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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	79152818
Applicant	Breitling SA
Applied for Mark	MERLIN
Correspondence Address	GLENN A GUNDERSEN DECHERT LLP CIRA CENTRE 2929 ARCH STREET PHILADELPHIA, PA 19104-2808 UNITED STATES trademarks@dechert.com, glenn.gundersen@dechert.com, jac-ob.bishop@dechert.com
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Filer's Name	Glenn A. Gundersen
Filer's e-mail	trademarks@dechert.com, glenn.gundersen@dechert.com, jac-ob.bishop@dechert.com
Signature	/Glenn A. Gundersen/
Date	07/05/2016

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application of:	:	
Breitling SA	:	
	:	Fred Carl III
	:	Law Office 108
Mark: MERLIN	:	
	:	
Serial No.: 79/152,818	:	
Filing Date: July 7, 2014	:	

**APPLICANT’S REPLY BRIEF**

Applicant Breitling SA respectfully submits this reply brief in response to the examining attorney’s refusal to register Applicant’s MERLIN mark under Section 2(d) of the Trademark Act.

With his evidence and arguments, the examining attorney has demonstrated one principle – that if someone used the name of a famous designer like RALPH LAUREN or CALVIN KLEIN on watches, the public would assume the designer to be the source or licensor of the watches. Applicant does not disagree with that principle. Unfortunately, it does not apply in the current situation, where the cited mark is not the name of a designer, is not famous, unique, or unusual, is used by many companies in the marketplace, and has literary significance and cultural associations that predated anyone adopting it as a trademark by more than 900 years.

The examining attorney’s brief makes assumptions for which there is no logical justification, and reaches conclusions for which he has supplied no evidence. At a fundamental level, he has not provided a consumer’s-eye-view explanation as to why someone who encounters a MERLIN watch would mistakenly assume that its source is a producer of MERLIN clothing. (Given Applicant’s fame as a watchmaker, its arguments and evidence have focused entirely on the potential for confusion for watches, and not jewelry, and consistent with that,

Applicant is simultaneously amending its identification of goods to delete jewelry and focus the argument entirely on watches.)

While this examining attorney is obviously not bound by the decisions of other examining attorneys on other applications, his broadbrush conclusion about the inherent potential for confusion between clothing and watches is clearly out of step with many other members of the examining corps, and with the Board's recent decisions. However, he is not able to justify why confusion is inherent with this particular mark.

MERLIN is not a mark that is unique to Applicant or unusual, and there's no evidence that the registrant is entitled to broad protection that spans not just Class 25, but Class 14 as well:

- The examining attorney bases the refusal in part on the registrations of eight marks whose identification of goods covers both watches and jewelry and clothing. He claims that “these records show that jewelry and watches are sold together with clothing” (emphasis added, Brief at 4), but he cannot reach that conclusion. He has only shown that these goods appear together in the same eight use-based registrations. He has not submitted any evidence of actual use of any of these marks in the marketplace.
- His only real-world marketplace evidence consists of web pages showing that four designers (Calvin Klein, Ralph Lauren, Michael Kors, and Kate Spade) use their designer names on watches, jewelry, and clothing. He leaps to the conclusion that “As a whole, the evidence shows that consumers will routinely find clothing, jewelry, and watches being sold in the marketplace under a single mark.” (Emphasis added, Brief at 4-5.) However, this limited evidence of designer use is obviously insufficient to show that consumers “routinely” find the same marks used for these goods. He has offered no marketplace evidence showing that consumers typically see non-designer marks such as MERLIN used on both classes of goods.
- The examining attorney mischaracterizes this small amount of evidence, saying that he “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.” (Emphasis added, Brief at 5.) However, there is no basis his conclusion that these webpages are “representative examples of the many relevant available websites” that supposedly prove the examining attorney's point. He issued an initial refusal, a final refusal, and a refusal of the request for reconsideration, all containing arguments against registration, and had ample opportunity to provide more evidence, but did not.

In terms of sheer numbers of registrations, Applicant has provided more than four times as much evidence to support its position as the examining attorney. The examining attorney is able to cite nine instances in which a non-designer name has been registered for both clothing and watches; Applicant has cited forty instances in which the same mark is registered by two different parties, one for clothing and the other for watches, and has shown that half of the watch marks are in current use. Although the examining attorney relies in significant part on registrations as evidence, he contradicts himself as to their significance – in page 6 of his brief, he notes that “Trademark Office records alone are insufficient and should be supplemented by evidence of actual use to reflect what consumers encounter in the marketplace”, yet also contends that he has relied on registrations alone “to show consumer expectations as to similarity of the goods”, and says that Applicant is not entitled to do so.

