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

Proceeding	91239222
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<p>Sterling Jewelers Inc.,</p> <p>Opposer,</p> <p>v.</p> <p>Tat Lee,</p> <p>Applicant.</p>	<p>Opposition No.: 91239222</p> <p>Mark: TITANIUM KAY</p> <p>Serial No.: 87435559</p>
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APPLICANT'S OPENING BRIEF

Pursuant to 37 C.F.R. §2.128

TABLE OF CONTENTS

TABLE OF AUTHORITIESii

INTRODUCTION 1

APPLICANT’S DESCRIPTION OF THE RECORD 2

APPLICANT’S STATEMENT OF THE ISSUES 4

APPLICANT’S STATEMENT OF FACTS 6

APPLICANT’S RESPONSE TO OPPOSER’S STATEMENT OF FACTS..... 9

 A. The Inadmissibility of Opposer’s Testimony and Exhibits..... 9

 1. The Rebuttal Declaration and Attached Exhibits of Bill Luth Are Inadmissible 9

 2. The Inadmissibility of Luth’s First Declaration 9

 B. Applicant’s Response and Objections to Opposer’s Statement of Facts 13

 1. Sterling’s Proffer of Evidence of Promotional Efforts 14

 2. Opposer’s Proffer of Evidence of Public Recognition 17

 3. Opposer’s Proffer of Evidence of Sterling’s Reputation for the Wide Variety of Goods and Services Offered..... 19

 4. Opposer’s Proffer of Evidence of Sterling’s Protection and Enforcement..... 21

APPLICANT’S ARGUMENT 21

 A. Opposer’s Standing..... 21

 B. No Likelihood of Confusion 21

 1. Opposer Has Failed to Prove Fame 22

 2. The Marks are Dissimilar When Viewed as A Whole, In Appearance, Sound, Connotation, and Commercial Impression 24

 3. Nature of Goods/Services Do Not Support Likelihood of Confusion 25

 4. Dissimilarity of Established, Likely-To-Continue Trade Channels Does Not Support Likelihood of Confusion 27

 5. The Conditions Under Which and Buyers to Whom Sales are Made Does Not Support Likelihood of Confusion 27

 6. Number and Nature of Similar Marks in Use on Similar Goods Does Not Support Likelihood of Confusion 28

 7. Absence of Actual Confusion Supports the Absence of Likelihood of Confusion 29

 8. The Concurrent Use Without Evidence of Actual Confusion Supports the Absence of Likelihood of Confusion 29

 C. Opposer Has Failed to Prove any Dilution 29

CONCLUSION..... 31

CERTIFICATE OF SERVICE 32

TABLE OF AUTHORITIES

Cases

Bison Corp. v. Perfecta Chemie B.V.,
4 USPQ2d 1718 (TTAB 1987)29

Bose Corp. v. QSC Audio Products Inc.,
293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002)24

Canadian Imperial Bank v. Wells Fargo Bank,
811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992)27

Coach Servs.,
101 USPQ2d at 172228

Coach Servs., Inc. v. Triumph Learning LLC,
668 F.3d 1356, 101 USPQ2d 1713 (Fed. Cir. 2012)26

Federated Foods, Inc. v. Fort Howard Paper Co.,
544 F.2d 1098, 192 USPQ 24 (CCPA 1976)23

In re E I. du Pont de Nemours & Co.,
476 F.2d 1357, 177 USPQ 563 (CCPA 1973) (“*du Pont*”)23

In re Majestic Distilling Company, Inc.,
315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003)23

Lacoste Alligator S.A. v. Maxoly Inc.,
91 USPQ2d 1594 (TTAB 2009)24

Leading Jewelers Guild Inc. v. LJOW Holdings LLC,
82 USPQ2d 1901 (TTAB 2007)24

Octocom Sys., Inc. v. Hous. Computers Servs. Inc.,
918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990)29

Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772,
396 F.3d 1369, 73 USPQ2d 1689 (Fed Cir. 2005)24

Recot Inc. v. M.C. Becton,
214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000)24

INTRODUCTION

Sterling Jewelers, Inc., (“Opposer”) opposes the trademark registration of Tat Lee (“Applicant”) for his “Titanium Kay” trademark because of its incorporation of the word “kay.” Applicant acquired the domain “titaniumkay.com” in 2005 and has continuously used the TITANIUM KAY trademark since 2006 in connection with his business of selling low cost alternative metal jewelry (primarily rings for men) through various internet marketing channels, such as Amazon.com without evidence of even one instance of confusion.

Opposer argues likelihood of confusion and dilution in connection with four of its registered service marks for “retail jewelry store services,” each of which includes the word “kay” as part of the mark - claiming entitlement to exclusive use of “kay” when incorporated as part of a trademark or service mark for jewelry or jewelry servicing notwithstanding that “kay” is currently used as part of thirteen registered trademarks for jewelry owned by ten different owners where two of those trademarks “TRU-KAY” and “MARY KAY” have been continuously registered in connection with jewelry for thirty five (35) years and further despite the absence of even a single instance of confusion between Opposer’s service marks and any of the other third-party uses of “kay,” in the fifteen years Applicant has used its TITANIUM KAY trademark.

Opposer pursues this opposition arguing that its four registered service marks are “famous” relying on two declarations of Luth and a number of exhibits alleged to support its argument of “fame.” However, as Applicant demonstrates:

- the rebuttal declaration of Luth is untimely filed and inadmissible under TTAB rules and the Federal Rules of Evidence;
- the filed first Luth declaration is substantially inadmissible under the rules of evidence as lacking foundation, not based on personal knowledge and therefore incompetent (FRE 601- 602), improper lay opinion (FRE 701-706), and hearsay (FRE 801-802); and
- most Exhibits are inadmissible as lacking foundation, being hearsay (FRE 801-802) or simple irrelevant to any issue before this Board.

Because Opposer has failed to meet its burden to show either “fame” or that any of the *du Pont* factors weighs in favor of a finding of likelihood of confusion or dilution. Accordingly, the Board should dismiss this opposition.

APPLICANT'S DESCRIPTION OF THE RECORD

I. APPLICANT'S TESTIMONY

Applicant submitted the following trial testimony and evidence:

A. Trial Testimony of Danny Lau

- Declaration dated (25 TTABVUE 138).

B. Applicant's Exhibits ("App. NoR." 25 TTABVUE)

- Exhibit 101, Applicant's Banner Ads. Distinctiveness of Applicant's mark as-a-whole. Dissimilar trade channels. Minimal market interface. (25 TTABVUE 101.)
- Exhibit 102, Applicant's Facebook Ads. Distinctiveness of Applicant's mark as-a-whole. Dissimilar trade channels. Minimal market interface. (25 TTABVUE 102.)
- Exhibit 103, Applicant's P&L Statement 2014. Concurrent use without actual confusion. Dissimilar trade channels. Minimal market interface. (25 TTABVUE 103.)
- Exhibit 104, Applicant's P&L Statement 2015. Concurrent use without actual confusion. Dissimilar trade channels. Minimal market interface. (25 TTABVUE 104.)
- Exhibit 105, Applicant's P&L Statement 2016. Concurrent use without actual confusion. Dissimilar trade channels. Minimal market interface. (25 TTABVUE 105.)
- Exhibit 106, Applicant's P&L Statement 2017. Concurrent use without actual confusion. Dissimilar trade channels. Minimal market interface. (25 TTABVUE 106.)
- Exhibit 107, Printout of Applicant's website regarding Affiliate Marketing. Concurrent use without actual confusion. Dissimilar trade channels. Minimal market interface. (25 TTABVUE 107.)
- Exhibits 108-126, Third-party registrations at the USPTO (25 TTABVUE 108-126.)
- Exhibits 127-129, Third-party common law owners. Opposer's assertions of "fame" are limited to its registered service marks view-as-a-whole. Nature of use of similar marks on similar goods. Degree of distinctiveness of Opposer's registered marks. (25 TTABVUE 127-129.)
- Exhibit 130, Applicant's First Amended Responses to Opposer's First Set of Interrogatories (served as Exhibit 3, Deposition of Tat Lee) Responses No. 1-6, and 9 further referencing https://web.archive.org/web/*/Titaniumkay.com. Selection election and adoption of

“TITANIUM KAY” mark in 2005 done without regard for or knowledge of Opposer or its registered marks – Interrogatory Response No. 1. Products on which “TITANIUM KAY” mark used; substantially non-overlapping internet marketing channels; distinctiveness of mark as a whole - Interrogatory No. 2. Motivation for seeking registration of “TITANIUM KAY” mark – Interrogatory No. 3. TITANIUM KAY products and price points since commencement of use in 2005 - Interrogatory No. 4 further referencing https://web.archive.org/web/*/Titaniumkay.com. Applicants lack of knowledge of Opposer – Interrogatory No. 5. No instance of confusion between Opposer’s registered marks and Applicant’s “TITANIUM KAY” mark during concurrent use since 2005 – Interrogatory No. 6. Substantially distinct Internet Trade Channels for Applicant’s goods offered under “TITANIUM KAY” trademark – Interrogatory No. 9. (25 TTABVue 130.)

