

ESTTA Tracking number: **ESTTA760623**

Filing date: **07/26/2016**

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	Certina A.G. (Certina S.A.) (Certina Ltd.)
Granted to Date of previous extension	07/27/2016
Address	chemin des Tourelles 17 Le Locle, 2400 SWITZERLAND
Attorney information	Jeffrey A. Lindenbaum Collen IP, Intellectual Property Law, P.C. The Holyoke-Manhattan Building, 80 South Highland Avenue Ossining, NY 10562 UNITED STATES jlindenbaum@collenip.com, docket@collenip.com, tgulick@collenip.com Phone:914-941-5668

Applicant Information

Application No	79169426	Publication date	03/29/2016
Opposition Filing Date	07/26/2016	Opposition Period Ends	07/27/2016
International Registration No.	1257407	International Registration Date	05/07/2015
Applicant	T.R.B. International SA Chemin du Pavillon 5 SWITZERLAND		

Goods/Services Affected by Opposition


Class 014. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Precious metals and their alloys; jewelry, precious stones; timepieces and chronometric instruments; watches, watch bands, watch cases, watch chains, wristwatches, smart watches
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	4600118	Application Date	10/02/2013
Registration Date	09/09/2014	Foreign Priority	NONE

		Date	
Word Mark	CERTINA DS		
Design Mark			
Description of Mark	The mark consists of the designation "Certina DS" over the design of a tortoise.		
Goods/Services	Class 014. First use: First Use: 2012/09/03 First Use In Commerce: 2013/06/03 Precious metals; precious metal alloys; goods in precious metals or coated therewith, namely, figurines and trophies; jewelry; jewelry boxes; jewelry caskets; precious stones; horological and chronometric instruments; watch chains; caskets for watches; cases for the presentation of watches		
U.S. Registration No.	4739714	Application Date	07/03/2013
Registration Date	05/19/2015	Foreign Priority Date	03/13/2013
Word Mark	DS		

Design Mark	
Description of Mark	The mark consists of the designation "DS" over the design of a tortoise shell.
Goods/Services	Class 014. First use: First Use: 2013/04/25 First Use In Commerce: 2013/11/07 Precious metals; precious metal alloys; precious stones; horological and chronometric instruments; caskets for watches; cases for the presentation of watches

Attachments	86080728#TMSN.png(bytes) 86002055#TMSN.png(bytes) U496_notice of opposition_160510.pdf(28028 bytes) U496 Ex A to Notice of Opp.pdf(91955 bytes)
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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	/Jeffrey A. Lindenbaum/
Name	Jeffrey A. Lindenbaum
Date	07/26/2016

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

Applicant : T.R.B. International SA
Serial No. : 79/169,426
Filed : May 7, 2015



For :
Published : March 29, 2016



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

NOTICE OF OPPOSITION



The Opposer, Certina A.G. (Certina S.A.) (Certina Ltd.), chemin des Tourelles 17, Le Locle, 2400, Switzerland, (“Certina” or “Opposer”) through its attorneys believes that it would be damaged by the registration in Class 014 of the mark shown in the above-identified application, and hereby opposes same, pursuant to 15 USC § 1063 and 37 CFR § 2.104.

As grounds for opposition, it is alleged that:

1) Certina is and has been engaged in the sale and marketing of identical goods to those recited by Applicant in its application to register since a time prior to the date of first use alleged by Applicant in its application for registration, and/or the date of filing of Applicant’s application and/or the priority date afforded Applicant’s application.

2) Certina is and has been engaged in the sale and marketing of goods under the registered trademarks  and  (the “Certina Marks”) including for watches and goods in Class 014, since a time prior to the filing of Applicant’s application and prior to any priority date afforded Applicant’s application. Certina has sold goods under its Certina Marks since that time.

3) CERTINA is the owner of, among others, the following valid and subsisting U.S. trademark registrations:

Registration No. 4,600,118 
Registration No. 4,739,714 

Copies of the United States Trademark Office’s records showing the status and title of these registrations are attached as Exhibit A.

