, including its flagship store in Times Square in New York City. Swatch's Time Square store, alone, draws an average of 3,000-5,000 visitors each day reaching an astounding one million+ visitors per year. Furlan Tr. 37:23-38:10. That's

over a million visitors for just this one store! Swatch also has stores in New York City's Grand Central Station and Caesar's Forum Shops in Las Vegas. Furlan Tr. at 52:17-53:24 and Ex. 11.

The SWATCH brand has been extensively advertised in numerous publications in the United States such as *NY Metro*, *NY Post*, *Vman*, *Another M*, and *Dazed & Confused*, among others. Furlan Tr. Ex 4, 5, 8. In addition to fame obtained through its own paid advertisement and marketing, fame of the SWATCH mark has also been achieved through, and is evidenced by, unpaid press and publications. Swatch has been featured in magazines such as *Details*, *Page Six Magazine*, *Wired*, *Dazed and Confused*, *Lucky Magazine*, *Women's Wear Daily*, *V Magazine*, *VMAN*, *Another Man* as well as newspapers such as *New York Post*, *DC Examiner*, *Los Angeles Times*, *Chicago Tribune*, *Metro (New York)*, including the following representative sampling:

- *The New York Times*, November 17, 1991
- *Newsweek*, December 2, 1991
- *Details*, April 2008
- *Page Six Magazine*, May 23, 2008
- *Islands of Outrigger*, June 2008
- *Women's Wear Daily*, July 2008
- *Wired*, September 2008
- *The New York Times Style Magazine*, Spring 2010
- *Dazed & Confused*, December 2010
- *V Magazine*, Winter 2010/11
- *VMAN*, Winter 2010/11
- *The New York Times*, April 23, 2011
- *Lucky Magazine*, December 2011

See Furlan Tr. at 44-45 and Ex. 7; Opposer's Notice of Reliance Exhibit 9.

For example, attached as Ex. 9 to the Furlan trial transcript is an article featured in the highly-circulated magazine *Women's Wear Daily*. The article reports the results of its own survey which captures "the apparel and accessory brands women know best."² Furlan Tr. at 46-

² Higgins Tr. at Ex. 19 is the *Women's Wear Daily*: Special Report the WWD 100 11th Annual Consumer Brand Awareness Survey ("WWD 100"). The WWD 100 is a survey of consumer brand awareness published by Women's Wear Daily. The purpose of the WWD 100 Survey is to assess Americans' awareness of apparel and accessories

48 and Ex. 9. The SWATCH brand is featured in this article and recognized as one of the top 100 recognized brands overall. Moreover, the article identified the most known brands for watches, and found Swatch in the top 10. Swatch was ranked fifth between Rolex (No. 4) and Tiffany (No. 7) – two brands that this Board has likewise found famous. *Furlan Tr. Ex. 9; Tiffany & Co. v. Classic Motor Carriages, Inc.*, 10 USPQ2D 1835, 1989 TTAB LEXIS 13, at *8 (TTAB Apr. 21, 1989); *Rolex Watch U.S.A., Inc. v. PRL USA Holdings, Inc.*, 2012 TTAB LEXIS 226, at *13-14 (TTAB June 7, 2012). Similarly, Ex. Q to the Quigley trial transcript is the analogous 2012 survey from Women’s Wear Daily in which the SWATCH Brand is again included as one of the top 100 recognized brands.

Swatch’s fame is also derived from its sponsorship of major sporting events and other cultural and entertainment activities. Swatch has gained enormous worldwide visibility, and particularly in the United States, as an Official Sponsor of the Olympic Games. Swatch was also the Official Timekeeper of certain Olympic Games, including the 1996 (Atlanta), 2000 and 2004 Summer Games – responsible for the actual timing and publication of the event results, with SWATCH timers and timing apparatus being seen on scoreboards and banners, as well as well as hundreds of millions of television screens during each Olympic Games. See *Furlan Tr. at 63-67* and Ex. 14. Swatch also sponsors professional surfers and snowboarders, such as Courtney Cologne, Coco Ho, and Jeremy Jones. *Furlan Tr. at 72, 75, 79, and Ex. 16.* Swatch is also