- Exhibit 131, Applicant Tat Lee’s Deposition – Selected pages/lines (a) 27/1-22; 28/14-22; 29/10-22; 33/4-21; 34/7-35/2; 35/16-25; 37/7-38/8; 38/9-39/23; 42/6-43/10 (b) 51/11-55/21; 58/2-5, 22-59/8; 61/8-10; 62/2-12; 64/3-13; 65/24-70/1; 70/10-72/5 (c) 230/3-9; Deposition Exhibit 4, Applicant’s Amended Response to Opposer’s First Set of Requests for Production of Documents and Things (Commencing on p. 25); Deposition Exhibit 5, Internet Sales through Sears.com market channel (commencing on p. 50) ***HIGHLY CONFIDENTIAL/ ATTORNEYS’ EYES ONLY*** Deposition Exhibit 7, Internet Sales through Facebook marketing channel – Ads payments (AO106) (commencing on p. 91) ***HIGHLY CONFIDENTIAL/ ATTORNEYS’ EYES ONLY*** Deposition Exhibit 8, Applicant’s expenses (AO100-101) for Google Adwords internet marketing (commencing on p. 97) Deposition Exhibit 9, Titanium Kay Facebook Page marketing channel (commencing on p. 105); Deposition Exhibit 10, www.titaniumkay.com affiliate program webpages (AO124-127) for affiliate marketing channels (commencing on p. 118); Deposition Exhibit 11, Commission Junction webpage (AO124 - 138) for affiliate marketing channels (commencing on p. 145); ***HIGHLY CONFIDENTIAL/ ATTORNEYS’ EYES ONLY*** Deposition Exhibit 12, Applicant’s payment to affiliate program participants (AO108) (commencing on p. 148); Deposition Exhibit 14, Walmart.com marketing channel (commencing on p. 185); Selection and adoptions of TITANIUM KAY 2004-2006 – no knowledge of Opposer or Opposer’s registered marks. Motivation to file TM registration application for TITANIUM KAY. Applicant’s marketing, competition and customer acquisition knowledge and efforts under “TITANIUM KAY” trademark. Distinctiveness and value of “TITANIUM KAY” trademark brand acquired after 14 years of continuous use. Selection and

adoption of “TITANIUM KAY” mark; lack of knowledge of Opposer or Opposer’s registered marks. Intent in filing application for “TITANIUM KAY” mark. Products sold under TITANIUM KAY brand consumers of TITANIUM KAY products and price point. Distinct Trade and marketing channels of TITANIUM KAY products: Sear.com; Facebook; Google Adwords; Commission Junction Affiliates; Pinterest, Twitter, www.titaniumkay.com; Walmart.com. Opposer sells only through retail stores and its own website www.kay.com. (25 TTABVUE 131.)

- Exhibit 132, Opposer’s Responses to Applicant’s First Set of Interrogatories. Absence of any instance of actual confusion experienced by Opposer in concurrent use since 2006 - Interrogatory No. 1 (6-7) response to “instances of Actual Confusion”. No likelihood of confusion. Opposer does not market goods under Opposer’s Registered service marks. No evidence of dilution or likelihood of confusion. (25 TTABVUE 132.)

- Exhibit 133, Whois website page for www.titaniumkay.com. <https://www.whois.com/whois/titaniumkay.com>. First use of “TITANIUM KAY” trademark on goods in 2005. (25 TTABVUE 133.)

- Exhibit 134, Selected pages from the Internet archive for the TITANIUM KAY website. (25 TTABVUE 134.)

- Exhibit 135, Photocopy of use of “Titaniumkay” on product packaging. Dissimilarity of marks in their entirety as to sound, appearance, connotation, commercial impression. Dissimilarity and nature of goods / services. No market interface or trade channels. (25 TTABVUE 135.)

- Exhibit 136, Brands of jewelry sold by Plaintiff/Opposer in its retail stores and on the internet. <https://www.kay.com/en/kaystore/cms/brands-collections-page?icid=MM:COLLECTIONS>. Dissimilarity between Opposer’s registered service marks used on retail services and Applicant’s “TITANIUM KAY” trademark used on goods. Dissimilarity of trade channels used. (25 TTABVUE 136.)

- Exhibit 137, “TITANIUM KAY” trademark application status. Date of first use, Dissimilarity, Application Status. (25 TTABVUE 137.)

APPLICANT’S STATEMENT OF THE ISSUES

Applicant restates Opposer’s statement of the issues as follows:

1. Whether Applicant's **TITANIUM***Kay*¹ (in IC 014) trademark, as applied to Applicant's claimed goods, so resembles one or more of Sterling's prior registered service marks:

,² for retail jewelry store services (IC 035),

“every KISS begins with KAY,”³ for retail jewelry store services (IC 035),

⁴, for retail jewelry stores (IC 035), and/or

KAY⁵, for retail jewelry and appliance store services (sic IC 042),

as to be likely, when applied to Applicant's goods, to cause confusion, mistake or deception under Section 2(d) of the Lanham Act.

2. Whether Applicant's **TITANIUM***Kay* trademark, as applied, Applicant's claimed goods, is likely to dilute Sterling's prior registered service marks:

,

“every KISS begins with KAY,”

, and

KAY,

when applied to Applicant's claimed goods under Section 43(a) of the Lanham Act.

¹ This is the form of Applicant's trademark most often presented to the public. Applicant also presents its trademark to the public in typewritten forms “Titanium Kay” or “TitaniumKay.”

² This is the form of Sterling's “Kay Jewelers” service mark most commonly presented to the public but the typewritten “Kay Jewelers” is also used.

³ This is the most common typed form adopted Sterling and presented to the public although various typewritten formats are common.

⁴ Opposer presents this form only once in its consumer warranty Exhibit 39 (19 TTABVUE 39) and in typed form Kay Jewelers Outlet, in Exhibit 35 (19 TTABVUE 35),

⁵ Opposer cites use of “KAY” by itself on only three Exhibits: Exhibit 37 where KAY is used presumably as a service mark on gift wrapping ribbon (19 TTABVUE 37); Exhibit 46 presented as an unregistered trademark in a 2019 Sterling ad (19 TTABVUE 46); and Exhibit 38 (Sterling's 2018 warranty) again presented as an unregistered trademark (19 TTABVUE 38). Exhibits 46 and 38 are both trademarks, not service marks, presented in the stylized form of Sterling's July 19, 2019 issued trademark registration number 5808408 which (not included in Opposer's Notice of Reliance (“NoR”).

APPLICANT'S STATEMENT OF FACTS

Applicant first adopted and began using the mark “TITANIUM KAY” in connection with various types of jewelry, primarily alternative metal men’s jewelry, shortly after obtaining the domain name “titaniumkay.com” on September 1, 2005. See Exhibit 133 ¶1 (25 TTABVUE 133 ¶1)⁶. The trademark “TITANIUM KAY” was selected as a statement that Titanium (and other alternative, less expensive metals), were “Okay”, that is, acceptable. The slang version “kay” (apparently used inadvertently) was then adopted for Applicant’s the domain name, titaniumkay.com, and subsequently “TITANIUM KAY” and the stylized  normally viewed by customers. See Exhibit 49, Response to Interrogatory No 1 (20 TTABVUE 49) and Exhibit 51 at 33:4-35:2 (20 TTABVUE 51). Applicant began using the “TITANIUM KAY” mark at least as early as April 12, 2006 (Exhibit 134, 25 TTABVUE 134), at which time Applicant offered its TITANIUM KAY brand jewelry for sale on the website www.titaniumkay.com. (Exhibit 138 ¶2, 25 TTABVUE 138).

Since Applicant first adopted and began using his “TITANIUM KAY” trademark, that use has been exclusively as a trademark to identify its jewelry goods which were substantial limited to men’s alternative metal jewelry (Exhibit 53, 20 TTABVUE 53) on its own website www.titaniumkay.com and on third party websites such as Amazon, Facebook, www.sears.com, www.walmart.com and various affiliate sites (Exhibits 138 ¶6; 130; 131; 132; 107; 102; 49 response to Interrogatory No.2; 51 e.g., at 207:12-15, 109:8-13, 109:23-110:6; 158:18-22 (25TTABVUE 138, 130, 131, 132, 107, 102 and 20 TTABVUE 49 and 51).

