

This Opinion is Not a
Precedent of the TTAB

Mailed: January 31, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Audemars Piguet Holding S.A.

v.

Tenegroup Ltd
—

Opposition No. 91244316
—

John Galbreath of Galbreath Law Offices PC,
for Audemars Piguet Holding S.A.


Jonathan Agmon of Soroker Agmon Nordman,
for Tenegroup Ltd.
—

Before Adlin, Allard and Cohen,
Administrative Trademark Judges.

Opinion by Cohen, Administrative Trademark Judge:

Applicant, Tenegroup Ltd, filed an application to register the standard character mark OAK & LUNA on the Principal Register for: “jewels; clocks; chokers; jewelry chains; bracelets; rings; jewelry watches; pins, namely, cloisonne pins, jewelry pins for use on hats, lapel pins jewelry, ornamental lapel pins, ornamental pins, ornamental pins made of precious metal, pins being jewelry, tie pins, tie-pins of precious metal; pearls; necklaces; imitation pearls; semi-precious stones; rough precious stones; synthetic precious stones; spinel; jewelry, precious stones; earrings;

ear clips; ankle bracelets; bracelets of precious metal; gold; gold jewelry; gold watches; gold alloy ingots; silver watches; silver jewelry; silver alloys,” in International Class 14; and “online retail store services featuring jewels and clocks and clothing, namely, shirts, dresses, skirts, blouses, pants, suits beachwear, swimwear, underwear, sportswear,” in International Class 35 (the “Application”).¹

In its amended pleading, Opposer, Audemars Piguet Holding S.A., opposes registration of Applicant’s mark on the grounds of fraud, dilution under Trademark Act Section 43(c), 15 U.S.C. § 1125(c), and likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on its allegations of common law prior use and ownership of registrations for: the typeset mark ROYAL OAK for “horological and chronometric instruments, namely, watch cases, watch bands, chronographs for use as watches, clocks, watches, wristwatches,” in International Class 14;² and the stylized mark  for “watches and clocks and parts thereof,” in International Class 14.³ Opposer’s fraud claim is that because Applicant has not used its mark on all the identified goods and services, the Application is void ab initio.⁴ As addressed below, we construe these allegations as a claim of partial nonuse. Applicant’s operative Answer denies some of the salient allegations and admits others (addressed later in this decision), and, as an affirmative defense in the

¹ Application Serial No. 87888209, filed April 23, 2018, under Trademark Act Section 1(a), 15 U.S.C. § 1051(b), alleging first use in commerce and anywhere on March 29, 2018.

² Registration No. 2885834, issued September 21, 2004; renewed.

³ Registration No. 965112, issued July 31, 1973; renewed.

⁴ 32 TTABVUE 17.

alternative under Section 18, seeks to amend its identification of goods by deleting certain goods and services.⁵ Applicant also filed a motion to amend its identification to add “all of the aforementioned being sold exclusively online” to each class, which was deferred until final decision.⁶

The case is fully briefed. For the reasons discussed below, we (1) sustain the construed partial nonuse claim as to certain goods and services, (2) dismiss the likelihood of confusion claim regarding the remaining goods and services, and (3) dismiss the dilution and fraud claims.⁷

I. The Record

The record includes the pleadings, the file of the challenged Application pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b). It was, therefore, unnecessary for Opposer to submit TRADEMARK STATUS AND DOCUMENT RETRIEVAL (“TSDR”) copies

⁵ 34 TTABVUE 10-12; *see also* 24 TTABVUE 111.

⁶ 79 TTABVUE; 90 TTABVUE 2-3.

⁷ Citations in this opinion to the briefs refer to TTABVUE, the Board’s online docketing system. *See New Era Cap Co. v. Pro Era, LLC*, 2020 WL 2853282, at *1 n.1 (TTAB 2020). The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear.

As part of an internal Board pilot program to broaden acceptable forms of legal citation in Board cases, case citations in this opinion are in the form recommended in Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 101.03 (2024). This decision cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals by the page(s) on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). For decisions of the Board and the Director of the USPTO, this opinion cites to the Westlaw legal database (“WL”) and, in the initial full citation of a case, also identifies the Board proceeding number. Practitioners should also adhere to the citation practice set forth in TBMP § 101.03(a).

of the Application under notice of reliance.⁸ In addition, the parties introduced the following evidence:

A. Opposer's Evidence

- Copies of Opposer's pleaded registrations, showing current title and status;⁹
- Testimonial Declaration of Opposer's counsel, Sarah Morellon, with exhibits;¹⁰
- Testimony and cross-examination both upon written questions of Zur Erez, Chairman and Co-founder of Applicant;¹¹
- Testimony upon written questions of Avital Benchetrit¹², former employee and Vice President of Strategy and Innovation of Applicant;¹³
- Expert Testimony of William Rohr;¹⁴
- Expert Testimony of Stephen Pulvirent;¹⁵
- Cross-examination of John McKie, Applicant's expert witness;¹⁶
- Notices of Reliance on:

⁸ 82 TTABVUE 93-96.

⁹ *Id.* at 85-92.

¹⁰ 61-68, 70 TTABVUE.

¹¹ 88 TTABVUE; 112 TTABVUE.

¹² Opposer identifies the witness as Avital Benchetrit and so, we also identify the witness as Avital Benchetrit. We note, however, that the transcript for this testimony identifies the witness as Avital Ben Shitrit. 89 TTABVUE 4-22.

¹³ 89 TTABVUE.

¹⁴ 92-97 TTABVUE.

¹⁵ 103-108 TTABVUE.

¹⁶ 111 TTABVUE.

- Various third-party websites, Opposer’s website, and TSDR printouts of Opposer’s pleaded registrations and Applicant’s Application;¹⁷
- TRADEMARK ELECTRONIC APPLICATION SYSTEM (“TEAS”) printouts, Instagram webpages and YouTube webpages;¹⁸
- TSDR printouts of Applicant’s registrations which are not the subject of this opposition and dictionary definitions;¹⁹
- Amazon and eBay webpages;²⁰ CENSUS.GOV webpages, Opposer’s pretrial and rebuttal disclosures, webpages from Applicant’s website;²¹ and
- Applicant’s interrogatory responses and admissions, Applicant’s supplemental interrogatory responses,²² and Opposer’s responses to Applicant’s interrogatories and requests for admission.²³

B. Applicant’s Evidence

- Testimonial Declaration of Zur Erez with exhibits;²⁴
- Testimonial Declaration of John McKie with exhibits;²⁵

¹⁷ 82 TTABVUE; 85 TTABVUE; 120-22 TTABVUE.

¹⁸ 86 TTABVUE.

¹⁹ 85 TTABVUE.

²⁰ 118-19 TTABVUE.

²¹ 120 TTABVUE.

²² 83-84 TTABVUE. The correspondence submitted also includes Applicant’s supplemental responses to Opposer’s requests for documents. As explained below, responses to document requests cannot be made of record by notice of reliance unless they are otherwise admissible under Trademark Rule 2.122(e). To the extent the correspondence includes Applicant’s response that no documents exist to Opposer’s document requests, the responses have been considered. *See McGowen Precision Barrels*, 2021 WL 2138663, at *3 n.6.

²³ 122 TTABVUE.

²⁴ 98, 100 TTABVUE.

²⁵ 99 TTABVUE.

- Notices of Reliance on:
 - Third-party websites and publications;²⁶ and
 - Opposer's interrogatory responses and admissions, and responses to requests for production.²⁷

II. Evidentiary Objections

Both parties have filed objections, some of which we address immediately below. However, Applicant filed numerous objections in an appendix attached to its main brief that seek to exclude evidence that is not outcome-determinative. Given the nature and number of Applicant's objections, we need not discuss each objection. *See e.g., AT&T Mobility LLC v. Thomann and Dormitus Brands LLC*, Opp. No. 91218108, 2020 WL 730632, at *3 (TTAB 2020). Our specific rulings on any evidentiary objections not addressed immediately below are set out herein as the need arises. In general,

the Board is capable of weighing the relevance and strength or weakness of the objected-to testimony and evidence, including any inherent limitations. . . . [W]e find no basis on which to strike any testimony or other evidence. As necessary and appropriate, we will point out any limitations in the evidence or otherwise note that the evidence cannot be relied upon in the manner sought. We have considered all of the testimony and evidence introduced into the record. In doing so, we have kept in mind the various objections raised by the parties and we have accorded whatever probative value the subject testimony and evidence merit.

Luxco, Inc. v. Consejo Regulador del Tequila, A.C., Opp. No. 91190827, 2017 WL 542344, at *2 (TTAB 2017); *see U.S. Playing Card Co. v. Harbro, LLC*, Opp. No. 91162078, 2006 WL 3704640, at *4 (TTAB 2006).

²⁶ 101, 114-116 TTABVUE.

²⁷ 102 TTABVUE.

A. Opposer's Objections

Opposer objects to Applicant's Exhibits 4 and 5²⁸ of its second Notice of Reliance arguing that because the "exhibits consist of responses to requests for production of document and things," the exhibits are not permitted.²⁹ Applicant responds that its exhibits "include for example Opposer's responses to production of documents stating it has no responsive documents about certain surveys and no responsive documents about actual confusion between Opposer's marks and Applicant's marks."³⁰

To the extent Applicant's exhibits 4 and 5 of its second Notice of Reliance include Opposer's responses to Applicant's document request that no documents exist, Opposer's objection is overruled and those responses have been considered. Trademark Rule 2.120(k)(3)(ii); *McGowen Precision Barrels, LLC v. Proof Rsch., Inc.*, Can. No. 92067618, 2021 WL 2138663, at *3 n.6 (TTAB 2021).

B. Applicant's Objections

Generally, many of Applicant's objections are based on relevance, being cumulative or lack of probative value and, as noted, Board proceedings are heard by Administrative Trademark Judges, not lay jurors who might easily be misled, confused, or prejudiced by irrelevant evidence. *Cf. Harris v. Rivera*, 454 U.S. 339, 346 (1981) ("In bench trials, judges routinely hear inadmissible evidence that they are presumed to ignore when making decisions."). In this capacity, we are capable of

²⁸ 102 TTABVUE 31-61.

²⁹ 123 TTABVUE 57.

³⁰ 124 TTABVUE 60. We note Applicant's exhibits 4 and 5 in the second Notice of Reliance are redacted but no corresponding unredacted version has been made of record.

assessing the proper evidentiary weight to be accorded the testimony and evidence, taking into account the imperfections surrounding the admissibility of such testimony and evidence.

We have considered Opposer's testimony, including expert testimony, and evidence. To the extent we rely on any of the objected-to testimony and evidence, we keep in mind its deficiencies and have accorded whatever probative value the testimony and evidence merits. *U.S. Playing Card Co*, 2006 WL 3704640, at *4.

III. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action is an element of the plaintiff's case in every inter partes case. *See Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 1303 (Fed. Cir. 2020). To establish entitlement to a statutory cause of action, a plaintiff must demonstrate: (i) an interest falling within the zone of interests protected by the statute and (ii) a reasonable belief in damage proximately caused by the registration of the mark. *Id.*

Opposer's entitlement to oppose registration of Applicant's mark is established by its unchallenged pleaded registrations, which Opposer entered into the record by way of notice of reliance.³¹ *See, e.g., Shenzhen IVPS Tech. Co. v. Fancy Pants Prods., LLC*, Opp. No. 91263919, 2022 WL 16646840, at *6 (TTAB 2022) (valid and subsisting pleaded registration establishes opposer's direct commercial interest in the proceeding and its belief in damage) (citing *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945 (Fed. Cir. 2000)). Because Opposer has proven its entitlement to a

³¹ 82 TTABVUE 85-92.

statutory cause of action on one pleaded ground, it has established its entitlement for any other ground, i.e., dilution, fraud and nonuse. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1377 (Fed. Cir. 2012).

