

Oral Hearing:
June 12, 2007

**THIS OPINION IS
NOT A PRECEDENT
OF THE TTAB**

Decision Mailed:
December 13, 2007
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Omega S.A.
v.
Edward Platts

Opposition No. 91158655 to application Serial No. 78189598
filed on November 27, 2002

Jeffrey A. Lindenbaum and Jess M. Collen of Collen IP for Omega
S.A.

Edward Platts, *pro se*.

Before Hohein, Cataldo and Taylor, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Edward Platts has filed an application to register the
mark "BROADARROW" in standard character form on the Principal
Register for "clocks and watches with electrical, electronic or
mechanical operation" in International Class 14.¹

Omega S.A. has opposed registration, *inter alia*, on the
ground that opposer "is the owner of the mark BROAD ARROW, as
used in connection with a variety of goods and services,
including watches and chronographs"; that opposer, "[o]n June 4,

¹ Ser. No. 78189598, filed on November 27, 2002, which is based on an
allegation of a bona fide intention to use such mark in commerce.

2003, ... filed an application, Serial No. 78/258,004[,] for the mark BROAD ARROW in [International] Class 14, and reciting a first use date of August 9, 2001"; that opposer "is and has been engaged in the sale of goods under the trademark BROAD ARROW since August 9, 2001"; that more particularly opposer, "[u]pon information and belief, ... is and has been engaged in the sale and marketing, under the BROAD ARROW mark, of identical or highly related goods to those recited by applicant in ... [his] application since a time prior to Applicant's first use of ... [his] mark"; that, moreover, opposer's mark "has been in use since a time prior to use or constructive use by the Applicant"; and that applicant's mark "is nearly identical to the Opposer's trademark and is likely, when used in conjunction with the goods offered by the applicant, to cause confusion, or to cause mistake or to deceive."²

Applicant, in his answer, has denied the allegations of the opposition.³

The record includes the pleadings, the file of the involved application and, as opposer's case-in-chief, the testimony with exhibits of Robert H. Emmons, formerly the general

² Although opposer has also pleaded that, "[o]n information and belief, the Applicant's mark is also likely to diminish and dilute the value and distinctive character of this mark, to the great detriment of the Opposer's BROAD ARROW mark," opposer has not pursued such allegation at trial or in its briefs and thus no further consideration will be given thereto.

³ While, under the rubric of "AFFIRMATIVE DEFENSE," applicant has pleaded various additional allegations, no further consideration will be given thereto inasmuch as they are: (i) merely amplifications of his denials of opposer's allegations with respect to its claim of priority of use and likelihood of confusion rather than affirmative

manager of opposer in the United States from 1996 until becoming its general manager for Canada in 2005, and a notice of reliance on a copy of information from an official record of the U.S. Patent & Trademark Office with respect to opposer's application for its "BROAD ARROW" mark for watches and a copy of applicant's answers to certain of opposer's requests for admission and interrogatories. The record also includes, as applicant's case-in-chief, a notice of reliance on various official records, some of which are duplicative of those which were already of record.⁴ Briefs have been filed,⁵ but applicant waived his appearance at the oral hearing, which was attended only by counsel for opposer.

Turning first to the issue of likelihood of confusion, our determination thereof is based upon consideration of all of the pertinent factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973), for which there is evidence in the record. See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003); and *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). However, as indicated in *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29

defenses; (ii) inapposite, irrelevant and/or immaterial; or (iii) lacking in any proper evidentiary support in the record.

⁴ Although applicant has listed additional evidence in his notice of reliance, such evidence (consisting of Exhibits 4 through 10) was stricken upon motion by opposer as improper subject matter for a notice of reliance and thus will not be given further consideration.

