

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

Mailed: December 7, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Rolex Watch U.S.A., Inc.*

*v.*

*Montres Jaquet Droz SA*

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Opposition No. 91242189  
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Beth Frenchman and Adam Sgro of Gibney, Anthony & Flaherty, LLP  
for Rolex Watch U.S.A., Inc.

Marie Anne Mastrovito of Abelman, Frayne & Schwab  
for Montres Jaquet Droz SA.

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Before Wellington, Heasley and Hudis,  
Administrative Trademark Judges.

Opinion by Hudis, Administrative Trademark Judge:

Montres Jaquet Droz SA (“Applicant”) seeks registration on the Principal Register of the proposed SOME WATCHES TELL TIME... SOME TELL A STORY mark (in standard characters) (Applicant’s “STORY Tagline”) for:

Precious metals and their alloys and goods made of these materials or plated therewith included in this class, namely, figurines, trophies; Jewelry, namely, rings, earrings, cufflinks, bracelets, charms, brooches, chains, necklaces, tie pins, tie clips, jewelry boxes, jewelry cases, precious stones, semi-precious stones in the nature of gemstones; Horological and chronometric instruments, namely, watches, chronographs, clocks, watches, watchstraps, clocks, alarm clocks and parts and fittings for the aforesaid goods, namely, needles, anchors, rockers, barrels, watch cases, watch straps, watch dials, clockworks, watch chains, watch movements, watch springs, watch glasses, cases for watchmaking, and cases for watches in International Class 14.<sup>1</sup>

In its Notice of Opposition,<sup>2</sup> Rolex Watch U.S.A., Inc. (“Opposer”) opposes registration of Applicant’s STORY Tagline under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that Applicant’s STORY Tagline, as applied to the goods identified in the application, so resembles Opposer’s unregistered alleged IT DOESN’T JUST TELL TIME. IT TELLS HISTORY mark (Opposer’s “HISTORY Tagline”), used in connection with watches, as to be likely to cause confusion, mistake, or to deceive. Specifically, Opposer alleges:

3. In January 2013, [Opposer] began an advertising campaign featuring notable individuals wearing Rolex watches (hereafter [Opposer]’s “Icon Campaign”). [Opposer]’s Icon Campaign features the HISTORY Mark in print, television, radio and social media advertising used in association with its offer for sale and sale of Rolex watches. Below are samples of

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<sup>1</sup> Application Serial No. 87497855 was filed on June 20, 2017, based upon Applicant’s allegation of a bona fide intention to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), claiming priority based upon the December 21, 2016 filing date of Applicant’s Switzerland Application under Trademark Act Section 44(d), 15 U.S.C. § 1126(d), and seeking registration based on the issuance of Applicant’s Switzerland registration issued on January 13, 2017 under Trademark Act Section 44(e), 15 U.S.C. § 1126(e).

<sup>2</sup> Notice of Opposition, 1 TTABVUE. References to the pleadings, the evidence of record and the parties’ briefs refer to the Board’s TTABVUE docket system. Coming before the designation TTABVUE is the docket entry number; and coming after this designation are the page and paragraph references, if applicable.

print advertisements featuring [Opposer]'s HISTORY Mark. [Images omitted].

4. [Opposer] has also used its HISTORY Mark consistently and continuously in other advertising campaigns it has developed. For the past five years, advertisements featuring the HISTORY Mark have appeared in newspapers such as the Wall Street Journal and New York Times, and in prominent magazines such as Vanity Fair, Town & Country and Esquire.

5. During the 2017 live broadcast of the Oscar awards ceremony televised across the United States by the ABC network and viewed by nearly 32 million people, a Rolex commercial aired which consisted of several notable movie clips in which iconic movie stars were wearing a Rolex watch. At the end of the commercial [Opposer]'s HISTORY Mark appeared across the screen.

6. Since the inception of [Opposer]'s Icon Campaign and other uses of [Opposer]'s HISTORY Mark, [Opposer] has spent millions of dollars in advertising which has resulted in the creation of an association between [Opposer] and its HISTORY Mark and has created a substantial impact on the purchasing public.

7. [Opposer] has established common law trademark rights in its HISTORY Mark through its prominent and continuous use.

8. [Opposer]'s HISTORY Mark is distinctive to both the consuming public and in [Opposer]'s trade.

9. Through [Opposer]'s continuous use, advertising and promotion, the HISTORY Mark has come to be associated exclusively with [Opposer] and the watches it offers for sale and sells.

10. Applicant, on June 20, 2017, filed an application under [Section] 44(e) of the Lanham Act to register the STORY Mark in IC 014 for, among other goods, watches.