brands. The survey was performed by New York-based market research firm Synovate, on behalf of Women’s Wear Daily. Synovate conducted an online survey, polling women between the ages of 13 and 64, with minimum household incomes of \$35,000. Synovate used a questionnaire containing 1,054 prelisted brands in 12 categories, such as denim, designer, accessories, innerwear, sportswear, etc. Women were asked to say whether they were “very familiar,” “somewhat familiar” or “not at all familiar” with each brand. The survey was fielded May 1 to 9, 2008 and yielded 2,218 responses. The results rank brands with the highest number of “very familiar” responses. For the overall top 100 ranking, the brands are rated using a net score and listed only once. For the various categories’ top 10 lists, brands are ranked only against other brands in that category—outerwear brands compete with outerwear brands, swim labels with swim labels, etc.—and the scores are based on performance in that category only. The results are accurate at the 95 percent confidence level and nationally projectable based on U.S. census data. Eight ties resulted in a total of 108 brands in the overall listing.

involved with the sport of motocross as the co-sponsor and official timekeeper of the Red Bull X-Fighters FMX world tour, which holds events in the United States. Furlan Tr. at 66 and Ex. 15.

As part of its marketing, Swatch organizes high-profile promotional events. These high-profile events are attended by famous musicians, athletes, and other celebrities. See Furlan Tr. at 58. For example, Opposer's licensee, SGUS, organized a large event, under the SWATCH brand, in New York City to promote the release of the Swatch Papparazzi, the world's first internet watch which was created through a joint project with Microsoft. *Id.* As part of this event, Sting, the famous singer and former member of the musical group the Police, gave a private performance which Swatch's most loyal customers were invited to attend. Furlan Tr. at 58-59.

Swatch's own membership club has thousands of loyal members, who regularly purchase SWATCH watches. See Furlan Tr. 59:24-60:2. Although Swatch's extensive advertising has been ongoing for more than 25 years, Swatch has continued to keep up with the latest trends and the newest channels of reaching a broad consumer audience. As testified by Mr. Furlan, in recent years Swatch has embraced social media, making its presence known on social media websites such as FACEBOOK[®]. Furlan Tr. at 60-63, Ex, 13. As of April 3, 2013 Swatch's FACEBOOK[®] page had 2,736,752 "likes." *Id.*

Swatch's fame and distinctiveness have been supported by Swatch's diligent efforts to police its mark and defend its Registrations before this Trademark Trial and Appeal Board. SWATCH is a unique Registration and the Opposer is the only owner of a Federal Registration for the mark SWATCH, in any Class.

Prior decisions have found SWATCH to be a famous mark, including most recently in the September 30, 2013 precedential decision in Opposition No. 91187092. *See Swatch AG (Swatch SA) (Swatch Ltd.) v. M.Z. Berger & Co., Inc.*, Opposition No. 91187902, 2013 TTAB LEXIS 515, at *15 (TTAB Sept. 30, 2013) (finding the evidence submitted by Swatch “to be sufficient to prove that the [SWATCH] mark is famous for purposes of the likelihood of confusion analysis”); *See also Swatch Watch S.A. v. Aste Trading Corp.*, 1986 U.S. Dist. LEXIS 30869, at *15 (S.D.N.Y. Jan. 3, 1986) (“Plaintiffs’ mark ‘SWATCH’ is fanciful and is therefore a strong mark”).

5. The Parties Share the Same Trade Channels

Opposer and Applicant have not limited the goods asserted in their respective registrations and application to any particular channels of trade. Further, the broad description of Opposer’s services in Class 035 are without “limitation as to the nature, type, channels of trade or class of purchasers,” which gives rise to a “presum[ption] that the registration encompasses all goods or services of the type described, [and] that they move in all channels of trade normal for these goods.” *In re Box Solutions Corp.*, 79 USPQ2d at 1953. Accordingly, Opposer is entitled to the presumption that the trade channels are identical. Where the descriptions of goods in trademark applications are not limited to specific channels of trade or classes of customers, there is a presumption that the parties share the same trade channels. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1101 (C.C.P.A. 1976). Because both parties offer identical services, it can be assumed that they would sell in the same channels of trade.

Furthermore, the record indicates that both parties offer their identical services to corporate clients. *See* Quigley Disc. Tr. at 109-11; Furlan Tr. at 7:10-25, 9:13-10:10, 12:19-24.

As a result, this factor weighs in Opposer's favor.