⁵ While applicant asserts in his brief that opposer's main brief "contains numerous substantive errors" in that it "has submitted no evidence in support of its statement[s]," the same may likewise be said about many of the statements in applicant's brief. Suffice it to say, however, that as set forth in TBMP §704.06(b) (2d ed. rev. 2004): "Factual statements made in a party's brief on the case can be given

(CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity in the goods at issue and the similarity or dissimilarity of the respective marks in their entireties.⁶ With respect to the former, it is obvious that applicant's "watches," as identified in his application to register the mark "BROADARROW," are identical in part to opposer's watches and chronographs, which the record shows are the goods in connection with which opposer has used its "BROAD ARROW" mark and has continued to do so. Thus, even if the record contained evidence supporting applicant's contentions in his brief that his "'BROADARROW' watches can only be purchased from Applicant's website on the Internet" and that, "[o]n average, Opposer's watches sell for at least ten times or more than the price of Applicant's watches," such arguments, which technically pertain respectively to the related *du Pont* factors of the similarity or dissimilarity of established, likely-to-continue trade channels and the conditions under which and buyers to whom sales are made, that is, "impulse" vs. careful, sophisticated purchasing, are irrelevant and immaterial in the context of this proceeding.

Specifically, it is well settled that in a proceeding of this kind that the registrability of an applicant's involved mark must be evaluated on the basis of the identification of the

no consideration unless they are supported by evidence properly introduced at trial."

⁶ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." 192 USPQ at 29.

goods as set forth in the subject application, regardless of what the record may (or may not) reveal as to the particular nature of the applicant's goods, their actual channels of trade, or the classes of purchasers to which they are in fact directed and sold. See, e.g., Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); and Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987). Consequently, it is also well established that, absent any specific limitations or restrictions in the identification of goods as listed in an applicant's subject application, the issue of likelihood of confusion must be determined in light of a consideration of all normal and usual channels of trade and methods of distribution for such goods. See, e.g., CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

Here, as opposer points out in its main brief, applicant "has not limited the goods asserted in his application to any particular channels of trade" nor, we note, to any specific price range, style or quality. In view thereof, his broadly identified "watches with electrical, electronic or mechanical operation" must be considered to encompass the same kinds of watches as marketed by opposer under its "BROAD ARROW" mark and to include the same channels of trade, such as jewelry stores and department stores, as well as the same classes of

purchasers, consisting of both ordinary consumers and jewelry retailers, as the watches and chronographs sold by opposer under the "BROAD ARROW" mark. Thus, insofar as the respective goods of the parties are identical in part, it is clear that if such goods were to be sold under the same or similar marks, confusion as to the source or sponsorship thereof would be likely to occur. The *du Pont* factor pertaining to the similarity or dissimilarity of the goods at issue, along with the related *du Pont* factors of the similarity or dissimilarity of established, likely to continue trade channels and the conditions under which and buyers to whom sales are made, that is, "impulse" vs. careful, sophisticated purchasing, therefore favor opposer.

As to the *du Pont* factor which pertains to the similarity or dissimilarity of the respective marks in their entirety as to appearance, sound, connotation and commercial impression, it is obvious that applicant's "BROADARROW" mark and opposer's "BROAD ARROW" mark are essentially identical. Opposer, in its main brief, accurately observes that "[t]he only visual difference between the marks is that Opposer's mark comprises ... two separate words, whereas Applicant's mark is one compound word." Opposer goes on in its brief to properly note that "[b]oth marks have identical sound and pronunciation" and, inasmuch as "both marks are comprised of the same English words, both marks share the same meanings." On the whole, given the identity in sound and connotation and the virtual identity in appearance, the respective marks also engender essentially the same commercial impression. Therefore, the *du Pont* factor

pertaining to the similarity or dissimilarity of the respective marks in their entireties as to appearance, sound, connotation and commercial impression favors opposer.

In view of the above, and inasmuch as on this record none of the remaining *du Pont* factors is applicable, much less in favor of applicant, we conclude that contemporaneous use by applicant of the mark "BROADARROW" in connection with "watches with electrical, electronic or mechanical operation" is likely to cause confusion with opposer's use of the virtually identical mark "BROAD ARROW" for watches and chronographs. Thus, the determinative issue in this proceeding is which party has priority with respect to the marks at issue. Based on the record herein, we find that opposer has proven that it has priority of use and, since such proof of its prior common law rights also establishes its standing to bring this proceeding, opposer is accordingly entitled to prevail on its claim of priority of use and likelihood of confusion.

