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

Proceeding	91239222
Party	Plaintiff Sterling Jewelers Inc.
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Date	10/28/2019
Attachments	Opposers Notice of Reliance - Rebuttal.pdf(105372 bytes) Ex 55 - Opposers Responses to Applicants First Set of Interrogatories -No 1 - Redacted - public.pdf(179296 bytes)

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

Sterling Jewelers Inc., Opposer, v. Tat Lee, Applicant.	Opposition No.: 91239222 Mark: TITANIUM KAY Serial No.: 87435559
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OPPOSER’S NOTICE OF RELIANCE: REBUTTAL (EXHIBIT 55)

Pursuant to 37 C.F.R. §§ 2.116(e), 2.120(k)(5), and 2.122(g), Sterling Jewelers Inc. (“Opposer”), by and through its undersigned counsel, hereby submits this Notice of Reliance.

No.	Description	Bates Number(s)	Rule	Relevance: Priority and Factors for Likelihood of Confusion and Dilution
55	Opposer's Objections and Responses to Applicant's First Set of Interrogatories, Number 1 (HIGHLY CONFIDENTIAL / ATTORNEYS' EYES ONLY)	N/A	2.120(k)(5), TBMP 704.10	Applicant submitted an incomplete version of Opposer's response to Interrogatory No. 1. Opposer submits this complete version of its response to avoid an unfair interpretation of the responses offered by Applicant. Opposer intends to rely on this complete response in the context of demonstrating that Applicant's TITANIUM KAY mark is likely to cause confusion with Opposer's KAY Marks under each of the confusion factors.

October 28, 2019

/s/ Amy J. Tindell _____

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**Attorneys for Opposer
 Sterling Jewelers Inc.**

CERTIFICATE OF SERVICE

I certify that on October 28, 2019 I served a copy of the above **NOTICE OF RELIANCE** to Counsel for Applicant by e-mail at:

gregwood@woodipdr.com

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/Amy Tindell/
Amy Tindell

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Exhibit 55

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

Sterling Jewelers Inc., Opposer, v. Tat Lee, Applicant.	Opposition No.: 91239222 Mark: TITANIUM KAY Serial No.: 87435559
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**OPPOSER’S OBJECTIONS AND RESPONSES TO
APPLICANT’S FIRST SET OF INTERROGATORIES, NUMBERS 1-10**

Pursuant to 37 C.F.R. § 2.120 and Federal Rule of Civil Procedure 26, Sterling Jewelers, Inc. (“Opposer”), by and through its undersigned counsel, hereby submits the following objections and responses to Applicant’s First Set of Interrogatory Numbers 1-10.

DEFINITIONS

The following definitions apply to all of Opposer’s discovery responses.

1. “Opposer” means Sterling Jewelers Inc., any parent, subsidiaries, divisions, affiliated entities, predecessor or successor entities, and their present and former officers, directors, employees, agents, representatives, and any other persons or entities acting or purporting to act on their behalf.
2. “Applicant,” “You,” or “Your” means Tat Lee and his predecessors-in-interest, past and present affiliates, subsidiaries, officers, agents, directors, employees, business partners, consultants, attorneys, representatives, and any other person acting on behalf of Tat Lee.
3. “Opposer’s Registrations” means the trademark registrations that Opposer has pleaded and asserted in this action.

4. “Opposer’s Marks” or “Kay Marks” means Opposer’s Registrations and Opposer’s common-law rights to KAY-formative marks that Opposer has pleaded and asserted in this action.

5. “Application” means Application Serial 87435559, filed in the United States Patent and Trademark Office (“USPTO”) on May 3, 2017, for registration of the mark TITANIUM KAY.

6. “Applicant’s Mark” means the TITANIUM KAY mark that is the subject of this action.

7. “Applicant’s Goods” includes all goods identified in the Applicant’s Application, namely, “Bracelets; Earrings; Necklaces; Rings; Hoop earrings; Wedding rings.”

8. “Opposer’s Goods” or the “KAY Goods” includes all goods and services identified in Opposer’s Registrations and those to which Opposer claims common-law rights.

GENERAL OBJECTIONS

1. Opposer objects to Applicant’s “Instructions” and “Definitions” to the extent they seek to impose obligations and demands on Opposer beyond those contemplated by the Federal Rules of Civil Procedure, the local rules, and/or the Trademark Trial and Appeal Board Manual of Procedure (TBMP). Opposer will respond to Applicant’s Interrogatories to the extent required by the Federal Rules of Civil Procedure, the Federal Rules of Evidence, and the Rules and Orders of the Board, and any purported definitions, requirements, or requests to the contrary may be disregarded.