During the intervening 15 years of use, with the sole exception of Sterling’s objection resulting in this opposition, Applicant has not experienced a single complaint arising from its use of

⁶ Opposer objects to the Trial Testimony of Lau, Exhibit 138 (25 TTABVUE 138), asserting that TBMP 703.01; 37 CFR §2.123(a); and 37 CFR § 2.116(e). Opposer’s objections are without merit. 37 CFR §2.123(a) states that “The testimony of witnesses in inter partes cases *may be submitted* in the form of an *affidavit or a declaration* pursuant to §2.20 and in conformance with the Federal Rules of Evidence, filed during the proffering party’s testimony period...” (emphasis added). 37 CFR § 2.116(a) states “... procedure and practice in *inter partes* proceedings shall be governed by the Federal Rules of Civil Procedure” and 37 CFR § 2.116(e) states “The submission of notices of reliance, *declarations and affidavits*, as well as the taking of depositions, during the assigned testimony periods correspond to the trial in court proceedings” (emphasis added). Finally, TBMP 704.01 states that “... evidence in an inter partes proceeding before the Board *can be introduced in a number of ways ...*” (emphasis added). Each of the sections affirmatively permits submission of testimony by declaration in the NoR which Applicant did. Opposer has failed to identify any specific authority that says otherwise. Indeed, if Opposer’s objection was well taken, the declarations of Luth would be equally objectionable.

“k-a-y” as part of its trademark, a single complaint arising from its adoption and use of its “TITANIUM KAY” trademark or a single instance of actual confusion with respect any trademark or service mark from the owners of the registered trademarks or service marks or common law marks identified hereafter in Exhibits 109-129 (25 TTABVUE 109-129). See Exhibit 138 ¶4 (25 TTABVUE 138). Likewise, Applicant has not experienced a single instance of confusion, misdirected mail, misdirected billing or any other mix-up between its goods and those of any other third party that incorporated “kay” as part of its mark in its fifteen years of selling jewelry under the “TITANIUM KAY” trademark. Applicant is not alone. Sterling likewise has admitted that it has not experienced a single instance of confusion related to Applicant’s “TITANIUM KAY” trademark. Exhibit 132 response to interrogatory number 1 (25 TTABVUE 132).

As previously noted, Applicant is not the only entity that incorporated “k-a-y” as part of their registered trademark for jewelry. Other examples of trademarks with active registrations include SCOTT KAY (first used in 1984, registered 2004) (Exhibit 109)⁷; THE GUARDIAN BY SCOTT KAY (first used in 2008, registered 2013) (Exhibit 110); SCOTT KAY GUARDIAN (first used in 2008, registered 2013)(Exhibit 111); SCOTT KAY (script) (first used in 2012, registered 2016)(Exhibit 112); EVAKAY (first used in 2014, registered 2018)(Exhibit 113); TRU-KAY (first used in 1946, registered 2017)(Exhibit 115); TRU-KAY (script) (first used in 1946, first registered 1984)(Exhibit 116); KAYLOCHEER (design) (first used in 2016, registered 2017)(Exhibit 116); JULIA KAYS (first used in 2017, registered 2018) (Exhibit 116); ALEXIA KAY (first used in 2013, registered 2015) (Exhibit 116); KAYSHINE (design) (first used in 2013, registered 2015) (Exhibit 116); JAYS AND KAYS (first used in 2001, registered 2016)(Exhibit 116); KAYMEN FASHION JEWELLRY (first used in 2015, registered 2016) (Exhibit 116); KAY BUENA (first used in 1974, registered 2011) (Exhibit 116); RAQUEL KAY (first used in 2012, registered 2013) (Exhibit 116); DETRA KAY JEWELRY DESIGN (first used in 2000, registered 2003) (Exhibit 116); DETRA KAY (design)(first used in 2002, registered 2003) (Exhibit 116); and MARY KAY (first used in 1983, registered 1985) (See Exhibits 109-126, 25 TTABVUE 109-126). Examples of service marks that include “kay” and used in connection with selling jewelry include letters “k-a-y” are BAR-KAY JEWELERS “since 1948” (Exhibit 127); SALLY KAY JEWELRY (Exhibit.

⁷ Applicant requests judicial notice that marks registered more than five years have been renewed based on the affidavits of continued use in commerce of record in the registration files of the U.S. Trademark office for each of the above registered marks.

128); KAY'S FINE JEWELRY (Exhibit. 129) (25 TTABVUE 127-129).

Applicant has marketed its jewelry solely through internet channels and has never had a retail store or any "brick and mortar" retail outlet. Exhibit 138 ¶6 (25 TTABVUE 138). Applicant also does not sell expensive jewelry or a large variety of jewelry types but limits its products to mostly men's jewelry made from alternative metals that are much less expensive than gold, silver or platinum which is the predominant metal used in jewelry that Opposer sells through its retail stores. Applicant sells only its own brand of Jewelry. By contrast, virtually all Sterling's sales are under the brands of suppliers or third party-brands. Exhibit 136 (25 TTABVUE 136).

Danny Lau examined the internet archive for the 2005 www.kay.com (Exhibit 34, 18 TTABVUE 34) and did not personally observe any way to purchase jewelry directly from the www.kay.com website and Opposer instead referred any potential customer to its retail stores because there was no "shopping bag" page enabling a purchase on line. Based on Lau's further examination, a "shopping bag" button was not added to the www.kay.com website until sometime between December 21, 2006 and December 24, 2007. By contrast, the only way to purchase TITANIUM KAY branded jewelry was on the internet through the www.titaniumkay webpage or through the websites of Walmart, Amazon, Bistrate, Facebook, Pinterest, Twitter, Sears, Shopping.com, picegrabber.com, or nestag.com or through affiliate websites which advertise TITANIUM KAY jewelry and receive a commission on each sale made through that affiliate advertising. These marketing channels are the only channels used by Applicant and until about 2007 were apparently unused by Sterling. Exhibit 138 ¶6 (25 TTABVUE 138).

Applicant's jewelry is also of a substantially different class and quality than that sold by Sterling. Applicant sells low to moderate value jewelry generally in the \$100 range with many items below that price and an occasional item being as much as \$250. By contract, Sterling sells many jewelry items at prices in the tens of thousands of dollars with many of those items bearing the trademark of other manufacturers. Most of the items sold by Opposer are women's jewelry with only a small fraction being men's jewelry. Applicant's jewelry is predominantly men's alternative metal jewelry. Exhibit 138 ¶7 (25 TTABVUE 138).

APPLICANT'S RESPONSE TO OPPOSER'S STATEMENT OF FACTS

A. The Inadmissibility of Opposer's Testimony and Exhibits

1. The Rebuttal Declaration and Attached Exhibits of Bill Luth Are Inadmissible

On October 28, 2019, thirty-one days after Opposer's rebuttal disclosures were due, and after Opposer's rebuttal period had ended (14 TTABVUE), Opposer filed the rebuttal declaration of Luth, attached Exhibits A and B and new Exhibit 55 (26-29 TTABVUE). Opposer's rebuttal evidence was untimely filed beyond the end of the Trial Period without notice to or stipulation with the Applicant or approval of the Board and is therefore properly stricken and not considered. 37 CFR 2.121(a).

The applicable scheduling order, 17 TTABVUE p.6, set September 27, 2019 as the deadline for [Opposer's] rebuttal disclosures. 37 CFR 2.121 clearly states that "[n]o testimony shall be taken of evidence presented except during the times assigned, unless by stipulation of the parties approved by the Board, or upon motion granted by the Board or by order of the Board." There has been no stipulation, no granted motion, and no Board order extending the time and therefore 26-29 TTABVUE are improper as untimely and must be stricken. The evidence is additionally inadmissible because it lacks foundation, was not based on Luth's personal knowledge as required under (FRE 602) and is improper lay opinion (FRE 701). Opposer's untimely submission of 26-28 TTABVUE and specifically Exhibit 55, Exhibits A and B and the Luth Rebuttal testimony must be stricken and not considered by the Board.

Opposer also attempts to introduce evidence from two documents Opposer failed to include in its NoR, namely STERLING000104 and STERLING000374. This failure cannot be cured by stealthily referring to them in the Declaration of Luth (22-24 TTABVUE) and hoping the failure would go unnoticed or by relying on their production to Applicant during discovery. Accordingly, these documents and all testimony or argument arising from or based on these documents are properly stricken and cannot considered by the Board.