6. The Sophistication of the Potential Purchasers is Outweighed by the Similarities of the Marks and Services

The record in this proceeding contains scant evidence, if any, regarding the sophistication of the parties' potential purchasers. There is no evidence regarding the price points, the purchasing conditions, or the extent of deliberation that a potential purchaser engages in prior to purchasing the relevant services. Nonetheless, the similar nature of the marks and the identical nature of the services to which the parties attach these marks make it inevitable that even an informed and sophisticated consumer will mistakenly attribute the parties' services to a common source. *CAE, Inc.*, 267 F.3d at 683; *HRL Assocs., Inc. v. Weiss Assocs., Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd*, *Weiss Assocs., Inc. v. HRL Assocs., Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods). The degree of care likely to be exercised by consumers is properly assessed by considering both parties' potential consumers. *CAE, Inc.*, 267 F.3d at 683. Customer sophistication does not equate to trademark sophistication. *Kos Pharms., Inc. v. Andrx Corp.*, 369 F.3d 700, 717 (3d Cir. 2004); *Fuji Photo Film Co. v. Shinohara Shoji Kabushiki Kaisha*, 754 F.2d 591, 596 (5th Cir. 1985). Although the record does show that both parties have offered testimony that their customers include corporate clients, it must be presumed that the consumers are of ordinary sophistication.

Further, the identification of services in Opposer's pleaded registrations and Applicant's application do not place any limits on the intended consumers of the services listed therein. *See*

Octocom Systems, Inc. v. Houston Computer Servs., Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). As such, either Opposer or Applicant could offer its services to less sophisticated consumers who would likely be confused by the similarity of the marks and services. *See* Quigley Test. Tr. 109:15-19.

Given the fact that the marks are highly similar, the services in the pleaded registrations and subject application are identical (and highly similar, in part), and there are no restrictions on the intended consumers or trade channels, the Board is justified in concluding that this factor weighs in favor of Opposer. Even where there is a lack of evidence in the record, it must then conclude that this factor is neutral. *See Futura, D.O.O. v. Media Farm Solutions, LLC*, Opposition No. 9117499, 2008 TTAB LEXIS 484, at *16 (TTAB Sept. 23, 2008).

7. The Number and Nature of Similar Marks In Use On Similar Goods

There is no evidence in the record of any similar third party marks being used with similar goods or services. Opposer's mark is strong and distinctive. Opposer has been diligent in policing its SWATCH mark. Opposer has instituted numerous legal proceedings to protect the fame and goodwill associated with its mark. Although not evidence as to third party use, Opposer repeats that it is the owner of the only live U.S. trademark registrations for the mark SWATCH.

8. Actual Confusion and Concurrent Use Without Actual Confusion

Although there are no known instances of actual confusion, Applicant's use of the SW:TCH mark is likely to cause confusion. The absence of actual confusion, by itself, does not indicate that there is no likelihood of confusion between the two marks. *Weiss Assocs.*, 902 F2d

at 1549. The test is likelihood of confusion, not actual confusion, and, as often stated, it is unnecessary to show actual confusion in establishing likelihood of confusion. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1571, 218 USPQ 390 (Fed. Cir. 1983). The fact that Opposer and Applicant offer the same services in similar trade channels establishes a finding of a likelihood of confusion between the marks. Opposer timely instituted an opposition proceeding against Applicant's SW:TCH mark shortly after Applicant commenced use of its mark.

9. The Variety of Goods on Which a Mark is or is Not Used

Applicant services are identical or highly similar to Opposer's, as discussed in point 3, above. Applicant has submitted no evidence that its mark is used, or intended to be used, on any other goods or services.

10. Market Interface Between Applicant And The Owner Of A Prior Mark

The respective marks are for identical and highly related services, and Applicant's application places no restrictions on its channels of trade. Furthermore, both Opposer and Applicant provide their services to corporate clients. Accordingly, this factor favors Opposer.

11. Applicant's Right to Exclude Others from Use of its Mark

Applicant does not have a right to exclude others from using its mark with its services. Opposer has priority over Applicant's mark as it has been used for over 20 years prior to Applicant's first use of its mark. Opposer has used and established goodwill in the SWATCH mark in the United States since 1982. See NOR Ex. 1. Opposer's mark is incontestable

pursuant to 15 U.S.C. § 1065 as it has been in continuous use for over 25 years. See *id.*

Opposer's mark is distinct and world-renowned. Opposer has been active in its protection of its valued trademark.

12. The Extent of Potential Confusion

For all the reasons discussed above, the potential for confusion is high, well beyond likely, and indeed inevitable.

