

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

SEPT 4, 97

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Rolex Watch U.S.A., Inc.
v.
Reuben Teves

Opposition No. 96,651
to application Serial No. 74/461,254
filed on November 22, 1993

David H. T. Kane, Siegrun D. Kane, Chrystal A. LeRoy of
Kane, Dalsimer, Sullivan, Kurucz, Levy, Eisele & Richard for
opposer

Reuben Teves, pro se

Before Sams, Hairston and Walters, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Rolex Watch U.S.A., Inc. filed its opposition to the
application of Reuben Teves to register the mark shown below
for "jewelry manufactured by Reuben namely rings, pins,
brooches, pendants, necklaces, earrings, tie tacks, charms,
bracelets and similar and related items of jewelry."¹



As grounds for opposition, opposer asserts that applicant's mark, when applied to applicant's goods, so resembles opposer's previously used and registered mark, as shown below, for "timepieces of all kinds and parts therefor"² as to be likely to cause confusion under Section 2(d) of the Trademark Act. In this regard, opposer further alleges that the goods of the parties are identical and/or closely related; and that both parties' goods are capable of sale to the same purchasers through the same channels of trade.

¹ Application Serial No. 74/461,254, filed November 22, 1993, based upon use of the mark in commerce in connection with the identified goods alleging first use and first use in commerce as of April 18, 1977.

² Registration No. 657,756, issued January 28, 1958 [renewed for a term of twenty years from January 28, 1978; Section 15 affidavit acknowledged]. The registration certificate issued originally to Montres Rolex, S.A., although the record establishes current title of the registration in opposer.



Applicant, in his answer,³ denied the salient allegations of the likelihood of confusion claim. In support of his denial, applicant claims that he does not manufacture or apply his mark to timepieces; that timepieces are different from the type of goods on which applicant's mark is used; that the channels of trade differ, as applicant sells his goods at the wholesale level entirely; that all of applicant's goods are custom ordered by retailers; that applicant's mark appears on the back of jewelry pieces, whereas opposer's mark appears on the front of its timepieces; and that, despite years of coexistence, there has been no actual confusion. Applicant admitted that opposer's trademark "has established widespread recognition in the public eye."⁴

³ To the extent that applicant's answer may be insufficient, any such insufficiency is considered waived by opposer's failure to object thereto.

⁴ On January 11, 1996, applicant filed a paper entitled "Applicant's Rebuttal to Opposer's First and Second Notice of Reliance" which consists entirely of argument in support of applicant's position herein. While this filing was not properly responsive to opposer's filing of its notice of reliance, nor was it filed within the time for filing applicant's brief, we will consider it as supplemental to applicant's brief, because, in its brief, opposer quotes from this submission and otherwise treats it as being of record. Thus, we consider applicant's statement therein that "the crown design shown in [opposer's]

The Record

The record consists of the pleadings; the file of the involved application; a photocopy of a title and status copy of opposer's pleaded Registration No. 657,756;⁵ and excerpts in the nature of advertisements from printed publications, all made of record by opposer's notices of reliance. Applicant submitted no testimony or other evidence. Both parties filed briefs on the case.

Analysis

Inasmuch as opposer's registration is of record, there is no issue with respect to opposer's priority. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Further, in his brief, applicant admits opposer's priority. (Applicant's brief, pps. 2-3.)

Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Two key considerations are the similarities between the goods and the similarities between the marks. This is

advertising is well known" along with the above-quoted statement in applicant's answer as an admission that opposer's mark is well known.
⁵ Opposer submitted a photocopy of the title and status of its pleaded registration, which is insufficient to make the registration of record. However, we will consider opposer's registration to be of record herein as applicant has not objected and has treated opposer's registration in every respect as being of record. See, Section 703.02(a) of the *Trademark Trial and Appeal Board Manual of Procedure* (TMBP).

especially true in cases where, as here, there is almost no evidence bearing on the other factors enumerated in the *duPont* case.⁶

Turning to the goods of the parties, we note that opposer's registration identifies the mark in connection with the broad category of timepieces, and that opposer's evidence pertains to watches, which are one type of timepiece. We take notice of the definitions⁷ of "jewel" as "n. 1. a costly ornament of precious metal or gems used as personal adornment. vt. 2. to fit with jewels, as a watch" and of "jewelry" as "n. jewels, esp. ornaments made of precious metals set with gems." In this regard, the record supports the conclusion that, while opposer's watches primarily allow the wearer to keep track of the time, both opposer's watches and applicant's jewelry may be worn by people as a form of adornment. Several of opposer's 210 exhibits, all of which are advertisements for its watches in various magazines, newspapers and playbills covering a period from February 1956 to November 1995, tout the quality and durability of the timekeeping mechanism as well as the attractive qualities of its watches. This is evidence that opposer markets its watches both as precision timekeeping

⁶ Applicant made a number of statements of fact in its brief and included copies of designs purported to be third-party marks. However, as applicant submitted no evidence during its testimony period, the facts and designs referenced in applicant's brief are not established in this record and have been given no consideration.