2. The Inadmissibility of Luth's First Declaration

Opposer presents the deposition of Bill Luth to provide foundational evidence (personal knowledge) for the exhibits listed in Opposer's NoR (22-24 TTABVUE and 18-21 TTABVUE). Opposer does not present Luth testimony as an expert and Luth was not qualified to provide either

lay or expert opinions under the Federal Rules of Evidence (FRE).⁸ Accordingly all opinions and argument in the Luth declaration are inadmissible and must be stricken. Furthermore, Luth's attempt to authenticate documents as to which he does not have personal knowledge must be rejected and those paragraphs and statements also stricken. Luth is not presented as the custodian of records for any of Opposer's Exhibits and therefore also cannot authenticate or provide foundational testimony for any of Sterling's records as to which he does not have affirmative personal knowledge. In short, Luth is not competent to provide testimony based on facts other than those clearly shown to have been based on his personal knowledge. Accordingly, the portions of the Luth declaration not clearly established by Opposer as within the personal knowledge of Luth are also inadmissible and must be stricken and disregarded (FRE 601- 602) by the Board. Luth's opinion testimony is also inadmissible and must be stricken and disregarded (FRE 701-706). Finally, Applicant objects to the Luth declaration to the extent Opposer has failed to lay a proper foundation as to, for example, the source, relevance or materiality of the referenced document to the likelihood of confusion or dilution issues in this opposition.

More specifically, Applicant interposes its objections to the following parts of the Luth declaration⁹ as being inadmissible for the following reasons:

- ¶2 *“Sterling is the largest specialty jewelry retailer in the United States.”* This statement is without foundation, is not shown to have been based on personal knowledge (FRE 601- 602), is inadmissible lay opinion (FRE 701-706) and is hearsay (FRE 801-802).
- ¶4 *“Sterling has expended significant money and effort in promoting the Kay marks to the public through its marketing and advertising efforts and its partnerships. In connection with this Opposition, I reviewed several articles that reflect Sterling investment in promoting the Kay marks and associated goods and services, and I can confirm that they accurately represent Sterling's efforts.”* Luth's opinion of accuracy of the document reviewed is inadmissible fails to lay a proper foundation of personal knowledge or relevance (FRE 601-602), are inadmissible lay opinion (FRE 701-702) and are inadmissible hearsay (FRE 801-802).

⁸ Expert declarations were due March 16, 2019 more than two months before the Luth fact declaration was filed. 14 TTABVUE at p.6.

⁹ Applicant objects to many of the Exhibits as not probative of or otherwise do not support Opposer's arguments and are therefore either inadmissible as irrelevant or if relevant are entitled to little weight in deciding the likelihood of confusion or dilution issues.

- ¶5 Except for the first phrase ending with “... *in 1985*,” this paragraph lacks foundation (no evidence that he personally viewed the cited Exhibits 22, 26-29 or made copies or that these are business records of which he was the custodian or has personal knowledge), and is inadmissible lay opinion (e.g., “brand awareness,” “fame,” “unsolicited attention”) (FRE 701-702) and hearsay (FRE 801-802) as to which no exception has been put forth.

- ¶6 the last sentence, lacks foundation as to source of the documents or Luth’s personal knowledge related to those documents. Furthermore, the documents speak for themselves and Luth’s testimony is inadmissible lay opinion.

- ¶7 Statement in its entirety is without foundation, is not based on personal knowledge (FRE 601- 602), is inadmissible lay opinion (FRE 701-706) and is hearsay (FRE 801-802) and is therefore inadmissible.

- ¶8 Statement in its entirety is without foundation, is not based on personal knowledge (FRE 601- 602), is inadmissible lay opinion (FRE 701-706) and is hearsay (FRE 801-802) and is therefore inadmissible.

- ¶9 Statement in its entirety is without foundation, is not based on personal knowledge (FRE 601- 602), is inadmissible lay opinion (FRE 701-706) and is hearsay (FRE 801-802). Furthermore, the statements as to quantity of followers is not supported by the documents and is inadmissible lay opinion.

- ¶10 Statement in its entirety is without foundation (Opposer fails to provide any source for the numbers recited or the chart and fails to authenticate Exhibit 47 as referring to Kay Jewelers rather than Sterling Jeweler’s or some other Sterling retailer) is not based on personal knowledge (FRE 601- 602), is inadmissible lay opinion (FRE 701-706) and is hearsay (FRE 801-802).

- ¶12 Statement in its entirety is without foundation, is not based on personal knowledge (FRE 601- 602), is inadmissible lay opinion (FRE 701-706) and is hearsay (FRE 801-802). Furthermore, this paragraph is based solely on a document, STERLING000104, that Opposer did not include in its NoR (18-21 TTABVue) and therefore cannot be considered by the Board and should be stricken. See 37 CFR 2.121(a).

- ¶13 Statement in its entirety is without foundation, is not based on personal knowledge (FRE 601- 602), is inadmissible lay opinion (FRE 701-706) and is hearsay (FRE 801-802). Furthermore, this paragraph is based solely on a document, STERLING000374, that

Opposer did not include in its NoR (18-21 TTABVUE) and therefore cannot be considered by the Board and should be stricken. See 37 CFR 2.121(a).

- ¶14 Statement in its entirety is without foundation, is not based on personal knowledge (FRE 601- 602), is inadmissible lay opinion (FRE 701-706) and is hearsay (FRE 801-802).

- ¶15 The statement “*and are marketed and used by consumers of specialty jewelry*” is without foundation, is not based on personal knowledge (FRE 601- 602), is inadmissible lay opinion (FRE 701-706) and is hearsay (FRE 801-802).

- ¶16 The statement “*Sterling’s Kay brand is well known for its selection of quality engagement and wedding rings*” is without foundation, is not based on personal knowledge (FRE 601- 602), is inadmissible lay opinion (FRE 701-706) and is hearsay (FRE 801-802).

- ¶18 The statement “*Sterling has sold jewelry product made from titanium under the Kay brand since as early as 1999*” is without foundation, is not shown to have been based on personal knowledge (FRE 601- 602), is inadmissible lay opinion (FRE 701-706) and is hearsay (FRE 801-802).

- ¶21 The statement “[*t*]hese products generally are sold to the public at a cost between approximately \$50 to \$180” is without foundation, is not based on personal knowledge (FRE 601- 602), is inadmissible lay opinion (FRE 701-706) and is hearsay (FRE 801-802).

- ¶22 Statement in its entirety is without foundation, is not based on personal knowledge (FRE 601- 602), is inadmissible lay opinion (FRE 701-706) and is hearsay (FRE 801-802). Furthermore, this paragraph is based solely on a document, STERLING000104, that Opposer did not include in its NoR (18-21 TTABVUE) and therefore cannot be considered by the Board and should be stricken.

- ¶¶23, 26-32 Statements are without foundation, are not based on personal knowledge (FRE 601- 602), are inadmissible lay opinion (FRE 701-706) and are legal argument by a fact witness and as such are inadmissible and must be stricken.

- ¶¶33-34 These statements are lacking in foundation, are not based on personal knowledge (FRE 601- 602), are inadmissible lay opinion as to the character of these decision (FRE 701-706) and is hearsay as to the nature of the case and description of the decisions (FRE 801-802). The decisions are also admittedly only the “successful” decisions where that success is simply the lay opinion of Luth and admittedly do not include all enforcement decisions. Finally,

to admit these statements would be prejudicial to Applicant since applicant requested evidence of all enforcement efforts not just the “successful” ones. These paragraphs and Exhibit 52 (21 TTABVUE) should be stricken.

- ¶35 The last sentence of this statement is without foundation, is not based on personal knowledge (FRE 601- 602), is inadmissible lay opinion (FRE 701-706) and is hearsay (FRE 801-802).

- ¶¶ 36-51 These statements are inadmissible legal argument and lay opinion (FRE 701-706) and otherwise inadmissible hearsay (FRE 801-802). These paragraphs are properly stricken and not considered by the Board.

Applicant moves the Board to strike the portions of the Luth declaration identified and described above for the reasons and based on the authority set out above.

B. Applicant’s Response and Objections to Opposer’s Statement of Facts

Opposer’s Statement of Facts consists of two parts: (I) Facts allege to support “fame’ of Opposer’s four registered trademarks (18 TTABUV 1-4), factors identified in *In re E I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*du Pont*”) and (II) Applicant and its “TITANIUM KAY” mark. Opposer focuses almost entirely on evidence it alleges support a finding that the word “kay” is famous and that Opposer is entitled to exclusive use of “kay” alone or in combination with any other words when used on jewelry or in connection with Jewelry related services. Fame of a registered mark is one of the thirteen listed *du Pont* factors to be considered in determining likelihood of confusion. While “fame,” if clearly proven, is often accorded greater weight in the determination of likelihood of confusion, Opposer has the heavy burden of proving “fame” for each of the registered marks in issue in this opposition: “KAY,” “Kay Jewelers,” “Kay Jewelers Outlet” and “Every Kiss Begins with Kay.” Opposer has failed in its burden of proving with admissible evidence that “fame” for “kay” in connection with jewelry or selling of jewelry is famous and entitled greater weight in the likelihood of confusion or dilution determinations.