11. The earliest date Applicant can rely on for priority of use of its STORY Mark is June 21, 2016 [sic] which is based on Applicant's foreign registration.<sup>3</sup>

12. Applicant was aware of [Opposer]'s Icon Campaign and the use of its HISTORY Mark prior to its adoption, use and application for registration of its STORY Mark.

13. [Opposer]'s HISTORY Mark has priority over Applicant's STORY Mark because [Opposer] established common law trademark rights

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<sup>3</sup> As stated above in Note 1, Applicant's priority date is actually December 21, 2016.

through its prominent use of its mark in association with its watches long prior to any date of first use Applicant may rely.

14. Applicant's STORY Mark is nearly identical in visual appearance, meaning and sound to [Opposer]'s HISTORY Mark.

15. Applicant's STORY Mark and [Opposer]'s HISTORY Mark have the same commercial impression.

16. Applicant's STORY Mark is confusingly similar to [Opposer]'s HISTORY Mark.

17. Applicant is seeking to apply and use its similar STORY Mark on watches, which are identical to the goods sold, distributed, promoted and sponsored by [Opposer].

18. Applicant's STORY Mark, when and if placed on watches and related goods in [International Class] 14 will likely cause consumer confusion as to the source of Applicant's products.

19. The registration of Applicant's STORY Mark will improperly give to Applicant the appearance of exclusive statutory ownership rights in a mark that is confusingly similar to the [Opposer]'s HISTORY Mark in violation and derogation of the prior and superior rights of [Opposer] in its trademark.

20. [Opposer] believes that it will be damaged by issuance of the registration of the STORY Mark.

21. Applicant's STORY Mark so resembles [Opposer]'s previously used and common law HISTORY Mark that, when and if applied to Applicant's goods, it is likely to cause confusion, mistake, or deception for purposes of Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)).<sup>4</sup>

Applicant denied the salient allegations of the Notice of Opposition in its Answer.<sup>5</sup>

The case is fully briefed. Opposer bears the burden of proving its Trademark Act Section 2(d) claim by a preponderance of the evidence. *See Jansen Enters., Inc. v. Rind*, 85 USPQ2d 1104, 1107 (TTAB 2007). Having considered the evidentiary record, the parties' arguments and applicable authorities, as explained below, we find that Opposer has not carried this burden, and dismiss the Opposition.

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<sup>4</sup> Notice of Opposition, 1 TTABVUE 3-6.

<sup>5</sup> Answer, 4 TTABVUE.

## **I. The Evidentiary Record**

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

### **A. Parties' Stipulations**

Opposer and Applicant stipulated as follows:

A. The following documents are admitted into evidence:

1. Subpoena from [Opposer] to Scott King, Inc. d/b/a King Jewelers ("Scott King"), dated July 8, 2019 (the "Scott King Subpoena"), and Notice of Subpoena dated July 8, 2019 to Jaquet Droz.<sup>6</sup>
2. Email from counsel of Scott King, Inc. to [Opposer]'s counsel in response to the Scott King Subpoena ....
3. Documents produced by Scott King in response to the Scott King Subpoena ....

B. With respect to the above-referenced documents admitted into evidence, the parties reserve their right to object to the competency, relevancy, materiality and/or scope of the documents.

C. The above-referenced documents do not constitute the entire trial record in this matter and the parties may separately file notices of reliance relative to other evidence or testimony depictions should they deem necessary.<sup>7</sup>

### **B. Opposer's Evidence**

- Opposer's First Notice of Reliance ("Opp 1<sup>st</sup> NoR") upon certain responses by Applicant to Opposer's First Set of Interrogatories (12 TTABVUE).
- Opposer's Second Notice of Reliance ("Opp 2<sup>nd</sup> NoR") upon the transcript and certain exhibits from the discovery deposition of Applicant's former U.S. Brand Manager, Francois Bezault, ("Bezault Dep. Tr.") (13 TTABVUE-Nonconfidential; 14 TTABVUE-Confidential).

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<sup>6</sup> Scott King, Inc. d/b/a King Jewelers is an authorized retailer of Applicant's JAQUET DROZ branded merchandise. Bezault Dep. Tr., 13 TTABVUE 177-78.

<sup>7</sup> Stipulation, 11 TTABVUE.

- Opposer’s Third Notice of Reliance (“Opp 3<sup>rd</sup> NoR”) upon third-party Internet materials (15 TTABVUE).
- Testimony Declaration of Opposer’s Vice President, Marketing and Communications, Mounia Mechbal, with exhibits (“Mechbal Decl.”) (16 TTABVUE-Nonconfidential; 17 TTABVUE-Confidential).