2. Opposer objects to each and every Interrogatory to the extent that it seeks information that is protected by the attorney/client privilege, attorney work product doctrine,

common interest privilege and any other judicially recognized protection or privilege with respect to all information protected by a privilege.

3. Opposer objects to each and every Interrogatory to the extent that it calls for confidential business information or documents, proprietary, trade secret, or competitively-sensitive information or documents. Such information and documents, if not otherwise objected to, will be produced with designation, pursuant to the Protective Order that is operative in this case.

4. Opposer objects to each and every Interrogatory to the extent it is compound, complex, or contains multiple subparts.

5. Opposer objects to each and every Interrogatory to the extent it calls for documents in the possession, custody, or control of any person or entity other than Opposer, or documents that are publicly available or equally or more accessible to Applicant.

6. Opposer has not yet completed its investigation of the facts pertaining to this action and discovery is ongoing. All answers and objections to these Interrogatories are based on information presently known to Opposer after a reasonable effort to locate documents and information requested. As a result, all answers and objections are given without prejudice to Opposer's right to supplement or revise its answers and objections as additional information may develop or be discovered.

7. Opposer objects to each and every Interrogatory to the extent that it seeks "any" or "all" information. Such Interrogatories are inherently vague, overly broad, unduly burdensome, duplicative of other Interrogatories, and could be read as improperly seeking information and documents protected by the attorney-client privilege, work-product doctrine, or

other applicable privileges. Opposer will use reasonable diligence to provide responsive information.

8. Opposer objects to each and every Interrogatory to the extent that it seeks information not reasonably calculated to lead to the discovery of relevant information or not proportional to the needs of the case. Opposer objects to all Interrogatories that are not targeted to the specific claims or defenses at issue in these proceedings.

9. Opposer reserves all rights to object to the competency, authenticity, relevancy, and admissibility of the documents and information disclosed pursuant to Applicant's Interrogatories.

10. Opposer objects to each and every Interrogatory to the extent it calls for a legal conclusion.

11. Opposer objects to each and every Interrogatory to the extent it seeks responses that are the subject of expert testimony.

12. The foregoing objections are incorporated by reference into each separate response below as though set forth in full therein.

SPECIFIC OBJECTIONS AND RESPONSES TO INTERROGATORIES 1 – 10

Interrogatory No. 1:

For each of the following listed Du Pont factors, DESCRIBE all probative facts and the supporting evidence for each probative fact YOU CONTEND supports YOUR claim in paragraph 15 of the Notice of Opposition that "TITANIUM KAY so resembles Opposer's prior use and registered KAY Marks as to be likely, when used in connection with the goods set forth in the Application [for TITANIUM KAY], to cause confusion, or to cause mistake, or to deceive . . .":

1. The similarity of the KAY Marks and the TITANIUM KAY Mark in appearance, sound, connotation, and commercial impression;
2. The similarity and dissimilarity of the nature of the goods . . . described in the TITANIUM KAY application;
3. The similarity and dissimilarity of established, likely-to-continue trade channels;
4. The conditions under which and buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing;
5. The number and nature of similar marks in use on similar goods or services;
6. The nature and extent of each instance of actual confusion;
7. The length of time during, and the conditions under which, there has been concurrent use without evidence of actual confusion;
8. The variety of goods on which the KAY Marks and the TITANTIUM KAY marks are or are not used;
9. The market interface between the applicant for TITANIUM KAY mark and the owner/user of the KAY Marks;
10. The extent to which applicant has a right to exclude others from use of its mark on its goods;
11. The extent of potential confusion; and
12. Any other established fact probative of the effect of use.

Answer to Interrogatory No. 1:

Opposer objects to this Interrogatory to the extent it is compound, complex, and contains at least twelve subparts. Opposer objects to this Interrogatory as overly broad and unduly burdensome to the extent that it requests the identity of “all probative facts and the supporting

evidence.” Opposer objects to this Interrogatory to the extent that it requests information that is covered by the attorney-client privilege and/or the attorney work product doctrine. Opposer objects to this request to the extent that it calls for a legal conclusion. Opposer objects to this Interrogatory to the extent that it is a premature contention Interrogatory and discovery in this case is ongoing.