More important, Applicant has submitted far more extensive real-world evidence showing that watch marks from a major watchmaker coexist on the trademark register with clothing marks from other companies. Specifically, Applicant showed that many of the world’s other leading watchmakers—including Citizen, Omega, Movado, Patek Philippe, Richemont, Rolex, Seiko, Swatch, TAG Heuer, Tissot, and Zenith—have all registered marks in Class 14 that are identical to Class 25 marks owned by others. Applicant submitted evidence that more than two dozen of these marks are currently in use as model names for specific watches, similar to the manner in which Applicant Breitling intends to use MERLIN:

<b>Watch Brand</b>	<b>Class 14 Mark (Reg. No.)</b>	<b>Third Party Registrant</b>	<b>Class 25 Mark (Reg./App. No.)</b>
Bulova	COMMANDER (894120)	Williamson-Dickie Holding Company	COMMANDER (2522822, 2031885, 838870)

<b>Watch Brand</b>	<b>Class 14 Mark (Reg. No.)</b>	<b>Third Party Registrant</b>	<b>Class 25 Mark (Reg./App. No.)</b>
Bulova	EXETER (3702155)	Phillips Exeter Academy	EXETER (1674335)
Citizen	BLACK EAGLE (3395985)	Ewald Haimerl	BLACK EAGLE (4181610)
Citizen	ELEKTRA (3763483)	Evolve Sports & Designs	ELEKTRA (4038304)
Citizen	MODENA (2854126)	Jin Myong Kang	MODENA (2607231)
Citizen	PROMASTER (1584567)	Sun Tiger, Inc.	PROMASTER (86072436)
Citizen	SKYHAWK (2589213)	TJX Companies, Inc.	SKYHAWK (2854747, 3429847)
Citizen	STILETTO (2776544)	Milwaukee Electric Tool Corporation	STILETTO (3122288)
IWC	ATMOS (559010)	Jako Enterprises	ATMOS (3651638)
IWC	BLACK TIE (3060488)	Lake Hollywood Productions Inc.	BLACK TIE (86110278)
IWC	CATWALK (2183587)	Runway	CATWALK (3761937)
IWC	LIMELIGHT (2357292)	Roland-Schuhe	LIMELIGHT (4193021)
IWC	MALIBU (4219899)	The Absolut Company	MALIBU (2989886)
IWC	NOVECENTO (1794879)	Forall Confezioni S.P.A.	NOVECENTO (1804555)
IWC	PORTOFINO (1846680)	Calvin Clothing Company	PORTOFINO (590274)
IWC	RIVIERA (1264895, 1324386)	Jack Victor Limited	RIVIERA (229285, 4121731)
IWC	SPITFIRE (3221076)	S.F. Deluxe Productions, Inc.	SPITFIRE (3001827)
IWC	TOP GUN (2980603)	Top Gun Intellectual Properties, LLC	TOP GUN (2817325)

<b>Watch Brand</b>	<b>Class 14 Mark (Reg. No.)</b>	<b>Third Party Registrant</b>	<b>Class 25 Mark (Reg./App. No.)</b>
IWC	YACHT CLUB (3872929)	Grupo Fratex S.A. de C.V.	YACHT CLUB (4469124)
Movado	CONCERTO (563424)	Sorbe Ltd.	CONCERTO (3517396)
Omega	DE VILLE (1309929)	Jessica Sarna Daniel Sarna	DE VILLE (86488208)
Patek Philippe	NAUTILUS (1173140)	Nautilus, Inc.	NAUTILUS (1084853, 1086063, 1391673, 2970870)
Rolex	DAYTONA (2331145)	International Speedway Corporation	DAYTONA (1445066, 1827196)
Rolex	EXPLORER (2518894)	San Mar Corporation	EXPLORER (3467722, 3323081)
Rolex	ORCHID (2644206)	Orkide Tekstil	ORKIDE (4390181)
Rolex	GOLDUST (3319994)	Roxana Zal Vanessa Dingwell	GOLD DUST (4153860)
Seiko	KINETIC (1829256)	Kurt Manufacturing Company	KINETIC (85295132)
Seiko	SOMA (4415003)	Chico's Brands Investments, Inc.	SOMA (4243695)
Swatch	ISKIN (85/968,063)	iSkin, Inc.	ISKIN (4142913)
Swatch	SKIN (3305051)	Skin Holdings, LLC	SKIN (3782765, 4266530, 4580499)
Swatch	VENTURA (1622393)	Messingschlager GmbH & Co. KG	VENTURA (4091316)
Tag Heuer	SEARACER (2195352)	SR Holdings, LLC	SEARACER (4251360)
Tag Heuer	ALTER EGO (2749102)	Novus, Inc.	ALTER EGO (4720250)