13. Other Established and Probative Facts- Bad Faith Adoption of the Mark by Applicant

The Applicant, the junior user, adopted its mark with prior knowledge of the Opposer's mark and had a duty to avoid conflict. The Applicant was aware of the SWATCH mark at a time prior to the Applicant's adoption of the SW:TCH mark. See Quigley Disc. Tr. at 82. As established above, the SWATCH mark is a famous mark known throughout the world. Applicant also admits that it conducted a trademark search prior to its adoption and use of the SW:TCH mark, leading to the reasonable conclusion that Applicant was aware that Opposer owned registrations in Class 35 and 42 prior to commencing use of the SW:TCH mark.

For all of the above reasons, there is a likelihood of confusion, mistake or deception and the Applicant's mark must be denied registration.

VI. CONCLUSION

Applicant's SW:TCH mark is confusingly similar to Opposer's SWATCH mark. Indeed, with the punctuation mark in Applicant's mark representing a missing vowel, Applicant's mark can easily be recognized by consumers as SWATCH, making confusion inevitable. Through its

earlier registrations and common law use, including in Class 035 for advertising services, Opposer has established its priority and that the parties' services are highly similar, if not identical. Application No. 77/505,539 should be refused registration because it is likely to cause confusion with Opposer's SWATCH marks. This Opposition should be SUSTAINED.

Respectfully submitted,

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October 18, 2013

CERTIFICATE OF FILING AND SERVICE

I, Jeffrey A. Lindenbaum, hereby certify that on October 18, 2013, the foregoing Trial Brief is being filed through the electronic system for Trademark Trial and Appeal Board and is being served on below-listed Applicant's counsel via US Mail:

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EXHIBIT H

**This Opinion is not a
Precedent of the TTAB**

Oral Hearing: June 11, 2012

Mailed: October 1, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

*Swatch AG (Swatch SA) (Swatch Ltd.)*¹

v.

The Spark Agency, Inc.

Opposition No. 91190380

Jess M. Collen and Jeffrey A. Lindenbaum of Collen IP for Swatch AG.

Annette P. Heller of Heller Associates for The Spark Agency, Inc.

Before Zervas, Shaw, and Hightower, Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

Applicant, The Spark Agency, Inc., filed a use-based application on the Principal Register to register the mark **SW:TCH**, in standard character form, for the following services:²

Marketing and promotional services, namely, planning, conducting, and organizing mobile marketing exhibits, trade show exhibits, point of sale exhibits, and marketing displays for business meetings and business events for advertising purposes; Design of advertising multimedia presentations and themed graphics for use in marketing

¹ Opposer is a Swiss corporation. The parentheticals are part of its name.

² Serial No. 77505539, filed June 23, 2008. Applicant claimed dates of first use anywhere and dates of first use in commerce of at least as early as February 2008.

campaigns for others for trade shows, business meetings, and business to business events, in International Class 35;

Custom manufacture of mobile marketing exhibits and trade show exhibits, in International Class 40; and

Design and development of websites for others, in International Class 42.

Opposer, Swatch AG, opposed the registration of Applicant's mark on the grounds of priority and likelihood of confusion under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d).³ Opposer pleaded ownership of ten SWATCH-formative registered marks for a variety of goods and services, including advertising agency services.⁴

Applicant admitted that Opposer owns its pleaded registrations and that some of them are incontestable, but denied the remaining allegations in the notice of opposition.

The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant's application file. In addition, the parties introduced the following testimony and evidence:

- A. Status and title copies of Opposer's pleaded U.S. Trademark Registrations, submitted with Opposer's notice of reliance:

³ Opposer also asserted a claim of dilution in the Notice of Opposition. However, insofar as Opposer has not argued any dilution claim in its brief we find, in accordance with the Board's usual practice, that this claim has been waived. *See, e.g., Knight Textile Corp. v. Jones Inv. Co.*, 75 USPQ2d 1313, 1314 n.4 (TTAB 2005).

⁴ Amended Notice of Opposition ¶ 3. Opposer amended its notice of opposition to remove Registration No. 3291129 which was cancelled during this proceeding and to add Registration No. 3799562 which matured into a registration during this proceeding. The Board approved the amendment to the notice of opposition on October 1, 2012.

