

ESTTA Tracking number: **ESTTA1081718**

Filing date: **09/14/2020**

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

Notice of Opposition

Notice is hereby given that the following parties oppose registration of the indicated application.

Opposers Information

Name	ICE S.A.
Granted to Date of previous extension	09/16/2020
Address	PLACE MCAULIFFE 34 BASTOGNE, 6600 BELGIUM

Name	ICE IP S.A.
Granted to Date of previous extension	09/16/2020
Address	3, RUE DES TILLEULS ROMBACH, L-8832 LUXEMBOURG

Attorney information	RYAN M. VAN OLST WOLF, GREENFIELD & SACKS, P.C. 600 ATLANTIC AVENUE BOSTON, MA 02210 UNITED STATES Primary Email: drwtrademarks@wolfgreenfield.com Secondary Email(s): rmvtrademarks@wolfgreenfield.com 6176468000
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Docket Number	I04555001600
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Applicant Information

Application No.	88771662	Publication date	05/19/2020
Opposition Filing Date	09/14/2020	Opposition Period Ends	09/16/2020
Applicant	Chen Weili NO. 15 PINGSHANPU TEAM, PINGSHAN VILLAGE DAQIAO TOWN, LUCHUAN COUNTY GUANGXI, 537715 CHINA		

Goods/Services Affected by Opposition

Class 014. First Use: 2019/12/15 First Use In Commerce: 2019/12/15 All goods and services in the class are opposed, namely: Buckles for watchstraps; Costume jewelry; Key chains; Pet collar accessories, namely, pendants; Pet jewelry; Straps for wristwatches; Watch
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bands; Watch bands and straps; Watch cases being parts of watches; Watch chains; Watch straps; Watchbands; Watches; Watches and straps for watches; Watchstraps made of leather; Women's jewelry

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Other	Common-Law Rights in ICE, ICE WATCH and ICE WATCH (DESIGN)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	4833971	Application Date	07/10/2012
Registration Date	10/20/2015	Foreign Priority Date	05/14/2012
Word Mark	ICE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 0 First Use In Commerce: 0 Precious metals and their alloys and goods made of these materials, namely, watches, watch straps, watch chains, watch casings, caskets and cases for clock and watch making, clocks, alarm clocks, stopwatches, chronographs, ornamental jewelry, charms, medals, medallions, insignias, amulets, rings, earrings, bracelets, brooches, chains, necklaces, figurines, cuff-links, tie-pins, hat-pins, hat ornaments, ornaments for footwear, and novelty key rings; jewelry, precious stones; timepieces and chronometric instruments		


U.S. Registration No.	4560526	Application Date	09/17/2008
Registration Date	07/01/2014	Foreign Priority Date	NONE
Word Mark	ICE WATCH		
Design Mark			
Description of Mark	The mark consists of the words "ICE WATCH" in which the word "ICE" is written above and in larger letters than the word "WATCH" and there is a line between the two words. To the above left of the word "ICE" a fanciful image of a diamond appears.		
Goods/Services	Class 014. First use: First Use: 2007/01/01 First Use In Commerce: 2009/06/01 GOODS IN PRECIOUS METALS OR COATED THEREWITH, NAMELY, WATCHES NOT INCLUDING DIAMONDS; AND HOROLOGICAL AND CHRONOMETRIC INSTRUMENTS NOT INCLUDING DIAMONDS		

U.S. Registration No.	4829305	Application Date	09/17/2008
Registration Date	10/13/2015	Foreign Priority Date	NONE
Word Mark	ICE WATCH		
Design Mark			
Description of Mark	The mark consists of the words "ICE WATCH" in which the word "ICE" is written above and in larger letters than the word "WATCH" and there is a line between the two words. To the above left of the word "ICE" a fanciful image of a diamond		

	appears.
Goods/Services	Class 014. First use: First Use: 0 First Use In Commerce: 0 PRECIOUS METALS AND THEIR ALLOYS; JEWELRY NOT INCLUDING DIAMONDS, PRECIOUS STONES NOT INCLUDING DIAMONDS

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	ICE		
Goods/Services	watches, jewelry, and watch accessories		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	ICE WATCH		
Goods/Services	watches, jewelry, and watch accessories		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Design Mark			
Goods/Services	watches, jewelry, and watch accessories		

Attachments	ICE_WATCH.JPG 10455.50016US00 Notice of Opposition.pdf(383034 bytes)
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Signature	/rmv/
Name	RYAN M. VAN OLST
Date	09/14/2020

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

ICE IP S.A. and ICE S.A.,

Opposers,

v.

Chen Weili,

Applicant.

