

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
September 12, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Omega SA (Omega AG) (Omega LTD.)

v.

Derral Leon Reynolds

Opposition No. 91197643

Ser. No. 77959566
—

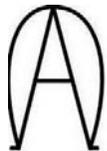
Jess M. Collen, Thomas P. Gulick and Oren Gelber of Collen IP
for Omega SA (Omega AG) (Omega LTD.).

Derral Leon Reynolds, pro se.
—

Before Zervas, Gorowitz, and Lynch, Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Derral Leon Reynolds (“Applicant”) filed an application to register the mark



for “jewelry” in International Class 14.¹ The originally-filed application

¹ Application Serial Number 77959566, filed March 15, 2010, on the basis of intent-to-use, pursuant to Trademark Act § 1(b), 15 U.S.C. § 1051(b).

includes the following description of the mark: “The mark consists of the Greek letter Alpha nestled inside of the Greek letter Omega.”

Omega S.A. (Omega AG) (Omega Ltd.) (“Opposer”) opposed the application on the grounds of (i) priority and likelihood of confusion pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d); and (ii) dilution pursuant to Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c). Opposer alleges that it is the owner of, *inter alia*, the following registrations for famous marks, collectively referred to as “the Omega Marks”:



1. Reg. No. 025036 for **OMEGA** for “watch movements and watch cases” in International Class 14 (issued May 23, 1894; renewed July 26, 2014);
2. Reg. No. 0566370 for the stylized mark **OMEGA** for “watches and parts thereof” in International Class 14 (issued November 4, 1952; renewed November 4, 2012);



3. Reg. No. 578041 for **OMEGA** for “watches (including pocket watches, wrist watches with or without straps, bands or bracelets, pendant watches, calendar watches, and stopwatches) either stem-wind or automatic; clocks; chronometers, chronographs, and parts for all of the foregoing” in International Class 14 (issued July 28, 1953; renewed July 5, 2013);



4. Reg. No. 660541 for **OMEGA** for “automatic recording machines and apparatus for use in determining the results of sporting events-namely,

electrical or mechanical equipment for determining elapsed times in games or sporting events comprising a plurality of instruments for placement at the starting and finishing lines of a racing course, the same being electrically operated and connected to and actuated by the starting gun or other signal so as to automatically provide a permanent visible record of the order in which one or more contestants finish the race and of the corresponding elapsed times” in International Class 9 (issued April 15, 1958; renewed May 9, 2008);

5. Reg. No. 1290661 for  for “watch cases” in International Class 14 (issued August 21, 1984; renewed October 17, 2014);

6. Reg. No. 1969071 for  for “metal key rings” in International Class 6; “pens and pencils; namely, mechanical pencils and ball point and felt-tip pens” in International Class 16; “umbrella and parasols” in International Class 18; and “scarves and neckties” in International Class 25 (issued April 23, 1996; renewed August 5, 2006); and

7. Reg. No. 3146117 for  for “retail store services featuring watches, clocks, horological and chronometric instruments and their accessories, jewelry” in International Class 35 (issued September 19, 2006; Section 8 accepted).

In addition, Opposer alleges use of the mark OMEGA since at least as early as 1894, and use of such marks in connection with a variety of goods including jewelry and accessories, and watches.²

² Notice of Opposition ¶¶ 2 and 6, 1 TTABVUE 8 and 10.

In his answer, Applicant denied all of the salient allegations in the notice of opposition. The Board has received a brief only from Opposer.

Evidentiary issues.

Opposer filed a motion to strike the majority of the evidence Applicant submitted by notice of reliance. Because Applicant did not respond to the motion, the Board granted Opposer's motion on April 21, 2015 and struck most of Applicant's evidence.³

Opposer also discusses (i) Applicant's Exhibits 15 – 17, which consist of material from a book apparently authored by Applicant, and (ii) Exhibits 23-24, which consist of third-party trademark applications and registrations, and argues that this evidence should be accorded little weight. We need not reach Opposer's arguments regarding the material from the book because this material is not important to the disposition of this opposition. We discuss the third-party applications and registrations later in this opinion.

The record.