1. SWATCH (stylized), Registration No. 1356512 for watches and parts thereof, in International Class 14;
2. SWATCH, Registration No. 1671076 for watches, clocks and parts thereof, in International Class 14;
3. SWATCH (stylized), Registration No. 1799862 for retail store services, namely, retail shops featuring watches, watch parts and watch accessories, in International Class 42;
4. SWATCH (stylized), Registration No. 1849657 for retail store services; namely, retail shops featuring, sunglasses and electronics, in International Class 42;
5. SWATCH, Registration No. 2752980 for jewelry, namely, earrings, necklaces, pendants, bracelets and rings, in International Class 14;
6. SWATCH (stylized), Registration No. 2050210 for books and periodicals, namely a series of books illustrating collectable articles; magazines for watch collectors, in International Class 16;
7. SWATCH, Registration No. 2100605 for pens, in International Class 16; suitcases, travel bags, handbags, umbrellas, in International Class 18; and non-metal keyholders, in International Class 20;
8. ISWATCH (stylized), Registration No. 3567953 for precious metals and their alloys, namely, white gold, yellow gold, pink gold, jewelry watches, precious stones, namely, diamond, sapphire, ruby, emerald, horological and chronometric instruments, namely, watch cases, chronographs, chronometers for use as watches, watches, watch movements, in International Class 14; retail store services in the field of horological instruments and jewellery, on-line retail store services in the field of horological instruments and jewellery, in International Class 35; and repair and maintenance of horological products and jewellery, in International Class 37;
9. ESWATCH (stylized), Registration No. 3554475 for precious metals and their alloys, namely, white gold, yellow gold, pink gold, jewelry watches, precious stones, namely, diamond, sapphire, ruby, emerald, horological and chronometric instruments, namely, watch cases, chronographs, chronometers for use as watches, watches, watch movements, in International Class 14; retail store services in the field of horological instruments and jewellery, on-line retail store services in the field of horological instruments and jewellery, in International Class 35; repair and maintenance of horological products and jewellery, in International Class 37; and

10. SWATCH, Registration No. 3799562 for, *inter alia*, management of business; advertising agencies; computer assisted processing of data derived from the timing of sporting activities for use in education, entertainment and publicity, in International Class 35.

B. The Trial Testimony of Opposer's witness, Frank Furlan, President, Swatch Group U.S. ("Furlan testimony") and related exhibits.

C. Portions of the Rule 30(b)(6) Discovery Deposition of Applicant's corporate representative, Kevin Quigley, Executive Vice President and co-owner ("Quigley deposition") and related exhibits, submitted by Opposer's Notice of Reliance.

D. The Trial Testimony of Kevin Quigley ("Quigley testimony") and related exhibits.

E. Applicant's responses to certain Interrogatories and Requests for Admissions propounded by Opposer, submitted with Opposer's Notice of Reliance.

F. Printed publications submitted with Opposer's Notice of Reliance.

G. Internet materials submitted with Opposer's Notice of Reliance.

Standing and Priority

Applicant does not dispute Opposer's standing or priority in the SWATCH marks. Opposer's standing to oppose registration of Applicant's mark is established by its pleaded registrations, which the record shows to be valid and subsisting, and owned by Opposer. *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (party's ownership of pleaded registration establishes standing). In addition, because Opposer's pleaded registrations are of record, priority is not an issue with respect to the goods and services covered by

Opposer's pleaded registrations. *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998) (citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)). This is true even as to Opposer's registration that issued after Applicant's mark published of for opposition.

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."). These factors, and any other relevant *du Pont* factors in the proceeding now before us, will be considered in this decision.

We focus our analysis on Registration No. 3799562 for the mark SWATCH as the mark and the identified services are most similar to Applicant's mark and services. If confusion is likely between that mark and Applicant's mark, there is no need for us to consider the likelihood of confusion with Opposer's other SWATCH marks, while if there is no likelihood of confusion between Applicant's mark and the mark

in Registration No. 3799562, then there would be no likelihood of confusion with Opposer's other SWATCH marks. *See, e.g., In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

1. Fame of Opposer's Marks

We start our analysis with the fifth *du Pont* factor, the fame of SWATCH marks. Opposer argues that its SWATCH marks are famous and therefore are "entitled to the broadest possible scope of protection."⁵

Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Fame may be measured indirectly by the volume of sales and advertising expenditures of the goods and services identified by the marks at issue, "by the length of time those indicia of commercial awareness have been evident," by widespread critical assessments and notice by independent sources of the products identified by the marks, as well as by the general reputation of the products and services. *Bose Corp.*, 63 USPQ2d at 1305-06 and 1309.