Subject to and without waiving its general and specific objections, Opposer states that not all *Du Pont* factors are relevant to every case, and only the relevant factors should be considered.

1. **The Marks Are Similar:** KAY is the dominant portion of Applicant’s mark and is identical to Opposer’s entire mark. TITANIUM is descriptive of the Application’s named goods (jewelry), and regardless of its position, does not negate a likelihood of confusion because consumers will perceive the arbitrary term KAY as the dominant and source-identifying portion of Applicant’s mark. *See e.g., In re RiseSmart, Inc.*, 104 U.S.P.Q.2d 1931, 1935 (TTAB November 27, 2012) (precedential) (finding confusion between Applicant’s marks TALENT ASSURANCE and JOB ASSURANCE and Opposer’s ASSURANCE mark where TALENT and JOB were both disclaimed as descriptive); *Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 1322 110 USPQ2d 1157, 1161 (Fed. Cir. Mar. 26, 2014) (finding STONE LION CAPITAL likely to be confused with LION CAPITAL and LION); *In re Rexel Inc.*, 223 U.S.P.Q. 830, 831-832 (TTAB August 27, 1984) (LITTLE GOLIATH found likely to be confused with GOLIATH). Indeed, Applicant admits that “titanium” is descriptive, as it disclaimed that term during prosecution of the Application. TBMP § 1213.10 (“Typically, disclaimed matter will not be regarded as the dominant, or most significant, feature of a mark”).

Additionally, given the fame of Opposer’s KAY mark, and because “titanium” identifies a metal commonly used to make jewelry, consumers are likely to interpret TITANIUM KAY as

identifying a line of jewelry made and sold by Opposer under its KAY brand. *See, e.g., In re RiseSmart, Inc.*, 104 U.S.P.Q.2d at 1935 (rejecting application due to likelihood of confusion with registered mark ASSURANCE because “the marks would convey the same connotation with regard to the word ASSURANCE and the additional words [TALENT and JOB] in applicant’s mark simply provide more information as to the nature of the services”). That Opposer actually makes and sells several titanium jewelry products further supports this fact.

2. **The Goods are Identical:** The goods listed in the Application are *identical* to those offered by Opposer. *See In Re Thomas*, 79 U.S.P.Q.2d 1021, 1023 (TTAB 2006) (precedential) (Applicant’s goods are ‘jewelry.’ Registrant’s services involve the retail sale of those goods. These are competitive, inherently related goods and services.”); *Fortunoff Silver Sales, Inc. v. Norman Press, Inc.*, 225 U.S.P.Q. 863, 866 (TTAB 1985) (“there is little question that jewelry store services and jewelry are highly related goods and services”); J. Thomas McCarthy, Trademarks and Unfair Competition §24:25 (2006) (“[w]here the services consist of retail sales services, likelihood of confusion is found when another mark is used on goods which are commonly sold through such a retail outlet.”).

3. **Trade Channels Are Identical:** Both Applicant and Opposer advertise and sell their goods and services on their respective websites and participate in additional promotional activities on social media such as Facebook, Pinterest, and Twitter.

4. **Consumer Care is Neutral:** Neither party’s identification of goods and services is limited by material or cost so it must be assumed that they cover both expensive and inexpensive jewelry. Accordingly, this is a case where ordinary consumers are purchasing jewelry items like rings, earrings, necklaces, and bracelets over the Internet, or perhaps in one of Opposer’s KAY-branded stores, in contrast to a case where highly educated, sophisticated

consumers are purchasing, for example, complex and expensive scientific equipment after weeks of negotiation with a specialized and dedicated salesperson. Further, even careful purchasers of expensive goods can be confused as to source where, as here, the marks and goods/services are identical or highly related. *See, e.g., Nikki Stark Jewelry Design & Repair, Inc.*, Opp. No. 91155798, 2005 WL 1822548, at *4 (July 22, 2005) (non-precedential) (opposition sustained and application refused because marks, services, trade channels, and purchasers were identical).

5. **The Register is Clear of “Similar” KAY Marks:** Opposer incorporates by reference its answer to Interrogatory No. 9. The marks with which Opposer coexists are distinguishable, and not likely to cause confusion with Opposer’s Kay Marks. Because the small number of referenced marks can easily be distinguished from Opposer’s Marks, Opposer’s Marks are strong.