Mark: ICEMODO

Serial No. 88/771662

Opposition No. _____

NOTICE OF OPPOSITION

ICE IP S.A., a company organized and existing under the laws of Luxembourg, having a place of business at rue des Tilleuls, 3, Rombach 8832, Luxembourg; and ICE S.A., a company organized and existing under the laws of Belgium, having a place of business at Place McAuliffe 34, Bastogne 6600, Belgium (together, “ICE” or “Opposers”); believe they would be damaged by registration of the mark depicted in Application Serial No. 88/771662 (the “662 Application”), filed by Chen Weili (“Applicant”), a citizen of China, having an address at No. 15, Pingshanpu Team, Pingshan Village, Daqiao Town, Luchuan County, Guangxi 537715, China, which application was published for opposition in the Official Gazette on May 19, 2020, and hereby oppose the same.

The grounds for this Opposition are as follows:

1. Applicant seeks to register the mark ICEMODO for the goods in Class 14 shown below (Serial No. 88/771662) (the “ICEMODO Mark”):

- Buckles for watchstraps; Costume jewelry; Key chains; Pet collar accessories, namely, pendants; Pet jewelry; Straps for wristwatches; Watch bands; Watch bands and straps; Watch cases being parts of watches; Watch chains; Watch straps; Watchbands; Watches; Watches and straps for watches; Watchstraps made of leather; Women's jewelry.

2. The opposed application was filed on January 24, 2020 pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on alleged use of the mark in commerce since December 15, 2019.

3. From a date long prior to Applicant's filing date and its alleged first use date,



Opposers and their affiliates have used the marks ICE, ICE WATCH, and **watch** for watches and related accessories. Accordingly, Opposers have created valuable goodwill and obtained common law rights in the ICE Marks, which represent high quality goods to consumers throughout the United States.

4. ICE IP owns U.S. Registration No. 4,833,971 for ICE covering the goods below in Class 14:

- Precious metals and their alloys and goods made of these materials, namely, watches, watch straps, watch chains, watch casings, caskets and cases for clock and watch making, clocks, alarm clocks, stopwatches, chronographs, ornamental jewelry, charms, medals, medallions, insignias, amulets, rings, earrings, bracelets, brooches, chains, necklaces, figurines, cuff-links, tie-pins, hat-pins, hat ornaments, ornaments for footwear, and novelty key rings; jewelry, precious stones; timepieces and chronometric instruments



5. ICE IP owns U.S. Registration No. 4,560,526 for **watch** covering the goods below in Class 14:

- Goods in precious metals or coated therewith, namely, watches not including diamonds; and horological and chronometric instruments not including diamonds



6. ICE IP owns U.S. Registration No. 4,829,305 for ICE watch covering the goods below in Class 14:

- Precious metals and their alloys; goods in precious metals or coated therewith, namely, watches not including diamonds; jewelry not including diamonds, precious stones not including diamonds

7. Under 15 U.S.C. § 1115(b), ICE's above-identified Registration No. 4,560,526 is conclusive evidence of the validity of the registered mark, of ICE's ownership thereof, and of ICE's exclusive right to use this mark in commerce for the goods specified in the registration. Pursuant to Trademark Rule 2.122(d), attached are printouts of the electronic records of the USPTO from the TSDR database for this registration.

8. Under 15 U.S.C. § 1057(b), the above-identified registrations for U.S. Reg. Nos. 4,833,971 and 4,829,305 are prima facie evidence of the validity of the registered marks, of ICE's ownership thereof, and of ICE's exclusive right to use these marks in commerce for the goods specified in the registrations. Pursuant to Trademark Rule 2.122(d), attached are printouts of the electronic records of the USPTO from the TSDR database for these registrations.

9. Collectively, Opposers' above-referenced registrations and common law rights are referred to as the "ICE Marks."

10. Despite ICE's long-standing prior use of the ICE Marks, Applicant filed Application Serial No. 88/771662 to register the mark ICEMODO for watches, jewelry, and related accessories, among other goods.

11. The goods in the '662 Application are identical or closely related to the goods offered by Opposers under the ICE Marks.

12. The goods in the '662 Application travel through the identical channels of trade as the goods offered by Opposers under the ICE Marks.

13. Applicant's ICEMODO Mark is confusingly similar to Opposers' ICE Marks in appearance, sound, connotation, and commercial impression.

14. In light of the relatedness of the goods; the overlapping channels of trade; and the similarities in appearance, sound, connotation, and commercial impression between the marks; consumers are likely to believe that Applicant's goods offered under the ICEMODO Mark emanate from or are licensed or approved by Opposers, when that is not the case. Any dissatisfaction with Applicant's goods will reflect upon and irreparably damage the reputation and goodwill of Opposers as embodied in their ICE Marks. Consequently, there exists a likelihood of confusion under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

15. If Applicant is granted registration on the opposed application, Applicant would obtain a prima facie exclusive right to use ICEMODO for the goods identified in its application, which would be a further source of damage to Opposers' rights in their ICE Marks.