<b>Watch Brand</b>	<b>Class 14 Mark (Reg. No.)</b>	<b>Third Party Registrant</b>	<b>Class 25 Mark (Reg./App. No.)</b>
Tag Heuer	VANQUISH (3256611)	Ceno Company Ltd.	VANQUISH (2946239, 4293854)
Tissot	NAVIGATOR (1385183)	Lands' End, Inc.	NAVIGATOR (2945772)
Tissot	STYLIST (1472168)	Express Inc.	STYLIST (3940767)
Zenith	EL PRIMERO (3038779)	Milano Hat Company, Inc.	EL PRIMERO (3711892)
Zenith	DEFY (3807272)	Michael S. Doherty	DEFY (4089917)

The examining attorney seems to have forgotten that Applicant submitted the extensive evidence of marketplace use shown above. He inaccurately states in his brief at page 6 that “he has provided both Office records and actual advertising materials [while] Applicant has only provided Office records” – this is plainly not true.

The examining attorney rejects the notion that MERLIN is a weak, commonplace mark, and then mistakenly leaps to the conclusion that if it’s not weak, it must automatically be a strong mark.

“[T]he evidence does not support the conclusion that the MERLIN mark ‘is relatively weak and entitled to only a narrow scope of protection. [cite omitted] Accordingly the registered mark MERLIN must be considered a strong mark.” Brief at 3

As a logical matter, it does not necessarily follow that a mark must be strong if it is not weak. As an evidentiary matter, he has provided nothing to support his assertion that “MERLIN must be considered a strong mark.” If he is going to claim that the MERLIN registration should block not just the registration of identical marks in Class 25, but identical marks in other classes,

he must provide a rationale as to why a consumer who encounters a MERLIN watch would immediately associate it with the source of MERLIN clothing.

Applicant has submitted dozens of registrations of the mark MERLIN, all owned by different registrants, including registrations covering a dozen different consumer products, including TV remote controls, cigars, bicycles, guitars, binoculars, books and greeting cards, vehicle anti-theft alarms, telephones, gaming machines, landscape lighting, educational loan services, and muffler shops. The examining attorney disregards this evidence on the premise that the DuPont test “considers trademarks relevant only to the extent they are in use on similar goods.” (Brief at 3.) However, this evidence contradicts the examining attorney’s conclusion that “MERLIN must be considered a strong mark.” There is no basis for assuming it to be strong when it is so commonplace.

In his brief, the examining attorney belatedly tries to analogize the mark MERLIN to the names of famous fashion designers like Ralph Lauren on the premise that “Merlin is a given name and could be understood by consumers to be the given name of a fashion designer.” This argument is not credible for multiple reasons. First, while confusion could occur if a famous clothing designer’s name appeared on watches, it does not follow that a consumer might guess that a first name *could* possibly refer to an unknown designer. Second, all of the designer names on which the examining attorney bases his claim are full names of individuals that have been famous for decades (Ralph Lauren, Calvin Klein, Kate Spade, and Michael Kors), not the first name of an unknown individual who might be guessed to be a designer.

In any event, the examining attorney’s basic premise is specious – that a consumer would ignore the fact that MERLIN is the name of a fictitious wizard, and instead guess it to be the first name of a living 21<sup>st</sup> century fashion designer. The Social Security Administration statistics

showing the popularity of baby names indicates that “Merlin” has not been among the top 1000 names given boys in the U.S. in forty years, and at a peak in 1961 represented only 110 boys born in the whole U.S. (Applicant submits this data as **Exhibit A**, respectfully requesting that the Board take judicial notice of it.) Thus, most consumers living today have likely never met or heard of someone named Merlin, and are unlikely to think it to be the name of a designer.

In contrast, Applicant has demonstrated that the cultural references to the MERLIN of Arthurian legend have lasted from generation to generation – Disney’s release of *Sword in the Stone* in the 1960s (available for decades later on VHS and DVD), *Excalibur* in the movies in the 1980’s, *Once Upon a Time* on current ABC prime-time television, and countless productions of the musical *Camelot* from 1960 to the present.

The term MERLIN clearly suggests magic or fantasy, evoking a wealth of images and associations from popular culture. That connotation has made it an appealing mark to many different companies who want to suggest that their products are out of the ordinary. Such references will be the consumer’s first and foremost touchstone. There’s no reason for a consumer to take a mental leap beyond that significance and mistakenly assume that MERLIN watches are connected with MERLIN clothing.

None of the nine Class 14/Class 25 registrations cited by the examining attorney are for marks analogous to MERLIN – i.e., none of them has a ready-made significance in popular culture. Three are entirely coined terms, with no apparent meaning (EBCLO, WOMDEE, and DAXX), three are coined combinations of dictionary terms (LA FREAK, MISS MARC, and THE TRENDY SWEDE), one is a dictionary word (DIVIDED), one is an individual’s name (KATHERINE HAMNETT), and one is a highly stylized design that is apparently intended as the initials HH.