In this regard, opposer is correct that because applicant has neither taken testimony nor otherwise submitted any proof that he has commenced use of his mark, the earliest date upon which applicant is entitled to rely in this proceeding for purposes of priority is the November 27, 2002 filing date of the involved application. See, e.g., *Lone Star Mfg. Co., Inc. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368, 369 (CCPA 1974); *Columbia Steel Tank Co. v. Union Tank & Supply Co.*, 277 F.2d 192, 125 USPQ 406, 407 (CCPA 1960); *Zirco Corp. v. American Telephone & Telegraph Co.*, 21 USPQ2d 1542, 1544 (TTAB 1991); and *Miss*

Universe, Inc. v. Drost, 189 USPQ 212, 213 (TTAB 1975). Opposer is also correct that, as stated in its main brief, it "has established that it used the BROAD ARROW trademark beginning in 2001" and, specifically, has "used BROAD ARROW as an Omega trademark continuously since its first date of sale of August 9, 2001," thereby demonstrating that opposer has priority of use.

The record shows in this regard that opposer's witness, Mr. Emmons, was "general manager of Omega in the United States" from 1996 until May of 2005. (Emmons dep. at 5.) His duties in such position were "[t]o guide the marketing and sales efforts of Omega" in the United States, including managing the field sales force and handling "the distribution of the product from New Jersey." (Id. at 6.) Opposer sells its goods in the United States through approximately 750 independent, individual retail locations. The goods so sold by opposer and to which opposer applies its marks are "mostly watches." (Id. at 8.) Mr. Emmons stated that he is familiar with opposer's marks, including its housemark "OMEGA" and "model designations, such as Constellation, Seamaster, Deville" and "Speedmaster." (Id. at 9.)

In particular, with respect to opposer's Exhibit 1 to his deposition, which consists of photographs of a watch which prominently displays, on the back of the case thereof, the mark "BROAD ARROW," Mr. Emmons confirmed that he recognized the watch shown therein as a product currently sold by opposer in the United States and identified such product as "an Omega Seamaster Broadarrow, coaxial chronograph." (Id. at 10.) To be clear, it is pointed out that although the deposition transcript repeatedly

refers to the mark as "Broadarrow" rather than "Broad Arrow," Exhibit 1 clearly shows--as previously mentioned--that the mark as displayed on the back of the watch case is "BROAD ARROW." Keeping such in mind, he further testified in connection with such exhibit as follows:

Q How long has this product been offered for sale in the United States, do you know?

A The product was launched in 2001.

Q By product are you referring to Broadarrow?

A Correct. Broadarrow as a product was launched in 2001.

Q If you look at Exhibit 1, do you see any trademark or trademarks affixed to that product?

A Yes.

Q What mark or marks do you see?

A I see three trademarks. I see Omega. Perhaps four. The Omega logo. The Omega name. The Seamaster name and the Broadarrow name.

Q You indicated that Broadarrow has been -- that this watch you recognize having been introduced in 2001, correct?

A Correct.

Q Are there other Broadarrow watches in the Omega collection?

A I believe currently there is approximately 20.

Q Twenty. So 20 different styles would that be?

A Twenty different stock keeping units. Individual differences might be dial variation or bracelet versus strap or even

metal contents, stainless steel versus 18 karat gold.

Q All 20 of those styles are offered for sale in the United States?

A Yes.

Q Would you know how many different models have been offered for sale in the United States since the introduction of the Broadarrow in 2001?

A I do believe that some models have been launched and discontinued and new models have come in.

Q Sure. That's the normal procedure --

A Yes.

Q -- in the watch business, I presume?

A Yes, sir. I don't know off the top of my head how many have been discontinued with new ones coming in. I know currently we sell approximately 20 different styles.

Q Is it fair to say that there have been more than 20 different styles offered in the United States in 2001 in Broadarrow?