4) Certina has used its Certina Marks in commerce extensively and has acquired a considerable and valuable goodwill and wide scale recognition for its Marks. The public has come to associate the Certina Marks with Opposer and Opposer’s goods.

5) Certina’s registrations are prima facie proof of ownership and use of the marks from at least the original date of filing of the applications, pursuant to 15 USC 1057(b), and of the exclusive right to use the registered mark in commerce.

6) Applicant’s mark is confusingly similar to Certina’s registered trademarks and when applied to the goods of the Applicant, namely, jewelry, watches and other goods in Class 014 is likely to cause confusion, or to cause mistake or to deceive. 15 USC 1052(e). Applicant’s mark makes a highly similar commercial impression.

7) The overall commercial impression of Applicant's mark, when applied to the goods identified in Class 014 in the application, would cause confusion or be likely to cause confusion, mistake, or deception.

8) Certina's date of first use of its Certina Marks, for highly related goods and services, is prior to the date of the Applicant's application.

9) On information and belief, use by the Applicant for goods in International Class 014 will cause confusion, mistake and deception with respect to those goods, by virtue of the Opposer's prior use of its Certina Marks, and by virtue of the Opposer's renown as a manufacturer and provider of various goods.

10) On information and belief, both the Applicant's mark and Opposer's marks are applied to highly related goods and are likely to be sold to the same or similar channels of distribution. Applicant's mark so resembles Opposer's registered and well-known trademarks, as used in the United States and not abandoned, as to be likely to cause confusion, or to cause mistake or to deceive.

11) On information and belief, Applicant's actions would substantially harm the Opposer, by permitting registration in favor of Applicant for a mark which the Opposer used on its goods and from an earlier date.

OPPOSER prays that this application Serial No. 79/169,426, be refused, that no registration be issued thereon to Applicant and that this Opposition be sustained in favor of Certina.

Respectfully submitted for
Opposer, Opposer, Certina A.G. (Certina S.A.)
(Certina Ltd.)

By: /Jeffrey A. Lindenbaum/
Jeffrey A. Lindenbaum
Jess M. Collen
COLLEN *IP*
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Ossining, NY 10562
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Encs.: Opposition fee \$300.00 per class (\$300.00)
DATED: July 26, 2016

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

CERTIFICATE OF FILING AND SERVICE

I, Jeffrey A. Lindenbaum hereby certify that on July 26, 2016, I caused a true copy of the foregoing Notice of Opposition to be filed electronically with the United States Patent and Trademark Office, and to be served upon Applicant, by United States First Class Mail and email, addressed to Applicant's correspondent of record as follows:

Linda M. Merritt
Norton Rose Fulbright US LLP
98 San Jacinto Blvd., Suite 1100
Austin, TEXAS 78701-4255
nyipdocket@nortonrosefulbright.com

By /Jeffrey A. Lindenbaum/ Date: July 26, 2016

EXHIBIT A

EXHIBIT A

Generated on: This page was generated by TSDR on 2016-07-26 15:54:15 EDT

Mark: CERTINA DS



US Serial Number: 86080728

Application Filing Date: Oct. 02, 2013

US Registration Number: 4600118

Registration Date: Sep. 09, 2014

Register: Principal

Mark Type: Trademark

TM5 Common Status Descriptor:



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Sep. 09, 2014

Publication Date: Jun. 24, 2014

Mark Information

Mark Literal Elements: CERTINA DS

Standard Character Claim: No

Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

Description of Mark: The mark consists of the designation "Certina DS" over the design of a tortoise.

Color(s) Claimed: Color is not claimed as a feature of the mark.