WHEREFORE, Opposers believe they will be damaged by registration of Applicant's mark, and pray that this Opposition be sustained, the '662 Application be rejected, and the mark applied for therein be refused registration.

Respectfully submitted,



Date: September 14, 2020

By _____
Ryan M. Van Olst

Douglas R. Wolf
John L. Welch
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Attorneys for Opposers
ICE IP S.A. and ICE S.A.



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ICE

Word Mark	ICE
Goods and Services	IC 014. US 002 027 028 050. G & S: Precious metals and their alloys and goods made of these materials, namely, watches, watch straps, watch chains, watch casings, caskets and cases for clock and watch making, clocks, alarm clocks, stopwatches, chronographs, ornamental jewelry, charms, medals, medallions, insignias, amulets, rings, earrings, bracelets, brooches, chains, necklaces, figurines, cuff-links, tie-pins, hat-pins, hat ornaments, ornaments for footwear, and novelty key rings; jewelry, precious stones; timepieces and chronometric instruments
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	79117436
Filing Date	July 10, 2012
Current Basis	66A
Original Filing Basis	66A
Published for Opposition	August 4, 2015
Registration Number	4833971
International Registration Number	1128035
Registration Date	October 20, 2015
Owner	(REGISTRANT) ICE IP S.A. Société anonyme LUXEMBOURG Rue des Tilleuls 3 L-8832 Rombach LUXEMBOURG Douglas R. Wolf

**Attorney of
Record**

Priority Date May 14, 2012
Prior Registrations 4344713;4348504
Type of Mark TRADEMARK
Register PRINCIPAL-2(F)
Live/Dead Indicator LIVE

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Trademark Assignment Abstract of Title

Total Assignments: 1

Serial #: [79117436](#)

Filing Dt: 07/10/2012

Reg #: [4833971](#)

Reg. Dt: 10/20/2015

Registrant: ICE IP S.A.

Mark: ICE

Assignment: 1

Reel/ Frame: [4988/0819](#)

Recorded: 03/23/2013

Pages: 2

Conveyance: CHANGE OF NAME

Assignor: [CHINALUX SA](#)

Exec Dt: 02/20/2013

Entity Type: UNKNOWN

Citizenship: LUXEMBOURG

Entity Type: NOT PROVIDED

Citizenship: NOT PROVIDED

Assignee: [ICE IP S.A.](#)

RUE DES TILLEULS 3

L-8832 ROMBACH, LUXEMBOURG

Correspondent: ICE IP S.A.

RUE DES TILLEULS 3

L-8832 ROMBACH

LUXEMBOURG

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Word Mark	ICE WATCH
Goods and Services	IC 014. US 002 027 028 050. G & S: GOODS IN PRECIOUS METALS OR COATED THEREWITH, NAMELY, WATCHES NOT INCLUDING DIAMONDS; AND HOROLOGICAL AND CHRONOMETRIC INSTRUMENTS NOT INCLUDING DIAMONDS. FIRST USE: 20070101. FIRST USE IN COMMERCE: 20090601
Mark Drawing Code	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code	17.03.01 - Diamonds, jewelry ; Nuggets of precious metals ; Stones, gems 26.17.05 - Bands, horizontal ; Bars, horizontal ; Horizontal line(s), band(s) or bar(s) ; Lines, horizontal 26.17.13 - Letters or words underlined and/or overlined by one or more strokes or lines ; Overlined words or letters ; Underlined words or letters 27.03.05 - Objects forming letters or numerals
Serial Number	77983619
Filing Date	September 17, 2008
Current Basis	1A
Original Filing Basis	1B
Published for Opposition	July 14, 2009
Registration Number	4560526
Registration Date	July 1, 2014
Owner	(REGISTRANT) ICE SA SOCIETE ANONYME BELGIUM AVENUE MATHIEU, 37 BASTOGNE BELGIUM 6600

(LAST LISTED OWNER) ICE IP S.A. SOCIÉTÉ ANONYME (SA) LUXEMBOURG RUE DES
TILLEULS 3 ROMBACH LUXEMBOURG L-8832

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record Douglas R. Wolf

Disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "WATCH" APART FROM THE MARK AS SHOWN

Description of Mark Color is not claimed as a feature of the mark. The mark consists of the words "ICE WATCH" in which the word "ICE" is written above and in larger letters than the word "WATCH" and there is a line between the two words. To the above left of the word "ICE" a fanciful image of a diamond appears.

Type of Mark TRADEMARK

Register PRINCIPAL

Affidavit Text SECT 15. SECT 8 (6-YR).

