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Subject: U.S. TRADEMARK APPLICATION NO. 79152818 - MERLIN - N/A - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 79152818

MARK: MERLIN



CORRESPONDENT ADDRESS:

GLENN A GUNDERSEN

DECHERT LLP

CIRA CENTRE 2929 ARCH STREET

PHILADELPHIA, PA 19104-2808

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Breitling SA

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

EXAMINING ATTORNEY'S APPEAL BRIEF

INTERNATIONAL REGISTRATION NO. 1217921

Applicant has appealed the trademark examining attorney's refusal to register the trademark MERLIN on the ground that it is likely to be confused with the mark MERLIN found at U.S. Registration No. 4483252.

FACTS

On June 22, 2015,¹ the examining attorney issued a Final Refusal based on the likelihood of confusion of applicant's mark with the registered mark.

Applicant filed this appeal together with a request for reconsideration on December 21, 2015, which the examining attorney denied. On April 18, 2016 applicant filed its appeal brief. The only issue on appeal is the likelihood of confusion with the registered mark, under Trademark Act Section 2(d), 15 U.S.C. §1052(d). Applicant's mark is MERLIN, for use on goods including:

jewelry, timepieces and chronometric instruments²

The registered mark is MERLIN, used on goods including:

Articles of clothing, namely, T-shirts, tops, jumpers, coats, vests, bottoms, trousers, shorts, skirts, dresses, jackets, gowns, overalls; waterproof and weatherproof clothing, namely, water proof boots, water repelling footwear, waterproof jackets and pants; thermal clothing, namely, jackets, coats, thermal socks, and thermal underwear; lightweight clothing, namely, tops, bottoms, shorts, pants, skirts, dresses; sports clothing, namely, boots for sports, moisture-wicking sports shirts, moisture-wicking sports pants, moisture-wicking sports bras, sport shirts, sport stockings, sports bras, sports caps and hats, sports jerseys, sports over uniforms, sports pants, sports vests; suit jacket; suit trousers; scarves; anoraks, pullovers, shirts, cagoules, smocks and salopettes; gloves, socks, stockings; articles of underclothing, namely, underwear, lingerie; nightwear, swimwear; footwear; hosiery; headwear³

Both marks are shown in Standard Characters. Applicant has appealed this refusal.

ARGUMENT

¹ The final refusal issued on June 22, 2015 was a subsequent final refusal to the final refusal issued on May 22, 2015. The June 22 refusal was identical to the May 22 refusal but for a discussion of applicant's evidence and clarification as to the partial abandonment option available to applicant. No new issues were raised in the June 22 final refusal.

² The identification of goods also includes "Precious metals and alloys thereof" and "precious stones." However, the examining attorney is not basing this refusal on these goods.

³ The registered mark is also used on additional goods in class 16 and services in class 41. These goods and services are not relevant to the refusal and are therefore omitted here.

Applicant's mark MERLIN is identical to the registered mark MERLIN. Applicant's goods are related to the goods sold under the registered mark MERLIN. For these reasons, applicant's mark is likely to be confused with the registered mark, under Trademark Act Section 2(d), 15 U.S.C. §1052(d), and the refusal should be affirmed.

Here, the likelihood of confusion analysis is organized in two parts. These are (1) the similarity of the marks, and (2) the similarity or relatedness of the goods. *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 (TTAB 2015) (citing *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976)); TMEP §1207.01.

(1) Applicant's Mark MERLIN is Identical to the Registered Mark MERLIN, and Therefore Exceeds the Requirement for Similarity in Appearance, Sound, Meaning, Connotation and Commercial Impression

When determining the likelihood of confusion, the marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014); TMEP §1207.01(b)-(b)(v). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); TMEP §1207.01(b).

In this case, applicant's mark MERLIN is identical to the registered mark MERLIN. This exceeds the requirement for similarity between the marks.