By rule, the record includes Applicant's application file and the pleadings. Trademark Rule 2.122(b), 37 CFR § 2.122(b). The record also includes the following:

Introduced by Opposer:

1. The testimony deposition of Gregory Swift, Brand Manager for the Omega division of the Swatch Group U.S, and exhibits thereto, (Swift Test.) (public document at 52 TTABVUE and confidential document at 53 TTABVUE);

³ 51 TTABVUE.

2. Status and title copies of Opposer's pleaded registrations submitted with Opposer's Notice of Reliance (44 TTABVUE);
3. Applicant's responses to certain Interrogatories and Requests for Admissions submitted with Opposer's Notice of Reliance (44 TTABVUE);
4. Articles and advertisements from various publications submitted with Opposer's Notice of Reliance (44 TTABVUE);
5. Webpages from OMEGA museum website regarding Opposer submitted with Opposer's Notice of Reliance (44 TTABVUE);
6. Third-party applications and registrations for OMEGA marks submitted with Opposer's Rebuttal Notice of Reliance (50 TTABVUE); and
7. Pages from Opposer's website submitted with Opposer's Rebuttal Notice of Reliance (50 TTABVUE).

Introduced by Applicant, by notice of reliance:

1. Opposer's responses to certain Requests for Admissions (48 TTABVUE);
2. A third-party application and third-party registrations (48 TTABVUE); and
3. Pages from Opposer's website (48 TTABVUE).

Standing

Standing is a threshold issue that must be proven by a plaintiff in every *inter partes* case. To establish standing in an opposition or cancellation proceeding, a plaintiff must show "both a 'real interest' in the proceedings as well as a 'reasonable basis' for its belief of damage." *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014) (quoting *ShutEmDown Sports, Inc., v. Lacy*, 102 USPQ2d 1036, 1041 (TTAB 2012)); *Ritchie v. Simpson*, 170 F.3d

1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). The Court of Appeals for the Federal Circuit has enunciated a liberal threshold for determining standing in Board proceedings. *Ritchie v. Simpson*, 50 USPQ2d at 1030.

Opposer has made its pleaded registrations of record, and has demonstrated use of its pleaded marks in connection with various goods, including jewelry. Opposer therefore has established that it has a personal stake in the outcome of this proceeding, and we find that Opposer has established its standing.

Priority

Priority is not an issue with respect to Opposer's pleaded registrations, which Opposer has properly made of record through the submission of status and title copies of such registrations with Opposer's notice of reliance. *See King Candy Co. v. Eunice King's Kitchen*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1167 (TTAB 2001).

Opposer also asserted common law use of its marks in connection with a variety of goods, including jewelry, prior to the filing date of Applicant's intent-to-use application. Through testimony and documentary evidence, Opposer has established it has used the Omega Marks for jewelry prior to the filing date of Applicant's application.⁴ Opposer therefore has priority of use for jewelry.

⁴ *See* Swift Tr. at 10-14 and Ex. 11-12, 52 TTABVUE 12-16, 87-196; Swift Tr. at 77-80 and Ex. 24, 52 TTABVUE 64-67, 241; App.'s NOR, Ex. 5, Request for Admission No. 30, 48 TTABVUE 39; App.'s NOR, Ex. 31, 48 TTABVUE 240.

Likelihood of Confusion

Our determination of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.* 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). *See also In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

A. Fame of Omega Marks.

When an opposer's mark is famous, that fact “plays a ‘dominant role in the process of balancing the *DuPont* factors,’ ... and ‘[f]amous marks thus enjoy a wide latitude of legal protection.” *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002) (quoting *Recot, Inc. v. Benton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000)). It is settled that a strong mark “casts a long shadow which competitors must avoid.” *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

In the absence of direct evidence of fame, “fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident.” *Bose*, 63 USPQ2d at 1305. Other relevant factors include “length of use of the mark, market share, brand awareness, licensing

activities, and variety of goods bearing the mark.” *Coach Services, Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012).

