

ESTTA Tracking number: **ESTTA710584**

Filing date: **11/24/2015**

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

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	INVICTA WATCH COMPANY OF AMERICA INC.
Granted to Date of previous extension	11/25/2015
Address	3069 Taft Street Hollywood, FL 33021 UNITED STATES
Attorney information	Howard Natter Natter & Natter 501 5th Avenue, Suite 808. New York, NY 10017 UNITED STATES hnatter@natterip.com

**Applicant Information**

Application No	86378683	Publication date	07/28/2015
Opposition Filing Date	11/24/2015	Opposition Period Ends	11/25/2015
Applicant	Sobral Invicta S.A. RUA DO ROCIO, 351, CONJ 52, ITAIM BIBI Sao Paulo, SP, BRAZIL		

**Goods/Services Affected by Opposition**


<p>Class 021. First Use: 1952/00/00 First Use In Commerce: 2014/01/00 All goods and services in the class are opposed, namely: bottle openers, electric and nonelectric; garlic presses; household utensils, namely, non-electric kneader; non-electric dough mixer for home use; Glass ampoules for medication sold empty; ice buckets; manual milk churns; cocktail shakers; isothermal insulated bags for food or beverages; Teapot; Non-electric coffee makers; Portable cooling boxes, non-electric; Mug; Jugs; Canteens; Beer mugs; Tea infusers; Kettles; dampers for use with Kettles; Sieve, except paper; Strainers for household purposes; Strainers tea; Strainers for use with non-electric coffee makers; cooking spoons, slotted spoons, serving spoons, cooking forks, serving forks, skimmers, and ladles, not for use as cutlery; Spoons for mixing; kitchen and serving ladle; Ladle for soup, for use in the kitchen; drinking cups; salt and pepper shakers; cutting board; cookie cutters, pasta cutters, and dough cutters; Ice cube molds; ice bowls; ice cubetrays; Vegetable peeler; non-electric juicer; Bottles; Bottles for sports drinks; Water Bottles; Bottles for freezing; thermal insulated containers for food or beverages; Portable coolers, non-electric; non-electric heaters for feeding bottles; Graters for kitchen use; scrapers for household purposes; Glass Containers for household use; Containers for household or kitchen use; Thermal containers for food or beverages; Glass Stoppers; Corkscrew, electric and non-electric; Bottle Holder, namely, insulating sleeve holder for bottles; Household utensils, namely spatulas; beverage glassware</p>
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## Grounds for Opposition


Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)
Other	Trademark Act section 13(a); section 1(a)

## Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2947259	Application Date	07/29/2002
Registration Date	05/10/2005	Foreign Priority Date	NONE
Word Mark	INVICTA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 1989/00/00 First Use In Commerce: 1989/00/00 WATCHES, CHRONOMETERS, CHRONOGRAPHS, CLOCKS, WATCH BANDS, WATCH CASES, and WATCH CHAINS		

U.S. Registration No.	3331253	Application Date	07/14/2005
Registration Date	11/06/2007	Foreign Priority Date	NONE
Word Mark	INVICTA YELLOW		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 2006/12/17 First Use In Commerce: 2007/01/10		


	Perfumes, colognes, and hand and body lotions
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U.S. Registration No.	4060431	Application Date	05/13/2009
Registration Date	11/22/2011	Foreign Priority Date	NONE
Word Mark	INVICTA ELEMENTS YOUR BASIC CATALYSTS		
Design Mark			
Description of Mark	The mark consists of a swirl design above the terms "Invicta elements your basic catalysts".		
Goods/Services	Class 014. First use: First Use: 2011/01/00 First Use In Commerce: 2011/01/00 Jewelry Class 016. First use: First Use: 2011/01/00 First Use In Commerce: 2011/01/00 Writing instruments		

U.S. Registration No.	4086630	Application Date	01/26/2011
Registration Date	01/17/2012	Foreign Priority Date	NONE
Word Mark	INVICTA		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 009. First use: First Use: 2001/00/00 First Use In Commerce: 2001/00/00 Sunglasses Class 016. First use: First Use: 2002/00/00 First Use In Commerce: 2002/00/00 Pens
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U.S. Registration No.	4381337	Application Date	11/21/2012
Registration Date	08/06/2013	Foreign Priority Date	NONE
Word Mark	INVICTA EYEWEAR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2013/05/07 First Use In Commerce: 2013/05/07 Cases for eyeglasses and sunglasses; Eyeglass frames; Eyeglass lenses; Eyeglasses; Frames for spectacles and sunglasses; Lenses for sunglasses; Sunglasses		

U.S. Registration No.	4399998	Application Date	02/06/2013
Registration Date	09/10/2013	Foreign Priority Date	NONE
Word Mark	INVICTA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2013/02/06 First Use In Commerce: 2013/02/06 Retail store services featuring timepieces, eyewear, and writing instruments		

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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Howard Natter/
Name	Howard Natter
Date	11/24/2015

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

In the matter of trademark application Serial No. 86378683  
Published in the Official Gazette on July 28, 2015  
Mark: INVICTA

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INVICTA WATCH COMPANY OF AMERICA, INC.	:	
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Opposer,	:	
	:	
	:	
v.	:	OPPOSITION NO.:
	:	
	:	_____
SOBRAL INVICTA S.A.	:	
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Applicant.	:	
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**NOTICE OF OPPOSITION**

INVICTA WATCH COMPANY OF AMERICA, INC., (“Opposer”) a Florida corporation having an office at 3069 Taft Street, Hollywood, Florida 33021, by and through its attorneys, Natter & Natter, believes that it will be damaged by the registration of the mark INVICTA shown in application Serial No. 86/378,683 and published for opposition July 28, 2015. Pursuant to Rule 2.101 et seq. of the Trademark Rules of Practice, Opposer hereby opposes registration.