**C. Applicant’s Evidence**

- Testimony Declaration of Applicant’s Chief Operating Officer, Christian Lattmann, with exhibits (“Lattmann Decl.”) (19 TTABVUE; 26 TTABVUE (corrected exhibit)).
- Testimony Declaration of Applicant’s former U.S. Brand Manager, Francois Bezault, with exhibits (“Bezault Decl.”) (22 TTABVUE-Nonconfidential; 23 TTABVUE-Confidential).
- Applicant’s First Notice of Reliance (“App 1<sup>st</sup> NoR”) upon dictionary definitions of “Story” and “History” (24 TTABVUE).
- Applicant’s Second Notice of Reliance (“App 2<sup>nd</sup> NoR”) upon certain responses by Opposer to Applicant’s First Set of Interrogatories (25 TTABVUE).

**D. Opposer’s Rebuttal Evidence**

- Rebuttal Testimony Declaration of Mounia Mechbal, with an exhibit (“Mechbal Rebuttal Decl.”) (27 TTABVUE).
- Opposer’s Fourth Notice of Reliance (“Opp 4<sup>th</sup> NoR”) upon third party Internet materials, dictionary definitions of “Story” and “History,” and a Wikipedia definition of Anaphora (rhetoric) (28 TTABVUE).
- Rolex’s Fifth Notice of Reliance upon dictionary definitions of “Story” and “History” and a third-party magazine displaying advertisements by Opposer and Applicant (“Opp 5<sup>th</sup> NoR”) (29 TTABVUE).

**II. The Parties**

Opposer asserts that it or its predecessors have continuously sold and offered for sale luxury watches in the United States under the ROLEX trademark since as early as 1912. Opposer sells its watches to the public through its network of official jewelers. These official Rolex Jewelers are independently owned retailers who, in

addition to ROLEX brand watches, offer other watch brands and jewelry for sale.<sup>8</sup> The manufacturer of Opposer's products is Opposer's ultimate corporate parent, Rolex S.A. of Geneva, Switzerland.<sup>9</sup>

Applicant asserts it was first established in 1738 by master craftsman Pierre Jaquet Droz. Jaquet Droz and his sons became known for their high-quality timepieces. These timepieces continue to be known for combining innovative design with the finest materials. In the United States, JAQUET DROZ brand watches are sold only in a limited number of select boutiques and jewelry stores.<sup>10</sup> Applicant is a wholly owned subsidiary of The Swatch Group Ltd.<sup>11</sup>

### **III. Entitlement to Bring and Maintain a Statutory Cause of Action**

To establish entitlement to bring and maintain a statutory cause of action under Trademark Act Section 13, 15 U.S.C., § 1063, a plaintiff must demonstrate "an interest falling within the zone of interests protected by the statute and ... proximate causation." *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at \*4 (Fed. Cir. 2020) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2067-70 (2014)).<sup>12</sup> Stated another way, a plaintiff is

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<sup>8</sup> Mechbal Decl., 16 TTABVUE 3, ¶ 4.

<sup>9</sup> Opposer's Interrogatory Answer No. 15, App 2<sup>nd</sup> NoR, 24 TTABVUE 12.

<sup>10</sup> Lattmann Decl., 19 TTABVUE 2-3, ¶¶ 5-7.

<sup>11</sup> Applicant's Interrogatory Answer No. 1, Opp 1<sup>st</sup> NoR, 12 TTABVUE 5.

<sup>12</sup> Our decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063-64, under the rubric of "standing." We now refer to this inquiry as entitlement to bring and maintain a statutory cause of action. Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 remain equally applicable.

entitled to bring and maintain a statutory cause of action by demonstrating a real interest in the proceeding and a reasonable belief of damage. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at \*3 (Fed. Cir. 2020); see also *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). According to the Court of Appeals for the Federal Circuit, there is “no meaningful, substantive difference between the analytical frameworks expressed in *Lexmark* and *Empresa Cubana*.” *Corcamore*, 2020 USPQ2d 11277 at \*4. Thus, “a party that demonstrates a real interest in [opposing registration of] ... a trademark under [Trademark Act Section 13, 15 U.S.C.] § 106[3] has demonstrated an interest falling within the zone of interests protected by [the Trademark Act]. ... Similarly, a party that demonstrates a reasonable belief of damage by the registration of a trademark demonstrates proximate causation within the context of § 106[3]. *Corcamore*, 2020 USPQ2d 11277 at \*7.

Entitlement to bring and maintain a statutory cause of action is demonstrated, for example, where the plaintiff pleads (and later proves) a claim of likelihood of confusion that is not wholly without merit. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000). This would include such a claim based upon prior use of a confusingly similar mark. *Double Coin Holdings Ltd. v. Tru Development*, 2019 USPQ2d 377409, at \*4 (TTAB 2019) (entitlement to bring and maintain likelihood of confusion claim established, in part, by testimony with exhibits of earlier use of confusingly similar mark).