Opposer has been selling its timepieces under the trademarks OMEGA and Ω OMEGA in the United States for over 100 years.⁵ Opposer’s goods are sold in Opposer’s boutiques, and through third-party authorized dealers.⁶

Opposer has submitted into the “confidential” record dollar figures reflecting Opposer’s sales and advertising expenses in the United States. Because they are designated “confidential,” they therefore will not be discussed specifically herein. Suffice it to say that from 1999 through 2009, Opposer’s sales of OMEGA-branded products, and its related advertising expenses from 2000-2009, have been significant.⁷

Furthermore, Opposer has received unsolicited media attention from and promoted its watches bearing the Omega Marks in a number of well-known publications. For example, OMEGA-branded watches have appeared in *The New York Times*, *O! Oprah Magazine*, *GQ*, *Harper’s Bazaar*, *hr.*, *Maxim*, *Men’s Vogue*, *Golf Digest*, *Chronos*, *Guitar Aficianado*, *OK! Magazine*, *WWD (Women’s Wear Daily)*, *Allure*, *Ebony*, *Elle*, and *Esquire*.⁸

⁵ Swift Tr. 15-18, 52 TTABVUE 17-20.

⁶ Swift Confidential Tr. 21, 53 TTABVUE 6. This information has been submitted under seal, but clearly is not confidential, as this information would be known to Applicant’s consumers.

⁷ Swift Tr. at 22-34, and Exs. 20-26; 53 TTABVUE 7-41, 35-51.

⁸ Opposer’s Notice of Reliance, Exs. 12-16, 21, 23, 26, 27, 30, 40, 52, 58, 62, 69 and 70; 52 TTABVUE 61-79, 88, 92, 98, 100, 106, 136, 165, 181, 190, 216 and 218.

Opposer's Olympic and other sponsorships and timekeeping responsibilities at significant sporting events have resulted in its Omega Marks being displayed at such events.⁹ Further, Opposer's "ambassadors," who "represent and promote the brand" appear in Opposer's advertising, include celebrities such as George Clooney, Nicole Kidman, Cindy Crawford, Daniel Craig, Michael Phelps and Anna Kournikova.¹⁰ As a result of "product placement" relationships, Opposer's watches have been featured in "James Bond" films and the film "Apollo 13."¹¹

Opposer has not provided any context for its advertising and sales figures, such as how the figures for watches bearing the Omega Marks compare with other brands of watches. *See Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1831 (TTAB 2012); *see also, Bose*, 63 USPQ2d at 1309 ("some context in which to place raw statistics is reasonable"). There also is no admissible evidence of the circulation figures for the various publications cited, or attendance/viewing figures for the movies in which Opposer's products have appeared.

Nonetheless, we do not require evidence to recognize that *The New York Times*, *USA Today*, *Sports Illustrated*, "James Bond" and "Apollo 13" films and Opposer's celebrity endorsers are well-known and popular. Considering the totality of Opposer's fame evidence, we find based on Opposer's century-long use of OMEGA for watches, significant sales success, intensive advertising, widespread unsolicited media

⁹ Swift Tr. 58-62, 52 TTABVUE 46-50.

¹⁰ Swift Tr. 51-52 and Ex. 28, 52 TTABVUE 39-40, 362.

¹¹ Swift Tr. 45-49 and Exs. 15-17, 52 TTABVUE 33-37, 217-225.

attention and association with prominent sports events and celebrities, that Opposer's Omega Marks are famous, but only for watches. *See Inter Ikea Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014) (recognizing similar deficiencies in the opposer's evidence of fame, but nonetheless finding fame for the opposer's primary service, acknowledging that context and “comparative information may be difficult, if not impossible to obtain, because companies may view such information as proprietary and not disclose it publicly”).

B. Similarity or dissimilarity of the goods.

Inasmuch as Applicant’s application recites “jewelry” as goods and Opposer has established that it uses the Omega Marks on jewelry, the goods are identical. As for Opposer’s watches and pendants, set forth in one or more of its registrations for the Omega Marks, Opposer has not submitted evidence to show a relationship between the two, and in fact, Opposer successfully sought to strike the evidence Applicant submitted which demonstrates a commercial relationship between the goods.¹² Watches and jewelry are related, however, because, at a minimum, some watches, especially those containing gemstones, may be considered a form of jewelry.