IV. Partial Nonuse, Fraud and Motion to Amend Identification of Goods and Services

We now consider the construed partial nonuse claim and proposed amendment to Applicant's identification of goods and services before our likelihood of confusion determination because it affects the scope of the identified goods and services. Moreover, if Applicant's identification of goods and services is amended, it would serve the interest of judicial economy, because if confusion is found between Opposer's watches and parts thereof vis-à-vis Applicant's goods and services as amended, it would also be found with respect to the goods and services as originally identified.

A. Partial Nonuse and Fraud

When a use-based application is involved, as in this case, a partial non-use in commerce claim under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), is based on allegations that the involved mark was not used in commerce in connection with all the recited goods or services as of the filing date of that application. An applicant's nonuse of the involved mark on some of the goods identified in the involved application results in a partial judgment to delete the goods and services on which or in connection with the mark was not used. *See, e.g., Univ. of Ky. v. 40-0 LLC*, Opp. No. 91224310, 2021 WL 839189, at *9-10 (TTAB 2021); *Grand Canyon W. Ranch*,

LLC v. Hualapai Tribe, Opp. No. 91162008, 2006 WL 802407, at *3 (TTAB 2006) (partial nonuse under Section 1(a) did not render the application void ab initio).

In its amended notice of opposition Opposer pleads that Applicant has not used, is not currently using or has not ever used its mark on clocks; jewelry watches; cloisonne pins; jewelry pins for use on hats; lapel pins jewelry; ornamental lapel pins; ornamental pins; ornamental pins made of precious metal; pins being jewelry; tie pins; tie-pins of precious metal; imitation pearls; spinel; ear clips; gold; gold jewelry; gold watches; gold allow ingots; silver watches; silver alloys; on-line retail store services featuring clocks and clothing, namely, shirts, dresses, skirts, blouses, pants, suits beachwear, swimwear, underwear, sportswear.³² These allegations are sufficient to put Applicant on notice that inasmuch as its use at the time the Application was filed is at issue, Opposer is also alleging a claim of nonuse. *See ShutEmDown Sports, Inc. v. Lacy*, Can. No. 92049692, 2012 WL 684464, at *11 (TTAB 2012) (“[T]he petition for cancellation clearly put respondent on notice that petitioner had alleged nonuse by respondent, in particular, ‘on all recited goods at the time of the application.’ ... [S]eparate pleading of a nonuse claim, while preferable, is not, however, critical, and the Board has found applications to be void *ab initio* even when nonuse was not pleaded as a separate claim or issue.”) (citations omitted). *Cf. Embarcadero Techs., Inc. v. Delphix Corp.*, Opp. No. 91197762, 2016 WL 462869, at *6 (TTAB 2016) (although claim of nonuse not separately pled, allegations in original petition for cancellation provided “sufficient notice to

³² 32 TTABVUE 9-15.

Respondent that its use at the time the statement of use was filed was at issue;” leave to amend petition granted).

We therefore construe Opposer’s operative pleading as asserting a separate claim of partial nonuse. The parties’ briefs also address Applicant’s nonuse.³³ In short, the issue of nonuse by Applicant at the time of filing its Application was clearly set out in the notice of opposition and tried by the parties.

Factual admissions in pleadings, unless amended, are considered judicial admissions conclusively binding on the party who made them and cannot be rebutted by contrary testimony or ignored by the Board. *Amgen Inc. v. Conn. Ret. Plans & Trust Funds*, 568 U.S. 455, n.6, 133 S. Ct. 1184, 185 L. Ed. 2d 308 (2013) (citing *American Title Ins. Co. v. Lacelaw Corp.*, 861 F.2d 224, 226 (9th Cir. 1988)); *Reliable Contracting Grp., LLC v. Dep’t of Veterans Affairs*, 779 F.3d 1329, 1334 (Fed. Cir. 2015) (“judicial admissions, which ‘have the effect of withdrawing a fact from issue and dispensing wholly with the need for proof of the fact,’ are limited to formal admissions made in, for example, a complaint, answer, or pretrial order.”) (quoting *American Title Ins. Co. v. Lacelaw Corp.*, 861 F.2d 224, 226 (9th Cir. 1988)); *see also Made in Nature, LLC v. Pharmavite LLC*, 2022 Opp. No. 91223352, 2022 WL 2188890, at *13 (TTAB 2022) (in contrast to an evidentiary admission, “a judicial admission ... is incapable of refutation”).

³³ See, e.g., 123 TTABVUE 44-45; 124 TTABVUE 50.

In its operative Answer, Applicant admits that as of the filing date of April 23, 2018 its mark was not used on certain goods³⁴ and sought to amend its identification of goods in an affirmative defense to “restrict the list of goods and services, which accurately reflects the goods and services offered by Applicant in connection with its ‘OAK & LUNA’ mark,”³⁵ as follows:

~~Class 14: jewels; cloaks; chokers; jewelry chains; bracelets; rings; jewelry watches; pins, namely, cloisonne pins, jewelry pins for use on hats, lapel pins jewelry, ornamental lapel pins, ornamental pins, ornamental pins made of precious metal, pins being jewelry, tie pins, tie pins of precious metal; pearls; necklaces; imitation pearls; semi-precious stones; rough precious stones; synthetic precious stones; spinel; jewelry, precious stones; earrings; ear clips; ankle bracelets; bracelets of precious metal; gold; gold jewelry; gold watches; gold alloy ingots; silver watches; silver jewelry; silver alloys.~~

~~Class 35: on-line retail store services featuring jewels and cloaks and clothing, namely, shirts, dresses, skirts, blouses, pants, suits beachwear, swimwear, underwear, sportswear.~~³⁶

In view thereof, we find that Applicant’s nonuse of OAK & LUNA for the noted goods and services at the time the Application was filed has been established.

Opposer’s claim of partial nonuse is sustained and the noted goods and services will

³⁴ Although Applicant admits it had not used its mark in connection with gold, Applicant qualifies this admission noting that “inasmuch as Applicant had not used its mark in connection with gold independently of jewelry, however Applicant has and is using its mark in connection with gold as part of its goods.” 34 TTABVUE 6 at ¶ 48. Applicant, however, in the next allegation then admits that it had not used its mark on gold jewelry at the time of filing its Application. *Id.* at ¶ 49.

³⁵ *Id.* at 5-6 at ¶¶ 34-94; see 32 TTABVUE 9-11.

³⁶ 34 TTABVUE 10-11.

be deleted from the Application in due course.³⁷ *See, e.g., Univ. of Ky. v. 40-0 LLC*, Opp. No. 91224310, 2021 WL 839189, at *10, 17 (TTAB 2021).

Even though the Application will be amended to remove those goods and services not in use, that does not avoid Opposer's fraud claim. Fraud as to any goods in a single class renders the application void as to all goods in that class; so fraud based on nonuse cannot be cured by deleting some goods from a class. *Meckatzer Lowenbrau Benedikt Weiß KG v. White Gold, LLC*, Can. No. 92051014, 2010 WL 1946273, at *3 (TTAB 2010).

Based on this record, it is clear that Applicant made a material, false representation of use as to the now-deleted goods and services that were not in use at the time of filing its Application. *See Nationstar*, 2014 WL 6480655, at *3 ("An applicant's statements as to its use of a mark for particular goods and services are unquestionably material to registrability."). The determinative issue is whether Applicant made the representation knowingly, with intent to deceive the USPTO.

We find that Opposer's evidence falls short of proving knowing intent to deceive the USPTO. "The standard for finding intent to deceive is stricter than the standard for negligence or gross negligence, and evidence of deceptive intent must be clear and convincing." *Milwaukee Elec. Tool Corp. v. Freud Am., Inc.*, Can. No. 92059634, 2019 WL 6522400, at *29 (TTAB 2019) (citing *Bose*, 589 F.3d at 1244). "Indeed,

³⁷ The remaining goods and services in the Application are: "jewels; chokers; jewelry chains; bracelets; rings; pearls; necklaces; semi-precious stones; rough precious stones; synthetic precious stones; jewelry, precious stones; earrings; ankle bracelets; bracelets of precious metals; silver jewelry" in International Class 14 and "online retail store services featuring jewelry" in International Class 35.

‘[t]here is no fraud if a false misrepresentation is occasioned by an honest misunderstanding or inadvertence without a willful intent to deceive.’” *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, Can. No. 92050879, 2013 WL 5407315, at *24 (TTAB 2013).

In spite of the admissions in Applicant’s Answer and Opposer’s evidence and allegations, “the record reveals no meaningful inquiry into the state of mind of any person who signed an application No showing of a subjective intent to deceive (an essential element of a fraud claim) arises from this record.”³⁸ *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, Opp. No. 91153147, 2014 WL 3686875, at *14 n. 69 (TTAB 2014). Even if we accept Opposer’s allegations regarding Applicant’s purported pattern of false claims,³⁹ we are not persuaded that Applicant had the necessary intent to deceive the USPTO in this Application. Intent can be inferred from indirect and circumstantial evidence but such evidence must still be clear and convincing, and inferences drawn from lesser evidence cannot satisfy the deceptive intent requirement.” *Bose*, 580 F.3d at 1245. On this record, “the overly expansive description of goods [and services], while a false statement, falls short of constituting a fraudulent statement which carries with it an actual or implied intent to deceive the USPTO.” *M.C.I. Foods, Inc. v. Bunte*, Can. No. 92045959, 2010 WL 3798506, at 5 (TTAB 2010). Absent proof of the requisite intent to mislead the PTO, “even a

³⁸ The Application was signed by Jonathan Agmon, Applicant’s attorney. April 23, 2018 Application at TSDR 1.

³⁹ *See, e.g.*, 123 TTABVUE 50 (Opposer argues that Applicant makes a habit of falsely claiming use in commerce on its previous registrations, and that establishes a pattern of behavior which is relevant to proving fraud in the present application”).

material misrepresentation would not qualify as fraud under the Lanham Act.” *Bose*, 530 F.3d at 1243.

Accordingly, Opposer’s fraud claim fails and is dismissed.

B. Section 18 Defense and Motion to Add Limitation to Amended Identification

In addition to the amendments sought in Applicant’s affirmative defense, during Opposer’s trial period and while proceedings were suspended, Applicant sought to amend its identification of goods and services to add “all of the aforementioned being sold exclusively online”⁴⁰ at the end of both classes.

Applicant asserts that if its motion to amend is granted, it consents to judgment “only with respect to the broader specification”⁴¹ and if the amendments sought in its affirmative defense are accepted, the identification would read as follows:

Class 14: jewels; chokers; jewelry chains; bracelets; rings; pearls; necklaces; semi-precious stones; rough precious stones; synthetic precious stones; jewelry, precious stones; earrings; ankle bracelets; bracelets of precious metal; silver jewelry; all of the aforementioned being sold exclusively online.