Applicant has not argued that the marks are not similar, but has argued that MERLIN is a "relatively weak" mark that should be given less protection. Applicant bases this argument partially on the fact that MERLIN is not "unique to the cited registrant."⁴ However, there is no requirement that a

⁴ Applicant's brief, page 7. For the purpose of showing the mark is not unique, applicant provided evidence of the name MERLIN appearing in popular culture. Applicants' Exhibit D.

trademark be unique to a particular registrant for confusion to be likely. *In re i.am.symbolic, Ilc*, 116 USPQ2d 1406, 1411 (TTAB 2015).

Applicant also indicated in its brief that the name MERLIN appears in “over 150 active federal marks.”⁵ However, this is not shown in the evidence of record. First, applicant provided only 59 records, of which only 48 can be considered.⁶ For these 48 registered trademarks, none are used on jewelry, horological instruments or clothing. This is significant because these records are provided in reference to the sixth *du Pont* factor. The sixth factor allows for consideration of the number and nature of similar marks in use on similar goods to determine whether confusion is likely. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). However, the sixth *du Pont* factor considers trademarks relevant only to the extent that they are in use on similar goods.

In this case, the 48 MERLIN registrations currently in use are not used on similar goods and therefore have little or no bearing on the determination of strength of the mark.⁷ See *Kay Chems., Inc. v. Kelite Chems. Corp.*, 464 F.2d 1040, 1042, 175 USPQ 99, 101 (C.C.P.A. 1972); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009). Therefore the evidence does not support a conclusion that the MERLIN mark “is relatively weak and entitled to only a narrow scope of protection.” *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005). Accordingly, the registered trademark MERLIN should be considered a strong mark and entitled to the full scope of protection.

⁵ Applicant’s brief, page 4. Additionally on page 7 of its brief applicant indicates that the mark appears in 60 “active applications and registrations.” The evidence of these records is found in applicant’s Exhibit E.

⁶ Three cannot be considered because they are either abandoned trademark applications or cancelled registrations (the Ser. No. of the abandoned application is 86450232; the Reg. Nos. for the cancelled registrations are 1764303 and 1606712). *In re Pedersen*, 109 USPQ2d 1185, 1197 (TTAB 2013); *In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1286 n.3 (TTAB 2006); *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1047 n.2 (TTAB 2002); see TBMP §704.03(b)(1)(A); TMEP §1207.01(d)(iv). Eight of the records not use-based (these are Reg. Nos. 79175045, 79152818, 86255744, 86246742, 86220441, 4390334, 4483252 and 4000651). Because there has been no allegation of use, applicant cannot rely on these as evidence of what consumers would see in the marketplace. *Calypso Tech., Inc. v. Calypso Capital Mgmt., LP*, 100 USPQ2d 1213, 1221 n.15 (TTAB 2011).

⁷ Additionally, none of the trademark records discussed in footnote 6 identify relevant goods either.

Applicant also argues that it “will use its MERLIN mark as part of its product line, together with the well-known BREITLING house mark.”⁸ While this may be the case, applicant has applied to register the mark MERLIN alone, and the Office must determine whether registration is appropriate for the trademark shown in the application. 37 C.F.R. §2.52, TMEP §807 *et seq.* For this reason, applicant’s intent, or assurances as to the intended use of the mark, cannot be considered in this case.

Simply put, the registered mark MERLIN presented in standard characters is identical to applicant’s mark MERLIN, also presented in standard characters. It is only necessary to show that the marks are similar, and in this case the marks exceed this requirement.

For these reasons, applicant's mark is at least similar to the registered mark.

(2) Applicant's Goods are Related to the Goods on which the Registered Mark is Used.

For confusion to be likely, applicant’s goods must be similar or related to the goods on which the registered mark is used. *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); TMEP §1207.01(a)(i). In this case, applicant’s goods are related⁹ to the goods on which the registered mark is used, based on common practice in the marketplace for designers to sell clothing, jewelry and watches¹⁰ under a single trademark that identifies all of the goods as originating from a single source. Evidence attached with the Office actions discloses:

(1) U.S. Registration No. 4104444 for the mark HH¹¹ used on:

⁸ Applicant’s brief, page 6.