6-7. **Instances of Actual Confusion:** Opposer objects to this Interrogatory as premature, as discovery has just begun. As of now, Opposer is not aware of any instances of actual confusion, but it reserves the right to supplement. However, it is well settled that the relevant test is likelihood of confusion, not actual confusion; thus, it is unnecessary to show actual confusion to establish likelihood of confusion. *See, e.g., Weiss Assocs. Inc. v. HRL Assocs. Inc.*, 902 F.2d 1546, 1549, 14 U.S.P.Q.2d 1840, 1842-43 (Fed. Cir. 1990).

8. **The Marks Are Used on Many Similar and Identical Goods:** Opposer’s Marks and Applicant’s Mark are both used on jewelry, including but not limited to: bracelets, earrings, necklaces, rings, hoop earrings, and wedding rings; a wide a range of accessories including but not limited to money clips, cufflinks, watches, pins, and key rings; and retail services therefor. *See generally* www.kay.com and www.titaniumkay.com showing current offerings of both parties.

Opposer objects to Applicant's request to list the goods on which Opposer's Marks and Applicant's Mark are not used as vague and ambiguous, not relevant to any claim or defense in this proceeding, not proportional to the needs of this case, and overly burdensome.

9. **Market Interface:** Opposer was not aware of Applicant or Applicant's TITANIUM KAY mark prior to Applicant's filing of App. No. 87435559. Applicant does not have Opposer's permission to use the TITANIUM KAY mark.

10. **Opposer Has Strong Rights to Exclude Others from Using KAY:**

Opposer maintains over 1200 KAY-branded brick and mortar stores in all fifty states. Sales of goods under the KAY brand topped \$2 billion in each of the Fiscal Years 2015-2018.

*****BEGIN CONFIDENTIAL – ATTORNEYS EYES ONLY PURSUANT TO PROTECTIVE ORDER ***** [REDACTED]

[REDACTED] ***** END CONFIDENTIAL – ATTORNEYS EYES ONLY PURSUANT TO PROTECTIVE ORDER ***** and Opposer advertises the KAY brand in print, radio, television, and online. Pursuant to FRCP 33(d), Opposer will produce documents relevant to this Interrogatory.

Additionally, users have “liked” the KAY JEWELERS Facebook page more than 1.6 million times and it has over 1.5 million followers (<https://www.facebook.com/KayJewelers/>). Opposer's other KAY social media accounts also have substantial followings: approximately 99,000 followers on Instagram (<https://www.instagram.com/kayjewelers/?hl=en>), 41,800 on Twitter (<https://twitter.com/KayJewelers>), and over 7,000 subscribers to its YouTube channel (<https://www.youtube.com/KayJewelers>). *****BEGIN CONFIDENTIAL – ATTORNEYS**

EYES ONLY PURSUANT TO PROTECTIVE ORDER *** [REDACTED]

[REDACTED]

Opposer objects to this Interrogatory as overly broad and unduly burdensome to the extent that it requests the identity of “each fact.” Opposer objects to this Interrogatory to the extent that it requests information that is covered by the attorney-client privilege and/or the attorney work product doctrine. Opposer objects to this request to the extent that it calls for a legal conclusion. Opposer further objects to this Interrogatory on the grounds that it is a premature contention Interrogatory. Discovery in this action is ongoing, and Opposer will provide this information sufficiently in advance of trial, as required under the Federal Rules.

Subject to and without waiving its general and specific objections, Opposer refers to its response to Interrogatory No. 1.

Dated this 16th day of October, 2018.

Respectfully submitted,

/s/Emily J. Cooper

Emily J. Cooper

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**Attorneys for Opposer
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VERIFICATION

I, Bill Luth, as Executive General Manager, verify that I have read the foregoing Opposer's Objections And Responses To Applicant's First Set Of Interrogatories, Numbers 1-10. I am familiar with the contents of the responses therein, and the same are true to the best of my knowledge, information, and belief.

I declare under penalty of perjury that the foregoing is true and correct.

DATED this 16th day of October, 2018.

Sterling Jewelers Inc.

BY: Bill Luth

NAME: Bill Luth

CERTIFICATE OF SERVICE

I certify that on October 16, 2018, I served a copy of the above **OPPOSER'S ANSWERS TO APPLICANT'S FIRST SET OF INTERROGATORY NUMBERS 1-10** via email on Applicant's counsel at the following address:

gregwood@woodipdr.com
amy@agilelegal.com

/s/ Amy Tindell
Amy Tindell

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