Class 35: on-line retail store services featuring jewels; all of the aforementioned being sold exclusively online.⁴²

Opposer objected to the motion to amend arguing that it was filed when this proceeding was suspended for a deposition on written questions and was not

⁴⁰ 79 TTABVUE 3.

⁴¹ 79 TTABVUE 3.

⁴² 79 TTABVUE 3-4. The proposed amended identification of goods and services incorporates the deletions included in Applicant’s affirmative defense.

germane to the matter underlying the suspension.⁴³ The Board deferred consideration of the motion to amend.⁴⁴

As recognized by Applicant,⁴⁵ a motion to amend an application “should be made prior to trial to give the opposer fair notice,” but here the motion was filed during Opposer’s trial period. *Monster Energy Co. v Lo*, Opp. No. 91225050, 2023 WL 417620, at *4 (TTAB 2023) (quoting *City of London Distillery, Ltd. v. Hayman Grp. Ltd.*, Opp. No. 91235280, 2020 WL 7258359, at *16 (TTAB 2020)); *see also* Trademark Rule 2.133(a), 37 C.F.R. § 2.133(a). Additionally, the motion to amend was contested by Opposer and not tried by implied consent.⁴⁶

In view thereof, Applicant’s motion to amend to add “all of the aforementioned being sold exclusively online” to Classes 14 and 35 is untimely and thus, denied.⁴⁷

We now turn to the likelihood of confusion claim.

V. Likelihood of Confusion

A. Priority

Because Opposer’s pleaded registrations are of record⁴⁸ and Applicant has not counterclaimed to cancel them, priority is not at issue with respect to the marks and

⁴³ 87 TTABVUE 2.

⁴⁴ 90 TTABVUE 2.

⁴⁵ 79 TTABVUE 5 (“this Motion is filed after Opposer’s trial period began”).

⁴⁶ 123 TTABVUE 54.

⁴⁷ We add that acceptance of the amendment would not change our decision herein.

⁴⁸ 82 TTABVUE 85-92.

goods and services identified in them. *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945 (Fed. Cir 2000).

B. Analysis of the *DuPont* Factors

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (setting forth factors to be considered) (“*DuPont*”). Opposer bears the burden of establishing that there is a likelihood of confusion by a preponderance of the evidence. *Cunningham*, 222 F.3d at 951. We consider the likelihood of confusion factors for which there is evidence and argument. *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379 (Fed. Cir. 2019). “Not all of the *DuPont* factors are necessarily ‘relevant or of equal weight in a given case, and any one of the factors may control a particular case.’” *Citigroup Inc. v. Cap. City Bank Grp. Inc.*, 637 F.3d 1344, 1355 (Fed. Cir. 2011) (quoting *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315 (Fed. Cir. 2003)); *In re Shell Oil Co.*, 992 F.2d 1204, 1206 (Fed. Cir. 1993) (“the various evidentiary factors may play more or less weighty roles in any particular determination”).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (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.”).

1. Similarity or Dissimilarity of the Goods and Services

We start with the second *DuPont* factor, under which we compare the goods and services as they are currently identified in the Application and the cited registrations. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1306 (Fed. Cir. 2018). It is sufficient for a finding of likelihood of confusion that identity is established for any item encompassed by the identification of goods or services in a particular class. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 1336-37 (CCPA 1981). It is also well recognized that use of the same or similar marks for goods by one party, and for services involving those or closely related goods by another, may lead to a likelihood of confusion. *See, e.g., Detroit Athletic Co.*, 903 F.3d at 1307 (finding clothing and sports apparel retail services related as “confusion is likely where one party engages in retail services that sell goods of the type produced by the other party”).

Evidence of relatedness may include news articles or evidence from computer databases showing that the relevant goods are used together or used by the same purchasers; advertisements showing that the relevant goods are advertised together or sold by the same manufacturer or dealer; or copies of prior use-based registrations of the same mark for both applicant's goods and the services listed in the pleaded registration. *See, e.g., Detroit Athletic Co.*, 903 F.3d at 1307 (relatedness supported by evidence that third parties sell both types of goods under same mark, showing that “consumers are accustomed to seeing a single mark associated with a source that sells both.”); *In re Embiid*, Ser. No. 88202890, 2021 WL 2285576, at *10 (TTAB 2021) (citing *In re Ox Paperboard, LLC*, Ser. No. 87847482, 2020 WL 4530517, at *7

(TTAB 2020); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1267-68 (Fed. Cir. 2002). The issue is not whether purchasers would confuse the goods and services, but rather whether there is a likelihood of confusion as to the source of these goods and services. *L'Oreal S.A. v. Marcon*, Opp. No. 91184456, 2012 WL 1267956, at *6 (TTAB 2012).

Applicant's operative goods and services are "jewels; chokers; jewelry chains; bracelets; rings; pearls; necklaces; semi-precious stones; rough precious stones; synthetic precious stones; jewelry, precious stones; earrings; ankle bracelets; bracelets of precious metals; silver jewelry" and "online retail store services featuring jewelry." Opposer's registrations identify both "horological and chronometric instruments, namely, watch cases, watch bands, chronographs for use as watches, clocks, watches, wristwatches" and "watches and clocks and parts thereof."

Opposer argues that the parties' goods and services are "highly similar ... because watches often contain jewels as ornamentation and are often made of or plated with precious metals, just like jewelry."⁴⁹ Opposer points to various third-parties that make and sell watches and jewelry including:

- TIFFANY.COM offering for sale earrings, bracelets, rings, necklaces and watches;⁵⁰
- JARED.COM displaying categories described as "BEST-SELLING MEN'S WATCHES," "SHOP JEWELRY BY TYPE," "SHOP EARRINGS BY TYPE";⁵¹

⁴⁹ 123 TTABVUE 15.

⁵⁰ 82 TTABVUE 8-10.

⁵¹ *Id.* at 12-13.

- ZALES.COM which reads “The Watch Guide ... find the watch that suits your personal style” and “Jewelry & Pendant Necklaces ... SHOP LAYERING NECKLACES”;⁵²
- AMERICANJEWELRYCOMPANY.COM which displays rings and necklaces and reads “What ever designer or style diamond engagement ring you are looking for its right here”⁵³ and “We’re home of the World’s Greatest Name in Swiss Timekeeping and wrist watch collections”;⁵⁴
- FOSSIL.COM which displays watches for sale and reads “Shop our selection of unique jewelry today and discover new ways to refresh your favorite wardrobe pieces”;⁵⁵ and
- TORYBURCH.COM displaying watches and earrings for sale.⁵⁶

In addressing Opposer’s evidence, Applicant argues that although “under certain circumstances jewelry and watches may be related, the circumstances are different in this case.”⁵⁷ This argument is unpersuasive.

We find that Opposer’s evidence of third-party use establishes Opposer’s watches and parts thereof are commercially related to Applicant’s various types of jewelry. *In re Davey Prods. Pty Ltd.*, Ser. No. 77029776, 2009 WL 2420527, at *5-6 (TTAB 2009). Indeed, even Applicant submitted evidence of various third-party registrations for both jewelry and watches.⁵⁸ In addition, the fact that Applicant initially sought registration of its mark for those goods and services is itself evidence

⁵² *Id.* at 15-16.

⁵³ *Id.* at 18-19.

⁵⁴ *Id.* at 20.

⁵⁵ *Id.* at 27-28.

⁵⁶ *Id.* at 30-42.

⁵⁷ 124 TTABVUE 23.

⁵⁸ *See, e.g.*, 101 TTABVUE 88, 140.

that the goods and services are related and may come from the same source under the same mark. *Octocom*, 918 F.2d at 941 (on the issue of relatedness of the applicant's "modems" and the opposer's "computer programs," the fact "that such goods might come from a single source is shown by [the applicant's] original application, which indicates [the applicant] itself used the mark OCTOCOM for both modems and computer programs"); *In re HerbalScience Grp., LLC*, Ser. No. 77519313, 2010 WL 5651672, at *3 (TTAB 2010) (applicant was found to have acknowledged the relatedness of nutritional supplements and dietary supplement drinks because the applicant originally included both sets of goods in its identification of goods).

Further, Applicant's amendments do not alter the nature of Applicant's goods and services in a meaningful way so as to avoid a likelihood of confusion. As the record shows, the same companies commonly provide both jewelry and watches under the same marks. More importantly, even if all of the amendments were accepted, that the goods and services are not identical is of no moment. The evidence shows that Applicant's goods and services are related to Opposer's goods. We need only find, and have found, that Opposer's watches and parts therefor and Applicant's jewelry and related retail store services will be encountered under circumstances that give rise to the mistaken belief that they have a common source. *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 1369 (Fed. Cir. 2012).

In view thereof, the second *DuPont* factor favors a finding of likelihood of confusion.

2. Channels of Trade, Classes of Consumers

We now consider the *DuPont* factors involving “the similarity or dissimilarity of established, likely-to-continue trade channels” and classes of consumers of the goods and services. *DuPont*, 476 F.2d at 1361.

Contrary to Applicant’s attempt to distinguish its trade channels and consumers from Opposer’s,⁵⁹ the evidence of record shows that watches and jewelry are often sold alongside each other to the same consumers. Because there are no limitations as to channels of trade or classes of purchasers in Applicant’s and Opposer’s respective identifications, we must presume that the respective goods move in all channels of trade usual for these goods, and are offered to all the usual purchasers for such goods including both online and physical retail store locations. *See Detroit Athletic Co.*, 903 F.3d at 1308 (quoting *In re i.am.symbolic, llc*, 866 F.3d 1315, 1327 (Fed. Cir. 2017) (“In the absence of meaningful limitations in either the application or the cited registrations, the Board properly presumed that the goods travel through all usual channels of trade and are offered to all normal potential purchasers.”)). We also note that Opposer’s interrogatory responses indicate that “the websites www.amazon.com and ebay.com sell new and pre-owned Royal Oak watches from non-official retailers;”⁶⁰ and that Opposer has submitted evidence of a third-party retailer selling its ROYAL OAK watches online.⁶¹

⁵⁹ 124 TTABVUE 26 (Applicant argues that its goods are sold exclusively online and Opposer’s are sold through “physical locations, namely brick and mortar high-end retail stores and/or Opposer’s own few boutiques”).

⁶⁰ 102 TTABVUE 11; *see* 118 TTABVUE 133-38; 119 TTABVUE 2-30.

⁶¹ 121 TTABVUE 17 (watch listed for sale on OAKGEM.COM).

As shown by the record, channels of trade for Applicant's goods and services as identified and Opposer's goods as identified include, or would include, online jewelry and department stores as well as brick and mortar jewelry and department stores which are, or would be, purchased by the usual classes of purchasers, which in this case include ordinary consumers. We accordingly find the channels of trade and the classes of consumers to overlap.

Accordingly, the *DuPont* factors concerning the trade channels and classes of consumers favor a finding of likelihood of confusion.

3. Purchaser Sophistication and Consumer Care

Applicant argues that because Opposer's goods are expensive costing "many tens of thousands of dollars and at times even hundreds of thousands of dollars ... Opposer's watches under the ROYAL OAK marks would not be bought on impulse, but rather by sophisticated consumers after careful consideration."⁶² In support, Applicant references Opposer's interrogatory response listing the suggested retail prices for its watches as ranging from \$11,000 - \$350,000.⁶³ Applicant asserts that its jewelry is lower priced "where the average price per item ranges around \$80 with few items sold over a hundred dollars per item."⁶⁴ Applicant asserts that "an individual purchasing Opposer's watch under the ROYAL OAK mark is not at all likely to believe they are purchasing an OAK & LUNA piece of jewelry and vice-

⁶² 124 TTABVUE 29.