⁹ As a point of clarification, in the INTRODUCTION of applicant’s brief, applicant alleges that ‘The examining attorney nevertheless contends that Class 14 goods and Class 25 goods are “highly related,” and consumer confusion will therefore inevitably occur...’ Applicant’s brief, page 4. At no time has the examining attorney used the phrase “highly related” in this refusal. While applicant’s goods are simply related to the goods on which the registered mark is used, this is sufficient and this is what the examining attorney has alleged. Additionally, the examining attorney was unable to find use of the word “inevitably” in any of the actions issued on this application. While confusion is likely, there is no need to determine that confusion is inevitable for the refusal to be appropriate.

¹⁰ The application uses the wording “chronometric instruments.” This identifies a wide range of timekeeping and time recording devices. For simplicity, the examining attorney will refer to these goods throughout the brief as “watches.”

¹¹ TICRS Outgoing, 05/22/2015, Page 3. The USPTO Trademark Application Records are kept in a software application known by the acronym TICRS. The identical information is available to the public on the USPTO internet web site under the Trademark Status and Document Retrieval system (TSDR).

- a. Jewelry and watches (applicant's goods)
- b. Clothing (goods on which the registered mark is used)
- (2) U.S. Registration No. 4577032 for the mark DIVIDE¹² used on:
 - a. Jewelry and watches (applicant's goods)
 - b. Clothing (goods on which the registered mark is used)
- (3) U.S. Registration No. 4574477 for the mark EBCLO (E-B-KLO)¹³ used on:
 - a. Jewelry and watches (applicant's goods)
 - b. Clothing (goods on which the registered mark is used)
- (4) U.S. Registration No. 4633433 for the mark LA FREAK¹⁴ used on:
 - a. Jewelry and watches (applicant's goods)
 - b. Clothing (goods on which the registered mark is used)
- (5) U.S. Registration No. 4543617 for the mark WOMDEE¹⁵ used on:
 - a. Jewelry and watches (applicant's goods)
 - b. Clothing (goods on which the registered mark is used)
- (6) U.S. Registration No. 4338950 for the mark MISS MARC¹⁶ used on:
 - a. Jewelry and watches (applicant's goods)
 - b. Clothing (goods on which the registered mark is used)
- (7) U.S. Registration No. 3747833 for the mark KATHERINE HAMNETT¹⁷ used on:
 - a. Jewelry and watches (applicant's goods)
 - b. Clothing (goods on which the registered mark is used)
- (8) U.S. Registration No. 4403418 for the mark DAXX¹⁸ used on:
 - a. Jewelry and watches (applicant's goods)
 - b. Clothing (goods on which the registered mark is used), and
- (9) U.S. Registration No. 4618620 for the mark THE TRENDY SWEDE¹⁹ used on:
 - a. Jewelry and watches (applicant's goods)
 - b. Clothing (goods on which the registered mark is used).²⁰

These records show that jewelry and watches are sold together with clothing and are of a kind that may emanate from a single source under a single mark. *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015) (citing *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988)); TMEP §1207.01(d)(iii). Also attached with the Office actions are:

- (1) Pages from the internet website CalvinKlein.com, showing the trademark CALVIN KLEIN²¹ used on clothing, jewelry and watches,

¹² TICRS Outgoing, 05/22/2015, Page 7.

¹³ TICRS Outgoing, 05/22/2015, Page 10.

¹⁴ TICRS Outgoing, 05/22/2015, Page 13.

¹⁵ TICRS Outgoing, 05/22/2015, Page 16.

¹⁶ TICRS Outgoing, 10/23/2014, Page 6.

¹⁷ TICRS Outgoing, 10/23/2014, Page 9.

¹⁸ TICRS Outgoing, 10/23/2014, Page 12.

¹⁹ TICRS Outgoing, 10/23/2014, Page 15.

²⁰ Also in the record is U.S. Reg. No. 4599176, which has since been cancelled. Accordingly, the examining attorney is not referring to it here.

²¹ TICRS Outgoing, 10/23/2014, Pages 21 – 24.