As Mr. Swift testified:

Q. “When we talk about jewelry line of products, we’re also including watches as part of the jewelry line of products, correct?”

A. “Correct.”¹³

¹² See Ex. 32 to Applicant’s NOR, 48 TTABVUE 245, stricken by the Board in its April 21, 2015 order. 51 TTABVUE.

¹³ Swift Tr. at 84, 52 TTABVUE 69.

Applicant's goods identified as "jewelry" in its identification of goods therefore are identical to Opposer's jewelry, and related to Opposer's "watches."

C. Similarity or dissimilarity of the channels of trade.

Because Applicant has not included any trade channel restrictions in its identification of goods, it is presumed that Applicant's goods will move in all usual channels of trade for jewelry, including those trade channels in which Opposer's jewelry moves. Such trade channels include third-party dealers authorized by Opposer, which sell third-party jewelry in addition to Opposer's jewelry, to members of the general public. It is also presumed that due to the lack of any trade channel restrictions in Applicant's identification of goods that Applicant's jewelry would be purchased by the same purchasers who purchase Opposer's jewelry. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-1162 (Fed. Cir. 2014).

As for watches, which we have found are related to jewelry, certainly both are marketed to members of the general public, who purchase both watches and jewelry. The record reflects that Opposer markets its watches and jewelry in its boutiques and sells to third-party retailers who in turn sell to members of the general public.¹⁴

D. Similarity or dissimilarity of the marks at issue.

In comparing the marks in this case, we bear in mind that "[t]he Lanham Act's tolerance for similarity between competing marks varies inversely with the fame of

¹⁴ Swift Tr. at 80, 52 TTABVUE 65.

the prior mark.” *Kenner Parker Toys, Inc. v. Rose Art Ind., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

We must compare the parties’ marks “in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). That is, we may not dissect the marks into their various components. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); see also *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981).

In addition, we do not make a side-by-side comparison of the marks, but rather consider whether their overall commercial impressions are so similar that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Servs. Inc.*, 101 USPQ2d at 1721; see also *Edom Laboratories Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012). Moreover, where, as here, the goods are identical in part, the degree of similarity of the marks necessary to find likelihood of confusion need not be as great. *Coach Servs., Inc.*, 101 USPQ2d at 1722; *In re Viterra*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (citing *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992)).

Further, it is not a necessary prerequisite for a finding of likelihood of confusion that marks be found similar in all respects, i.e., in sight, sound and meaning, and a likelihood of confusion may be found principally on similarity in one or two of these.

See, e.g., In re Sarkli, Ltd., 721 F.2d 353, 220 USPQ 111, 113 (Fed. Cir. 1983) (“the [USPTO] may reject an application *ex parte* solely because of similarity in meaning of the mark sought to be registered with a previously registered mark”).

Here, Opposer relies on its registrations of OMEGA marks in various formats, including the following:

OMEGA Ω OMEGA Ω OMEGA

Each of Opposer’s Omega Marks is likely to be pronounced as “omega”; Opposer’s marks including the Greek letter “Ω” are not likely to be pronounced as “omega omega” even though consumers will perceive the Greek letter “Ω” within the mark; the evidence demonstrates that Opposer’s marks are referred to in text as “Omega.”¹⁵ Thus, in the latter two marks, consumers will likely view the term “omega” as identifying the significance of the Greek letter “Ω.”

Applicant described its mark in its initial application as “the Greek letter Alpha nestled inside of the Greek letter Omega.” Applicant himself considers the Greek

¹⁵ *See, e.g.,* Opposer’s NOR Ex. 31 - 33, 44 TTABVUE 109 - 118.

letter “Ω” to be readily discernable within his mark.¹⁶ If he articulates the “omega” component of his mark, as he does in his description of the mark, it is likely that his customers will also articulate the “omega” component of his mark.”¹⁷ “Omega” is the entire verbal portion of Opposer’s Omega Marks. While Applicant’s customers will also articulate the Greek letter “alpha,” which is identical to the letter “A,” we find that Applicant’s and Opposer’s marks are similar in sound because the “omega” will be articulated in both Applicant’s and Opposer’s marks.