Opposer has been selling its watches and jewelry under the SWATCH marks in the United States for over 30 years. Opposer's confidential sales and advertising

⁵ Reply Br. at 4.

figures, number of retail stores, extensive advertising in a variety of media, brand recognition by third parties, and prolonged and widespread consumer exposure to its marks are all significant and are sufficient to establish the fame of Opposer's SWATCH marks with respect to watches and jewelry. Applicant does not seriously contest the fame of Opposer's marks for watches and jewelry.⁶

Although Opposer offers a variety of other products and services under its SWATCH marks, virtually all of the advertisements and unsolicited articles produced by Opposer relate to Opposer's watches and jewelry. Applicant argues that the Board, therefore, should give Opposer's evidence of fame "no weight at all" inasmuch as there is no evidence that Opposer has established fame with respect to "advertising agencies."⁷ In contrast, Opposer argues that the fame of its SWATCH mark "must be accorded its full weight regardless of the relatedness of the parties' goods and services."⁸

Fame is not an all-or-nothing proposition. "Fame for purposes of likelihood of confusion is a matter of degree that 'varies along a spectrum from very strong to very weak.'" *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012), quoting *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1375 (Fed. Cir. 2005). Moreover, fame does not create a right in gross in a mark regardless of the goods or services offered by a party. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505, 507

⁶ Applicant's Br. at 3.

⁷ *Id.* at 8.

⁸ Reply Br. at 1.

(Fed. Cir. 1983) (“It must also be established that there is a reasonable basis for the public to attribute the particular product or service of another to the source of the goods or services associated with the famous mark.”). We agree that Opposer has not shown SWATCH is famous for its advertising agencies. Nevertheless, the fame of the SWATCH marks for watches and jewelry casts a long shadow which may include other goods or services. *See Kenner Parker Toys Inc. v. Rose Art Indus. Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992) (“A strong mark ... casts a long shadow which competitors must avoid.”). Here, Opposer’s registration of the SWATCH mark for advertising agencies and its use of the SWATCH marks in connection with a variety of goods and services support Opposer’s argument that there is a reasonable basis for the public to associate the advertising agencies with Opposer’s famous mark used on watches and jewelry. *See Notre Dame*, 217 USPQ at 507. Accordingly, we find that SWATCH is a strong mark when used in connection with Opposer’s advertising agency services. This *du Pont* factor favors a finding of likelihood of confusion.

2. Similarity or Dissimilarity of the Services

This *du Pont* factor requires us to determine the similarity or dissimilarity of the services as identified in Applicant’s application and in the cited registrations, respectively. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 76 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Opposer's services most similar to Applicant's services are "advertising agencies," in International Class 35. Applicant's services are identified as:

Marketing and promotional services, namely, planning, conducting, and organizing mobile marketing exhibits, trade show exhibits, point of sale exhibits, and marketing displays for business meetings and business events for advertising purposes; Design of advertising multimedia presentations and themed graphics for use in marketing campaigns for others for trade shows, business meetings, and business to business events, in International Class 35;

Custom manufacture of mobile marketing exhibits and trade show exhibits, in International Class 40; and

Design and development of websites for others, in International Class 42.

Applicant does not argue that advertising agencies are not related to its identified services, but instead argues that "Opposer has no use of the SWATCH mark in the United States in connection with many of the products and services listed in [Registration No. 3799562]."⁹ This argument is unavailing. Applicant may not collaterally attack the validity of Opposer's registration in the absence of a counterclaim for cancellation. Trademark Rule 2.106(b)(2)(ii). See *Cosmetically Yours, Inc. v. Clairol, Inc.*, 424 F.2d 1385, 165 USPQ 515, 517 (CCPA 1970) ("[I]n the absence of a counterclaim for cancellation ... it is not open to an applicant to prove abandonment of the opposer's registered mark."); *Nasdaq Stock Market, Inc. v. Antartica, S.R.L.*, 69 USPQ2d 1718, 1735 (TTAB 2003) ("The law, of course, is well settled that an applicant cannot collaterally attack opposer's registration in the absence of a counterclaim for cancellation."); *Edom Labs. Inc. v. Lichter*, 102

⁹ Applicant's Br. at 9.

USPQ2d 1546, 1549 n.6 (TTAB 2012) (Board will not consider collateral attack on the validity of Opposer's pleaded registration absent properly filed counterclaim). Accordingly, Applicant's argument relating to Opposer's use of the SWATCH mark for "advertising agencies" is given no further consideration.