⁶³ 102 TTABVUE 13-14.

⁶⁴ *Id.*; 98 TTABVUE 5 at ¶12.

versa.”⁶⁵ While the record confirms the pricing of Opposer’s goods, it also supports the pricing of jewelry by Applicant for as high as \$975.⁶⁶

Our analysis is based on the goods and services as identified in the pleaded registrations and the Application. *Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 1323 (Fed. Cir. 2014). Because neither Opposer’s identification of goods nor Applicant’s identification of goods and services contain any limitations as to pricing of products, we must consider that purchasers may include ordinary consumers who may purchase parts for their watches, or watches at varying price points, including a less expensive watch by Opposer, as nothing in the identification prevents Opposer from making such a design or product change. Moreover, precedent requires that we base our decision on the least sophisticated potential purchasers. *Stone Lion*, 746 F.3d at 1325 (relying on Board precedent requiring consideration of the “least sophisticated consumer in the class”); *Davey Prods.*, 2009 WL 2420527, at *6 (In considering that Registrant’s goods cost thousands of dollars, the Board affirms that “it is the identification of goods that controls, not what extrinsic evidence may show about the specific nature of the goods... An applicant may not restrict the scope of the goods covered in the cited registration by argument or extrinsic evidence.”) (internal citations omitted).

We therefore find the *DuPont* factor regarding purchaser sophistication and care neutral in our analysis.

⁶⁵ *Id.* at 30.

⁶⁶ 112 TTABVUE 41.

4. Strength of Opposer's Marks

Before we compare the marks, we consider the strength, including any fame, as well as any weakness of Opposer's ROYAL OAK marks. We do so because a determination of the strength or weakness of this mark helps inform us as to its scope of protection.

The fifth and sixth *DuPont* factors consider “the strength of the prior user's mark as a central factor in the likelihood of confusion analysis.” *Spireon, Inc. v. Flex LTD*, 71 F.4th 1355, 1362 (Fed. Cir. 2023) (“Two of the *DuPont* factors (the fifth and sixth) consider strength.”). We examine the conceptual strength of the mark as well. The scope of protection that is accorded a mark based on its strength may narrow with proof of third-party use demonstrating weakness in the industry or third-party registrations demonstrating that a term has a normally understood and well recognized descriptive or suggestive meaning. *See Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1339 (Fed. Cir. 2015); *Tao Licensing, LLC v. Bender Consulting Ltd.*, Can. No. 92057132, 125 WL 6336243, at *14 (TTAB 2017) (Third-party uses may bear on the commercial weakness of a mark and third-party registrations “may bear on conceptual weakness if a term is commonly registered for similar goods or services.”).

a. Conceptual Strength

We first consider the inherent, or conceptual strength, of the ROYAL OAK marks, “based on the nature of the mark itself.” *DC Comics v. Cellular Nerd LLC*, Opp. No. 91246950, 2022 WL 17832492, at *11 (TTAB 2022). Because Opposer's marks are registered on the Principal Register, without a claim of acquired distinctiveness, the

marks are presumed to be inherently distinctive for those goods. Trademark Act Section 7(b), 15 U.S.C. 1057(b); *Tea Bd. of India v. Republic of Tea, Inc.*, Opp. No. 91118587, 2006 WL 2460188, at *17 (TTAB 2006) (a “mark that is registered on the Principal Register is entitled to all Section 7(b) presumptions including the presumption that the mark is distinctive and moreover, in the absence of a Section 2(f) claim in the registration, that the mark is inherently distinctive for the goods”). In other words, ROYAL OAK is at worst suggestive because “marks that are merely descriptive cannot be registered unless they acquire secondary meaning under § 2(f) of the Lanham Act, 15 U.S.C. § 1052(f), but marks that are suggestive are ‘inherently distinctive’ and can be registered.” *In re N.C. Lottery*, 866 F.3d 1363, 1366 (Fed. Cir. 2017).

Applicant does not argue that the entire ROYAL OAK mark is conceptually or inherently weak, or that the term ROYAL OAK has a recognized meaning beyond the meaning of the separate words ROYAL and OAK, and does not assert that the term OAK is suggestive of Opposer’s goods simply noting that it is a common term and refers to a type of tree.⁶⁷ In the context of arguing dissimilarity of the marks, however, Applicant asserts that ROYAL is an adjective referring to “an item that relates to a sovereign, regal, or fit for a king or a queen.”⁶⁸ Applicant continues that it evokes the idea of something regal, noble, expensive, and luxurious; and that Opposer’s evidence indicates that ROYAL OAK “derives from British Royal Navy

⁶⁷ 124 TTABVUE 19, 22; *see* 116 TTABVUE 9, MERRIAM-WEBSTER.COM.

⁶⁸ 124 TTABVUE 20; *see* 116 TTABVUE 6-8, MERRIAM-WEBSTER.COM.

battleships which themselves were named after a famous English oak tree in Boscobel Wood where King Charles II hid from enemies following the Battle of Worcester in 1651.”⁶⁹

Applicant also includes evidence of third-party registrations which include the terms ROYAL or OAK for the same or similar goods and services as the parties, examples of which are:

- NORTHERN ROYAL for “on-line retail stores services featuring handcrafted jewelry; retail jewelry stores”;⁷⁰
- ROYAL HUMMINGBIRD for “retail jewelry stores” and “jewelry design”;⁷¹
- ROYAL TIME for “chronometers; jewellery; wristwatches; cases being parts of watches and clocks; chronographs as watches; clocks and watches, electric; jewelry boxes; watch ands; watch chains; watch pouches”;⁷²
- TUDOR ROYAL for “watches and parts thereof”;⁷³
- ROYAL AURA for “gemstone jewelry; precious and semi-precious stones; jewelry”;⁷⁴
- ROYAL JEWELRY for “wholesale and retail store services featuring jewelry”;⁷⁵
- 1OAK for “jewelry; watches”;⁷⁶

⁶⁹ 67 TTABVUE 196; 124 TTABVUE 21.

⁷⁰ 101 TTABVUE 84.

⁷¹ *Id.* at 86.

⁷² *Id.* at 88.

⁷³ *Id.* at 95.


⁷⁴ *Id.* at 97.

⁷⁵ *Id.* at 127.

⁷⁶ *Id.* at 140.

- IVYOAK for a variety of goods including “jewels; ornaments of precious metal in the nature of jewelry”;⁷⁷
- ASHCROFT & OAK for “retail stores featuring jewelry”;⁷⁸
- OAK & IVY BOUTIQUE for “on-line retail store services featuring ladies clothing, jewelry, scarves, socks, shoes and handbags; retail store services featuring ladies clothing, jewelry, scarves, socks, shoes and handbags”;⁷⁹
- CUSTOM OAKS for “cases being parts of watches and clocks; parts for watches; watch cases being parts of watches; watch parts; watch parts and fittings; all of the foregoing being made of metal”;⁸⁰ and



-  for a variety of goods including “watches.”⁸¹

None of the registrations incorporate the entirety of Opposer’s marks. Rather, each registration consists of marks with different terms with different appearances and pronunciation. *See Sabhnani v. Mirage Brands, LLC*, Can. No. 92068086, 2021 WL 6072822, at *13 (TTAB 2021) (“[W]hile the registered marks all contain the word ‘MIRAGE,’ they contain additional elements that cause many of them to be less similar to Petitioner’s mark”).

In the context of the goods, ROYAL may evoke an expensive or stylish watch and is therefore somewhat suggestive. With respect to OAK, the evidence of record shows

⁷⁷ *Id.* at 149.

⁷⁸ *Id.* at 156.

⁷⁹ *Id.* at 166.

⁸⁰ *Id.* at 244.

⁸¹ *Id.* at 252.

some third-party watches made of wood⁸² but neither Applicant nor Opposer assert their goods are made or will be made with wood. Notwithstanding the foregoing, this does not mean that ROYAL OAK, as a whole, is also suggestive and so weak as to be limited in its scope of protection. *See In re Carnation Co.*, Ser. No. 16916, 1977 WL 22612, at *2 (TTAB 1977) (“The fact that the term ‘partner’ [in the mark POTATO PARTNER] may be somewhat suggestive [for food topping] does not necessarily mean that a mark comprised in whole or in part of such term is a ‘weak’ mark entitled to but a limited scope of protection.”). To the contrary, based on this record, we find that ROYAL OAK, as used on watches and parts thereof, is arbitrary and thus, is a conceptually strong mark.

b. Commercial Strength and Fame

We next consider the commercial strength and fame of Opposer’s mark. Commercial strength or fame is the extent to which the relevant public recognizes a mark as denoting a single source. *New Era Cap Co., Inc. v. Pro Era, LLC*, Opp. No. 91216455, 2020 WL 2853282, at *12 (TTAB 2020). When fame exists, it plays a dominant role in the likelihood of confusion analysis. Indeed, famous marks “enjoy a wide latitude of legal protection.” *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 1371 (Fed. Cir. 2002) (quoting *Recot, Inc. v. Benton*, 214 F.3d 1322, 1327 (Fed. Cir. 2000)). Fame is not “an all-or-nothing factor,” however. *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 1325 (Fed. Cir. 2017). Likelihood of confusion fame “varies along a spectrum from very strong to very

⁸² *See, e.g.*, 114 TTABVUE 73-76, 87, 110.

weak.” *Id.* (quoting *Palm Bay Imps. v. Veuve Clicquot Ponsardin Masion Fondée En 1772*, 396 F.3d 1369, 1374-75 (Fed. Cir. 2005)). Fame for likelihood of confusion purposes arises as long as a “significant portion of the relevant consuming public ... recognizes the mark as a source indicator.” *Palm Bay Imps. Inc.*, 396 F.3d at 1375. “Commercial strength or fame may be measured indirectly by the volume of sales and advertising expenditures in connection with the goods or services sold under the mark, and supported by other indicia such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the goods or services identified by the marks; and the general reputation of the goods or services.” *New Era Cap*, 2020 WL 2853282, at *12.

Opposer argues that its ROYAL OAK mark is “famous in the United States due to [its] long history of use, significant sales success, extensive advertising and promotion, numerous well-known spokespeople and endorsers, sponsorship of major public events, and frequent mentions in the media.”⁸³ In support of its claim of fame and commercial strength, Opposer relies on the testimony of its in-house Senior IP

⁸³ 123 TTABVUE 20-21. The parties also reference Opposition Nos. 91242213 and 91242238 involving a third-party’s MOSSY OAK mark for watches wherein the Board, based on the facts of those cases, did not find ROYAL OAK famous. *Audemars Piguet Holding, S.A. v. Haas Outdoors, Inc.*, Opp. No. 91242213, 2023 WL 4574950, at *11 (TTAB 2023) (non-precedential). While we have considered these arguments, “[i]t is axiomatic that the ‘Board must assess each mark on its own facts and record.’” *In re Korn Ferry*, Ser. No. 90890949, 2024 WL 3219482, at *5 (TTAB 2024) (quoting *In re Am. Furniture Warehouse Co.*, Ser. No. 86407531, 2018 WL 1942214, at *7 (TTAB 2018) (citing *In re Nett Design, Inc.*, 236 F.3d 1339, 1342 (Fed. Cir. 2001)); *In re Dolce Vita Footwear, Inc.*, Ser. No. 88554717, 2021 WL 2285577, at *2 n.6 (TTAB 2021) (“Each case is decided on its own facts, and each mark stands on its own merits.”).