Unlike MERLIN, which appears in dozens of registrations held by dozens of registrants, the majority of the marks on which the examining attorney relies are unique to the registrant – there are no other active federal registrations of EBCLO, WOMDEE, LA FREAK, or THE TRENDY SWEDE, there’s only one other registration of MISS MARC owned by the same registrant, and only one other registration of DAXX for unrelated goods (electrical wires and audio products).

Needless to say, the marks cited by the examining attorney are unusual, some of them are even oddball. The examining attorney hasn’t shown that any of these are brands that the average consumer might actually have encountered in use on both watches and clothing. Thus, for multiple reasons, the examining attorney has not shown what he claims he has shown – namely, that “consumers will routinely find clothing, jewelry, and watches being sold in the marketplace under a single mark.”

Finally, the examining attorney cites three cases as precedent in support of the refusal.

None is on point:

- The most recent decision involved the SEIKO mark for watches cited against a mark for shoes and footwear, and turned on the fact that SEIKO was “an arbitrary, famous watch trademark”, described in *The Wall Street Journal* as 9<sup>th</sup> among the top 20 best-known brands in the world.
- The *David Crystal* decision involved a designer name and a cited mark for jewelry, not watches. The Board found that the designer mark had been extensively advertised in *Vogue*, *Glamour*, *Mademoiselle*, *Harper’s*, *The New Yorker*, and *Women’s Wear Daily*, in local newspapers throughout the country, and via brochures and fashion shows, and generated millions of dollars in sales.

- In *Society Brand*, the decision described the mark as “one of the more widely known marks in the apparel field.”

Aside from being distinguishable on the facts, the oldest of these cases, *Society Brand*, was decided 62 years ago, and *Crystal* was decided 49 years ago. The assumptions made about the marketplace a half century ago don't necessarily apply to 2016.

The examining attorney has not shown that the cited registrant's MERLIN mark is famous, unique, well-known, or even particularly distinctive. There's no evidence that the mark is even in use for “cagoules, smocks, salopettes” or any of the 60 different items listed in the identification. Nevertheless he is willing to accord a mark in a Class 44 registration broad protection, extending beyond Class 25 to block a Class 14 application. If the Board were to agree that all such marks should prevent the registration of identical marks in Class 14, that decision would only exacerbate the current gridlock on the U.S. trademark register at a time when applications are at an historic high.

For all of the foregoing reasons, Applicant respectfully requests that the refusal to register be reversed.

Date: July 5, 2016

Respectfully submitted,

/Glenn A. Gundersen/  
Glenn A. Gundersen  
Jacob Bishop  
DECHERT LLP  
Cira Centre  
2929 Arch Street  
Philadelphia, PA 19104-2808

Attorneys for **BREITLING SA**

**Exhibit A**

Baby Name Data

Popular Names by Birth Year

Popularity of a Name

### See How the Popularity of a Name has Changed Over Time!

merlin Name

1980 & later Years

Sex associated with name

- Male
- Female



Social Security  
Official Social Security Website

## Popularity of name Merlin

Select another name?

Merlin

**Merlin is not in the top 1000 names for any year of birth beginning with 2000.  
Please enter another name.**

Sex associated with name

Male  Female



Social Security  
Official Social Security Website

## Popularity of name Merlin

Select another name?

Merlin

**Merlin is not in the top 1000 names for any year of birth beginning with 1980.  
Please enter another name.**

Sex associated with name

Male  Female



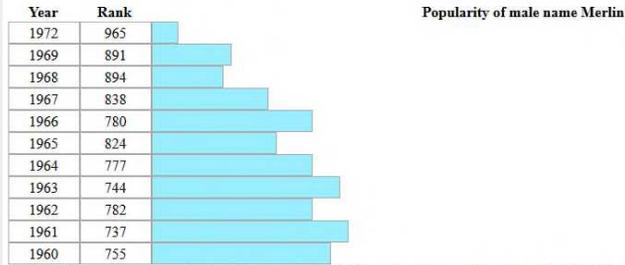
## Popularity of name Merlin

[Popular baby names](#)  
[Background information](#)

Select another name?

sex associated with name  
 Male  Female

For each year, we show the rank for Merlin and a bar representing the popularity of that name. The longer the bar, the more popular the name. The more popular the name in a given year, the numerically lower the rank, with rank 1 being the most popular.



Data are missing for 45 years where the name Merlin is not in the top 1000 most popular names. Name data are from Social Security card applications for births that occurred in the United States.

### More information for male name Merlin

- For 1972, the number of births with name Merlin is 71, which represents 0.004 percent of total male births in 1972.
- The year when the name Merlin was most popular is 1961. In that year, the number of births is 110, which represents 0.005 percent of total male births in 1961.