The record shows that the services of the parties are closely related, and in some ways the same, in that they are all directed to advertising. Applicant's Executive Vice President, James Quigley, testified that Applicant is "a marketing, communication, advertising, [and] sales promotion agency" whose main businesses are "Sales promotion, advertising, digital advertising, out-of-home advertising, point-of-sale advertising, large consumer events.... Field sampling. Mobile marketing ... all focused on getting brands connected to their consumers."¹⁰ Applicant's identification of services in Class 35 indicates that Applicant's "marketing and promotional services" are conducted "for advertising purposes." Applicant also identifies its "multimedia presentations and themed graphics" as "advertising." Similarly, the "custom manufacture of mobile marketing exhibits and trade show exhibits" in Class 40 and the "design and development of websites for others" in Class 42 both fall within the commonly understood purview of advertising agencies.¹¹ This *du Pont* factor favors a finding of likelihood of confusion.

3. Similarities or Dissimilarities of the Marks

Next, we consider the *du Pont* factor of the similarities or dissimilarities of the marks. We must compare the marks "in their entirety as to appearance, sound,

¹⁰ Quigley Testimony, pp. 8-9 (TTABVUE 35 pp. 11-12).

¹¹ *Id.*

connotation and commercial impression” to determine the similarity or dissimilarity between them. *Du Pont*, 177 USPQ at 567. “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs.*, 101 USPQ2d at 1721, citing *Leading Jewelers Guild v. JLOW Holdings, LLC*, 82 USPQ2d 1901, 1905 (TTAB 2007).

Viewing the appearance of the marks in their entirety, we find them to be more similar than dissimilar. Both marks begin with the letters “SW” and end with the letters “TCH.” The only difference between the marks is the letter “A” in the middle of Opposer’s mark and a colon in the middle of Applicant’s mark. Applicant argues that the colon in its mark “is an integral, unique, and distinctive visual portion of Applicant’s SW:TCH mark that significantly differentiates it from Opposer’s SWATCH mark.”¹² But when the marks are spoken or pronounced, it is likely that the marks have a similar sound. We assume that each mark is susceptible to varying pronunciations; nevertheless, there are only a few ways that Applicant’s mark can be pronounced and all of them rhyme with SWATCH. See *Kimberly-Clark Corp. v. H. Douglas Enters., Ltd.*, 774 F.2d 1144, 227 USPQ 541, 542 (Fed. Cir. 1985) (“HUGGIES and DOUGIES sound much alike and actually rhyme....”). Thus, if the colon is pronounced as an “I,” SW:TCH is likely to be pronounced as “switch.” Alternatively, if the colon is pronounced as an “A” or not pronounced at all, SW:TCH is likely to be pronounced as “swatch.” In any case, the difference in pronunciation

¹² Applicant’s Br. at 6.

between “swatch” and variations of “sw:tch” is slight and both marks rhyme. This similarity in sound, as well as the similarity in appearance, reinforces the similarity in connotation and commercial impression.

Considering the marks in their entireties, Applicant’s SW:TCH mark bears strong similarities to Opposer’s SWATCH mark, especially as to likely pronunciation. This *du Pont* factor regarding the similarities of the marks favors a finding of likelihood of confusion.

4. Bad Faith

Opposer argues that Applicant adopted its applied-for mark in bad faith because it “was aware” of the SWATCH marks.¹³ We disagree.

To show bad faith adoption of a mark, Opposer must establish that Applicant had more than mere knowledge of Opposer’s prior mark. *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 1565, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987) (“[A]n inference of ‘bad faith’ requires something more than mere knowledge of a prior similar mark.”). Here, the evidence does not show anything more than Applicant’s mere knowledge of Opposer’s mark. This is insufficient to show bad faith on Applicant’s part. The factor of Applicant’s intent therefore is neutral.

5. Balancing the Factors

We have carefully considered all of the parties’ evidence and argument, including that which we have not specifically discussed. We find that Opposer enjoys significant renown in its pleaded SWATCH marks and that parties’ respective services are closely related. We further find that the parties’ marks share

¹³ Opposer’s Br. at 24.

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significant similarities. We therefore conclude that Applicant's registration of its SW:TCH mark for the identified services is likely cause confusion with Opposer's registered and previously used SWATCH marks.

Decision: The opposition is SUSTAINED and registration to Applicant is refused in Application No. 77505539.