- (2) Pages from the internet website RalphLauren.com, showing the trademark RALPH LAUREN²² used on clothing, jewelry and watches,
- (3) Pages from the internet website of Michael Kors, showing the mark MICHAEL KORS²³ used on clothing, jewelry and watches, and
- (4) Pages from the internet website of Kate Spade, showing the mark KATE SPADE²⁴ used on clothing, jewelry and watches.

As a whole, the evidence shows that consumers will routinely find clothing, jewelry and watches being sold in the marketplace under a single mark that is used to identify a single source for these goods. Because consumers find these goods originating from a single source, applicant's jewelry and watches would be related in consumers' minds to clothing, and this would cause consumers to conclude that the source of MERLIN brand watches or jewelry is the same source as MERLIN brand clothing.

Applicant contends that the evidence provided is not sufficient. A large part of applicant's argument is based on the number of trademarks provided. However, this is not merely a case of providing a greater number of Office records or advertisements to support an argument. The examining attorney has provided representative examples of the many relevant available records and websites at which consumers will find jewelry, watches and clothing being sold under a single mark used to identify a single source for these goods. While applicant may feel that nine registrations and four internet websites are too few in number, these materials speak directly to the issue of what consumers will find in the marketplace and how consumers form opinions about related goods.

Applicant has also argued that the examining attorney's evidence is inapplicable because it shows only the names of fashion designers used on jewelry, watches and clothing.²⁵ This is a misleading argument, because applicant asks the Board to consider the given name MERLIN to be something other

²² TIGRS Outgoing, 10/23/2014, Pages 25 – 35.

²³ TIGRS, Outgoing 05/22/2015, Pages 19 – 35.

²⁴ TIGRS, Outgoing 05/22/2015, Pages 36 – 50.

²⁵ Applicant's brief, page 9.

than a name, based on “associations to literature and magic.”²⁶ However, “Merlin” is a given name and could be understood by consumers to be the name of an individual fashion designer. In this way, MERLIN may be more like CALVIN KLEIN or KATE SPADE than perhaps WOMDEE, or other –non-name- trademarks, discussed above.

Also, applicant has deliberately ignored the registrations in evidence, which show eight out of thirteen trademarks that may not identify individual fashion designers. As a whole, the evidence shows both name-like trademarks and word-like trademarks used on jewelry, watches and clothing.²⁷ Based on this evidence, jewelry and watches are related to clothing with respect to various marks used on these goods.

Applicant has argued that there is no “overlap” of applicant’s goods and the goods on which the registered mark is used. However, there is no requirement for the goods to “overlap” in determining whether confusion is likely. *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i). For this reason, applicant’s discussion of “overlap” is of little relevance.

Regarding channels of trade, applicant has provided evidence that the owner of the registered mark operates theme parks and entertainment attractions. While this is interesting, the question of likelihood of confusion must be determined based on the identification of the goods in the registration at issue, not on extrinsic evidence of use.²⁸ *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d

²⁶ *Id.*

²⁷ Applicant itself has supplied for the record evidence of trademarks comprised of a single given name, that might identify a fashion designer. These would be Aphrodite, Athena, Elektra, Guinevere and Hercules, all potentially names of individuals who are fashion designers. For this reason also, applicant’s criticism of the evidence is spurious.

²⁸ On page 6 of its brief, applicant also suggests that the registered mark is not in use on the goods identified in the registration. The registration is based on Trademark Act Section 44(e), 15 U.S.C. §1126(e). A registration based on this section is not required to show use until an affidavit of use is required under Trademark Act Section 8, 15 U.S.C. §1058. Therefore discussions of use of the mark are not relevant to this case.

1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014). The registration identifies clothing that is not restricted as to distribution in theme parks or any other way. Because of this, we must conclude that the clothing is available in all channels of trade in which these goods are customarily sold. *See Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002). For this reason, applicant's channels of trade are construed as identical to the channels of trade in which the goods are sold under the registered mark.