Here, we find that Opposer's allegations recited above sufficiently plead a claim of likelihood of confusion that is not wholly without merit. Opposer's entitlement to bring and maintain a statutory cause of action moreover is derived from its demonstrated position as a competitor of Applicant and its reasonable belief in a likelihood of confusion between its HISTORY Tagline and the STORY Tagline. *See, e.g., Books on Tape, Inc. v. Booktape Corp.*, 836 F.2d 519, 5 USPQ2d 1301, 1302 (Fed. Cir. 1987) (competitor has standing because it has an interest in the outcome beyond that of the general public); *Grote Indus., Inc. v. Truck-Lite Co., LLC*, 126 USPQ2d 1197, 1201-2 (TTAB 2018) (same). Opposer thus has proven its entitlement to bring and maintain this Opposition.<sup>13</sup>

#### **IV. Priority**

A party opposing an application for registration under Trademark Act Section 2(d) must prove that it has prior proprietary rights in the term on which it relies to demonstrate likelihood of confusion as to source. *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981). "These proprietary 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." *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002). "[W]ithout proof of priority, [an]

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<sup>13</sup> To be clear, Opposer's proof of its prior use of the HISTORY Tagline in order to establish its entitlement to bring and maintain this Opposition is not the equivalent of proving sufficient common law use for purposes of establishing priority over Applicant's STORY Tagline – a subject to which we turn later in this decision.

opposer [asserting a Section 2(d) claim] cannot prevail.” *Syngenta Crop Protection, Inc. v. Bio-Chek, LLC*, 90 USPQ2d 1112, 1119 (TTAB 2009).

#### **A. Possible Bases for Opposer’s Assertion of Priority**

The earliest priority date on which Applicant can rely is the December 21, 2016 filing date of its Switzerland Application under Trademark Act Section 44(d). Applicant did not make of record any evidence showing use of the STORY Tagline in commerce before this date.<sup>14</sup> *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1436 (TTAB 2012) (“[T]he Section 44(d) priority filing date of the involved application ... is the earliest date applicant is entitled to claim.”). We now proceed to look at the bases on which Opposer could rely to establish priority.

In this Opposition, Opposer does not assert ownership of a federal registration for its claim of proprietary rights.<sup>15</sup> Opposer also readily concedes it does not rely on technical (affixation) trademark use on watches under the Trademark Act<sup>16</sup> to

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<sup>14</sup> “Applicant filed its application to register [the STORY Tagline] on June 20, 2017, based on its priority application in Switzerland filed on December 21, 2016. Thus, Applicant's rights to the [Tagline] ... date back to at least as early as December 21, 2016.” Applicant’s Brief, 36 TTABVUE 7.

<sup>15</sup> “Because Opposer has not pleaded and submitted any registrations, it must rely on its asserted common law rights ....” *WeaponX Performance Prods. Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1040-41 (TTAB 2018).

<sup>16</sup> For purposes of the Trademark Act, “a mark shall be deemed to be in use in commerce — (1) on goods when — (A) it is **placed in any manner** on the goods or their containers or the displays associated therewith or on the tags or labels **affixed** thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and (B) the goods are sold or transported in commerce ....” Trademark Act Section 45, 15 U.S.C. § 1127. (Emphasis added).

establish such rights.<sup>17</sup> Further, Opposer neither pleaded, argued in its briefs, nor provided any evidence to support a claim of trade name use of the HISTORY Tagline:

The term “trade name” is defined in the [Trademark] Act to mean “any name used by a person to identify his or her business or vocation” as distinguished from a trademark or service mark which is defined to mean a name or symbol used to identify and distinguish goods or services from those of others and to indicate the source of those goods or services.

*Nat'l Cable Television Ass'n v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1428 (Fed. Cir. 1991) (citing Trademark Act Section 45, 15 U.S.C. § 1127 (definitions of “trade name,” “trademark” and “service mark”).

## **B. Use Analogous to Trademark Use**

Rather, Opposer argues that it established proprietary rights, and therefore priority, in the HISTORY Tagline exclusively by way of use analogous to trademark use (“analogous trademark use” for short).<sup>18</sup>

### **1. Analogous Trademark Use Was Not Pleaded or Tried**

Applicant objects to Opposer’s reliance on its putative analogous trademark use because this was not asserted in its Notice of Opposition. Therefore, says Applicant, Opposer should be precluded from relying on analogous trademark use due to Opposer’s failure to plead it.<sup>19</sup>

A claim of priority based on analogous trademark use must be pleaded in order for the plaintiff to rely on it. *DeVivo v Ortiz*, 2020 USPQ2d 10153, at \*3 n.10 (TTAB

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<sup>17</sup> Opposer’s Brief, 32 TTABVUE 29; Opposer’s Rebuttal Brief, 37 TTABVUE 7, 15, 17 (Opposer’s use on which it relies for priority is solely based on its advertising).

