

Hearing:  
May 13, 2010

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

Mailed:  
July 30, 2010  
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Cartier N.V.

Serial No. 77227767

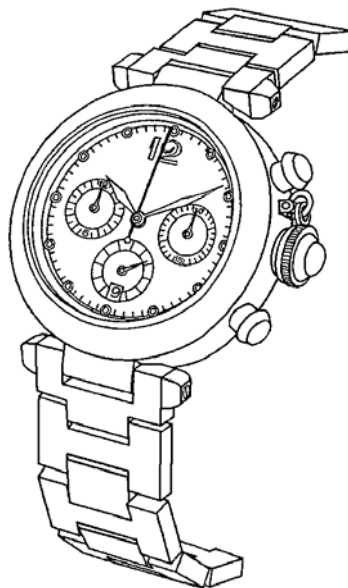
Milton Springut and Tal Benschar of Kalow & Springut LLP for  
Cartier N.V.

April K. Roach, Trademark Examining Attorney, Law Office 115  
(Tomas V. Vlcek, Managing Attorney).

Before Hairston, Bucher and Walsh, Administrative Trademark  
Judges.

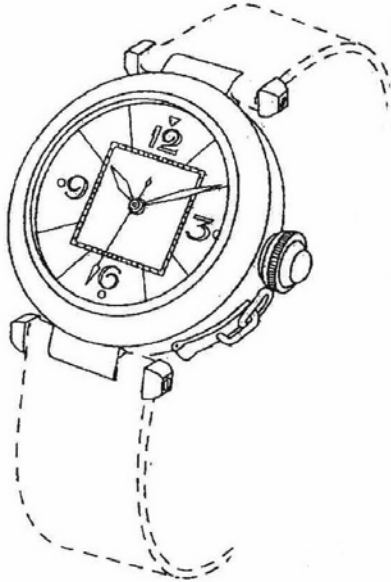
Opinion by Bucher, Administrative Trademark Judge:

Cartier N.V. seeks registration on the Principal  
Register of the following alleged mark:

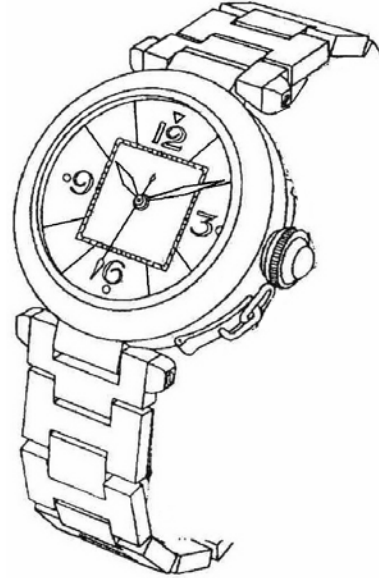


for goods identified as "horologic and chronometric instruments, namely, watches" in International Class 14.<sup>1</sup>

Applicant is the owner of two prior registrations:



REGISTRATION No. 3211038



REGISTRATION No. 3211039

<sup>1</sup> Application Serial No. 77227767 was filed on July 12, 2007, based upon claims of first use anywhere and first use in commerce at least as early as January 1, 1994. Applicant claims acquired distinctiveness under Section 2(f) for the entire configuration. However, applicant has disclaimed "the Arabic numeral 12, the three dials on the face of the watch, and the hand on the face and the dials of the watch." Applicant describes the mark as follows: "The mark consists of a configuration of a round and thick watch case (i.e., deep) with a thick outer metal bezel surrounding the watch face that slopes downward from the inside of the case to the outside; a removable, screw down cap that covers a central crown, such that in looking at the watch from the front, there are three metal rings of increasing thickness with engaved striations, a fourth thick metal ring, and a rounded cap, all of which is attached to the watch with a chain link; two smaller crowns positioned above and below the central crown, that are capped with non-removable caps that mimic the cap on the central crown; single horned extensions at the top and bottom of the watch case connecting it to the strap, such that the strap fits between the extensions with only one single extension on each side; a lug that extends through the strap/bracelet and the single horned extension with pyramid-shaped caps; Arabic numerals in curly font; and a metal bracelet that consists of H-shaped links alternating with rectangular shaped links, the width of the H-shaped links being half that of the rectangular link." Color is not claimed as a feature of the mark.

The Trademark Examining Attorney refused registration under Trademark Act Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052 and 1127, on the ground that this matter consists of non-distinctive features of product design and that applicant's evidence is insufficient to establish the acquired distinctiveness of the applied-for mark. Inasmuch as applicant has applied under the provisions of Section 2(f) of the Act, the only issue before us is whether the alleged mark has acquired distinctiveness.

After the Trademark Examining Attorney made the refusal final, applicant appealed to this Board. Both the Trademark Examining Attorney and applicant's counsel appeared for an oral hearing before this panel of the Board. We reverse the refusal to register.

Applicant has been active in the United States for over a century, and owns trademark rights here in the famous word mark **CARTIER**, as well as U.S. trademark registrations for distinctive designs of jewelry and watches. The watch configuration involved herein is the chronograph entry into the **PASHA** (or "Pasha de Cartier") line of watches. This particular line of watches was first introduced in 1985. The record shows that Pasha watches are one of Cartier's best sellers, and have become

world famous among luxury goods consumers over the past twenty-five years. Robert Wexler Decl. ¶¶ 7-10; Kristina Skoczylas Decl. ¶¶ 3-4, 8-12, Exhibit E The configuration of the non-chronograph version of the Pasha line of watches has already been registered as distinctive under Section 2(f) of the Trademark Act ['038 and '039, above].