With respect to the first of the four marks in issue - Exhibit 1 (18 TTABVUE 1), Opposer appears to have presented only three supporting Exhibits¹⁰: Exhibit 37, a photo of what appears

¹⁰ Opposer has not specified the Exhibits which it asserts supports the alleged fame of Exhibits 1 or 3 (22 TTABVUE 1, 3) so Applicant’s analysis is based on Applicant’s attempt to carefully review each of the Exhibits submitted in Opposer’s NoR.

to be a ribbon bearing the repeated word “KAY.” This photo is of unknown origin, ownership, date of origin, purpose, is not self-authenticating as to either jewelry or selling services and does not bear any trademark registration notice (18 TTABVUE 37) and therefore is entitled to little if any weight; Exhibit 38 which is a copy of a September 2018 Sterling company warranty bearing a stylized “KAY” trademark (not service mark) designation (18 TTABVUE 38) and is therefore irrelevant; and Exhibit 46 which is an undated webpage of unknown origin or origination date also bearing a “KAY” trademark (not service mark) designation (18 TTABVUE 47) and is therefore without foundation and irrelevant. These Exhibits are also inadmissible for failure to lay a foundation for their admissibility or their relevance as being a use of “kay” “for retail jewelry and appliance store” services (18 TTABVUE 1).

With respect to KAY JEWELERS OUTLET, Exhibit 3 (18 TTABVUE 3), Opposer proffers only two exhibits on which Kay Jewelers Outlet appears: Exhibit 35, the annual report of Signet Jewelers, the parent of Sterling Jewelers Inc., where reference to the service mark appears only on pages STERLING000137 and 139 (19 TTABVUE 35); and Exhibit 38 (19 TTABVUE 38) where reference to this mark appears on a warranty provided to Sterling Jewelers customers. Use in the annual report is irrelevant to use in commerce as a designation of retail jewelry store services and Opposer has failed to provide foundation as to how use on a warranty (an after sale document) is in anyway relevant to likelihood of confusion determination. Applicant therefore objects to the admissibility of Exhibits 35 or 38.

Even if admissible, these documents are entirely insufficient to show fame for either of Opposer’s two registered marks, “Kay” or “Kay Jewelers Outlet.”

Opposer has submitted Exhibits on which its registered service marks KAY JEWELERS and EVERY KISS BEGINS WITH KAY appear and Applicant addresses the admissibility of each of those Exhibits in the following response to Opposer’s Statement of Facts.

1. Sterling’s Proffer of Evidence of Promotional Efforts

Opposer proffers the following as evidence of Sterling’s alleged promotion efforts: First, Luth ¶¶ 4, 5, 9, 10, 13 (22-24 TTABVUE ¶¶ 4, 5, 9, 10, 13). For the reasons discussed above, paragraphs 4, 9, 10, 13 should be stricken in their entirety and disregarded. What remains is the portion of paragraph 5 reciting the launch of an advertising campaign for “Every Kiss Begins with

Kay” in 1985¹¹, to the extent the statement refers to the beginning of the advertising campaign, the statement is arguable admissible base on Luth’s personal knowledge. As to Luth’s statement that the start date was 1985, the statement is hearsay and inadmissible.

Opposer also cites, in order, Exhibits 32, 25, 36, 22, 24, 19-21, 55, 26, 29, 27, and 28 (18 TTABVUE 32, 25, 36, 22, 24, 19-21, 55, 26, 29, 27, and 28).

Exhibit 32 is a largely generic third party 2009 marketing article that does not mention any of Opposer’s service marks, mentions Sterling Jewelers only three times, and does not identify any marketing efforts or financial expenditure regarding Sterling’s promotional effort with respect to the “Kay Jewelers” or “Every Kiss Begins with Kay” services marks. Exhibit 32 is irrelevant and Opposer has failed to provide any foundation as to its probative significance or relevance to any likelihood of the confusion or dilution factors including alleged fame of Opposer’s “Kay Jewelers” or “Every Kiss Begins with Kay” marks and should be accorded no weight on the issue of promotional efforts.

Exhibit 25 is a 2015 article regarding a charitable commitment of Sterling Jewelers. The article mentions, in passing, that Sterling is the parent company of Kay Jewelers and Jared the Galleria of Jewelry and that Kay Jewelers was proud to be a part of the relationship between St. Jude’s and Sterling Jewelers. Opposer’s “Every Kiss Begins with Kay” service mark does not appear in this article. While this Exhibit shows participation in promotional efforts, the primary instigator and beneficiary of that promotion was Sterling Jewelers, not Kay Jewelers. Accordingly, this Exhibit is entitled to little, if any weight in showing fame of the “Kay Jewelers” service mark and should be accorded no weight in showing “fame” as to Opposer’s “Every Kiss belongs to Kay” service mark.

Exhibit 36 appears to be a power point presentation created sometime after May 2018 and after this opposition was initiated. Inserted within Exhibit 36 are many editorial comments by an unknown person and includes what appears to be copies of various documents, none of which are authenticated as to date, source, or relevance. Opposer has failed to lay any foundation for their admissibility. Exhibit 36 is proffered by Opposer under 37 CFR §2.116(e) (submission of NoR and declaration), 37 CFR §2.123(a) (declaration during testimony period), and 37 CFR §2.122(e) (printed publication). However, none of these bases for admissibility are applicable on the face of

¹¹ According to its trademark registration, the first use of this trademark was November 1, 2000, not 1985 and any statement to the contrary based on any of Opposer’s proffered exhibits is inadmissible hearsay. Exhibit 4 (18 TTABVUE 4).

the document. Other evidentiary objections might also be applicable but cannot be determined absent disclosure of its source. This Exhibit is therefore inadmissible, and Applicant requests the Board strike and disregard Exhibit 36 (19 TTABVUE 36).

Exhibit 22 is a press release dated September 5, 2018, after this opposition was initiated on January 31, 2018, after Applicant's application for registration was filed on May 3, 2017, and twelve (12) years after Applicant began using its trademark. Opposer fails to lay any foundation as to the purpose or relevance of this Exhibit or any evidence of metrics showing its impact if any, on the public or its contribution to the fame the "Kay Jewelers" or "Every Kiss Begins with Kay" service marks. This Exhibit lacks foundation and should be denied admission in evidence or if admitted given minimal weight.

Exhibit 24 appears to be a publication of what purports to be a Kay Jewelers press release dated August 15, 2014 by Cision PR Newswire, approximately eight years after Applicant began using its mark. This press release discloses that Kay Jewelers retail stores were carrying and selling "so Sofia" brand jewelry and accordingly is a press release focusing on the "so Sofia" jewelry trademark, not the Kay Jewelers service mark. Whatever "fame" is evidenced for Kay Jewelers is incidental. At most, Opposer is communicating to the public that "so Sofia" is a brand of jewelry as to which Kay Jewelers is rendering retail selling services. This anecdotal Exhibit should be given minimal weight on the issue of fame from publicity as to the Kay Jewelers service mark absent any evidence of market impact or penetration.

Exhibits 9, 20, and 21, proffered as evidence of fame of the Kay Jewelers registered service mark, are pages downloaded for Opposer's own website on September 7, 2018 after this opposition was initiated and at most are anecdotal of Opposer's current use of the "Kay Jewelers" service mark on its website. However, Opposer provides no foundational evidence such as metrics of consumer or public impact of this avenue of use and Opposer does not present any evidence that would connect this contemporary use of Kay Jewelers (after the registration of "TITANIUM KAY" was filed), as relevant to a showing of fame as to "Kay Jewelers" or "Every Kiss Begins with Kay" service marks as of Applicant's filing date. Absent this essential foundational showing, these Exhibits are inadmissible and in any event are of virtually no relevance to the confusion or dilution issues in this opposition. These Exhibits are inadmissible or at the very least are entitled to minimal if any weight regarding fame through publication.

Exhibits 26, 27, 28 and 29 are four illustrations of publicity for the “Kay Jewelers” and “Every Kiss Begins with Kay” service marks over the six-year time period from 2012 through 2018. Exhibits 26 and 28, published in 2012, are entitled to little if any weight as evidence of publicity of the service mark “Every Kiss Begins with Kay.” Exhibit 27 is entitled to no weight as it was published November 2017 (six months after Applicant’s filing date) and is therefore irrelevant and inadmissible and Exhibit 29 is undated and inadmissible for lack of foundation. Exhibits 26 and 28 also appear to be publications addressed to the jewelry industry not consumers and are therefore of limited relevance on the issue of fame of the relevant marks with the public. Again, Opposer presents no metrics as to distribution quantities or other objective measures from which impact on the public could be inferred. As such, these Exhibits are entitled to little if any weight in inferring fame from publicity.