A Yes, sir.

Q Okay. I believe you indicated in your earlier testimony a few moments ago that you see three or maybe four trademarks on this watch; is that correct?

A Yes, sir.

Q I believe one of the trademarks you identify with this watch is Broadarrow according to your testimony, is that an accurate statement?

A Yes, sir.

Q What type of knowledge or information do you have about that?

A Retailers and consumers both will often will call this watch the Broadarrow. If they are calling about availability they will ask for the Broadarrow.

Q Is it more common for a consumer to ask for an Omega Speedmaster Broadarrow or for a consumer to ask for a Broadarrow?

A They will ask for a Broadarrow.

Q You have had that experience with a customer of Omega SA asking you for a Broadarrow watch?

A Yes, sir.

Q More than once, I presume?

A Yes, sir.

Q Is it fair to say that it's not an unusual occurrence for a consumer to ask you for a Broadarrow watch?

A Both the consumer and the retailer, sir.

Q Is it your experience that retailers asking you to order this watch, the type we see here in Exhibit 1[,] will ask for a Broadarrow watch?

A Yes, sir.

....

Q Do you have any understanding as to why they would refer to this as Broadarrow?

A That to the retailer and the consumer is the product designation.

Q Is there any distinction in your mind between product designation and trademark?

A No, sir.

Q Just for the record here, could you point to where on Exhibit 1 you see the Broadarrow trademark?

A On the first page of the exhibit and the second page. Honestly, it is plainly printed on the back of the case.

Q On the back of the case of the watch?

A Yes, sir.

(Id. at 10-15.)

In addition, Mr. Emmons testified with respect to the statements set forth in opposer's Exhibit 2 to his deposition, which consists of a copy of the declaration he executed on March 2, 2005 in connection with opposer's motion for summary judgment in this proceeding,⁷ that the statements he made therein were true when made and are still true. Among other things, in his declaration he states that he has "personal knowledge of the distribution and sales in the United States of the Opposer, Omega S.A.'s watches bearing the BROAD ARROW mark"; that "Omega S.A. distributes and sells watches, and related parts for watches bearing the mark "BROAD ARROW"; that "[t]he BROAD ARROW mark has been used in United States commerce by Omega S.A. with watches as early as August 9, 2001"; and that "[a]ttached hereto as Exhibit A, are invoices reflecting Omega S.A.'s sales in the United States of watches bearing the BROAD ARROW mark as early as August 9, 2001. (Opposer's Exh. 2.) Exhibit A, which Mr. Emmons testified "is an invoice to us, Omega U.S.A. of the product coming in from Switzerland on our weekly deliveries"; that

⁷ Such motion was denied on July 21, 2005 because opposer failed to provide sufficient evidence of technical trademark use of its "BROAD ARROW" mark. Opposer's request for reconsideration thereof was denied on October 28, 2005.

"[e]ach week we would get a delivery of products"; and that "this is the invoice for our weekly deliveries from Omega S.A.," is dated August 9, 2001 and lists (with customer identity redacted) various models comprising a total of 63 "BROAD ARROW" watches shipped by air freight to The Swatch Group (US) Inc., Omega Division, of Lancaster, Pennsylvania. (Emmons dep. at 16.)

Furthermore, according to the following testimony by Mr. Emmons, opposer's watches have been continuously sold throughout the United States under its "BROAD ARROW" mark since their first sale on August 9, 2001:⁸

Q Since these first sales in the United States in 2001, the Broadarrow product has been sold continuously in the United States?

A Yes, sir.

Q Where are Broadarrow watches sold?

A They are sold nationally. They are sold everywhere.

Q So from coast to coast?

A From Alaska to Hawaii to all 50 states and Puerto Rico.

Q Has that been the case since the first sale in 2001?

A Yes, sir.

Q So it's your testimony that the Broadarrow watch has been sold in the United States each year without interruption since 2001?

A Yes, sir.