⁷ *Webster's II, New Riverside University Dictionary*, 1984.

instruments and as a type of jewelry for adornment. Several examples follow:

Exhibit No. 176, ad in *Town and Country*, December 1989, states "From the master watchmakers of Rolex comes a new hand-crafted 18 kt. gold timepiece that pays homage to the skills of Renaissance sculptor and goldsmith, Benevenuto Cellini. . . the curved design of its thin case radiates the elegant warmth of 18 kt. gold. The matching 'Milanese' style bracelet is entirely handwrought."

Exhibit No. 181, ad in *The New Yorker*, November 26, 1990, states "For generations Bailey Banks & Biddle has set the standard for excellence in fine jewelry and watches."

Exhibit No. 73, ad in *Harper's Bazaar*, June 1974, states "Rolex brings the smolder of gold and the fire of diamond . . . This is the sovereign Rolex couple of the Day-Date in 18 kt. gold, encircled by 46 full cut diamonds; and the Lady Datejust, with its noose of 34 full-cut diamonds."

Exhibit No. 196, ad in *49ers Report*, August 23, 1994, states "Twin classics of integrity and beauty, the Rolex Day-Date and Rolex Lady Datejust . . ."

Neither the application nor the pleaded registration contains any limitations to the identification of goods. Rather, both identifications of goods are broadly worded. Therefore, we must presume that the goods of the opposer and applicant are sold in all of the normal channels of trade to all of the normal purchasers for goods of the type identified. See *Canadian Imperial Bank v. Wells Fargo*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). As several of the advertisements for opposer's watches are placed by jewelers, we can conclude that at least one source for

consumers of opposer's timepieces is jewelers.⁸ As both watches and jewelry may be worn by people for adornment and may be sold through jewelers for purchase by the general public, we conclude that the goods of the parties are closely related and may be sold through the same channels of trade to the same class of purchasers.

Turning to the marks, opposer contends that the crown portion of applicant's mark is dominant; that the jeweler's sawframe is a peripheral feature of applicant's mark that is not familiar to the general public and appears to hold the crown in place; and that the crown portion of both marks is a base supporting five elongated prongs with a ball on the top of each prong.

Applicant contends that the jeweler's sawframe design is the dominant portion of his mark; and that the crown portion of his mark is significantly smaller than the jeweler's sawframe, so that it is merely an incidental element of the design.

We agree with opposer that we must base our determination on a comparison of the marks in their entireties, but that, in articulating reasons for reaching a

⁸ See, for example, opposer's exhibits nos. 114 [*The Daily Report*, December 19, 1978, ad by Bryant & Co. Jewelers]; 117 [*Corpus Christi Caller*, February 23, 1979, ad by Taylor Brothers Jewelers]; 119 [*Times and Democrat*, March 11, 1979, ad by Andraes - Quality Jewelers since 1888]; 149 [*The New Yorker*, November 16, 1981, ad by Wempe - Exquisite Timepieces and Jewelry - Est. 1878]; 181 [*The New Yorker*, November 26, 1990, ad by Bailey Banks & Biddle]; 196 [*49ers Report*, August 23, 1994, ad by Sidney Mobell - Designer and Creator of Fine Jewelry].

conclusion on the issue of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.*, 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). In this regard, we find that, purely from a design standpoint, the jeweler's sawframe and the crown portions of applicant's mark appear equally predominant. However, the jeweler's sawframe, a tool which applicant describes as being used in process of making jewelry, is highly suggestive in connection with jewelry. Thus, we conclude that the commercial impression of applicant's mark is dominated by the crown design, which, on this record, we must find to be arbitrary in connection with applicant's goods. Further, as opposer points out, while the base of the crown in opposer's mark is narrower, relative to the prongs, than the base of the crown in applicant's mark, and opposer's mark is viewed, slightly, from below, the crowns in the two marks are otherwise substantially similar. We find that when opposer's and applicant's marks are considered in their entireties, they engender similar overall commercial impressions.

In view of the similarities in the overall commercial impressions of the parties' marks and the close relationship

between the parties' goods, we find that a likelihood of confusion exists herein. While there are obvious differences between the parties' marks, these differences are not sufficient to distinguish these marks for closely related goods. First, opposer's mark is well known in connection with timepieces, as applicant admits. "[T]he fame of a trademark may affect the likelihood purchasers will be confused inasmuch as less care may be taken in purchasing a product under a famous name." *Specialty Brands v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 6765, 223 USPQ 1281, 1284 (Fed. Cir. 1984). In addition, the fame of a mark magnifies the significance of the similarities between the marks which are compared. *Kenner Parker Toys Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992), *cert. denied*, 113 S.Ct. 181 (1992).

Second, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The issue is whether the marks create the same overall commercial impression. *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). Due to the consuming public's fallibility of memory and consequent lack of perfect recall, the emphasis is on the recollection of the average customer, who normally retains a general rather than a specific impression of trademarks or service marks. *Spoons*

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Restaurants, Inc. v. Morrison, Inc., 23 USPQ2d 1735 (TTAB
1991), *aff'd*. No. 92-1086 (Fed. Cir. June 5, 1992).

Decision: The opposition is sustained.

J. D. Sams

P. T. Hairston

C. E. Walters
Administrative Trademark Judges,
Trademark Trial and Appeal Board