Design Search Code(s): 03.21.07 - Terrapins; Tortoises; Turtles

03.21.24 - Stylized reptiles, frogs and snails

Related Properties Information

Claimed Ownership of US Registrations: 0401762, 3283211

Foreign Information

Foreign Registration Number: 642342

Foreign Registration Date: Apr. 16, 2013

Foreign Application/Registration Country: SWITZERLAND

Foreign Expiration Date: Apr. 08, 2023

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;

- Double parenthesis ((..)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Precious metals; precious metal alloys; goods in precious metals or coated therewith, namely, figurines and trophies; jewelry; jewelry boxes; jewelry caskets; precious stones; horological and chronometric instruments; watch chains; caskets for watches; cases for the presentation of watches

International Class(es): 014 - Primary Class

U.S Class(es): 002, 027, 028, 050

Class Status: ACTIVE

Basis: 1(a) 44(e)

First Use: Sep. 03, 2012

Use in Commerce: Jun. 03, 2013

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: Yes

Currently 44E: Yes

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: CERTINA AG (CERTINA SA) (CERTINA LTD)

Owner Address: Chemin des Tourelles 17
Le Locle SWITZERLAND CH-2400

Legal Entity Type: JOINT STOCK COMPANY

State or Country Where Organized: SWITZERLAND

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Jess M. Collen

Docket Number: P947

Attorney Primary Email Address: trademark@collenip.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: JESS M. COLLEN
COLLEN IP, INTELLECTUAL PROPERTY LAW, P.C.
80 S HIGHLAND AVE
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Correspondent e-mail: trademark@collenip.com

Correspondent e-mail Authorized: Yes

Domestic Representative

Domestic Representative Name: Jess M. Collen

Phone: (914) 941-5668

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Domestic Representative e-mail: trademark@collenip.com

Domestic Representative e-mail Authorized: Yes

Prosecution History

Date	Description	Proceeding Number
Sep. 09, 2014	REGISTERED-PRINCIPAL REGISTER	
Jun. 24, 2014	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Jun. 24, 2014	PUBLISHED FOR OPPOSITION	
Jun. 04, 2014	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	

May 21, 2014	LAW OFFICE PUBLICATION REVIEW COMPLETED	73797
May 20, 2014	ASSIGNED TO LIE	73797
May 08, 2014	APPROVED FOR PUB - PRINCIPAL REGISTER	
May 07, 2014	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
May 07, 2014	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
May 07, 2014	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Apr. 16, 2014	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Apr. 16, 2014	NON-FINAL ACTION E-MAILED	6325
Apr. 16, 2014	NON-FINAL ACTION WRITTEN	61272
Apr. 14, 2014	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Apr. 14, 2014	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Apr. 14, 2014	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Oct. 16, 2013	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Oct. 16, 2013	NON-FINAL ACTION E-MAILED	6325
Oct. 16, 2013	NON-FINAL ACTION WRITTEN	61272
Oct. 16, 2013	ASSIGNED TO EXAMINER	61272
Oct. 10, 2013	NOTICE OF DESIGN SEARCH CODE E-MAILED	
Oct. 09, 2013	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Oct. 05, 2013	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Sep. 09, 2014

Generated on: This page was generated by TSDR on 2016-07-26 15:57:28 EDT

Mark: DS



US Serial Number: 86002055

Application Filing Date: Jul. 03, 2013

US Registration Number: 4739714

Registration Date: May 19, 2015

Register: Principal

Mark Type: Trademark

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: May 19, 2015

Publication Date: Jul. 08, 2014

Notice of Allowance Date: Sep. 02, 2014

Mark Information

Mark Literal Elements: DS

Standard Character Claim: No

Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

Description of Mark: The mark consists of the designation "DS" over the design of a tortoise shell.

Color(s) Claimed: Color is not claimed as a feature of the mark.