<sup>18</sup> Opposer’s Brief, 32 TTABVUE 29-30; Opposer’s Rebuttal Brief, 37 TTABVUE 15-20.

<sup>19</sup> Applicant’s Brief, 36 TTABVUE 15-16.

2020) (“Opposer has not pleaded use analogous to trademark use and Applicant has made clear that use analogous to trademark use is not an issue in this proceeding.”); *Central Garden & Pet Co. v. Doskocil Mfg. Co.*, 108 USPQ2d 1134, 1142 (TTAB 2013) (“reliance on priority through analogous use must be pleaded”); *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1539 (TTAB 2007) (“Opposer[s] ... alleg[ation] of ‘analogous use ...’ [should] provide[] applicant with ample notice of the basis upon which it seeks to establish priority in this case for its Section 2(d) claim.”).

Although the purpose of notice pleading is to obviate the need to allege particular “magic words,” *See Levi Strauss & Co. v. R. Josephs Sportswear, Inc.*, 36 USPQ2d 1328, 1330 (TTAB 1994), we find that Opposer’s above-recited allegations in its Notice of Opposition did not provide Applicant with sufficient notice of the basis for Opposer’s claim of priority as argued in Opposer’s Briefs. The Notice of Opposition, the pertinent sections of which are recited at length above, claim general common law trademark rights, not analogous trademark use. *Compare Fair Indigo*, 85 USPQ2d at 1539 (“Opposer, by alleging ‘analogous use starting January 2006,’ has provided applicant with ample notice of the basis upon which it seeks to establish priority in this case for its Section 2(d) claim.”).

Notwithstanding, the question remains whether the parties litigated analogous trademark use by express or implied consent under Fed. R. Civ. P. 15(b). Rule 15(b), made applicable to Board proceedings by Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a), provides, in pertinent part, that when issues not raised by the pleadings are tried by the express or implied consent of the parties, they shall be treated in all

respects as if they had been raised in the pleadings. From a reading of its Brief, Applicant clearly did not expressly consent to the trial of analogous trademark use as part of Opposer's case.

On the other hand, “[i]mplied consent to the trial of an unpleaded issue can be found only where the non-offering party (1) raised no objection to the introduction of evidence on the issue, and (2) was fairly apprised that the evidence was being offered in support of the issue.” TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 507.03(b) (2020); *see also Noble House Home Furnishings, LLC v. Floorco Enters., LLC*, 118 USPQ2d 1413, 1414-15 (TTAB 2016) (motion to amend petition after close of trial denied where defendant did not know or agree that the newly asserted claim was being tried, and where plaintiff unduly delayed in moving to amend). “The question of whether an issue was tried by consent is basically one of fairness. The [adverse] ... party must be aware that the issue is being tried, and therefore there should be no doubt on this matter.” *Morgan Creek Prods. Inc. v. Foria Int’l Inc.*, 91 USPQ2d 1134, 1139 (TTAB 2009).

Applicant argues that “[t]he first instance in which ... Opposer gives notice of its intention to rely on analogous use ... appears [in] ... its Trial Brief ...”<sup>20</sup> Aside from the allegations in the Notice of Opposition (which we find insufficient), the only other specific portion of the record Opposer points to as demonstrating Applicant was fairly

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<sup>20</sup> Applicant's Brief, 36 TTABVUE 15.

apprised that Opposer was offering evidence in support of a claim of analogous trademark use is Opposer's response to the following interrogatory:<sup>21</sup>

**INTERROGATORY NO. 3:**

Describe all facts and circumstances surrounding Opposer's adoption of Opposer's Mark including the date the mark was adopted, the manner in which the slogan was created and selected, the reasons for adopting the mark, and the person(s) involved in the selection of the mark.

**Response to Interrogatory No. 3:**

[After asserting objections] Opposer's Mark was first used by Opposer in advertising in the United States in May of 2013. Opposer's Mark was featured in Opposer's advertising campaign entitled the Icons campaign. The advertising which contains Opposer's Mark was produced by J. Walter Thompson. The reasons for adopting Opposer's Mark were for use in its advertising and to facilitate the sale of its watches.

Opposer follows its quotation from this interrogatory answer by its more general assertion that "the entire trial testimony of [Opposer]'s only witness, Mounia Mechbal, provides Applicant with fair warning that [Opposer]'s use of the HISTORY Tagline is solely based on [Opposer]'s advertising."<sup>22</sup> We find that neither Opposer's interrogatory answer nor Ms. Mechbal's trial testimony fairly apprised Applicant that Opposer was offering evidence in support of a claim of analogous trademark use.