Exhibit 55 was untimely filed as above discussed and is therefore inadmissible and should be stricken and disregarded.

2. Opposer’s Proffer of Evidence of Public Recognition

Opposer next proffers evidence alleged to support Sterling’s public recognition and success as follows:

Exhibit 26 is a February 10, 2012 third party market publication referencing “Kay Jewelers” and “Every Kiss Begins with Kay” proffered without any foundational showing of metrics of circulation, market penetration, or the target audience and therefore lacks sufficient foundation to be admissible on “public recognition” (18 TTABVUE 26).

Exhibit 29 is an undated Sterling generated ad mentioning “Kay Jewelers” and “Every Kiss Begins with Kay” and is also devoid of any foundation as to when, how, to whom, and how widely this ad was published or distributed if at all, and therefore is inadmissible as lacking foundation and even if admitted, bears little if any weight on the issue of fame arising from public recognition (18 TTABVUE 29).

Luth ¶12 is the subject to Applicant’s objection and motion to strike above and should be disregarded. 22-24 TTABVUE.

Luth ¶ 8 is the subject to Applicant’s objection and motion to strike above and should be disregarded. 22-24 TTABVUE.

Exhibit 33 is a November 3, 2016, ten page third party publication directed to other jewelry retailers and is an analysis of a number of jewelry retailers and mentions Signet and its use of the “Every Kiss Begins with Kay” and “He Went to Jared” catch phrases and its retail jewelry store “Kay Jewelers.” However, this Exhibit does not appear to have been intended for or distributed to the Public and Opposer has failed to lay any foundation regarding public distribution metrics. This Exhibit is therefore inadmissible or if admissible is entitled to little, if any, weight in as evidence of fame from public recognition.

Exhibit 45 is a 2019 publication / notice awarding “Kay Jewelers” an award as “America’s most recommended jewelry retailer” and appears to have been published to the public on the “Kay Jewelers” website. However, again, there are no distribution or public impact metrics. This lack of necessary foundation renders this Exhibit inadmissible as evidence from which fame could be inferred or attributed and is entitled to little if any weight to show fame from public recognition (19 TTABVUE 45).

Luth ¶7 is the subject of Applicant’s objection and motion to strike above and should be disregarded.

Exhibit 23 (a September 2011 CNN Money article) is apparently directed to the Jewelry retail industry rather than the public, regarding the use of alternative metals in jewelry by many Jewelry retailers including “Blue Nile,” “Kay Jewelers,” and “Scott Kay.” No metrics as to its distribution or impact on the public are provided rendering this Exhibit inadmissible for lack of foundation or relevance and even if admitted is entitled to little if any weight (18 TTABVUE 23).

Exhibit 30 is a March 26, 2015 Fortune Magazine article, which highlighted Tiffany and Signet with a passing reference to the Signet retail chains “Kay Jeweler,” “Zales” and “Jared.” This reference is again devoid of any foundation as to public recognition metrics garnered, which is particularly critical for this Exhibit because this article was, on its face, directed primarily to business interests rather than the consuming public (18 TTABVUE 30).

Exhibit 31 is a 2018 Market Watch publication and is a jewelry market industry analysis for 2018-2022 regarding jewelry retailers Tiffany and Signet (through its retail chains “Kay Jewelers,” “Zales,” and “Jared”) and was intended for distribution to the jewelry trade and not to the public. Opposer has provided no foundation as to metrics regarding distribution or consumer impact or relevance to the issue of fame from “public” recognition attributable to this Exhibit and

the Exhibit is therefore inadmissible and if admitted is entitled to little if any weight (19 TTABVUE 31).

Exhibit 32 is a November 2, 2009 Index Online Research report of ad spending in 2008 by different retail jewelers including Sterling Jewelers and Zales. However, the article does not break out any sales, advertising or other metrics that could be attributable to the marks in issue and specifically does not even mention either “Kay Jewelers” or “Every Kiss Begins with Kay.” This Exhibit is therefore inadmissible for lack of foundation or relevance (19 TTABVUE 32).

Exhibit 54 appears to be a 2015 analysis by Market Realist of 2015 financial results for Tiffany and Signet. However, there is no reference or mention of any of the service marks in issue and is this Exhibit is therefore irrelevant and inadmissible (20 TTABVUE 54).

Exhibit 36 (19 TTABVUE 36) is the subject of Applicant’s objection and motion to strike recited above.

Each of the above references purporting to show public recognition either do not reference any of Opposer’s marks in issue or includes only the service marks “Kay Jewelers” or “Every Kiss Begins with Kay.” None of the Exhibits are accompanied by necessary foundation evidence as to distribution or public impact from which fame could be reasonable inferred.

3. Opposer’s Proffer of Evidence of Sterling’s Reputation for the Wide Variety of Goods and Services Offered

Opposer thirdly proffers the following alleged evidence supporting fame for its registered mark arising from the goods and services offered. Applicant objects to these Exhibits as inadmissible for the following stated reasons:

- Exhibit 5 is a photocopy showing “Kay Jewelers” website listing of various types of jewelry offered as of September 7, 2019. This Exhibit is irrelevant and inadmissible and lacking in foundation as to relevance since there is no showing that the jewelry offered in Exhibit 5 was offered prior to Applicant’s registration application filing. This Exhibit should not be considered on the issue of fame.
- Exhibit 55 is inadmissible and should be disregarded as late filed as above argued.
- Luth Rebuttal Declaration. This declaration was untimely filed and is inadmissible as above recited.
- Exhibit 16 (18 TTABVUE 16) is an undated advertisement of selling services regarding alternative men’s jewelry under the “Every Kiss Begins with Kay” service mark. Opposer has

provided no foundation as to the publication, duration of publication, metrics as to quantity of distribution to the public or any other indicia of exposure to the public and this Exhibit is therefore inadmissible.

- Exhibit 17 (18 TTABVUE 17) is an advertisement bearing a 2002 copyright notice offering selling services under the “Kay Jewelers” service mark with respect to women’s rings and men’s alternative metal rings. While devoid of any associated metrics evidence, Applicant does not object to this exhibit but only on the issue of variety of goods sold by Opposer under its Kay Jewelers service mark before Applicant’s registration filing.

- Exhibit 37 (19 TTABVUE 37) shows “Kay Jewelers” and “Every Kiss Begins with Kay” imprinted on bags and what appears to be gift wrapping. This Exhibit is without foundation as how these items are used in conjunction with the retail jewelry store services of Opposer, over what period of time these items are used, or how this Exhibit is relevant to the variety of jewelry as to which Opposer offered its retail jewelry store service. Absent such foundation, this Exhibit is inadmissible.

- Exhibits 38 and 39 (19 TTABVUE 38,39) shows “Kay Jewelers” and “Every Kiss Begins with Kay” appearing on warranty pamphlets dated 2015 and 2018. Opposer fails to provide any foundation as when or how its own warranty pamphlets were used or how they were provided to customers or how these documents fall within the items of third party branded jewelry in connection with which Opposer offered its retail jewelry store services or how this is relevant to show the “wide variety of goods and services” alleged to be offered under Opposer’s service marks. These Exhibits are therefore inadmissible as irrelevant and without foundation.

- Exhibits 40-42 (19 TTABVUE 40-42) are recent examples of receipts bearing the “Kay Jewelers” service mark for either Signet branded goods or “Kay Jewelers” retail services; Exhibit 43 (19 TTABVUE 43) shows a gift card imprinted with “Kay Jewelers” and Exhibit 44 (19 TTABVUE 44) is a business card imprinted with “Kay Jewelers.” However, none of the items depicted represent jewelry offered by Opposer as retail jewelry store services and therefore are irrelevant to showing the “wide variety of goods and services” alleged in support of Opposer’s “fame” argument. Accordingly, these Exhibits should be disregarded as irrelevant for this purpose.

4. Opposer's Proffer of Evidence of Sterling's Protection and Enforcement

Opposer finally relies on Luth ¶¶7, 12-13, 22, 23, 27 and 29-34 as evidence of enforcement of its trademarks to show "fame." For the reasons given in Section II.A.2, those paragraphs of the Luth declaration are inadmissible under the Federal Rules of Evidence (FRE) and 37 CFR 2.121(a) and must be stricken.

Opposer also relies on Exhibit 52 (20 TTABVUE 52) as evidence of enforcement. However, of the six registrations or registration applications for different marks alleged as evidence of aggressive enforcement, one was a default because of a failure to respond to a notice; three were applications that actually proceeded to issuance (KAYSI, EVAKAY and KAY ME) although one involved an agreement regarding modification of statement of goods; two registrations were intentionally abandoned; and three other matters were infringement issues where others were using Opposer's exact marks.