Live/Dead Indicator LIVE

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Trademark Assignment Abstract of Title

Total Assignments: 2

Serial #: [77983619](#)

Filing Dt: 09/17/2008

Reg #: [4560526](#)

Reg. Dt: 07/01/2014

Registrant: ICE SA

Mark: ICE WATCH

Assignment: 1

Reel/ Frame: [5404/0007](#)

Recorded: 11/19/2014

Pages: 2

Conveyance: ASSIGNS THE ENTIRE INTEREST

Assignor: [ICE SA](#)

Exec Dt: 11/14/2014

Entity Type: CORPORATION

Citizenship: BELGIUM

Entity Type: CORPORATION

Citizenship: LUXEMBOURG

Assignee: [ICE IP S.A.](#)

RUE DES TILLEULS 3

ROMBACH, LUXEMBOURG L-8832

Correspondent: DOUGLAS R. WOLF
600 ATLANTIC AVENUE
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Domestic rep: DOUGLAS R. WOLF
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BOSTON, MA 02210

Assignment: 2

Reel/ Frame: [6735/0750](#)

Recorded: 09/04/2019

Pages: 4

Conveyance: CORRECTIVE ASSIGNMENT TO CORRECT THE LEGAL ENTITY TYPE OF THE ASSIGNEE FROM "CORPORATION" TO "SOCIÉTÉ ANONYME (SA)" PREVIOUSLY RECORDED ON REEL 005404 FRAME 0007. ASSIGNOR(S) HEREBY CONFIRMS THE ASSIGNMENT OF THE ENTIRE INTEREST AND THE GOODWILL.

Assignor: [ICE SA](#)

Exec Dt: 11/14/2014

Entity Type: CORPORATION

Citizenship: BELGIUM

Entity Type: SOCIÉTÉ ANONYME (SA)

Citizenship: LUXEMBOURG

Assignee: [ICE IP S.A.](#)

RUE DES TILLEULS 3

ROMBACH, LUXEMBOURG L-8832

Correspondent: DOUGLAS R. WOLF
600 ATLANTIC AVENUE
WOLF, GREENFIELD & SACKS, P.C.
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[Home](#) | [Site Index](#) | [Search](#) | [FAQ](#) | [Glossary](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#)

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Word Mark	ICE WATCH
Goods and Services	IC 014. US 002 027 028 050. G & S: PRECIOUS METALS AND THEIR ALLOYS; JEWELRY NOT INCLUDING DIAMONDS, PRECIOUS STONES NOT INCLUDING DIAMONDS
Mark Drawing Code	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code	17.03.01 - Diamonds, jewelry; Nuggets of precious metals; Stones, gems 26.17.05 - Bands, horizontal; Bars, horizontal; Horizontal line(s), band(s) or bar(s); Lines, horizontal 26.17.13 - Letters or words underlined and/or overlined by one or more strokes or lines; Overlined words or letters; Underlined words or letters 27.03.05 - Objects forming letters or numerals
Serial Number	77572373
Filing Date	September 17, 2008
Current Basis	44E
Original Filing Basis	1B
Published for Opposition	July 28, 2015
Registration Number	4829305
Registration Date	October 13, 2015
Owner	(REGISTRANT) ICE IP S.A. CORPORATION LUXEMBOURG RUE DES TILLEULS 3 ROMBACH LUXEMBOURG L-8832
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	Douglas R. Wolf

Disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "WATCH" APART FROM THE MARK AS SHOWN

Description of Mark Color is not claimed as a feature of the mark. The mark consists of the words "ICE WATCH" in which the word "ICE" is written above and in larger letters than the word "WATCH" and there is a line between the two words. To the above left of the word "ICE" a fanciful image of a diamond appears.

Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead Indicator LIVE

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Total Assignments: 2

Serial #: [77572373](#)

Filing Dt: 09/17/2008

Reg #: [4829305](#)

Reg. Dt: 10/13/2015

Registrant: ICE IP S.A.

Mark: ICE WATCH

Assignment: 1

Reel/ Frame: [4952/0739](#)

Recorded: 01/31/2013

Pages: 5

Conveyance: CHANGE OF NAME

Assignor: [TKS S.A.](#)

Exec Dt: 10/24/2012

Entity Type: JOINT STOCK COMPANY

Citizenship: BELGIUM

Entity Type: SOCIETE ANONYME

Citizenship: BELGIUM

Assignee: [ICE SA](#)

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NEW YORK, NY 10016-2223

Assignment: 2

Reel/ Frame: [5384/0694](#)

Recorded: 10/21/2014

Pages: 3

Conveyance: ASSIGNS THE ENTIRE INTEREST

Assignor: [ICE SA](#)

Exec Dt: 07/04/2014

Entity Type: CORPORATION

Citizenship: BELGIUM

Entity Type: CORPORATION

Citizenship: LUXEMBOURG

Assignee: [ICE IP S.A.](#)

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