

ESTTA Tracking number: **ESTTA1011822**

Filing date: **10/28/2019**

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

| | |
|------------------------|---|
| Proceeding | 91239222 |
| Party | Plaintiff Sterling Jewelers Inc. |
| Correspondence Address | AMANDA MARSTON HOLLAND & HART LLP PO BOX 8749 ATTN TRADEMARK DOCKETING DENVER, CO 80201 UNITED STATES docket@hollandhart.com, shavlick@hollandhart.com, anmarston@hollandhart.com, ejcooper@hollandhart.com, mamooore@hollandhart.com, ajtindell@hollandhart.com, ceradoci@hollandhart.com 303-473-2861 |
| Submission | Testimony For Plaintiff |
| Filer's Name | Amy J. Tindell |
| Filer's email | ajtindell@hollandhart.com, docket@hollandhart.com |
| Signature | /Amy J. Tindell/ |
| Date | 10/28/2019 |
| Attachments | Rebuttal_Luth_Declaration_-_Redacted_-_Public.pdf(217548 bytes) Ex A - Kay Jewelers - Wayback 2002.pdf(126379 bytes) Ex B - KAY mens.pdf(128689 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 |
|---|--|

DECLARATION OF BILL LUTH

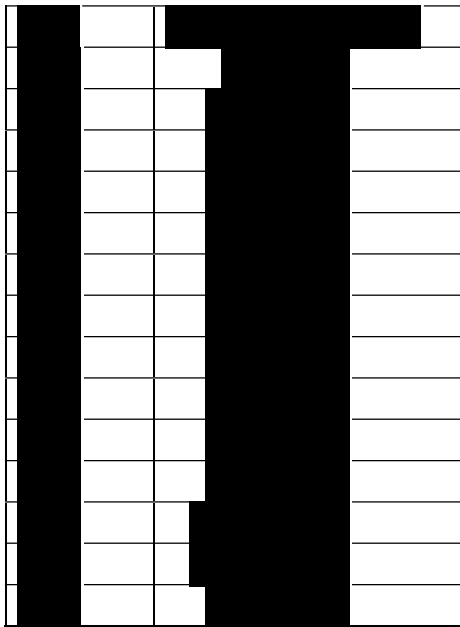
I, Bill Luth, make the following Declaration under penalty of perjury and pursuant to 37 C.F.R. § 2.20:

1. I am the Executive Vice President of Global Store Operations at Sterling Jewelers Inc. (“Sterling”). I have worked at Sterling in various capacities for over twenty (20) years and have responsibility for the goods and services sold and advertised under the KAY Marks as defined in Sterling’s Notice of Opposition. In that capacity, I am familiar with Sterling’s policies and practices regarding its business and its trademarks. I am additionally familiar with the facts of this case and am competent and authorized to make this Declaration on behalf of the Opposer. The facts set forth below are known to me personally or based upon my review of records kept by Sterling in the ordinary course of business.

2. According to my search of the WayBack Machine at < <https://archive.org/web/>>, the <www.kay.com> website has been active since at least as early as March 2002. Attached as Exhibit A is a true and correct printout of the WayBack Machine result for <www.kay.com>.

3. Consumers have been able to purchase jewelry and jewelry-related services on the www.kay.com website since at least as early as September 2006.

4. Consumers of the KAY brand may purchase jewelry in KAY retail stores or through the www.kayoutlet.com and www.kay.com websites. Sterling earns substantial revenues from jewelry goods purchased on the internet. Below is a true and correct chart showing the revenue from Internet purchases of the KAY brand from 2007 to the present. Although Sterling has been unable to retrieve sales records prior to 2007 due to age, I am personally aware and can recall that Sterling's revenue from internet sales in the five years preceding 2007 were close and comparable to the sales years shown on this chart. ****BEGIN: HIGHLY CONFIDENTIAL / ATTORNEYS' EYES ONLY****



****END: HIGHLY CONFIDENTIAL / ATTORNEYS' EYES ONLY****

5. Sterling also offers a substantial number of jewelry items for men and has offered such items since at least as early as 2005. As of October 8, 2019, the www.kay.com website shows 2,273 items that are identified as “men’s.” Attached as Exhibit B is a true and correct

screenshot of the search results on the <www.kay.com> website for “men’s” items. This number of items far exceeds the total number of items that I counted on the entire

<www.titaniumkay.com> website, approximately 700 as of October 8, 2019.

6. ****BEGIN: HIGHLY CONFIDENTIAL / ATTORNEYS’ EYES ONLY****

[REDACTED]

[REDACTED]

[REDACTED]

■ [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

• [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

■ [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

- [REDACTED]
[REDACTED]
[REDACTED]

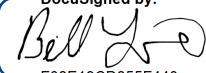
****END: HIGHLY**

CONFIDENTIAL / ATTORNEYS' EYES ONLY**

The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true. 37 C.F.R. § 2.20.

October 28, 2019

Date: _____

DocuSigned by:

E08E19CD855F440...

Bill Luth
EVP, Global Store Operations
Sterling Jewelers Inc.

13659761_v2

Exhibit A

http://kay.com/

Go

JAN MAR MAY

25

2001 2002 2003



About this capture

2,640 captures

7 Jun 1997 - 2 Oct 2019

Every kiss begins with Kay.™

kay.com



KAY®
JEWELERS

welcomes you!

Come in and browse our jewelry selection and see all of the services available to you when you shop at any of our convenient locations.

enter

Exhibit B



FREE 2ND DAY SHIPPING OVER \$50
To Your Home or Any Store! >

KAY[®]
JEWELERS

What can we help you find?



WEDDING

ENGAGEMENT

RINGS

NECKLACES

EARRINGS

BRACELETS

WATCHES

PERSONALIZED

GIFT IDEAS

COLLECTIONS

CLEARANCE

20-40% OFF ENGAGEMENT RINGS >
AND WEDDING BANDS, TOO!

20% OFF CREATE YOUR OWN RING >
USE CODE P93Z0000001010

Home / Search Results

Select Refinements

^ **JEWELRY TYPE**

- Watch (1,218)
- Ring (384)
- Necklace (298)
- Bracelet (247)
- Accessory (92)
- Charm (20)
- Earrings (11)
- Set (2)

^ **GENDER**

- MEN (2,251)

2,273 Items found for men's

All Items

Store Availability

Select My Store

Sort By

Relevancy ▾



Additional Options +

\$49.99

Men's Foxtail Chain Bracelet 9" Length

★★★★☆ (8)



Additional Options +

\$29.99

Men's Wheat Chain Stainless Steel
Necklace 22" Length

★★★★★ (15)



Additional Options +

\$79.99

Men's Foxtail Chain Necklace Stainless
Steel 22" Length

★★★★★ (16)