What Opposer does not mention is the absence of any evidence that it opposed or objected to use of any of the marks in Exhibits 109-129 (25 TTABVUE 109-129) consisting of 21 registered trademarks for jewelry and three common law uses for retail jewelry store services each of which incorporated "kay" as part of the marks used either when the registration application was filed or thereafter upon renewal. Opposer also does not mention that despite its alleged vigorous UDRP enforcement policies, Opposer failed to take any action against use of the titaniumkay.com domain name or use of www.titaniumkay.com website in the fifteen years since their adoption.

APPLICANT'S ARGUMENT

A. **Opposer's Standing**

Applicant does not dispute that Opposer has standing.

B. **No Likelihood of Confusion**

The determination of Likelihood of Confusion under Section 2(d) is made based on the factors set out in *In re E I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*du Pont*"). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). The relevant *du Pont* factors in this matter are: (1) The fame of the prior mark(s); (2) The similarity or dissimilarity of the marks in their entirety as to appearance,

sound, connotation, and commercial impression; (3) The similarity or dissimilarity and nature of the goods; (4) The similarity or dissimilarity of established, likely-to-continue trade channels; (5) The conditions under which and buyers to whom sales are made; (6) The number and nature of similar marks in use on similar goods; (7) The nature and extent of any actual confusion; and (8) The length of time during and the conditions under which there has been concurrent use without evidence of actual confusion.

1. Opposer Has Failed to Prove Fame

Fame, when proven, plays a dominant role in determining likelihood of confusion analysis. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). However, because of the wide latitude of legal protection accorded a famous mark, the party asserting fame must clearly prove it. *Lacoste Alligator S.A. v. Maxoly Inc.*, 91 USPQ2d 1594, 1597 (TTAB 2009); *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

Here Opposer claims “kay” alone is famous in the eyes of the public with respect to jewelry and jewelry services. In order to prevail, Opposer must clearly prove that a “significant portion of the relevant consuming public ... recognizes the mark as a source indicator.” *See Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed Cir. 2005) (“*Palm Bay Imports*”). Opposer’s proffered evidence fails to do so for the following reasons:

- Luth’s rebuttal declaration and related filings were, inter alia, untimely and inadmissible. 26-30 TTABVUE.
- Luth’s declaration (22-24 TTABVUE) is almost entirely inadmissible as set forth above because the testimony lacks essential foundation, is not competent because not based on personal knowledge (FRE 601- 602), is inadmissible lay opinion (FRE 701-706) and is hearsay (FRE 801-802).
- The inadmissibility of exhibits cited by Opposer in its argument regarding fame as more particularly discussed above.
- Opposer’s failure to present admissible evidence supporting “fame” as to Exhibit 1 (“Kay”) or Exhibit 4 (“Kay Jewelers Outlet”). Indeed, Signet, Opposer’s parent corporation, in its

2018 quarterly report does not even mention its registration for “Kay” as among its important marks. See page STERLING000139.

- Opposer’s Exhibit 35 (19 TTABVUE 35) also does not separate out any sales or cost figures attributable to the business conducted under the “Kay Jewelers” or “Every Kiss Begins with Kay” service marks and is therefore irrelevant to and not probative of fame as to “Kay Jewelers” or “Every Kiss Begins with Kay” service marks and must be disregarded.

For each of the above reasons, Opposer has failed to clearly prove, with credible and admissible evidence, that “Kay” alone, “Kay Jewelers,” “Kay Jewelers Outlet” or “Every Kiss Begins with Kay” individually or collectively are entitled to status as “famous.”

In support of its “fame” argument, Opposer also asserts that “kay” is arbitrary. Opposer cites authority but no evidence to support this assertion and this argument must therefore be disregarded.

Opposer’s argument that it vigorously protects and defends its marks is also without credible factual support and is contradicted by the fact that Applicant obtained its domain name, “titaniumkay.com” in 2005 and has continued to use that domain name for the last 16 years without complaint by, opposition from, or notice by Opposer. Also, Applicant has cited 21 trademarks, 19 of which are registered, that incorporate “kay” as part of the mark. Some of those registrations have been renewed one or more times based on affidavits of continued use of those marks in commerce. The Board can take judicial notice of this continued use in commerce over an extended time based on these affidavits of continued use in the official record of the USPTO and that those registrations were timely submitted in Applicant’s NoR (18 TTABVUE 109-126). Accordingly, Opposer’s assertion that there is no evidence of actual use is without merit and must be rejected.

Opposer gives excuses for not objecting to these uses of marks incorporating “kay”: Sterling does not need to police its marks for “relatively insignificant” or “low risk” marks; the third-party registrations pose insignificant risk because they have a connotation of a person’s name; or because of some allege affiliation with Opposer. Yet, Opposer fails to cite a single exhibit or present any declaration supporting the reality rather than the theory of these arguments and those arguments are properly rejected.

Opposer has failed to present admissible, relevant evidence to “clearly prove” its registered marks were “famous.” Accordingly, the “fame” *du Pont* factor does not support a finding of likelihood of confusion.

2. When Viewed as a Whole, the Marks are Dissimilar In Appearance, Sound, Connotation, and Commercial Impression

The next *du Pont* factor is similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. See *Palm Bay Imports*, 73 USPQ2d at 1692. “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted).

Opposer argues: (1) Applicant’s mark “merely combines” “titanium” which by itself was disclaimed as descriptive, and its allegedly “arbitrary” “kay”; (2) the appearance of TITANIUM KAY as normally viewed by the public appear in different fonts that emphasizes “kay”; and (3) the alleged “fame” of its marks and the common use of titanium to make jewelry would cause consumers to interpret TITANIUM KAY as jewelry sold by Opposer.

In response, Applicant first notes that the descriptiveness of “titanium,” when used apart from the mark-as-a-whole, is irrelevant. Marks of both Applicant and Opposer must be view “as a whole” in the likelihood of confusion analysis. Opposer’s bifurcation of Applicant’s trademark into pieces with each piece analyzed separately must be rejected as legally improper. The law required analyzing the marks as-a-whole just as consumers in the real world would encounter the mark.

Opposer’s remaining arguments are based on Opposer’s unsupported speculations rather than facts and rely on attempts to analogize the unique facts of this case with the unique facts of several other cases. However, the facts showing the appearance, sound, connotation, and commercial impression in this case are unique, and the cited cases are therefore of limited if any value.

Turning first to the appearance of Applicant mark, viewed as-a-whole as the relevant public would perceive the mark, numerous distinctions over Opposer’s marks are apparent:



- “TITANIUM” appears in stylized, all capitals, thick block letter font with continuous, diagonal grey metal-like striations connoting metal structural beams. The non-kay portion of

Opposer's marks ("...jewelers," "every kiss begins with...", and "...jewelers outlet") all connote the services (retail selling services) being provided, not the metal from which jewelry is made.

- The "kay" part of Applicant's mark is in blue script font that varies in width, is connected without space to "titanium" and appears as a superscript suggesting, "as an aside" or "incidentally," that titanium is an *Okay* alternative metal for jewelry, particularly the men's jewelry dominantly sold by Applicant (25 TTABVUE 138 paragraph 5). By contrast, Opposer always uses thin block letters that are separated from the other words in the marks and do not appear as a superscript. Opposer's presentation of its marks are also for retail services with Opposer always distinguishing its marks used for services from the trademarks (both its own and the marks of others) under which its jewelry goods are identified (25 TTABVUE 136).
- The dominant part of Applicant's mark is Titanium, not "kay" because it appears first in the trademark, which is generally taken as the position of primacy. Titanium has eight letters as opposed to just three for the "kay" part of the mark, the letters are of a style which connotes strength and dominance and 'kay' is a superscript placement that suggests "oh by the way titanium is Okay."
- When spoken, the articulation of Applicant's mark, as-a-whole, is quite different from the sound of any of Opposer's registered marks.
- The connotation to the dominant customer base to which Applicant is appealing and the commercial impression of Applicant's mark are also quite different for the reasons describe above.

For each of the above reasons, Opposer has failed to satisfy its burden and Applicant submits that this factor weighs strongly against likelihood of confusion.

3. Nature of Goods/Services Do Not Support Likelihood of Confusion

The next factor is a comparison of the goods recited in Applicant's application vis-à-vis the services identified in opposer's pleaded registrations. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992).