Applicant's interrogatory addressed the adoption of Opposer's claimed mark. Opposer's response, referring to its advertising, merely indicates Opposer's intent to facilitate the sale of its watches. That might be relevant to a claim of technical common law trademark rights (a ground on which Opposer states it does not rely). It

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<sup>21</sup> Opposer's Rebuttal Brief, 37 TTABVUE 17 (citing to App 2<sup>nd</sup> NoR, 25 TTABVUE 9).

<sup>22</sup> *Id.*

would not alert Applicant to Opposer's shift to a new, unpleaded ground for its priority claim (analogous trademark use).

Ms. Mechbal's trial testimony and exhibits discuss and make of record examples of Opposer's use of the HISTORY Tagline in a subsidiary, supportive role in ROLEX watch advertising. Her testimony, at best, is ambiguous on the question of analogous trademark use and cannot fairly be read to imply that Opposer was relying on this ground to establish priority. *See Colony Foods, Inc. v. Sagemark, Ltd.*, 735 F.2d 1336, 222 USPQ 185, 187 (Fed. Cir. 1984) ("The board reviewed the record and found that nothing in the transcript alerted [respondent] ... that [petitioner] ... intended to use the [noted documentary evidence] ... as a ground for cancellation. Our review of the record confirms the board's conclusion."); *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1629 (TTAB 1998) ("The evidence allegedly bearing on mere descriptiveness easily could be interpreted as going to genericness. Under such circumstances, we cannot say that applicant was fairly apprised that the evidence was being introduced in support of the unpleaded mere descriptiveness issue."). Consequently, we find that Opposer did not plead or place Applicant on notice during discovery or trial that analogous trademark use was being litigated in this Opposition.

## **2. Analogous Trademark Use Was Not Proven**

Even were we to find that analogous trademark use was properly pleaded or tried by consent of the parties, Opposer did not meet its burden of proving analogous trademark use. Rather, Opposer – at all times shown in the record – used the HISTORY Tagline in a subsidiary, supportive role in ROLEX watch advertising.

ROLEX was shown as the mark designating the source of the watches, not the advertising tagline.

“[O]ne may ground one’s opposition to an application on the prior use of a term in a manner analogous to service mark or trademark use. ... Such an ‘analogous use’ opposition can succeed, however, only where the analogous use is of such a nature and extent as to create public identification of the target term with the opposer’s product or service.” *T.A.B. Sys. v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879, 1881 (Fed. Cir. 1996) (internal citations omitted). “Where, however, [the] ... evidence falls short of supporting the critical inference of identification in the mind of the consuming public, we have not hesitated to reject an analogous use opposition.” *Id.*

The mere fact that Opposer intended the HISTORY Tagline to function as a trademark is insufficient. *Roux Labs., Inc. v. Clairol, Inc.*, 427 F.2d 823, 166 USPQ 34, 39 (CCPA 1970) (“The mere fact that a combination of words or a slogan is adopted and used by a manufacturer with the intent [that it function as a trademark] does not necessarily mean that the slogan accomplishes that purpose in reality.”). “Before a prior use becomes an analogous use sufficient to create proprietary rights, the [opposer] must show prior use sufficient to create an association in the minds of the purchasing public between the mark and the [opposer]’s goods. ... [T]he activities claimed to create such an association must reasonably be expected to have a substantial impact on the purchasing public ....” *Herbko*, 64 USPQ2d at 1378. These activities must be “sufficiently clear, widespread and repetitive to create the required association in the minds of the potential purchasers between the mark as an indicator



of a particular source and the [product] ... to become available later.” *T.A.B. Sys.*, 37 USPQ2d at 1883.

Moreover, the “tacking” theory under which analogous trademark use operates requires that actual technical trademark use must follow within a commercially reasonable period of time. *Westrex Corp. v. New Sensor Corp.*, 83 USPQ2d 1215, 1218 (TTAB 2007) (citing *Dyneer Corp. v. Automotive Products plc*, 37 USPQ2d 1251 (TTAB 1995)); *Shalom Children’s Wear Inc. v. In-Wear AIS*, 26 USQP2d 1516, 1519 (TTAB 1993). *See also* Cohen, A.B., *Intent to Use: A Failed Experiment?*, 35 U.S.F. L. Rev. 683, 690 (2001) (“[A] ... [use analogous to trademark use] claim would be valid as long as the opposer can also show actual commercial use within a reasonable time.”); 1 Gilson, J., *Gilson on Trademarks*, § 3.04 (Matthew Bender & Company, Inc. Sept. 2020 Update) (“Use analogous [to trademark use] can give an opposer priority over an applicant for registration of the same mark, provided that the use analogous is followed by actual use of the mark ‘within a commercially reasonable period of time.’”).