The current chronograph treatment adds three small dials on the face of the watch (disclaimed in the application) and has two smaller buttons on the side of the watch. These additional features are integral to the chronograph functions. Otherwise, applicant seeks herein a registration having the same combination of visual design features contained in the '039 registration. Peter Kramer Decl. ¶¶ 3-12; Kristina Skoczylas Decl. ¶¶ 5-7 The fact that this configuration was earlier registered for this combination of visual features is consistent with applicant's position that this composite image reflects strong public recognition of the Pasha de Cartier line of watches.

Applicant argues that it seeks to register a specific combination of design elements as its mark. Hence, we agree that we must consider its registrability from the standpoint of the product appearance in its entirety. *In re Bose, Inc.*,

216 USPQ 1001 (TTAB 1983), *aff'd*, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985). Applicant's protectable rights rest on the distinctiveness of the entirety of that design - not merely the sum of the protectability of its individual features.

### **Survey**

Applicant submitted evidence into this record of a consumer survey taken in the course of another litigation involving a knock-off watch design that incorporated all the protectable elements of the Pasha Chronograph.<sup>2</sup> In order to test the level of consumer confusion as to that infringing watch, applicant commissioned a survey by Dr. Sidney I. Lirtzman. This survey's use of "look-alike" watches to determine levels of acquired distinctiveness has been explicitly approved by our primary reviewing Court. *See Textron, Inc. v. U.S. Intl. Trade Comm'n*, 753 F.2d 1019, 225 USPQ 625 (Fed. Cir. 1985). A high percentage of respondents erroneously identified the knock-off watch as coming from Cartier. We find this to be powerful evidence that this overall configuration has acquired distinctiveness. The survey

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<sup>2</sup> *Richemont North America, Inc. et al v. Sweepstakes Clearinghouse*, 06 Civ. 4698 (S.D.N.Y. 2007).

properly focused on the totality of the watch design. On this point, we disagree with the Trademark Examining Attorney's position that such a survey is not probative of acquired distinctiveness if it fails to inquire about respondents' recognition of specific "features" of the watch at issue.

### **Prior Litigation**

The distinctiveness of the Pasha watch line was also implicated in earlier litigation in the United States District Court for the Southern District of New York.<sup>3</sup> The District Court ruled twice<sup>4</sup> that the Pasha watch design comprised protectable trade dress inasmuch as it had acquired distinctiveness, and the Court permanently enjoined the defendant's sales of look-alike watches.<sup>5</sup> In the course of issuing the final injunction, the Court found that, *inter alia*, the Pasha design had acquired distinctiveness consistent with the test set

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<sup>3</sup> *Cartier, Inc. v. Four Star Jewelry Creations, Inc.*, No. 01 Civ. 11295, 2003 WL 21056809 (S.D.N.Y. 2003). See applicant's response of January 16, 2009, Exh. 2.

<sup>4</sup> Once as a preliminary injunction [f.3], and then again as a permanent injunction following an eight-day bench trial [f.5].

<sup>5</sup> *Cartier, Inc. v. Four Star Jewelry Creations, Inc.*, 348 F.Supp.2d 217, 241-44 (S.D.N.Y. 2004). See applicant's response of January 16, 2009, Exh. 3.

forth in *Wal-mart*.<sup>6</sup> In describing the Pasha line, this Court relied on the same basic design elements set forth above. Moreover, with reference to the chronograph treatment of the involved design, the Court noted that “[s]ome models within the [Pasha watch] family contain two smaller crowns positioned above and below the central crown. They are capped with non-removable caps, similarly designed to the central cap, and ending in matching cabochon.” *Cartier, Inc. v. Four Star Jewelry Creations, Inc.*, 348 F.Supp.2d at 223. Significantly, this Court found that the overall configuration of the Pasha de Cartier line was protectable trade dress due to a showing of acquired distinctiveness, both with and without a metal bracelet, with and without chronograph treatment, with and without the grill design on the glass of the watchface. *Id.* at 241.

### **Additional Evidence of Acquired Distinctiveness**

Applicant has submitted evidence supporting substantial sales of the Pasha line of watches over decades. *Contra In re ic! berlin brillen GmbH*, 85 USPQ2d 2021 (TTAB 2008). There are numerous national advertisements in the record

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<sup>6</sup> See *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 54 USPQ2d 1065 (2000).

displaying images of the Pasha chronograph watch quite reminiscent of the drawing herein. Consistent with the survey results, there are unsolicited articles talking about the way in which those in the relevant market for high-end watches immediately recognize the Pasha line of watches from the very features claimed in this trademark application.<sup>7</sup>

Furthermore, we are certainly not bound by the registrability decisions of an earlier Trademark Examining Attorney. However, in reflecting on the possible interests of legitimate competitors in the field of luxury goods, the fact the configuration marks of Registration Nos. 32110388 and 32110389 have so recently survived the opposition process is also an argument in applicant's favor. These two prior registrations depict and claim substantially similar watch configurations. The current Trademark Examining Attorney has not made the argument that these earlier registrations issued in error. Yet consistency and logic make it difficult to argue that the instant set of seven elements is not distinctive when somewhat smaller subsets of five or six of precisely the same elements were deemed distinctive several years ago. If we were to affirm this refusal, applicant could well be handicapped in its efforts

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<sup>7</sup> Rudiger Bücher *[No known relationship with the author of this opinion]*, *Comparative Test: Chronos with the Frederic Piguet Caliber 1185*, *WATCHTIME*, June 2001.



to deal with the threat of future knock-off artists after having gotten tripped up by a registration system that proved to be both unpredictable and inconsistent.

*Decision:* We reverse the refusal to register under Sections 1, 2 and 45 of the Trademark Act, finding that applicant's evidence is sufficient to establish acquired distinctiveness under Section 2(f) of the Act.