Applicant uses its trademark on articles of jewelry, dominantly men's alternative metal jewelry, sold on the internet (25 TTABVUE 101, 102, 107, 131, 138 paragraphs 6-7). Opposer's service marks are for "retail jewelry store services" (18 TTABVUE 1-4). These facts are not disputed. Instead, Opposer argues that this distinction should be ignored because Opposer also sells a small number of alternative metal jewelry in its retail jewelry stores, although not under one

of its own “kay” registered marks. However, the comparison pursuant to the above authority must be for retail jewelry store services not for goods of others that Opposer sells from its stores and which bear different third-party trademarks not in issue here. Furthermore, as argued above, Opposer has intentionally and consistently distinguished between its registered ‘kay’ service marks used on its retail services and ‘non-kay’ trademarks under which it sells both its own, and third-party jewelry goods (25 TTABVUE 136).

Significantly, Opposer has not identified a single product sold under one of its registered ‘kay’ marks in issue here¹² likely because Opposer could not obtain a service mark registration for its retail store service if it only sold its own jewelry in its retail stores. Also significant is that Applicant does not provide retail store services and does not sell the jewelry of others.

Opposer’s argument that it delivers third-party branded jewelry in boxes with ‘kay’ marks is at best misleading. The packaging boxes and bags identified bear only the “Kay Jewelers” or “Every Kiss Begins with Kay” (not ‘kay’ by itself) each communicating to consumers that Opposer was providing the selling services since the goods are otherwise branded with different marks independently indicating the origin of the goods. Furthermore, those boxes are presented to the customer *after the sale* precluding relevance to any risk of likelihood of confusion prior to the purchase decision, a decision which is in any event is made at Opposer’s retail stores. Lastly, Opposer fails to identify the packaging in which Applicant delivers its goods and whether that packaging bears any marking at all.

Accordingly, Opposer has failed to meet its burden of proving that the goods and services are so similar or overlap to such a degree that there would be a likelihood of confusion.

By contrast, Applicant has demonstrated that it does not engage in any selling services and only sells its own goods under its “TITANIUM KAY” trademark through internet channels. The dissimilarity between the nature of the goods sold and services at issue (primarily men’s alternative metal rings over a narrow low price range sold on the internet verses a retail store services in selling a wide range of primarily women’s jewelry over a wide price range) precludes likely consumer confusion (25 TTABVUE 138 ¶¶6-7).

This factor also weighs in favor of no likelihood of confusion.

¹² It is “hornbook” law that an applicant cannot obtain a service mark registration based on selling its own goods.

4. Dissimilarity of Established, Likely-To-Continue Trade Channels Does Not Support Likelihood of Confusion

The relevant trade channels focus on the classes of customers targeted by the parties. *See, e.g., Coach Servs.*, 101 USPQ2d at 1722. Opposer’s services are provided almost entirely through its “brick and mortar” retail jewelry store outlets (over 1200 of them according to Luth ¶2 (22 TTABVUE ¶2) with some service provide through its www.kay.com web site. By contrast, Applicant does not sell through retail stores but sells exclusively through its own and various collaborating third-party websites (25 TTABVUE 138 ¶¶6-7). Accordingly, the respective goods and services, as identified, travel in distinct trade channels *See Octocom Sys., Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718 (TTAB 1987). The customers targeted by Opposer are generally retail customers with the goods sold focusing on a wide range of jewelry across a wide price range. By contrast, Applicant targets customers seeking men’s alternative metal jewelry sold exclusively over the internet and in a narrow low-cost price range (25 TTABVUE 101, 102, 107, 130, 131, 137, 138, 1-15).

In the face of this evidence, Opposer argues that evidence of actual limitations on trade channels should be ignored and should instead be presumed to be unlimited. Such a conclusion is illogical where there is evidence to the contrary. Furthermore, Opposer is wrong. Opposer’s registrations explicitly recited “Retail Jewelry Store Services.” The evidence is undisputed that Applicant does not sell its goods in retail jewelry stores.

Applicant submits this factor also weighs in favor of no likelihood of confusion.

5. The Conditions Under Which and Buyers to Whom Sales are Made Does Not Support Likelihood of Confusion

The evidence and facts bearing on this factor have been recited above in connection with other *du Pont* factors. Customers of Opposer are predominantly walk-in mall shoppers who purchase jewelry sold under various ‘non-kay’ brands that are displayed using physical display cases in show rooms attended by salespersons. The costs charged for the goods sold vary over a wide range from several tens of dollars to many tens of thousands of dollars and include a wide range of third-party branded jewelry. Opposer does have an internet site for displaying its goods but has only enabled sales through the internet in recent years (25 TTABVUE 138 ¶6).

Opposer has presented no evidence as to the significance or nature of its internet sales relative to its in-store sales but does emphasize that provides its retail jewelry store services to more than 1200 retail stores across the US.

By contrast, Applicant sells through its own and third-party web sites where customers are already looking for specific items such as Applicant sells. While Applicant agrees that the products sold overlap to a minor extent, there is no overlap between the sale of Applicant's branded goods and the goods sold by Opposer under the jewelry brands it uses on the goods it sells.

Finally, there is no dispute that the parties have been using their respective service marks and trademarks concurrently for fifteen years during which time neither party has experienced even a single instance of actual confusion. Furthermore, Applicant has not experienced a single instance of actual confusion as to any of the other 21 owners of trademarks that incorporate "kay" as part of their mark.

Applicant submits that buyers have not been and in the future are not likely to be confused between the source of Applicant's goods and Opposer's retail jewelry store services and that this factor also favors a conclusion that there is no likelihood of confusion.

6. Number and Nature of Similar Marks in Use on Similar Goods Does Not Support Likelihood of Confusion

Opposer responds to this this *du Pont* factor with the argument that such evidence is irrelevant without evidence showing use. However, to obtain a registration an applicant must give evidence of use of the mark in commerce by providing a specimen and a sworn affidavit of such use. When a registration is renewed, an affidavit and evidence of use is again required. Such evidence is in the official records of the US Patent and Trademark office of which the Board can take judicial notice. Such judicial notice is appropriate for the cited registrations of record in this opposition as 25 TTABVUE 109 – 126, all marks that incorporate 'kay' as an integral part just as Applicant has done.

Because Opposer admitted that it presented no evidence that would support a finding of likelihood of confusion under this factor and Applicant has submitted numerous trademark registration in the field of jewelry all of which include 'kay' in a manner similar to Applicant's "TITANIUM KAY" application. Applicant submits that this factor also weighs in favor of finding no likelihood of confusion.

7. Absence of Actual Confusion Supports the Absence of Likelihood of Confusion

Opposer is correct that the likelihood of confusion does not require evidence of actual confusion. However, that does not mean that the total absence of any evidence of actual confusion between Opposer's service marks and Applicant's trademarks is not relevant or that Applicant bears any burden of producing evidence on this factor. Opposer has failed to produce any evidence of actual confusion and therefore this factor weighs against a finding of likelihood of confusion.

8. The Concurrent Use Without Evidence of Actual Confusion Supports the Absence of Likelihood of Confusion

Applicant ignores this factor. However, it weighs heavily against finding likelihood of confusion. The undisputed fact is that the parties have been concurrently using their respective marks for over fifteen years. During that time there has not been a single instance of actual confusion - No misdirected mail, No communications from customer, and No misdelivered goods. Confusion as to the retail jewelry store service is indeed impossible because Applicant does not have any retail jewelry stores. The evidence that there is no likelihood of confusion is further bolstered by the evidence that Applicant also experienced not a single instance of confusion with respect to any of the mark owners who marks also include 'kay' as a part. 25 TTABVUE 138 and 109-126.

This factor weighs strongly against finding likelihood of confusion.

C. Opposer Has Failed to Prove any Dilution

Opposer correctly acknowledge that it has the burden to prove dilution with admissible evidence. However, Opposer's argument fails because it rests entirely on evidence that is inadmissible as fully recited above. Further, Opposer has failed to demonstrate it is entitled to a "famous" designation as to any of its registered service marks in issue here.

Opposer cites Applicant's lack of knowledge of Opposer's business and service marks at the time it selected its mark as evidence of "intention." However, Applicant's registration was allowed by the Trademark Examiner who was presumably not negligent. Also, Opposer, despite its alleged diligent enforcement efforts, concedes it did not challenge Applicant's domain name registration and did not know of Applicant use of its "TITANIUM KAY" mark prior to the official Gazette publication of Applicant's "TITANIUM KAY" registration application. Opposer's

argument that Applicant was somehow “negligent” much less grossly negligent is nonsense and must be rejected.

CONCLUSION

For the reasons give above, Opposer has failed to meet its burden of showing likelihood of confusion or dilution. Applicant requests this Opposition therefore be dismissed.

Dated this 26 day of May 2020.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I certify that on 26 May 2020, I served a copy of the above Applicant's Opening Brief via email on Opposer's counsel at the following address:

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_____/s/
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