Counsel, Ms. Morellon, and its expert witnesses, Messrs. Rohr and Pulvirent.

According to this evidence:

- ROYAL OAK was launched in 1972 and in 2006-2012, U.S. sales of ROYAL OAK totaled \$339 million dollars;⁸⁴
- Opposer has advertised ROYAL OAK in “well-known newspapers and magazines that are widely distributed in the United States, including Time Magazine, The New York Times, Vanity Fair, Elle, The New Yorker, ... Forbes, The Wall Street Journal ...” and expenditures in the U.S. for 2015-2020 “totaled about \$4,435,866 – or about \$739,000 per year, on average”;⁸⁵
- From 2003-2013, spokespersons have included LeBron James, Jay-Z, Sahquielle O’Neal, Arnold Schwarzenegger, Rory McIlroy, and Serena Williams⁸⁶ and from 2008-2020, various “well-known American professional golfers have also served as ROYAL OAK endorsers”;⁸⁷
- Sponsorship of public events or public displays such as events in Miami and New York, ROYAL OAK clocks placed in Delta Airline terminals and Four Seasons properties in various locations in the U.S., the 2009-2014 Tony Awards where the ROYAL OAK watches were displayed and worn by celebrities, the Time to Give Foundation charity auction in 2000;⁸⁸ and
- Media coverage in the U.S. including the Los Angeles Times in 1994, Opulence Magazine in 2020, Women’s Wear Daily in 2005, Vanity Fair Magazine in 2005, The New York Times in 2011, Gentlemen’s Quarterly in 2012, The Wall Street Journal in 2013 and 2017 and Town & Country Magazine in 2018.⁸⁹

Additionally, Messrs. Rohr and Pulvirent testified as to what they believe is the extent of renown for Opposer’s ROYAL OAK mark on watches. Mr. Rohr, who has

⁸⁴ 61 TTABVUE 4, 15-16; 123 TTABVUE 27.

⁸⁵ *Id.* at 5; 63 TTABVUE 149-50; 123 TTABVUE 27.

⁸⁶ *Id.* at 5-7.

⁸⁷ *Id.* at 7.

⁸⁸ *Id.* at 7-9.

⁸⁹ *Id.* at 9-11.

over 20 years in the watch industry as journalist, designer, consultant, collector, and auctioneer, testifies that he considers ROYAL OAK watches and cufflinks famous not just with rich people but “a wide range of people around a wide geographic area ... It’s across different social classes, across different nationalities.”⁹⁰ Mr. Pulvirent, a journalist and media professional in the luxury watch industry, testifies that in his opinion, “the Royal Oak mark is extremely famous, is well-advertised well-promoted, well-publicized, has connections with celebrity, has connections with popular culture, is featured in popular culture and there has been significant effort made to make it and keep it a part of the conversation long-term”;⁹¹ and that “it is famous with the general public. It’s an extremely well-known watch, It’s one of only a handful of watches that I think the general public is aware of.”⁹²

Applicant introduced a consumer survey conducted by its expert, John McKie,⁹³ which as noted, Opposer argues is flawed.⁹⁴ Applicant argues the survey indicates that “less than 4% of the adult population in the U.S. was able to recognize ROYAL

⁹⁰ 92 TTABVUE 12-13, 168.

⁹¹ 103 TTABVUE 193.

⁹² *Id.*

⁹³ Mr. McKie was previously a Research and Direct Marketing Officer at Goodwin Group and Director of Direct Marketing and Production at McRae’s Department Stores, a division of Saks Fifth Avenue. 99 TTABVUE 4. Mr. McKie testifies that 480 surveys were completed with 409 used to calculate results and of the 409 used to calculate results, 71 were disqualified but “did not lower the percentage of the ROYAL OAK mark consumer recognition.” 99 TTABVUE 5.

⁹⁴ 125 TTABVUE 10-19.

OAK as a brand of watches. The ROYAL OAK mark was not recognized as a brand of jewelry.”⁹⁵ Mr. McKie testifies that:

the survey results demonstrate very low brand awareness of the ROYAL OAK mark in general and specifically for watches or jewelry among the general consuming public in the United States. Almost half of the respondents (49%) could not identify the term ROYAL OAK with any products, goods or services. 16% associated the ROYAL OAK mark with charcoal, 7% associated ROYAL OAK with travel, accommodation, and leisure. Only approx. 3%, or 14 respondents (of 409), associated the ROYAL OAK mark with watches. Jewelry, other than watches, did not come up once. Several other items, including furniture, woods products, and alcohol/liquor received approx. 2%-3% each.⁹⁶

Applicant’s survey, as noted, used aided questions by prompting participants with a list of questions involving three brands and specifically, ROYAL OAK, and asking them if they knew of any products associated with them. *Cf. Carefirst of Maryland, Inc. v. Firsthealth of the Carolinas, Inc.*, Opp. No. 91116355, 2005 WL 2451671, at *17 (TTAB 2005) (declining to find a mark to be well-known and famous based upon aided awareness results from brand image studies). Nonetheless, the survey corroborates what Opposer’s evidence of use reveals (as discussed below) - that ROYAL OAK is not famous.

In particular, while Opposer’s expert witnesses testified that the fame of the ROYAL OAK mark on watches goes beyond the luxury watch market into the mainstream, their underlying bases for making this conclusion is lacking. That is, Messrs. Rohr and Pulvirent rely on their personal experiences and interactions with

⁹⁵ 124 TTABVUE 33.

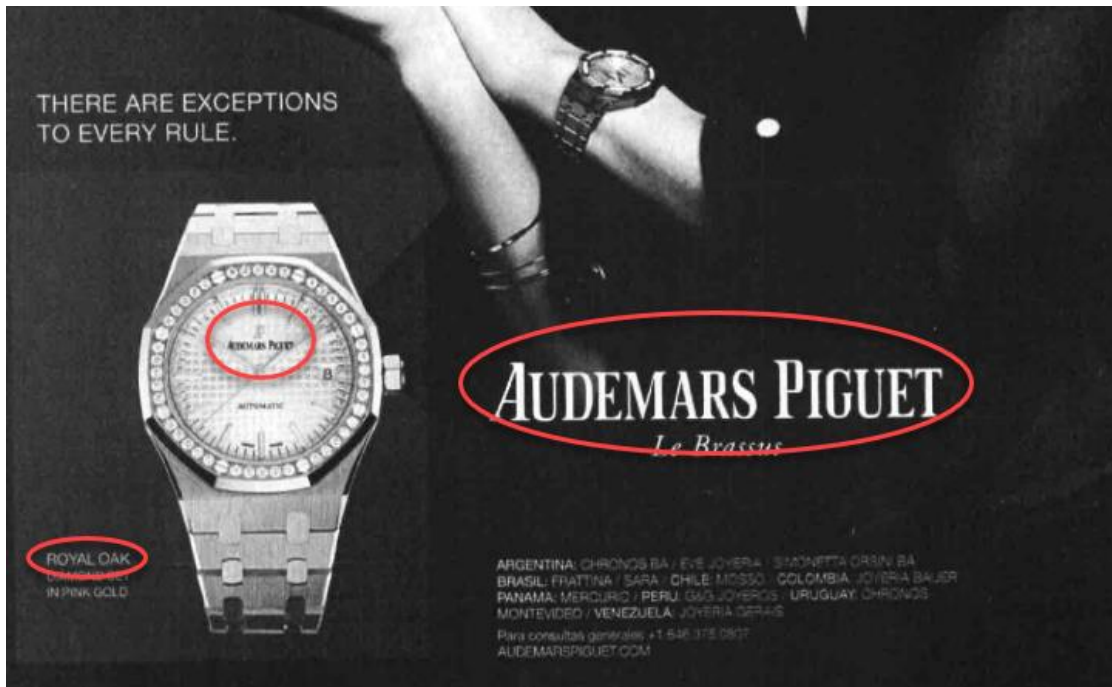
⁹⁶ 99 TTABVUE 6-15. As noted, we need not rely on the survey results in view of the other evidence of record.

individuals for their conclusions and so, their conclusions are anecdotal and not based on real data.

Opposer's evidence of sales, advertising and promotion expenditures and efforts, while in the multi-millions, is provided without context, such as market share or sales or advertising figures for comparable types of goods, to enable us to determine the extent to which Opposer's sales and expenses may indicate the well-known nature of its mark and to determine whether consumers recognize the mark. *See Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 1320 (Fed. Cir. 2018) (quoting *Bose*, 293 F.3d at 1375 ("raw numbers alone in today's world may be misleading.")). As explained in *Omaha Steaks*, "a 30-second spot commercial shown during a Super Bowl football game may cost a vast sum, but the expenditure may have little if any impact on how the public reacts to the commercial message." *Id.*

Even though the sales, promotion and advertising evidence provides some indicia of renown, Opposer's evidence indicates that its ROYAL OAK mark is almost always used and advertised along with its house mark AP or AUDEMARS PIGUET. We must assess the fame of ROYAL OAK separately from Opposer's house marks. *See Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 1374 (Fed. Cir. 2002) ("those who claim fame for product marks that are used in tandem with a famous house mark can properly be put to tests to assure their entitlement to the benefits of fame for the product marks" and "[t]he nature and context of promotion is an equally reliable measure of mark independence"); *Promark Brands Inc. v. GFA Brands, Inc.*,

Opp. No. 91194974, 2015 WL 1646447, at *12 (TTAB 2015) (“where a party’s advertising and sales data is based on materials and packaging in which the mark at issue is almost always displayed with another mark, such data does not prove that the mark at issue possesses the requisite degree of consumer recognition”). For example, Opposer submits sample advertising and promotions including:



⁹⁷ 63 TTABVUE 3.



TO BREAK THE RULES,
YOU MUST FIRST MASTER
THEM.

IN 1993, AUDEMARS PIGUET CHANGED THE WORLD OF THE SPORTS WATCH FOREVER. THE POWERFUL ARCHITECTURE OF THE ROYAL OAK OFFSHORE BECAME THE ULTIMATE STATEMENT IN PERFORMANCE HAUTE HOROLOGY.

THE 2014 ROYAL OAK OFFSHORE COLLECTION MOVES THE GAME ON ONCE MORE: THE 22 CARAT GOLD OSCILLATING MASS NOW VISIBLE THROUGH THE SAPPHIRE CASEBACK, A WINDOW ONTO 139 YEARS OF HOROLOGICAL MASTERY.



ROYAL OAK OFFSHORE
PINK GOLD
CHRONOGRAPH

AUDEMARS PIGUET
Le Brassus


AUDEMARS PIGUET BOUTIQUE: 646.375.0907
NEW YORK, 65 EAST 37TH STREET, NY 10018
BAL HARBOUR, BAL HARBOUR SHOPS, FL 866.595.9700
AUDEMARSPIGUET.COM

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⁹⁸ *Id.* at 11.

TO BREAK THE RULES,
YOU MUST FIRST MASTER
THEM.