Design Search Code(s): 26.13.14 - Quadrilateral (three or more quadrilaterals); Three or more quadrilaterals
26.13.21 - Quadrilaterals that are completely or partially shaded
26.15.13 - More than one polygon
26.15.21 - Polygons that are completely or partially shaded
26.15.28 - Miscellaneous designs with overall polygon shape; Polygonal shapes (miscellaneous overall shape)
26.17.01 - Bands, straight; Bars, straight; Lines, straight; Straight line(s), band(s) or bar(s)
26.17.04 - Bands, vertical; Vertical line(s), band(s) or bar(s); Lines, vertical; Bars, vertical
26.17.05 - Bands, horizontal; Bars, horizontal; Horizontal line(s), band(s) or bar(s); Lines, horizontal
26.17.06 - Diagonal line(s), band(s) or bar(s); Bars, diagonal; Bands, diagonal; Lines, diagonal

Related Properties Information

Claimed Ownership of US Registrations: 0401762, 3283211

Foreign Information

Priority Claimed: Yes

Foreign Application Number: 53175/2013

Foreign Application Filing Date: Mar. 13, 2013

Foreign Registration Number: 641526

Foreign Registration Date: Mar. 22, 2013

Foreign Application/Registration: SWITZERLAND

Foreign Expiration Date: Mar. 13, 2023

Country:

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (..) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *.* identify additional (new) wording in the goods/services.

For: Precious metals; precious metal alloys; precious stones; horological and chronometric instruments; caskets for watches; cases for the presentation of watches

International Class(es): 014 - Primary Class

U.S Class(es): 002, 027, 028, 050

Class Status: ACTIVE

Basis: 1(a) 44(e)

First Use: Apr. 25, 2013

Use in Commerce: Nov. 07, 2013

Basis Information (Case Level)

Filed Use: No	Currently Use: Yes	Amended Use: No
Filed ITU: Yes	Currently ITU: No	Amended ITU: No
Filed 44D: Yes	Currently 44D: No	Amended 44D: No
Filed 44E: Yes	Currently 44E: Yes	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: CERTINA AG (CERTINA SA) (CERTINA LTD)

Owner Address: Chemin des Tourelles 17
2400 Le Locle
SWITZERLAND

Legal Entity Type: CORPORATION

State or Country Where Organized: SWITZERLAND

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Jess M. Collen

Docket Number: P721

Attorney Primary Email Address: trademark@collenip.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: JESS M. COLLEN
COLLEN IP, INTELLECTUAL PROPERTY LAW, P.C.
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Correspondent e-mail Authorized: Yes

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Domestic Representative Name: Jess M. Collen

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Fax: (914) 941-6091

Domestic Representative e-mail: trademark@collenip.com

Domestic Representative e-mail Authorized: Yes

Prosecution History

Date	Description	Proceeding Number
May 19, 2015	REGISTERED-PRINCIPAL REGISTER	
Apr. 14, 2015	NOTICE OF ACCEPTANCE OF STATEMENT OF USE E-MAILED	
Apr. 13, 2015	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Apr. 09, 2015	STATEMENT OF USE PROCESSING COMPLETE	76538
Mar. 02, 2015	USE AMENDMENT FILED	76538
Apr. 06, 2015	CASE ASSIGNED TO INTENT TO USE PARALEGAL	76538
Mar. 02, 2015	TEAS STATEMENT OF USE RECEIVED	
Sep. 02, 2014	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	
Jul. 08, 2014	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Jul. 08, 2014	PUBLISHED FOR OPPOSITION	
Jun. 18, 2014	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
May 31, 2014	LAW OFFICE PUBLICATION REVIEW COMPLETED	70468
May 22, 2014	ASSIGNED TO LIE	70468
May 12, 2014	APPROVED FOR PUB - PRINCIPAL REGISTER	
May 08, 2014	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
May 07, 2014	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
May 07, 2014	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Apr. 16, 2014	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Apr. 16, 2014	NON-FINAL ACTION E-MAILED	6325
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Apr. 14, 2014	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
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Oct. 16, 2013	NON-FINAL ACTION E-MAILED	6325
Oct. 16, 2013	NON-FINAL ACTION WRITTEN	61272
Oct. 16, 2013	ASSIGNED TO EXAMINER	61272
Jul. 16, 2013	NOTICE OF DESIGN SEARCH CODE E-MAILED	
Jul. 15, 2013	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jul. 06, 2013	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Apr. 13, 2015