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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

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>

APPLICANT: Breitling SA

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

**REPLY BRIEF AFTER REQUEST FOR REMAND
WITH AMENDMENT –
AMENDMENT ACCEPTED, RECONSIDERATION DENIED**

ISSUE/MAILING DATE:

INTERNATIONAL REGISTRATION NO. 1217921

This action follows a remand from the Trademark Trial and Appeal Board regarding an appeal of a refusal regarding the trademark application identified above. The Board has remanded the application to the examining attorney to act on applicant's amendment of the identification of goods to delete

“jewelry” from the identification of goods, pursuant to applicant’s request of July 6, 2016. Additionally, the examining attorney notes that applicant has filed an additional amendment, via TEAS, on August 10, 2016, without leave of the Board. This amendment deletes all goods from the identification, but for:

timepieces and chronometric instruments

The examining attorney does not object to the August 10 amendment. However, the Board has not had an opportunity to consider applicant’s additional amendment. While it is not in the examining attorney’s discretion to presume the Board’s response, in the interest of saving time, the examining attorney will respond to both amendments as if the Board has seen and approved them. Applicant is advised that the Board may take alternative action on the August 10 amendment.

As to both submissions of July 6 and August 10, 2016, the examining attorney has reviewed applicant’s evidence¹ and the revised identification of goods. After consideration of the evidence and amendments, and based on the identification of goods shown above, the examining attorney is denying the reconsideration request for the reasons stated below. *See* 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The refusal under Trademark Act Section 2(d) made final in the Office action dated June 22, 2015 is maintained and continues to be final. TMEP §§715.03(a)(ii)(B), 715.04(a).²

RESPONSE AND EVIDENCE

¹ Normally, an applicant is precluded from providing additional evidence after filing of an appeal. 37 C.F.R. §2.142(d); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c). The examining attorney is not objecting to the evidence submitted on July 6, because the Board has offered the examining attorney an opportunity to respond to the evidence here.

² Regarding the question as to whether applicant has a bona fide intent to use the mark on the additional goods in the application as of the July 6 remand request, the amendment of August 10, 2016 has obviated this issue. Accordingly, the examining attorney is not issuing a new non final refusal as to these goods and whether or not applicant had an intent to use the mark on these goods, as discussed in the Board’s remand of August 9, 2016.

In its reply brief, applicant argues that the evidence of record shows only use of names of famous fashion designers as trademarks on clothing and watches, and for this reason the evidence is inapplicable because applicant's trademark is not the name of a famous fashion designer.³ First, the examining attorney points to the registrations already in the record, showing the use of the trademarks WOMDEE, HH, LA FREAK, EBCLO(E-B-KLO) and DIVIDE,⁴ and MISS MARC, THE TRENDY SWEDE, WON AND DONE and DAXX.⁵ None is the name of a famous fashion designer, and all are evidence of trademarks in use in the U.S.⁶ for both applicant's goods and the goods on which the registered mark is used.

However, accepting for the sake of argument both applicant's characterization of the evidence and applicant's conclusion regarding consumer perception of "famous designer name" trademarks, the examining attorney is providing here additional evidence of trademarks that are not individuals' names at all, and are used on both clothing and watches:

- (1) U.S. Registration No. 5024031 for the mark PRESELF used on:
 - a. Watches (applicant's goods) and
 - b. Clothing (goods on which the registered mark is used).
- (2) U.S. Registration No. 5020293 for the mark SOYA GIFT used on:
 - a. Watches (applicant's goods) and
 - b. Clothing (goods on which the registered mark is used).
- (3) U.S. Registration No. 5016960 for the mark ILMATIC used on:
 - a. Watches (applicant's goods) and
 - b. Clothing (goods on which the registered mark is used).

³ Applicant's reply brief, TTABView 07/05/2016, page 8. There is no evidence in the record that these trademarks identify the names of famous fashion designers. The record merely shows that these are trademarks. Applicant has merely concluded that these are names (specifically, famous fashion designers). The examining attorney has similarly concluded that Merlin is also a name. Also, there is no provision in U.S. Trademark law for enhanced scrutiny of registered trademarks based on their fame, as it applies to the registration of trademarks. For this reason, applicant's conclusions as to the nature of these trademarks and the legal effect of this conclusion are unsupported and spurious.

⁴ Provided with the Office Action of May 22, 2015.

⁵ Provided with the Office Action of October 23, 2014.

⁶ Applicant suggests that this evidence is suspect due to the failure to provide additional evidence that these registered trademarks are currently in use. However, these valid registrations under Section 1(a) have been reviewed for use by the examining attorney prior to registration and do not require additional supporting evidence of use. *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB), *aff'd per curiam*, 864 F.2d 149 (Fed. Cir. 1988); TMEP §1207.01(d)(ii).