The grounds for the opposition are as follows:

1. Opposer is a manufacturer and distributor of watches and related products including jewelry, eyewear, and writing instruments, among other goods to which it applies its mark INVICTA.

2. Opposer's INVICTA mark is also used on promotional, souvenir and accessory items such as mugs, tools and repair kits, watch boxes and cases, and watch bands as well as on other items.

3. Opposer distributes its INVICTA branded products through an established network of independent retailers, through self-branded retail stores, through Internet sales such as on Amazon.com, on-line shopping websites and on television, including home shopping networks.

4. Opposer's products sold under INVICTA mark are promoted on Opposer's website [www.invictawatch.com](http://www.invictawatch.com), including online calendars, catalogs and videos, newsletters and on social media.

5. Opposer is the owner of numerous trademark registrations on the Principal Register including, but not limited to, the following:

<u>Mark</u>	<u>Reg. No.</u>	<u>Reg. Date</u>	<u>Goods</u>
INVICTA and design	2,947,259	05/10/05	Watches, chronometers, chronographs, clocks, watch bands, watch cases, watch chains in Class 014
INVICTA YELLOW	3,331,253	11/6/07	Perfumes, colognes, etc. in Class 003

<u>Mark</u>	<u>Reg. No.</u>	<u>Reg. Date</u>	<u>Goods</u>
INVICTA ELEMENTS YOUR BASIC CATALYSTS plus design	4,060,431	11/22/11	Jewelry in Class 014 and writing instruments in Class 016
INVICTA	4,086,630	01/17/12	Sunglasses in Class 009 and Pens in Class 016
INVICTA EYEWEAR	4,381,337	08/06/13	Cases for eyeglasses and sunglasses; eyeglass frames; eyeglass lenses; eyeglasses; frames for spectacles and sunglasses; lenses for sunglasses; sunglasses in Class 009
INVICTA	4,399,998	09/10/13	Retail store services featuring timepieces, eyewear, and writing instruments in Class 035.

6. Opposer's above registrations are in all respects, valid and subsisting, and are conclusive evidence of Opposer's exclusive rights to use the mark INVICTA in commerce on the goods and for the services specified in said registrations.



7. As a result of Opposer's longstanding, continuous, and exclusive use of the mark INVICTA independently or in combination with other terms and/or symbols or designs, in the United States in connection with the sale and marketing of said goods and services, Opposer has established valuable goodwill in the mark and the mark has become well-known and recognized by consumers as identifying goods and services which have their origin with Opposer.

8. Applicant, a Brazilian company, filed the opposed application for registration of the mark INVICTA on August 27, 2014 based on use in commerce [15 U.S.C. § 1051(a)] at least as early as January, 2014 as applied to goods in Class 21.

9. Applicant did not use the mark INVICTA in commerce controlled by U.S. Congress for all of the goods in its application designated in Class 21 as of the application filing date.

10. The Applicant lacked the requisite use requirement at the time of filing the application.

11. Applicant's use and/or registration of the mark INVICTA in connection with the goods of the opposed application is likely to cause confusion, or to cause mistake, or to deceive purchasers and potential purchasers as to source and/or will create the mistaken belief that there is an association, affiliation, authorization, sponsorship, or other connection between Applicant's and Opposer's goods.

12. As a result of Opposer's extensive promotional and marketing efforts and the resulting sales of its products, under the INVICTA mark in the U.S. for more than 20 years, Opposer's mark has achieved a high degree of consumer awareness and attributed fame such that the mark is viewed by relevant purchasers as a famous mark.

13. Opposer's mark had achieved fame before Applicant's filing date.

14. Applicant's use and/or registration of the mark INVICTA for goods in Class 21 is likely to cause confusion, or to cause mistake, or to deceive purchasers or potential purchasers for the reason that relevant purchasers would consider Applicant's goods to be an expansion or extension of Opposer's goods under its famous mark.

15. Applicant's mark is likely to cause dilution by blurring or by tarnishment of the distinctiveness of Opposer's famous INVICTA mark.

16. Opposer believes it will be damaged by the registration of Applicant's mark for the reason that it is contrary to the exclusive and superior rights of Opposer in and to its INVICTA mark.

WHEREFORE, Opposer prays that the mark INVICTA of application Ser. No. 86/378,683 be refused registration and that this opposition be sustained.

Dated: November 24, 2015

Respectfully submitted,  
NATTER & NATTER  
Attorneys for Opposer  
501 Fifth Avenue, Suite 808  
New York NY 10017  
(212) 840-8300

By /Howard Natter/  
Howard Natter

**CERTIFICATE OF SERVICE**

This will certify that on the 24<sup>th</sup> day of November, 2015 a true and correct copy of this **NOTICE OF OPPOSITION** was mailed, first class, postage prepaid to attorneys for Applicant as follows:

John P. Murtaugh, Esq.  
Pearne & Gordon LLP  
1801 East 9<sup>th</sup> Street, Suite 1200  
Cleveland, OH 44114-3108

/Howard Natter/  
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Howard Natter