¹⁶ *C.f.*, *In re Serac*, 218 USPQ 340, 342 (TTAB 1983). in which the Board considered, but did not find persuasive, an applicant’s description of its mark, stating:

However, finding as we do that the natural impression of the public in viewing the design would not be to regard it as a picture of a ram’s head, the application notation fails to alter our conclusion that applicant’s mark falls short of the kind of pictorial representation of registrant’s “RAM’S HEAD” that would be likely to cause confusion within the meaning of Section 2(d) of the Trademark Act.

We note too that the dissenting opinion, in *Serac*, gave great weight to Applicant’s characterization of its mark, stating:

The fact that applicant described its mark as a “Ram Design” in its application for registration seems to me to have some significance. While not, of course, conclusive of what, in fact, is the public’s perception of the design, the statement in the application is inconsistent with appellant’s present position that the design “would be more likely to [be verbalized] in any one of several ways other than a ram’s head, including mountain goat, mountain sheep, bighorn sheep, goat, sheep or even ‘ram’ alone[.]” ... I would have given considerable weight to the fact that applicant -- being in the best position to know -- first considered the design to be that of a ram.

Id.

¹⁷ “Alpha” is the first letter of the Greek alphabet and “omega” is the last letter thereof, and the mark would likely be pronounced as “Alpha Omega.”

We find too that the Greek letter “Ω” is readily recognizable in Applicant’s mark, surrounding the letter “A” or “alpha.” Although Applicant’s “Ω” differs somewhat in shape from the “Ω” in two of Opposer’s Omega Marks, it is still recognizable as “Ω.” Thus, the Omega Marks and Applicant’s mark are similar in appearance because they both include the Greek letter “Ω.” While the dissent notes points of difference between the appearance of Opposer’s and Applicant’s marks, marks “must be considered ... in light of the fallibility of memory” and “not on the basis of side-by-side comparison.” *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1 (CCPA 1977). There is nothing in the record to persuade us that any of the differences argued by the dissent sufficiently distinguishes the appearance of the respective marks to outweigh their other similarities. Moreover, even when consumers note the additional “alpha” element in Applicant’s mark, when encountering the mark on goods identical and related to Opposer’s, consumers likely would perceive Applicant’s mark as a variation of Opposer’s well known Omega Marks.

With regard to the commercial impression of the marks, we too find them to be similar, largely because of the manner in which the marks are verbally referred to. The marks all refer to the Greek letter “omega,” and Applicant’s mark and some of the Omega Marks include the symbol for that letter, increasing the similarity of commercial impression.

For these reasons, the *du Pont* factor concerning the similarity of the marks favors a finding of likelihood of confusion.

E. The number and nature of similar marks in use on similar goods.

Applicant sought to introduce samples of third-party use of marks containing the term OMEGA. However, the Board struck Applicant's evidence of third-party use when it granted Opposer's motion to strike on April 21, 2015.

Applicant did successfully introduce several third-party applications and registrations for marks containing the term OMEGA.¹⁸ This evidence has limited probative value because "[a]n application is not evidence of anything except that the application was filed on a certain date," see *Wet Seal, Inc. v. FD Management*, 82 USPQ2d 1629, 1634 n.11 (TTAB 2007), and the registrations are for goods unrelated to the goods in issue in the present proceeding.

F. The conditions under which and buyers to whom sales are made.

Opposer correctly notes that there are no restrictions on the price of the goods in the opposed application or any of the cited registrations, and that the Board must consider the goods as jewelry which can be sold at high or low prices. See *Octocom Sys., Inc. v. Houston Computer Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). The "jewelry" therefore is presumed to include low-priced items, which are subject to impulse purchases. Similarly, Opposer's registrations for "watches" encompass low-priced watches. Additionally, the applicable standard of care for a likelihood-of-confusion analysis is that of the least sophisticated consumer. See *Stone Lion Capital Partners*, 110 USPQ2d at 1163 (affirming that TTAB properly considered all potential investors for recited services, which included sophisticated

¹⁸ 48 TTABVUE 199-219.

investors, but that precedent requires consumer care for likelihood-of-confusion decision to be based “on the least sophisticated potential purchasers”); *Alfacell Corp. v. Anticancer, Inc.*, 71 USPQ2d 1301, 1306 (TTAB 2004). As previously noted, the identified goods are sold to members of the general public, with no particular sophistication. In view thereof, we resolve the *du Pont* factor regarding the conditions under which and buyers to whom sales are made in favor of a finding of likelihood of confusion.