THE VALLEE DE Joux, FOR MILLENNIA A HARSH,
UNYIELDING ENVIRONMENT, AND SINCE 1875 THE
HOME OF AUDEMARS PIGUET IN THE VILLAGE OF LE
BRASSUS, THE EARLY WATCHMAKERS WERE
SHAPE HERE, IN AWE OF THE FORCES OF NATURE,
YET DRIVEN TO MASTER ITS MYSTERIES THROUGH
THE COMPLEX MECHANICS OF THEIR CRAFT. STILL
TODAY THIS PIONEERING SPIRIT INSPIRES US TO
CONSTANTLY CHALLENGE THE CONVENTIONS OF
FINE WATCHMAKING.




AUDEMARS PIGUET
Le Brassus

ROYAL OAK
PERPETUAL
CALENDAR
50mm x 45mm
5125

.99

⁹⁹ *Id.* at 65.

THE VALLEE DE JOUX, FOR MILLENNIA A HARSH, UNYIELDING ENVIRONMENT, AND SINCE 1875 THE HOME OF AUDEMARS PIGUET, IN THE VILLAGE OF LE BRASSUS, THE EARLY WATCHMAKERS WERE SHAPED HERE, IN AWE OF THE FORCE OF NATURE YET DRIVEN TO MASTER ITS MYSTERIES THROUGH THE COMPLEX MECHANICS OF THEIR CRAFT. STILL TODAY THIS PIONEERING SPIRIT INSPIRES US TO CONSTANTLY CHALLENGE THE CONVENTIONS OF FINE WATCHMAKING.



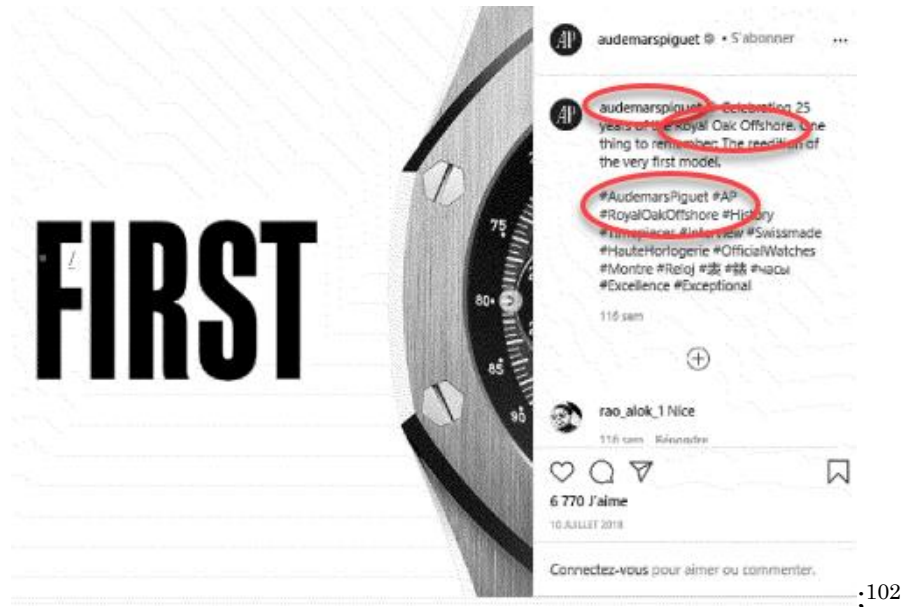
AUDEMARS PIGUET
Le Brassus

ROYAL OAK
CHRONOGRAPH
IN YELLOW GOLD

AUDEMARS PIGUET BOUTIQUES
NEW YORK - BAL HARBOUR SHOPS
BEVERLY HILLS - LAS VEGAS
CONTACT US 888.214.8858
AUDEMARSPIGUET.COM

100

¹⁰⁰ *Id.* at 75.



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audemarspiguet • The new Royal Oak Frosted Gold.

Watch yourself.

Ref. 15454BA.GG.1259BA.02

#APxCB #CarolinaBucci #IGotFrosted

#RoyalOakReflections

#AudemarsPiguet #AP

#MadameLebrassus #RoyalOak

#LimitedEdition #FlorentineFinish

#FrostedGold #SwissMade

#OfficialWatches #Montre #Reloj #表

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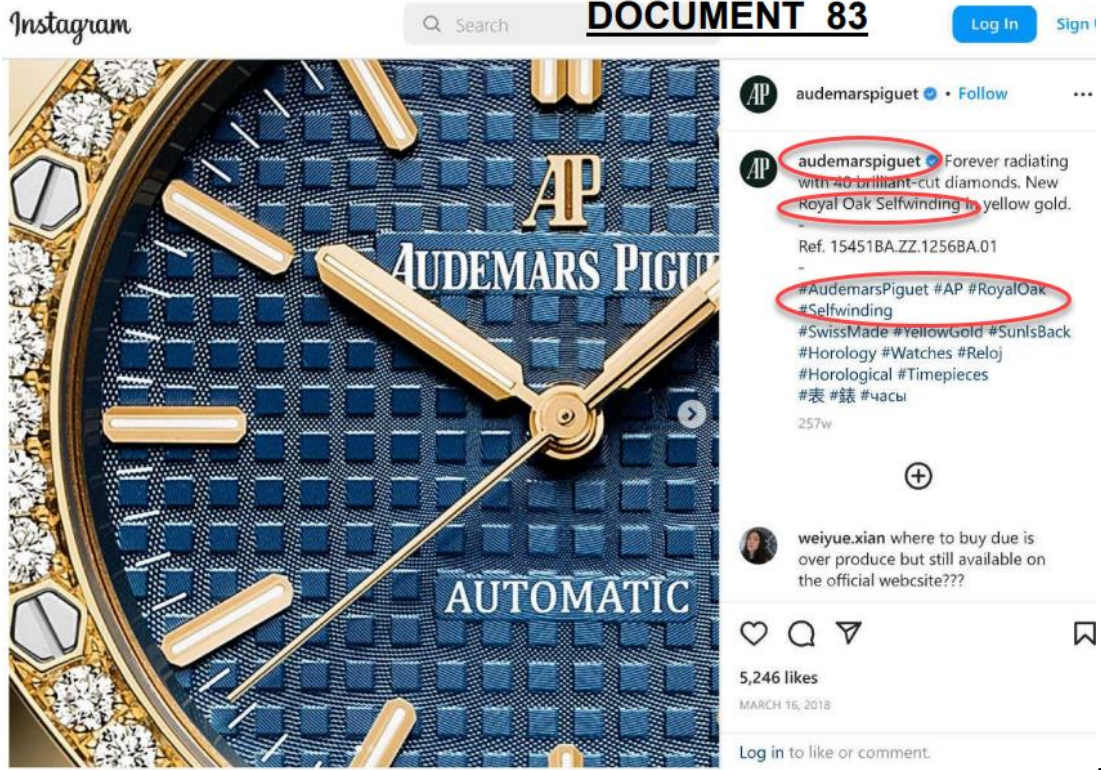
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botticelli_z 好漂亮! 能不能出一款

,103 and

¹⁰² 66 TTABVUE 4.

¹⁰³ 86 TTABVUE 117.



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We also include screenshots of some of Opposer's video submissions:

¹⁰⁴ *Id.* at 127.



,105





THE NEW ROYAL OAK
FROSTED GOLD
CAROLINA BUCCI LIMITED EDITION

AUDEMARS PIGUET
Le Brassus

;¹⁰⁶ and

¹⁰⁶ 70 TTABVUE at Exh. 446.



Additionally, in some of Opposer’s videos, the speakers, identified as either Opposer’s CEO or its Historian, refer to its watches as the ROYAL OAK OFFSHORE or just OFFSHORE.¹⁰⁸

In short, the evidence of record indicates that ROYAL OAK does not appear independent of AP or AUDEMARS PIGUET in its print or video advertising and promotion.¹⁰⁹ Indeed, ROYAL OAK is often less prominent than AUDEMARS PIGUET and ROYAL OAK frequently appears with other language such as

¹⁰⁷ *Id.* at Exh. 447. We also note that in this video, the speaker repeats AUDEMARS PIGUET twice and ROYAL OAK is spoken once.

¹⁰⁸ *See, e.g., Id.* at Exhs. 448, 464 (speakers, Opposer’s CEO and its Historian, each refer to the watch as an “offshore”), Exhs. 450-52, 463-64, 471, 488 (speakers, Opposer’s CEO and its Historian, each refer to the watch as the “Royal Oak Offshore”).

¹⁰⁹ In instances where ROYAL OAK is independent from AP or AUDEMARS PIGUET, it is typically because it is within a larger article or advertisement where AUDEMARS PIGUET or AP has already been discussed and referenced. *See, e.g.,* 64 TTABVUE 75; 70 TTABVUE (videos).

OFFSHORE or PERPETUAL CALENDAR¹¹⁰ and the watch is at times referred to by that other language.¹¹¹

As to Opposer's evidence of media coverage, although some of the coverage comes from sources with presumably large public circulation – e.g., The New York Times, The Wall Street Journal, Vanity Fair Magazine – there is no indication of just how widely the specific articles about Opposer and its ROYAL OAK mark may have circulated to the relevant purchasing public or whether the particular articles were actually read or encountered by the relevant purchasing public. Additionally, the media coverage, like Opposer's own advertising and promotion, include Opposer's AP and AUDEMARS PIGUET marks with ROYAL OAK, with AUDEMARS PIGUET being more prominent (e.g., appearing alone as a title or in bold or a different color from the text) than ROYAL OAK and again, with ROYAL OAK used with other terms such as OFFSHORE, CONCEPT, PERPETUAL CALENDAR or TOURBILLON. For example:

¹¹⁰ See also, e.g., 63 TTABVUE 7, 11, 13, 29, 43; 64 TTABVUE 168, 170, 173, 227.

¹¹¹ See, e.g., 70 TTABVUE at Exhs. 448, 450-52, 463-64, 471, 488.

19th century as anything but a roppish appendage for gentlemen of limited loins, but this handsome hanging pair could yet affect my opinion.



Audemars Piguet

The Royal Oak Offshore chronograph in its original 42mm state, despite being perhaps the most important watch design of the past 25 years, has of late been something of the forgotten man of the Audemars collection. While it was an oversized beast in 1993, more recent super-oversized models, celebrity endorsements and hip hop pageantry have, some might say, taken an unnecessarily large slice of the story. Therefore, a completely revamped range of 42mm pieces, with nary a limited edition in sight, was welcome news. Ceramic pushers and crown replace rubber, while a sapphire case-back puts the AP movement on full display, and pin buckles on the leather bracelet versions reduce the bulk. Reducing bulk, in fact, is a theme even of the (still spectacular) rose-gold version, in which 90g less mass – an easier wear – equates to several thousand pounds off the price-tag.

White ceramic was wheeled out for the Offshore in the form of a new Diver, as well as featuring in the latest, Stormtrooper-styled Royal Oak Concept GMT Tourbillon. But this was the year the 42mm ROO returned to stake its claim as the definitive luxury sports watch, and not before time.