From a review of the record, we find that Opposer consistently uses its ROLEX mark as an indicator of source, but has not shown that its HISTORY Tagline “in and of itself” serves to identify the source of its goods. *See Textron Inc. v. Cardinal Eng’g Corp.*, 164 USPQ 397, 399 (TTAB 1969). Opposer’s presentations of its HISTORY Tagline do not show a substantial impact on the purchasing public, *Herbko*, 64 USPQ2d at 1378, sufficient to create the required association in the minds of the

potential purchasers between the HISTORY Tagline and a particular source of Opposer's watches to become available later. *T.A.B. Sys.*, 37 USPQ2d at 1883.

Except for a cessation of use from 2014-2015, Opposer promoted its HISTORY Tagline from 2013-2019<sup>23</sup> in print and online magazine advertisements,<sup>24</sup> in connection with the sponsorship of sporting tournaments and cinema award events,<sup>25</sup> in television and radio advertisements,<sup>26</sup> on billboards,<sup>27</sup> and in coop advertising with its authorized dealers.<sup>28</sup> Opposer's promotional expenditures for these activities during the stated time periods were in excess of \$21 million.<sup>29</sup> While Opposer's various uses of the HISTORY Tagline were repetitive, and might have been widespread (a point on which the record leaves a degree of doubt), they were not sufficiently clear to create the required association in the minds of the potential purchasers between the HISTORY Tagline as an indicator of a particular source of Opposer's watches.

Representative examples of Opposer's advertising using the HISTORY Tagline appear below:

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<sup>23</sup> Opposer's Answer to Interrogatory No. 2, App 2<sup>nd</sup> NoR, 24 TTABVUE 8-9.

<sup>24</sup> Mechbal Decl., 16 TTABVUE 3-6, 12-32, 34-89, 174-188, 234-49, ¶¶ 6-10, 12-14, 19, Exhs. 1-2, 4, 8, 10; 17 TTABVUE 2-9, Exhs. 3, 12.

<sup>25</sup> *Id.* at 5-7, 90-173, 189-233, ¶¶ 15, 17, 18, 20, Exhs. 5-7, 9.

<sup>26</sup> *Id.* at 6-7, 137-140, 189-249, ¶¶ 17, 19-21, Exhs. 6, 9-10.

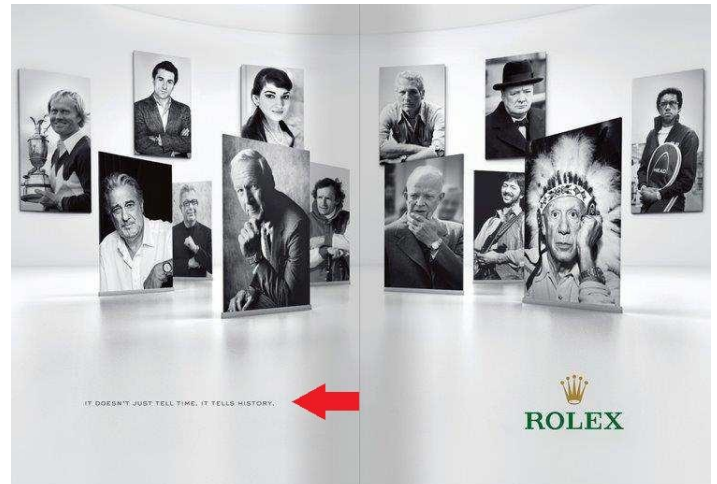
<sup>27</sup> *Id.* at 5-7, 190-136, 174-188, 234-49, ¶¶ 15, 19, 21, Exhs. 5, 8, 10.

<sup>28</sup> *Id.* at 7, 25-254, ¶ 22, Exh. 11.

<sup>29</sup> *Id.* at 4-5, ¶¶ 11, 16; 17 TTABVUE 2-9, Exhs. 3, 12.



Mechbal Decl., 16 TTABVUE 19



Mechbal Decl., 16 TTABVUE 32



Mechbal Decl., 16 TTABVUE 97



WHEN YOU  
REACH THE  
PINNACLE OF  
EXCELLENCE,  
YOU'VE MADE  
HISTORY.

This watch is a witness to the picturesque beauty of The Evian Championship, played in the Alps overlooking Lake Geneva. Worn by those who pursue excellence at the final Major of the season, it doesn't just tell time. It tells history.