G. Other factors.

Opposer mentions that the *du Pont* factor regarding actual confusion is neutral, and we agree with Opposer; there are no instances of actual confusion in the record. Opposer also maintains it uses the Omega Marks on a variety of goods (timepieces, jewelry including earrings, pendants, necklaces, rings, bracelets, and cufflinks, leather goods, accessories such as key chains or money clips, fragrances, iPad holders and cell phone covers); and that such use on a variety of products increases the likelihood of confusion.¹⁹ We agree with Opposer that the likelihood of confusion increases in light of the different goods on which Opposer has used its mark. As for the remaining factors, because there is no evidence in the evidentiary record which bears on such factors, we consider them neutral.

H. Balancing the factors.

We have found that priority is not an issue insofar as Opposer is the owner of certain subsisting registrations and that Opposer has used the Omega Marks on

¹⁹ Swift Tr. at 10-14, 77 and Exs. 4, 11, and 12, 52 TTABVUE 12-16, 85-196, 53 TTABVUE 25.

jewelry well before the filing date of Applicant's application. Further, we have found that Opposer's Omega Marks are famous for watches, and the goods involved herein are identical with regard to jewelry, and similar with regard to watches; that Opposer uses its Omega Marks on a variety of goods; and that the goods travel in the same trade channels and are sold to the same purchasers. Further, we have found the marks to be similar in appearance, sound and commercial impression. There are no instances of third-party use in the record that we may consider, and no third-party registrations of similar marks for relevant goods. The goods which are the subject of Opposer's registrations for its Omega Marks are presumed to include low cost goods that are subject to purchase on impulse, as is Applicant's jewelry identified in its identification of goods. Especially in view of the "long shadow" cast by Opposer's famous marks, we therefore conclude that Applicant's mark, when use on "jewelry," is likely to be confused with Opposer's Omega Marks, for goods including jewelry and watches.

Dilution.

Because Opposer has prevailed on its claim of likelihood of confusion, we need not reach Opposer's additional claim of dilution.

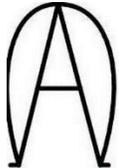
Decision: The opposition based on Opposer's likelihood of confusion claim is sustained. Registration to Applicant is refused.

* * *

Gorowitz, Administrative Trademark Judge, dissenting.

The majority has found that there is a likelihood of confusion between Opposer's

marks **OMEGA**, **Ω OMEGA**, and **Ω OMEGA**; and Applicant's

mark . I respectfully disagree.

While I concur with the majority that Opposer's marks are famous in connection with timepieces and that fame plays a dominant role in any likelihood of confusion decision, I believe that Applicant's mark is so different from Opposer's registered marks that even when used on identical goods, confusion is unlikely. *See Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

The majority relies on Applicant's description of its mark as "the Greek letter Alpha nestled inside of the Greek letter Omega" to establish that the marks are similar. I believe this reliance is misplaced. In the *Serac* case, discussed by the majority, the Board decided that the "mark's meaning is based upon its [sic] impression of the purchasing public and not an applicant's description." *In re Serac*, 218 USPQ 340, 342 (TTAB 1983). In that case, the Board, in finding no likelihood of confusion between the marks RAMS HEAD and the highly stylized depiction of a "ram's head," set forth below,



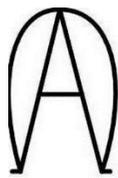
for related clothing items

said: “(t)he critical question in

this case, however, is whether applicant’s design is a sufficient ‘picture’ of a ram’s head that it would readily generate purchaser impressions to that effect and thereby produce a likelihood that buyers would assume a common source for applicant’s and registrant’s clothing products.”

I believe that this approach should be applied in this case, wherein the description of the mark is the “Greek letter Alpha nestled inside of the Greek letter Omega.”