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Rolex, Cartier and Breitling to name a few, have developed their own chronograph calibers. New calibers were introduced this year by Patek Philippe, Longines, Zenith, TAG Heuer, Montblanc, Omega, Hublot and Breguet. Today, innovations are mainly evolutionary, but technically, the newest movements are state-of-the-art, with components made of silicon and other non-friction, non-magnetic materials. Aesthetically, they generally fall into one of two categories: traditional and modern. Patek Philippe, the ultimate traditionalist, thrilled collectors this year with the Ref. 5370 split-seconds chronograph with manual-wound Calibre CHR 29-535 PS. The base calibre, the CHR-29-535 was

AUDEMARS PIGUET
ROYAL OAK OFFSHORE
SELF-WINDING TOURBILLON
CHRONOGRAPH
 THIS DISTINCTLY HIGH-TECH ROYAL OAK OFFSHORE MATCHES A FORGED CARBON CASE WITH A CERAMIC BEZEL, TITANIUM AND CERAMIC PUSHERS, AND A RUBBER STRAP. IT IS DRIVEN BY THE NEW, SELF-WINDING CALIBRE 2887 WITH A PLATINUM ROTOR WHOSE POSITION AT THE EDGE OF THE MOVEMENT REDUCES THICKNESS. THE TOURBILLON WEIGHS JUST 0.45 GRAM, WHILE THE COLUMN-WHEEL CHRONOGRAPH IS A STUDY IN MECHANICAL SOPHISTICATION.

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112 63 TTABVUE 31.

113 *Id.* at 37.

Two pages of an article

PERPETUALLY ON TIME

Audemars Piguet's Historian Michael Friedman sits down with watch expert Michael Clerizo to discuss the enduring appeal of timekeepers.

Michael Friedman loves his job—especially as he has to explain what he does to almost everyone he meets. As Audemars Piguet's in-house historian, Friedman—who, with his shaved head, glasses and salt-and-pepper beard gives off the vibe of a college professor—describes his work as “a pie with many pieces.”

Indeed it is a big pie, filled with the staples of an historian's diet: researching and writing, often in the archives maintained by the Heritage Department at Audemars

Piguet's headquarters in Le Brassus, Switzerland; traveling around the world to meet with press, current and potential collectors; a hefty program of lectures and panels about the industry and the brand's role as a family-owned company in the preservation and progress of fine watchmaking, as well as attending auctions and visits to watch dealers.

His preparation for this role began in the 1990s while still a student at Clark University where he studied psychology and interdisciplinary studies, and wrote several

papers on horology, the study of time measurement.

Before joining the company, Friedman worked as a museum curator, auction house expert, appraiser and advisor to institutions and private clients, including guitarist Eric Clapton.

“The primary function that I have is weaving the history of Audemars Piguet—the watches and watchmakers, executives and family members—into the narrative of what the company does today.”

Weaving history into present day

and



narrative ~~visual communications~~ materials such as the double-sided Royal Oak Perpetual Calendar book, which was published in 2015. The book's right hand pages tell the story of the new 41mm ROPC, while the left hand pages chronicle the history of all 188 AP vintage calendar wristwatches as well as 20 double complication wristwatches produced before 1978.

Another theme in Friedman's work is the cultural context of timekeepers and why mechanical watches remain popular. "There is a massive cultural desire to have objects that last," he says. "Everything else in our lives is really here for a moment; and as we move deeper into the digital age this is becoming the norm. But it is going to be those objects that stand in defiance of this constant obsolescence that will capture people's imagination."

For Friedman, the most prominent of those objects is the luxury, hand finished mechanical watch. "People use the word experience a lot when they talk about luxury. What they mean by experience is humanity, the desire for long lasting objects made by hand," he explains. "At our Art Basel exhibitions in our collectors lounge we always have watchmakers, finishers, dial makers and gem setters. What we have found is that everyone gravitates to where these people are working."

This year marks the fifth year of Audemars Piguet's involvement with Art Basel and Friedman says that one reason for the brand involvement is that the fair provides the opportunity to create interesting experiences for clients, like seeing an artisan at work. Art they always present an exhibition of timepieces from its museum alongside contemporary watches.

"This year we're exploring Perpetual Calendar watches, gem set watches and watches that go through metalurgical transformation like our new frosted gold watches for women. The unifying theme is nature. Perpetual calendar watches relate directly to a most important natural event: the earth's orbit around the sun," explains Friedman. "About gem set watches I always like to remind people when they are looking at a diamond set watch that gemmology is geology. Diamonds are the product of time, pressure, carbon and luck, a natural process. Watch cases and bracelets and the movement inside are created from naturally occurring materials that are transformed into something novel and interesting by the human hand applying lessons from metallurgy, physics, chemistry and engineering."

With that flourish the discussion ends, and with a knowing smile Friedman takes a pause and watches as I meditate on the lessons learned.

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¹¹⁴ Id. at 109-110.



CARNET CHAMELEON
Above and right: Carnet by Michelle Ong's ruby and diamond Captivation Kaleidoscope.
Below: the Audemars Piguet Diamond Punk

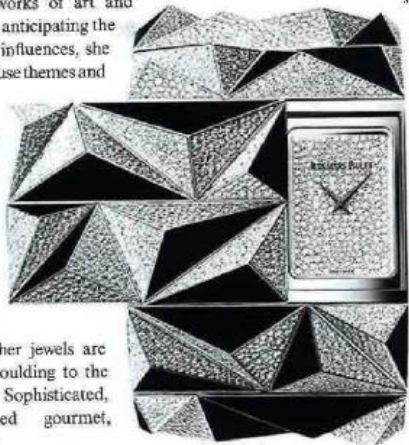


she needs to express her fantasies, helping push her ideas to the next boundary and beyond. So it was a natural progression for her to begin designing watches to meld perfectly with her jewels, to dream up a striking, stunning, statement watch to wear in the evening, for an added glug of glamour. She's made secret watches, the dial covered by a thin, translucent slice of dendritic diamond, and watches with a strong narrative and graphic theme, a choreography of Chinese fans, an ocean fantasy of shimmering sea-life and shades of blue and green. Each is one-of-a-kind; each drifts further and further away from the usual preconceptions, forms and fancies of the high-jewellery watch. Her Captivation Kaleidoscope watch, in ravishing rubies, is a dynamic, chaotic, graphic composition of circles of different sizes, styles and moods, that seem to dance and spin with every flick of the wrist, creating a kaleidoscopic illusion of constant movement. It's a clever and supremely glamorous allusion, too, to the cogs and wheels of watchmaking wizardry.

variety was named after him). The bracelet of the watch is strewn with an abundance of diamond roses and tourmaline leaves, leading round and up to the voluptuously huge centre rose, deeply three-dimensional with gorgeously glittering multi-layered petals snow-set (the random-pavé technique that is a speciality of watchmakers) with diamond dew drops. The centre of the rose lifts to reveal a small, neat watch dial, simply and charmingly reminiscent of mid-century dress watches. A ravishingly romantic take on old-fashioned glamour.

CARNET

Ms Michelle Ong, the creative force behind Hong Kong-based boutique brand Carnet, is one of a handful of individual artist-jewellers across the globe whose creations are prized by discerning collectors as contemporary works of art and future heirlooms. In the 1990s, anticipating the current wave of Asian design influences, she was one of the first jewellers to fuse themes and inspirations from East and West: a ravishing European antique lace cuff in blackened silver, or a diamond cobweb-like organdie collar, as well as a drifting calligraphic Asian cloud, or a fiery Chinese dragon. Her intuitive use of coloured gemstones is fearless; her wayward way with diamonds is delicate yet powerful, and most off all, her jewels are fluid, superbly articulated, moulding to the body like a second skin. Sophisticated, cosmopolitan, a renowned gourmet,



AUDEMARS PIGUET

If you needed any more confirmation that this is the year of the high-glamour, high-drama high-jewellery watch, then just look at what fiercely traditional watchmaker Audemars Piguet has done. A startling departure from their previous forays into jewels and gems, a world away from a diamond-encrusted Royal Oak, their sensational Diamond Punk watch packed a mighty punch at this year's SIHH. A deep cuff bracelet spiked all around with 56 daring, dazzling, diamond-glinting pyramidal facets, it has a section that slides smoothly away to reveal a rectangular diamond-set dial. Sharp, chic and excitingly edgy, this is a jewellery watch to make a strong style statement. As the name suggests, the design was inspired by punk style, by angry studs, spikes, straps and hardware. Jewels with a flash and frisson of danger and the rush of rebellion. The uncompromisingly graphic, barbaric yet super-sophisticated Diamond Punk certainly screams rebellion, pushing boundaries, breaking the mould of the hyper-feminine jewellery watch, challenging preconceptions of gems and glamour. Which is all, in fact, appropriate for Audemars Piguet, one of the oldest family-owned watch manufacturers, which prides itself on its spirit of independence. With Diamond Punk, it has mined that rebellious seam of singularity and at the same time showcased its extensive expertise, both technical and creative. The monumental scintillating shackles took some 1,440 hours to


CARNET BY MICHELLE ONG (ALL CARNET PICS)

and

115 *Id.* at 47.

Audemars Piguet is all over Manhattan's 34th Street Heliport

Sell Your Watch For Cash
We Buy All Luxury Watches. #1 in New York City. Call Today!
www.buyersofnewyork.com

AdChoices 




PHOTO CREDIT: Albert Ferreira/startrakphoto.com

We live in an era where advertising stunts go a long way in strengthening businesses and attracting potential clients. Subscribing to the prevailing trend is Audemars Piguet that has partnered with Roaring Thunder Media to capture Manhattan's 34th Street Heliport through an innovative medial program. The custom-tailored "domination program" entails Audemars Piguet brand to feature exclusively on all interior and exterior signage, state-of-the-art digital monitor at NYC's prime location. The domination program for Audemars Piguet includes five backlit interior static duratrans, a state-of-the-art digital monitor, Extra-thin Royal Oak Tourbillon in stainless steel emblazoned on the tarmac and the Royal Oak Chronograph featured in rose gold. (Iconic design that commemorates the brand's 40th anniversary)

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In support of Applicant's contention that Opposer's mark is commercially weak, Applicant submits evidence of third-party uses of the terms OAK or ROYAL with jewelry, such as:

- SOLIDOAKINC.COM website which displays and lists Solid Oak's "Jewelry Collections";¹¹⁷
- OAKGEM.COM website which describes Oak Gem Fine Estate and Designer Jewelry as a store that "For over 30 years, we have dealt with the purchase and sale of fine estate and designer signed jewelry" and appears to have links to "NEW JEWELRY," "ESTATE JEWELRY" and "TIMEPIECES";¹¹⁸
- STONEOAKJEWELERS.COM website which describes STONE OAK JEWELRS as a jeweler and jewelry store;¹¹⁹
- WOODWATCH.COM website listing a "French Oak Wine Barrel" watch for sale;¹²⁰
- LIVEOAKJEWELRY.COM website which reads that LIVE OAK JEWELRY has a "Wide assortment of engagement rings, pendants, watches, and more" and displaying wedding bands and watches;¹²¹
- NYWATCHSTORE.COM website listing for a "Men's Fossil Oak Barrel Chronograph Sports Watch" which also indicates that the "item is no longer available";¹²²
- OAKANDOSCAR.COM website displaying an OAK & OSCAR branded watch for sale;¹²³
- HAVENWATCHES.COM website displaying "The Orion White Oak" watch for sale;¹²⁴

¹¹⁷ 114 TTABVUE 66-68.

¹¹⁸ *Id.* at 69.

¹¹⁹ *Id.* at 71.

¹²⁰ *Id.* at 73-76.

¹²¹ *Id.* at 78.

¹²² *Id.* at 79.

¹²³ *Id.* at 81.

¹²⁴ *Id.* at 87.