⁸ It is again noted that while the transcript of his deposition refers repeatedly to opposer's mark as "Broadarrow" instead of "Broad Arrow," the exhibits thereto show use of opposer's mark as "BROAD ARROW."

Q Geographically across the country?

A Yes, sir.

Q Without exception?

A Yes, sir.

Q Are all of those watches that have been sold since 2001 to which you just testified [been] marked with a Broadarrow mark in a manner similar to what we see in Exhibit 1?

A Yes, sir.

(Id. at 19-20.)

As to the types of stores which sell opposer's "BROAD ARROW" watches in the United States, Mr. Emmons testified that "[i]t's predominantly jewelers, both independently owned, family operations, to large corporations ... with multiple points of sale" as well as "some department stores." (Id. at 27.) Opposer advertises its "BROAD ARROW" watches on its Internet website and through consumer brochures, which "are offered to retailers free of charge" for distribution to their customers. (Id. at 25.) Basically, according to Mr. Emmons, opposer offers two different types of brochures, "one that has a cross section of all of our products that we offer" and "other ones that highlight a specific product." (Id. at 24.) As an example of the latter, Mr. Emmons testified with respect to Opposer's Exhibit 3, which is a copy of a consumer brochure for its "OMEGA SPEEDMASTER BROAD ARROW" watch that, among other things, contains a picture of such watch in which the marks "SPEEDMASTER" and "BROAD ARROW" are separately and prominently displayed on the back of the case of the watch.

In fact, according to Mr. Emmons, opposer's "BROAD ARROW" brand "continues to be one of our flagship products." (*Id.* at 25.)

As the preceding discussion makes manifest, the record is sufficient to establish that watches have been sold in the United States under opposer's "BROAD ARROW" mark since at least sometime in 2001, including as early as August 9, 2001.⁹ Given that such time is earlier than the November 27, 2002 filing date of applicant's involved application, it is clear that opposer has priority of use of its mark and, in view thereof, has standing to bring this proceeding. Applicant, in fact, admits in his brief that "[t]he only evidence of use of the BROAD ARROW name presented by opposer is on the *back* of its watches" (italics in original), but appears to contend that such use is invalid because, as further stated in his brief:

The SPEEDMASTER and OMEGA marks appear on the face or dial of the watch. Watches are normally displayed face up. Thus the prospective purchaser would see the SPEEDMASTER and OMEGA marks first, and only

⁹ Section 45 of the Trademark Act, 15 U.S.C. §1127, which defines "use in commerce" as "the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark," further states that for purposes thereof "a mark shall be deemed to be in use in commerce—(1) on goods when—(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto." While, as indicated in, for instance, *In re Selinus Wines, Inc.*, 557 F.2d 806, 194 USPQ 261, 264 (CCPA 1977), an "appellant's importation [of wine bearing its mark] is not itself a 'use in commerce' by appellant, it is evidence that appellant's sale within Massachusetts was so intimately involved with foreign commerce as to become a 'use in commerce' as defined in the Lanham Act." Hence, the court held that the "appellant's importation of wine bearing its trademark from France and intrastate sale of imported wine is a 'use in commerce' as defined by the Trademark Act." *Id.* at 194 USPQ 267. Similarly, lest there be any doubt, we find that opposer's importation of watches bearing its "BROAD ARROW" mark into the United States and their sale by its network of independent retailers constitutes bona fide use in commerce of such mark.

after turning the watch over to look at the back would they see the BROAD ARROW mark.

However, we know of no authority which holds that just because a mark appears on the back of a product rather than the front, the former does not constitute technical trademark use within the meaning of the definition in Section 45 of Trademark Act of "use in commerce." To the contrary, so long as the mark is plainly visible and otherwise functions as a mark to identify and distinguish the origin of the product, as is the case with the prominent and separate display of the "BROAD ARROW" mark on the back of the cases for opposer's watches, the statutory definition of use in commerce is met. Opposer, therefore, has satisfied its burden of proof in this proceeding and is entitled to prevail on its claim of priority of use and likelihood of confusion.

Decision: The opposition is sustained and registration to applicant is refused.