Applicant also argues that there is no *per se* rule that its goods are similar to the goods on which the registered mark MERLIN is used.²⁹ This is most certainly true as there are no *per se* rules as to similarity of any goods or services. Each application must be evaluated based on its own facts, and conclusions as to similarity of goods must be based on the available record. *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Binion*, 93 USPQ2d 1531, 1536 (TTAB 2009). Based on the available record, applicant's goods are related to the goods on which the registered mark is used.

Regardless, applicant's evidence must be addressed. Applicant has provided, in its Exhibits G, H and I, trademark pairs,³⁰ registered to different owners, that applicant asserts show identical marks used on jewelry or watches or clothing. All together these Exhibits include 112 records. However of these,

²⁹ Applicant's brief, page 7.

³⁰ These are mostly pairs of trademarks. There are 8 sets of three or more records showing identical marks. These are for the marks COMMANDER (record numbers 894120, 838870, 2031885 and 2522822), DAYTONA (record numbers 1445066, 2331145 and 1827196), EMERGENCY (record numbers 1934800, 1934800 and 1317111), EXPLORER (record numbers 2518894, 3323081 and 3467722), NAUTILUS (record numbers 1173140, 1084853, 1086063, 1391673 and 2970870), RIVIERA (record numbers 1264895, 1324386, 229285 and 4121731), SKIN (record numbers 3305051, 3782765, 4266530 and 4580499) and SKYHAWK (record numbers 2589213, 2854747 and 3429847). For ease of discussion, the examining attorney here will discuss all of the records as "pairs" regardless of the number of trademarks provided.

only 14 trademark pairs can be considered.³¹ Applicant has dedicated a full section of its brief³² to discuss how the examining attorney has not presented sufficient evidence for the refusal.³³ However, a simple accounting of acceptable and relevant pieces of evidence in the record shows that applicant has provided no more trademarks that might militate against a finding of likelihood of confusion than are shown to support a finding that the goods are similar.³⁴ Additionally, applicant has provided only Trademark Office records supporting its position. Generally, Trademark Office records alone are insufficient and should be supplemented by evidence of actual use to reflect what consumers encounter in the marketplace. From what they see in the marketplace, consumers form their opinions about the similarity of the goods. *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA

³¹ Eight are pairs that include an abandoned or cancelled trademark records. These are record numbers: 2123645 for ATHENA, 894120 for COMMANDER, 3517396 for CONCERTO, 86488208 for DE VILLE, 2979531 for GUINEVERE, 1794879 for NOVECENTO, 590274 for PORTO FINO and 2946239 for VANQUISH. As discussed in footnote 6, abandoned or cancelled registrations cannot be considered. *In re Pedersen*, 109 USPQ2d 1185, 1197 (TTAB 2013). Twenty-two are pairs that include one or more applications or registrations for which use has not been alleged or shown. These are record numbers: 4578209 for AIRBORNE, 2749102 for ALTER EGO, 4181610 for BLACK EAGLE, 3060488 for BLACK TIE and 86110278 for BLACK TIE, 2183587 for CATWALK, 3807272 for DEFY, 3763483 for ELEKTRA, 1934800 for EMERGENCY and 1934800 for EMERGENCY, 3254009 for GALACTIC, 85968063 for ISKIN, 2357292 for LIMELIGHT, 4219899 for MALIBU, 1385183 for NAVIGATOR, 4390181 for ORKIDE, 86072436 for PROMASTER, 2195352 for SEARACER, 3221076 for SPITFIRE, 2980603 for TOP GUN, 3256611 for VANQUISH and 4293854 for VANQUISH, and 3872929 for YACHT CLUB. Also as discussed in footnote 6, trademarks that are not in use are not relevant as to consumers' state of mind for likelihood of confusion purposes. *Calypso Tech., Inc. v. Calypso Capital Mgmt., LP*, 100 USPQ2d 1213, 1221 n.15 (TTAB 2011). Two sets are inapplicable because they disclose trademarks that are not identical. These are record numbers: 4255017 for APHRODITE and 4236988 for APHRODITE NIGHTIE, and 2302375 for BREITLING COLT and 3275579 for COLT. While trademarks do not need to be identical for confusion to be likely, in this case applicant's MERLIN is identical to the registered mark MERLIN and this is relevant to the determination of likelihood of confusion. *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015) (citing *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993)); TMEP §1207.01(a). Two sets are inapplicable because the goods are not similar to the goods in this case. Record numbers: 559010 for ATMOS is registered for use on "clocks." While in class 14, clocks are much narrower goods than those for which applicant is seeking registration and if applicant were to amend its identification in the class to read "clocks," this refusal may not have been made. Also, 85295132 for KINETIC is registered for goods in classes 12 and 28, not for any of the goods at issue in this appeal. Six records show one trademark without a corresponding partner to create a pair of trademarks. Record Numbers: 2572724 for AVENGER, 1909931 for CHRONOMAT, 3280243 for MONTBRILLANT, 1923563 for NAVITIMER, 3171794 for SUPEROCEAN and 3228245 for TRANSOCEAN.