- OAKANDJACKAL.COM website displaying OAK & JACKAL branded watches for sale;¹²⁵
- 1OAK.COM website displaying rings, bracelets, earrings and necklaces for sale;¹²⁶ and
- ZADOK.COM displaying watches for sale including TUDOR Royal 41 Brown Dual Steel Watch, TUDOR Royal 34 Brown Dual Steel Watch, TUDOR Royal Mother of Pearl with Diamon Bezel Watch;¹²⁷

While these third-party uses contain ROYAL or OAK, suggesting that ROYAL or OAK are not unique for watches or jewelry, these uses contain different terms, designs and other matter that render them dissimilar to Opposer's mark. Further, there is no other information about these third-party uses (consumer exposure, length of use, etc.) that would support a finding that consumers may have become so accustomed to encountering ROYAL or OAK marks that they are conditioned to overlook any similarity in marks containing the term ROYAL or OAK.

Although the record shows that Opposer has used its ROYAL OAK mark since at least 1972 and gone to great efforts and expense to promote its ROYAL OAK mark to the general public, in view of the evidence regarding the use of ROYAL OAK with additional terms or in connection with AP, AUDMARS PIGUET, we find the mark is not famous but falls on the higher end of the fame/commercial strength spectrum for watches.

¹²⁵ *Id.* at 92-103.

¹²⁶ *Id.* at 107.

¹²⁷ 114 TTABVUE 121-23.

c. Conclusion

On balance, after consideration of the parties' arguments and the record, including evidence not specifically mentioned, we find that Opposer's ROYAL OAK mark is conceptually and commercially strong, although not a famous mark. *See Joseph Phelps Vineyards*, 857 F.3d at 1325 (an opposer's mark's renown may "var[y] along a spectrum from very strong to very weak.") (internal quotations omitted). Upon consideration of the record and arguments, we find these factors favor a finding of likelihood of confusion.

5. Similarity or Dissimilarity of the Marks

We next compare Applicant's OAK & LUNA mark with Opposer's ROYAL OAK marks "in their entirety as to appearance, sound, connotation and commercial impression." *In re Viterra*, 671 F.3d 1358, 1362 (Fed. Cir. 2012) (quoting *DuPont*, 476 F.2d at 1361). The issue 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. *Coach Servs.*, 668 F.3d at 1368 (Fed. Cir. 2012); *Stone Lion*, 746 F.3d at 1322; *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 1007 (CCPA 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion."). Therefore, "[t]he focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks." *In re Assoc. of the U.S. Army*, Ser. No. 76578579, 2007 WL 1033481, at *2 (TTAB 2007).

While the appearance of the marks is somewhat similar because they share the term OAK, the additional terms in each mark add a measure of difference in the marks. *See Be Sport, Inc. v. Al-Jazeera Satellite Channel*, Opp. No. 91213743, 2015 WL 5118060, at *4 (TTAB 2015) (finding the prior mark BEIN and the subsequent mark BEIN SPORT to create different commercial impressions); *Lever Brothers Co. v. Barcolene Co.*, 463 F.2d 1107, 1108-09 (CCPA 1972) (ALL and ALL CLEAR different in commercial impression). Applicant's mark begins with the term OAK whereas Opposer's begins with ROYAL. Further, the additional terms – LUNA in Applicant's mark and OAK in Opposer's marks – have equal impact because each term, from a conceptual viewpoint, is equally strong as none of the terms have a descriptive significance in connection with the relevant goods and services. The additional terms also differentiate the marks as to sound and cadence. Even though the marks share the term OAK, the additional, distinct terms in each of the party's marks results in marks that when viewed in their entirety, differ significantly in appearance, pronunciation, and impression.

Further, when ROYAL OAK is encountered by consumers, the connotation engendered is that of an oak tree that is regal or fit for a king or queen.¹²⁸ In fact, evidence submitted by Opposer shows it has included in its promotional materials for its ROYAL OAK watches details about King Charles II of Scotland hiding from Oliver Cromwell inside the hollow of an old oak tree known as the Royal Oak.¹²⁹ This

¹²⁸ 116 TTABVUE 7, MERRIAM-WEBSTER.COM.

¹²⁹ 104 TTABVUE 181.

indicates that a consumer would likely perceive ROYAL OAK when applied to Opposer's goods as being a tree fit for a king or queen. Conversely, Applicant's OAK & LUNA does not have a similar meaning and is instead likely to be perceived as arbitrary, a reference to nature, or perhaps the names of people associated with Applicant.

This difference in commercial impression and connotation, along with the difference in sight and sound, lead us to find that the marks are more dissimilar than similar. *See In re P. Ferrero & C.S.p.A.*, 479 F.2d 1395, 1397 (CCPA 1973) (TIC TAC TOE creates a different impression than TIC TAC); *In re Aquamar, Inc.*, Ser. No. 85861533, 2015 WL 4269973, at *6 (TTAB 2015) (applying doctrine of foreign equivalents, finding identity in meaning outweighed differences in appearance and sound between MARZUL and BLUE SEA).

Any of the *DuPont* factors may play a dominant role. *DuPont*, 476 F.2d at 1361. In fact, in some cases, a single factor may be dispositive. *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 333 (Fed. Cir. 1991). The dissimilarity of the marks in appearance, sound, meaning and commercial impression is so great as to outweigh the second, third, and fourth *DuPont* factors. *See, e.g., Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 1375 (Fed. Cir. 1998) (Court affirmed Board finding no likelihood of confusion between mark CRYSTAL CREEK for wine and marks CRISTAL for wine and CRISTAL CHAMPAGNE for champagne, where dissimilarity of marks was dispositive).

Here, the first *DuPont* factor is pivotal, weighing against a finding that confusion is likely.

6. Actual Confusion

We now address the seventh *DuPont* factor, the “nature and extent of any actual confusion,” and the related eighth *DuPont* factor, the “length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” *DuPont*, 476 F.2d at 1361. In assessing these factors, we are required to look at actual market conditions, to the extent there is evidence of such conditions of record. *See In re Guild*, 912 F.3d at 1379; *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406 (Fed. Cir. 1997).

Although Opposer did not produce any evidence of confusion,¹³⁰ Opposer argues that the “reason there has not been more actual confusion reported to date is because [A]pplicant only began selling OAK & LUNA products in March 2018, or little more than six months before the instant opposition was filed”;¹³¹ and that Applicant is “relatively small” but should the OAK & LUNA business grow, it “will no doubt increase the consumer confusion.”¹³²

Applicant argues that in spite of using its OAK & LUNA mark since 2018 “with sales exceeding US\$75 million between 2018 and 2022” there has been no instances of confusion.¹³³

¹³⁰ 102 TTABVUE 42.

¹³¹ 123 TTABVUE 25.

¹³² *Id.*

¹³³ 124 TTABVUE 45.

“The absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by applicant of its mark for a significant period of time in the same markets as those served by opposer under its mark[].” *Citigroup Inc. v. Cap. City Bank Grp., Inc.*, Opp. No. 91177415, 2010 WL 595586, at *17 (TTAB 2010). “In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred.” *Made in Nature, LLC v. Pharmavite, LLC*, Opp. No. 91223352, 2022 WL 2188890, at *30 (TTAB 2022).

We do not have enough information concerning the nature and extent of Applicant’s use or advertising to determine whether there has been sufficient opportunity for confusion to occur. Applicant’s claim that no instances of actual confusion have occurred is not indicative of an absence of a likelihood of confusion. *See Gillette Canada Inc. v. Ranir Corp.*, Opp. No. 91082769, 1992 WL 215312, at *6 (TTAB 1992). In any event, we are mindful that the test under Section 2(d) of the Act is likelihood of confusion, not actual confusion.

We therefore find this factor to be neutral.

7. Conclusion

We have considered all of the evidence relating to the *DuPont* factors, including those that have not been discussed, and conclude that notwithstanding the close similarities of the goods and services, overlap in channels of trade and classes of purchasers, and strength of Opposer’s mark, the marks are too dissimilar to warrant a determination of likely confusion. We find that the first *DuPont* factor, the differences in the marks, outweigh the other factors. *See Oakville Hills Cellar, Inc.*

v. Georgallis Holdings, LLC, 826 F.3d 1376, 1381-82 (Fed. Cir. 2016) (quoting *Odom's Tenn. Pride Sausage, Inc. v. FF Acquisition, LLC*, 600 F.3d 1343, 1346-47 (Fed. Cir. 2010) (“[A] single *DuPont* factor ‘may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks.”)); *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 1375 (Fed. Cir. 1998) (“[O]ne *DuPont* factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks.”). We have considered the marks in their entireties, and in doing so, find that the differences between them are substantial and sufficient to distinguish the marks.

The likelihood of confusion claim is dismissed.

VI. Dilution

Dilution by blurring is “association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.” Trademark Act § 43(c)(2)(B); 15 U.S.C. § 1125(c)(2)(B). Dilution may be likely “regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.” Trademark Act § 43(c)(1); 15 U.S.C. § 1125(c)(1). To prevail on a claim of dilution by blurring, a plaintiff must prove:

- (1) the plaintiff owns a famous mark that is distinctive;
- (2) the defendant is using a mark in commerce that allegedly dilutes the plaintiff's famous mark;
- (3) the defendant's use of its mark began after the plaintiff's mark became famous; and
- (4) the defendant's use of its mark is likely to cause dilution by blurring.

Coach Servs., 668 F.3d at 1373-74 (Fed. Cir. 2012).

“A mark can acquire ‘sufficient public recognition and renown to be famous for purposes of likelihood of confusion without meeting the more stringent requirement for dilution fame.’” *Coach Servs.*, 668 F.3d at 1373 (quoting *7-Eleven Inc. v. Wechsler*, Opp. No. 91117739, 2007 WL 1431084, at *7 (TTAB 2007)). Where, as here, a mark is not proven famous for purposes of likelihood of confusion, it will certainly not meet the higher threshold for fame required to prove dilution.

Given our determination above that Opposer has failed to prove the fame of its marks for purposes of its likelihood of confusion claim, Opposer cannot show that its marks are famous for dilution purposes and thus cannot meet its burden of proving dilution. *See Palm Bay Imports Inc.*, 396 F.3d at 1375; *Coach Servs.*, 668 F.3d at 1373 (“Fame for likelihood of confusion and dilution are distinct concepts. Fame for dilution requires a more stringent showing.”).

The dilution claim is dismissed.

VII. Summary and Decision

We sustain Opposer’s partial nonuse claim as to “clocks, jewelry watches, cloisonne pins, jewelry pins for use on hats, lapel pins jewelry, ornamental lapel pins, ornamental pins, ornamental pins made of precious metal, pins being jewelry, tie pins, tie-pins of precious metal, imitation pearls, spinel, ear clips, gold, gold jewelry, gold watches, gold alloy ingots, silver watches, silver alloys” in International Class 14, and “on-line retail store services featuring clocks and clothing, namely shirts, dresses, skirts, blouses, pants, suits beachwear, swimwear, underwear, sportswear” in International Class 35.

We dismiss the likelihood of confusion claim regarding OAK & LUNA for “jewels; chokers; jewelry chains; bracelets; rings; pearls; necklaces; semi-precious stones; rough precious stones; synthetic precious stones; jewelry, precious stones; earrings; ankle bracelets; bracelets of precious metals; silver jewelry” in International Class 14 and “online retail store services featuring jewelry” in International Class 35. We also dismiss the dilution and fraud claims.

Decision: The opposition is sustained in part and dismissed in part.