

ESTTA Tracking number: **ESTTA812756**

Filing date: **04/11/2017**

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	Rolex Watch U.S.A., Inc.		
Entity	Corporation	Citizenship	New York
Address	665 Fifth Ave New York, NY 10022 UNITED STATES		

Attorney information	Adam Sgro Gibney Anthony & Flaherty LLP 665 Fifth Ave New York, NY 10022 UNITED STATES asgro@gibney.com, pcousins@gibney.com, vtoranzo@gibney.com Phone:212-688-5151		
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**Applicant Information**

Application No	87204867	Publication date	03/21/2017
Opposition Filing Date	04/11/2017	Opposition Period Ends	04/20/2017
Applicant	YES CHOICE INTERNATIONAL GROUP CO ROOM 8, 6/F, WING HANG INDUSTRIAL BLDG KWAI CHUNG, 00000 HONG KONG		

**Goods/Services Affected by Opposition**


Class 014. First Use: 2016/10/01 First Use In Commerce: 2016/10/01 All goods and services in the class are opposed, namely: Beads for making jewellery; Bracelets; Cases adapted for holding watches; Charms; Clasps for jewelry; Earrings; Jewellery; Jewelry cases; Jewelry chains; Necklaces; Paste jewellery; Rings; Shoe ornaments of precious metal; Straps for wristwatches; Watch bands; Watch chains; Watches; Wristwatches; Jewelry ornaments; Key chains as jewellery; Key rings of precious metal
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act Section 2(d)
Other	False Designation of Origin: Trademark Act 43(a) (15 USC 1125(a)).

**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	657756	Application Date	04/02/1957
Registration Date	01/28/1958	Foreign Priority	NONE

		Date	
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 1941/01/15 First Use In Commerce: 1943/06/01 TIMEPIECES OF ALL KINDS AND PARTS THEREOF		

U.S. Registration No.	4458524	Application Date	05/08/2013
Registration Date	12/31/2013	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of Five point crown open at the top.		
Goods/Services	Class 035. First use: First Use: 2008/12/31 First Use In Commerce: 2008/12/31 Retail store services featuring watches, timepieces, clocks and jewelry		

Attachments	72027385#TMSN.png( bytes ) 85926217#TMSN.png( bytes ) 00632903.PDF(359867 bytes )
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Signature	/AWS/
Name	Adam Sgro
Date	04/11/2017

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

In re the Matter of:

ROLEX WATCH U.S.A., INC.,

Opposer,


v.

YES CHOICE INTERNATIONAL  
GROUP CO.

Applicant.


Opposition No. \_\_\_\_\_

Application Serial Number 87204867


Mark opposed: 

Filing date: October 17, 2016

**NOTICE OF OPPOSITION**



Rolex Watch U.S.A., Inc., hereby opposes registration of the mark  in International Class ("IC") 14 for "Beads for making jewellery; Bracelets; Cases adapted for holding watches; Charms; Clasps for jewelry; Earrings; Jewellery; Jewelry cases; Jewelry chains; Necklaces; Paste jewellery; Rings; Shoe ornaments of precious metal; Straps for wristwatches; Watch bands; Watch chains; Watches; Wristwatches; Jewelry ornaments; Key chains as jewellery; Key rings of precious metal," Application Serial No. 87204867. As grounds in support of this opposition, Opposer alleges as follows:

1. Opposer, Rolex Watch U.S.A., Inc. ("Rolex"), is a New York corporation with a business address of 665 Fifth Avenue, New York, New York 10022.

2. Rolex, for over 50 years and long prior to any date of first use upon which Applicant can rely, has adopted, used and continues to use the distinctive  (hereafter

“Crown Design” trademark) in connection with each Rolex watch distributed by Rolex in the United States. Since 2008, the Crown Design trademark has also been used to identify retail stores, featuring watches and jewelry, which are sponsored or authorized by Rolex to sell its genuine, high quality products.


3. Rolex is the owner of the following United States principal registrations which are valid and subsisting:

<b>Trademark</b>	<b>Reg. No.</b>	<b>Reg. Date</b>	<b>Goods</b>
	657,756	1/28/1958	(IC 14) Timepieces of all kinds and parts thereof.
	4,458,524	12/31/2013	(IC 35) Retail store services featuring watches, timepieces, clocks and jewelry

4. Rolex is the exclusive distributor and warrantor in the United States of watches all bearing the Crown Design trademark.

5. For over 50 years Rolex has consistently used the Crown Design trademark in its advertisements, promotional materials and all of its sponsorship events. Rolex has spent in excess of \$100,000,000 (one hundred million dollars), over the past 50 years, advertising and promoting its Crown Design trademark.

6. As a result of its long, continuous use, and its vast advertising of the Crown Design trademark in connection with not only watches but various sporting, entertainment and charitable events that Rolex sponsors, Rolex’s Crown Design trademark has become extremely well known and famous and items sold or marketed under the Crown Design mark are immediately and exclusively associated with Rolex.

7. Applicant, on October 17, 2016, filed an application under 1(a) of the Lanham Act seeking to register a crown mark  that when or if applied to the goods listed in

Applicant's application is likely to cause consumer confusion or be associated with Rolex's Crown Design.

8. Applicant's crown mark and Rolex's Crown Design trademark are similar in appearance.

9. Applicant's mark, like Rolex's Crown Design mark, consists of an open crown design with five tapered prongs with a ball on top of each prong.

10. The dominant feature of Applicant's mark is the crown.

11. Applicant is seeking to apply its similar crown mark on goods that are the same and/or similar to goods promoted and sponsored by Rolex.

12. Applicant has made no significant monetary investment in the sale, promotion or advertising of its mark, as the first date of its use in commerce is only October 1, 2016.

Moreover, the specimens Applicant submitted along with its application appear to be leather and plastic bracelets, and materials used to display watches and other jewelry.

13. Applicant was aware of Rolex's Crown Design trademark before the filing date of its application.

### COUNT ONE

#### Likelihood of Confusion, 15 U.S.C. § 1052(d)

14. Applicant's crown mark so resembles Rolex's previously used and registered Crown Design trademark that, when applied to Applicant's goods is likely to cause confusion, mistake, or deception for purposes of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052 (d).

**COUNT TWO**


**False Designation of Origin, 15 U.S.C. § 1125(a)**

15. Applicant's use of a crown mark on watches and other goods in IC 14, which are similar and related to the products on which Rolex uses its Crown Design trademark, is likely to cause a false association, affiliation or connection as to the origin of Applicant's mark in violation of Section 43(a) of the Trademark Act (15 U.S.C. §1125(a)).

WHEREFORE, it is respectfully requested that this Opposition be sustained and that registration to Applicant be refused.

Respectfully submitted,  
ROLEX WATCH U.S.A., INC.

Dated:  
April 11th, 2017

By:   
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Peter Cousins (pcousins@gibney.com)  
Gibney, Anthony & Flaherty, LLP  
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**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing NOTICE OF OPPOSITION has been served on this 11th day of April, 2017 by email and mailing through U.S. Post Office to the following:

Yes Choice International Group Co  
13-29 Kwai Hei St.  
Room 8, 6/F, Wing Hang Industrial Building  
Kwai Chung  
Hong Kong  
[info@lagroup.com.hk](mailto:info@lagroup.com.hk)

  
Veronika Sostak