³² Section 4, pages 8, 9 and 10 of applicant's brief.

³³ Applicant frames this in terms of insufficient "evidence to controvert Applicant's showing that no likelihood of confusion exists." However, the examining attorney does not bear the burden of overcoming applicant's showing. The examining attorney makes the initial refusal in an *ex parte* hearing, making the case in chief, and applicant bears the burden of overcoming the refusal.

³⁴ This determination includes one trademark DAYTONA, U.S. Reg. No. 1445066, found in applicant's evidence that is used on both jewelry and clothing. This would support the examining attorney's contention that the goods are similar, rather than supporting applicant's contention that confusion is not likely.

1973). The examining attorney has provided both Office records and actual advertising materials.

Applicant has only provided Office records. For these reasons, applicant's assessment of the evidence is disingenuous.

Applicant also accuses the examining attorney of contradicting himself by using Office records while simultaneously finding fault in applicant's Office record evidence. However, the Office records are presented for two different purposes. The examining attorney has relied on this evidence to show consumer expectations as to similarity of the goods. Applicant is using its evidence to try to establish that, per Office policy, the goods are not related. However, as each case must be decided on its own merits, this is not an appropriate use of prior registrations. *In re Midwest Gaming & Entm't LLC*, 106 USPQ2d 1163, 1165 n.3 (TTAB 2013) (citing *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)); TMEP §1207.01(d)(vi). For this reason, there is no contradiction in using the evidence to show similarity of the goods while rejecting evidence of the same type that is used for a different purpose.

Finally, the Board and Commissioner have determined that jewelry or watches are related to clothing for purposes of determining likelihood of confusion, in previously published decisions. *Kabushiki Kaisha Hattori Seiko V. Satellite International Ltd.*, 29 USPQ 2d 1317 (TTAB 1991) (SAKO for shoes and footwear is likely to be confused with SEIKO used on watches and clocks); *David Crystal, Inc. v. Dawson* 156 U.S.P.Q. 573 (TTAB 1967) (CRYSTYLE for jewelry is likely to be confused with A CRYSTAL COTTON, CRYSTAL, DAVID CRYSTAL, THE CRYSTAL LOOK, MISS CRYSTAL and A CRYSTAL KNIT, used on women's clothing); *Society Brand Clothes, Inc., v. Kirsch*, 102 USPQ 260 (Comm'r of Patents 1954) (SOCIETY BRAND for jewelry is likely to be confused with SOCIETY and SOCIETY BRAND used on clothing). This case law supports the conclusion that applicant's goods are related to the goods on which the registered mark is used.

Based on the foregoing, applicant's goods are related to the goods on which the registered mark is used.

CONCLUSION

Because applicant's mark MERLIN is identical to the registered mark MERLIN and because applicant's goods are related to the goods on which the registered mark is used, applicant's mark is likely to be confused with the registered mark and the refusal to register on the basis of Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), should be affirmed.

Respectfully submitted,

/Fred Carl III/

Trademark Examining Attorney

U.S. Pat. & Trademark Office

Law Office 108

571/272-8867 direct phone

571/273-8867 fax

fred.carl@uspto.gov

Andrew Lawrence

Managing Attorney

Law Office 108