



## ROLEX vs. ROLL-X: TTAB Says that ROLL-X for X-ray Tables Does Not Dilute Famous ROLEX Mark

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In a precedential decision issued on December 5, 2011, the Trademark Trial and Appeal Board ("TTAB") held that ROLEX was famous for watches under the Trademark Dilution Revision Act of 2006, 15 USC 1125 (c) ("TDRA"), but the mark ROLL-X was not sufficiently similar to create a likelihood of dilution. See *Rolex Watch U.S.A. Inc. v. AFP Imaging Corp.*, 101 USPQ2d 1188 (TTAB 2011). The decision provides guidance on the TTAB's test for determining similarity for purposes of dilution and its interpretation of survey evidence.

AFP Imaging Corp. ("AFP") filed an application in 2008 for ROLL-X for "x-ray tables for medical and dental use." AFP claimed that it adopted the mark as an extension of its DENT-X brand (also for x-ray products). It also stated that it adopted ROLL-X because the mark evoked the description of its product, namely a rolling tray for taking x-rays. Both of these facts proved critical to the TTAB's decision. Upon publication of the application, Rolex opposed. The case went to trial on two issues: (1) whether ROLL-X diluted ROLEX by blurring the significance of the ROLEX mark, and (2) whether AFP had a *bona fide* intention to use ROLL-X.

On dilution, the TTAB found for Rolex on every factor, except two: the similarity of the marks, and AFP's intent to dilute. To determine whether the marks were similar for dilution purposes, the TTAB applied its previously iterated test: "[A]re applicant's and opposer's marks 'sufficiently similar to trigger consumers to conjure up a famous mark when confronted with the second mark?'" *citations omitted*. The Board stated that while the marks were pronounced identically, "[b]ecause of the hyphen between ROLL and X, consumers are likely to view the mark as consisting of the English word ROLL, which has various meanings including 'to move on rollers or wheels,'...and the letter 'X,' which, when the mark is used in connection with applicant's goods, is likely to be perceived as suggesting the term 'x-ray' ...." The Board cited applicant's CEO's testimony, confirming AFP's intent to create that association. Because of this stated intent, the Board found there was no evidence that AFP intended to dilute.



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The Board also found that Rolex's own survey supported a lack of dilution. Forty-two percent of qualified respondents stated that "ROLEX" came to mind when they encountered ROLL-X in a telephone survey. However, 32 percent said "portable/movable/rolling," 18 percent said "x-ray tables/equipment" and seven percent said "x-rays." While 42 percent would, at least in the context of a confusion survey, be considered a compelling number, "[t]his figure is not persuasive given that a higher percentage...thought of a feature of the goods...or the actual goods themselves." In other words, respondents understood ROLL-X to convey the impression AFP sought to convey.

The Board cited a common problem with dilution surveys: they prove association, but not likelihood that the applicant's mark will impair the distinctiveness of the opposer's mark." Since AFP's application was based on intent-to-use, it seems nearly impossible to construct a survey that could establish likelihood of impairment.

The Board also found that Applicant had a *bona fide* intent to use the ROLL-X mark when it filed the application. AFP did not have any documentary evidence of its intent to use the mark, therefore, it carried the burden to show that it did have such an intent. The Board found that AFP's prior use and registration of DENT-X was evidence that "ROLL-X is consistent with an extension of [AFP's] current product line." In addition, the Board found that AFP's production of DENT-X x-ray products showed it had the capacity to produce other x-ray-related products, like those to be sold under the ROLL-X brand.

Here, AFP was saved because it could establish that it intended ROLL-X to be suggestive of its products' characteristics. Overall, the case emphasizes the significant difficulty of proving a dilution case. Moreover, it underscores a best practice, namely that applicants should maintain documentary evidence of intent to use trademarks at the time of filing, so that they may overcome oppositions on the basis that they lacked this intent.

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