OYSTER PERPETUAL 31



THE EVIAN CHAMPIONSHIP  
EVIAN RESORT GOLF CLUB, FRANCE  
SEPTEMBER 16TH TO 19TH, 2016



Mechbal Decl., 16 TTABVUE 136

As these illustrative samples show, Opposer's HISTORY Tagline advertising uniformly includes a depiction of the ROLEX house mark in bright green lettering. The ROLEX mark is clearly the most eye-catching presentation in each advertisement. No matter the font size or style in which it is presented, the HISTORY Tagline is always shown in a muted gray color. In a good portion of Opposer's marketing pieces made of record, the font size of the HISTORY Tagline is much smaller than that of either the ROLEX mark or other textual matter on the page. *Compare Bose Corp. v. QSC Audio Prods.*, 63 USPQ2d 1303, 1306-07 (Fed. Cir. 2002) ("consumer was presented with frequent references to the product mark standing

alone and apart from the famous house mark in advertising and promotional materials, allowing the consumer to disassociate the product mark from the house mark”).

Opposer directs us to a 2013 online issue of FASHION PASSION, ranking ROLEX as a top luxury brand and stating “Rolex doesn’t just tell time, it tells history.”<sup>30</sup> The intertwining of the ROLEX mark with the HISTORY Tagline in this fashion reinforces that the HISTORY Tagline does not stand on its own as a representation of source of Opposer’s watches.<sup>31</sup>

Opposer also makes much of a 2014 article appearing in an online publication called MASHABLE, titled “Rolex: How a 109-Year-Old Brand Thrives in the Digital Age,” stating that “[o]ne of the company’s best-received campaigns is a series of commercials with the tag line, ‘It doesn’t just tell time; it tells history.’”<sup>32</sup> Reading this quote in the context of the article in its entirety, it is clear that the content is directed to the advertising industry, not to watch consumers.<sup>33</sup> We therefore find this article to be of low probative value. The test for determining acceptable analogous trademark use “is directed at **the actual perception of the potential consumers of the [goods]**, not some hypothetical person or the intent of the marketer. ... [I]t is

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<sup>30</sup> Opposer’s Brief, 32 TTABVUE 28; Opp 3<sup>rd</sup> NoR, 15 TTABVUE 44.

<sup>31</sup> The same may be said of the third-party PINTEREST postings that Opposer made of record (15 TTABVUE 75-82).

<sup>32</sup> Opposer’s Brief, 32 TTABVUE 28; Opp 3<sup>rd</sup> NoR, 15 TTABVUE 52-70 (quote at 15 TTABVUE 67).

<sup>33</sup> The same may be said of other third-party articles that Opposer made of record, such as those appearing in ECRATER (15 TTABVUE 13-14), HORBITER (15 TTABVUE 15-38) and BLND PR (15 TTABVUE 41-43).

actual public perception that is required.” *T.A.B. Sys*, 37 USPQ2d at 1883 (emphasis added).

We also find the undated Pinterest postings Opposer made of record to be unhelpful, as they merely show republished versions of Opposer’s advertising bearing the HISTORY Tagline with no further discussion.<sup>34</sup> We further find the Internet blog posts mentioning the HISTORY Tagline that Opposer provided to be of little value, because all of them are subsequent to Applicant’s application priority date and the readership volume and frequency of these blog posts were not supplied.<sup>35</sup> Note, *Proving Ownership Online ... and Keeping It: The Internet’s Impact on Trademark Use and Coexistence*, 104 TMR 1275 (INTA 2020) (“A party attempting to prove use analogous from online trademark use is well advised to show examples of how its mark is used on the site, as well as the frequency of hits to the site, any advertising responses and any business done by it during the relevant time.”).

Moreover, nowhere in the record is there evidence that Opposer ever made actual technical (affixation) trademark use of the HISTORY Tagline at any time in the 6-year period that the mark has been in use. *Westrex*, 83 USPQ2d at 1218. Thus, absent clear evidence of technical trademark use of the HISTORY Tagline within a commercially reasonable time, Opposer has in any event not perfected its purported analogous trademark use.

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<sup>34</sup> Pinterest postings, Opp 3<sup>rd</sup> NoR, 15 TTABVUE 75-82, 148-51.

<sup>35</sup> Internet blogs, Opp 3<sup>rd</sup> NoR, 15 TTABVUE 83-146.

We therefore find that Opposer has not demonstrated analogous trademark use of the HISTORY Tagline sufficient to establish priority over Applicant's STORY Tagline. *Central Garden*, 108 USPQ2d at 1142 (“[T]he touchstone of analogous use is a factual determination of whether the use of the mark has created in the minds of the relevant public an association between the goods or services and their source.”).

#### **V. Conclusion**

Opposer established its entitlement to bring and maintain a statutory cause of action for likelihood of confusion in this Opposition. However, Opposer neither properly plead nor adequately proved its trademark priority. “We need not reach the issue of likelihood of confusion because[,] without proof of priority, [O]pposer cannot prevail.” *Syngenta v. Bio-Chek*, 90 USPQ2d at 1119.

**Decision:** The Opposition is dismissed.