Although the “A” may be one way of writing the Greek letter “alpha,” it is also a normal way to write a capital “A” in the everyday Latin alphabet that is used to write in English in the United States today. Further, because of the manner in which the Greek letter omega appears in the mark in conjunction with and surrounding the



letter “A,” it is unlikely that consumers would perceive it to be an “omega.”

but would view it as merely part of a design element surrounding the letter “A,” and the mark as a whole would be understood as a capital “A” with a slight design element. Accordingly, Applicant’s mark does not have the meaning of “omega,” and therefore the connotation and the commercial impressions of the marks in their entireties are different. *See Eagle Clothes, Inc. v. Robert Lewis, Inc.*, 165 USPQ 266

(TTAB 1970) wherein the Board determined that despite use on related clothing items, Applicant's design of a "skua bird"²⁰ would not likely be regarded as a "stylized eagle". "Regardless, even in the unlikely event that a purchaser might conceivably associate applicant's design mark with an eagle, it would not be confused with the pictorial representations of eagles being used and/or registered by opposer because of the many and obvious differences in appearance there between." *Id.* at 268.

The majority speculates that Applicant's mark will be pronounced as "alpha omega," apparently based only on the description of the mark provided by Applicant in the application, from which the majority has concluded that Applicant "considers the Greek letter 'Ω' to be readily discernable within his mark." Majority Opinion at p. 13. The majority goes on to speculate that if Applicant's mark is pronounced in this manner, the "omega" portion of the mark makes Applicant's mark similar to Opposer's mark in pronunciation. I consider this too tenuous a connection to support a finding of likelihood of confusion. Applicant's mark is a letter mark that partakes of both literal and design elements, and in most cases involving such marks, it is the appearance of the marks, not the pronunciation, that is accorded the greater weight in the likelihood of confusion determination. *Diamond Alkali Company v. Dundee*



²⁰

Cement Company, 343 F2d 781, 145 USPQ 211, 213 (CCPA 1965) (“When symbol marks, such as these, are being considered, appearance is most significant.”),²¹ *cf. In re Cook Medical Technologies LLC*, 105 USPQ2d 1377, 1381 (TTAB 2012) (“When, as in the present case, the marks at issue are non-literal design marks, the similarity of the marks must be decided primarily on the basis of visual similarity”). In view of the fact that the marks are very different in appearance, meaning and commercial impression, the reliance on a hypothetical articulation of the mark should not be the basis for finding the marks to be similar.

The dissimilarities in the mark are such that they outweigh the other *du Pont* factors and are dispositive. *See Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 1460-61 (Fed. Cir. 1998) (Federal Circuit affirmed Board finding of no likelihood of confusion between mark CRYSTAL CREEK for wine and marks CRISTAL for wine and CRISTAL CHAMPAGNE for champagne, where Board relied solely on dissimilarity of marks); *Kellogg Co. v. Pack'em Enterprises Inc.*, 21 USPQ2d at 1145 (“We know of no reason why, in a particular case, a single *du Pont* factor may not be dispositive”). *Cf. In re Covalinski*, 113 USPQ2d 1166, 1169 (TTAB 2014).

²¹ No likelihood of confusion between stylized D marks:



Based on the foregoing, I would find that there is no likelihood of confusion between Opposer's marks and Applicant's mark.

Similarly, Opposer cannot prevail on its dilution claim. "Dilution by blurring is [the] association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark." Section 43(c)(2)(B) of the Act, 15 U.S.C. § 1125(c)(2)(B). "Dilution diminishes the 'selling power that a distinctive mark or name with favorable associations has engendered for a product in the mind of the consuming public.'" *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1182 (TTAB 2001) (internal citation omitted).

"[T]o prevail on a dilution claim ..., a plaintiff must show that: (1) it 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. Inc.* 101 USPQ2d at 1723-24.

In order for Applicant's use of its mark, which notably has not yet commenced, to cause dilution by blurring, the marks must be similar. Section 43(c)(2)(B)(i) of the Trademark Act, 15 U.S.C. §1125(c)(2)(B)(i). As fully discussed above, the marks at issue are not similar and thus, Applicant's use of its mark is not likely to cause dilution by blurring of Opposer's marks.

Accordingly, I would dismiss the opposition.