- (4) U.S. Registration No. 5015706 for the mark YUMMY GUMMY used on:
 - a. Watches (applicant's goods) and
 - b. Clothing (goods on which the registered mark is used).
- (5) U.S. Registration No. 4990464 for the mark PRR used on:
 - a. Watches (applicant's goods) and
 - b. Clothing (goods on which the registered mark is used).

Also attached here is "real world" evidence comprising:

- (1) Images showing the trademark JUSTICE used on:
 - a. A watch (applicant's goods) and
 - b. A pair of shorts (clothing, goods on which the registered mark is used).
- (2) Pages from the internet website of the Fossil Group, showing use of the brand FOSSIL on:
 - a. Watches (applicant's goods) and
 - b. Hats (clothing, goods on which the registered mark is used).
- (3) Images showing the trademark TAG HEUER on:
 - a. Watches (applicant's goods) and
 - b. Shirts (clothing, goods on which the registered mark is used).
- (4) Pages from the internet website of American Eagle Outfitters, showing the brand AMERICAN EAGLE on:
 - a. Watches (applicant's goods) and
 - b. A shirt (clothing, goods on which the registered mark is used).
- (5) A page from applicant's website, showing the BREITLING brand used on a watch, and a page from The Breitling Museum On Line,⁷ showing the BREITLING brand used on clothing (the goods on which the registered mark is used).

These representative examples⁸ of evidence available both on the internet and from the USPTO records show various brands used on both watches and clothing. These brands are without any obvious origin as famous designer names.

⁷ The website is identified as an unofficial website for the brand, but the images show what appear to be clothing that are either manufactured and sold by applicant or licensed for sale by applicant, all using the BREITLING brand.

⁸ Applicant in its reply brief has objected to the fact that the examining attorney has called the evidence "representative examples" of trademarks, which applicant itself has characterized as a "small amount of evidence." TTABView 07/05/2016, page 3. The examining attorney has provided only representative examples of the available evidence because it would not be possible to provide all available evidence. Time considerations, bandwidth considerations, and pity for those who must review the record all informed the examining attorney's decision to provide few examples of the more relevant evidence rather than everything that is available. The examining attorney believes that applicant has also winnowed its evidence to either the most relevant or most economically obtainable evidence.

Most importantly, the evidence shows that applicant itself is using its house brand BREITLING⁹ on both watches and clothing. This shows the close relationship of the goods at issue and applicant's use of its own brand on both types of goods.

Applicant, in its reply brief has criticized the record for failing to contain sufficient "real world" evidence.¹⁰ The evidence provided here addresses this specific concern as to whether applicant's goods are related to the goods on which the registered mark is used, based on evidence from sources outside of the USPTO records.¹¹ Additionally, applicant has argued that it has provided "more than four times as much evidence" as the examining attorney.¹² However, applicant has presented this evidence to show that the Office customarily allows similar marks to register for both watches and clothing, rather than as evidence that the goods are not related for purposes of consumer confusion. It is established that existing registrations are not binding as precedent. TMEP §1207.01(d)(vi). Each case is decided on its own facts. *See 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). For this reason, the amount of evidence provided here is less important than the purpose for which it is provided. There is no per se rule in the Office regarding similarity of particular goods and no amount of evidence should change this.

Applicant's reply brief raises additional issues¹³ regarding the nature of the mark MERLIN, which merely distract from the fact that applicant's mark MERLIN is identical to the registered mark MERLIN. However, in the end these marks are identical and this is one important fact that cannot be ignored.

⁹ It should be safe to assume that applicant's mark is not a "famous designer name" because applicant itself is drawing a distinction between its marks and the marks provided with the office actions, which it characterizes as "famous designer names," and different from applicant's mark by virtue of being such.

¹⁰ TTABView 07/05/2016, page 3.

¹¹ The examining attorney notes that applicant's evidence as to the relatedness of the goods consists solely of USPTO records. Applicant has provided no "real world" evidence that consumers will not consider clothing and watches to be related goods.

¹² TTABView 07/05/2016, page 4.

¹³ These are (1) that Merlin is not a popular boy's name. TTABView 07/05/2016, page 9, (2) MERLIN has cultural relevance. TTABView 07/05/2016, page 9. (3) The evidence discloses "unique" trademarks that are inherently unlike

CONCLUSION

In this case, applicant's amendment has not resolved the outstanding issue, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue in the final Office action. Applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

This application is returned to the Trademark Trial and Appeal Board. The Board will be notified to resume the appeal. *See* TMEP §715.04(a).

Respectfully submitted,

/Fred Carl III/

Trademark Examining Attorney

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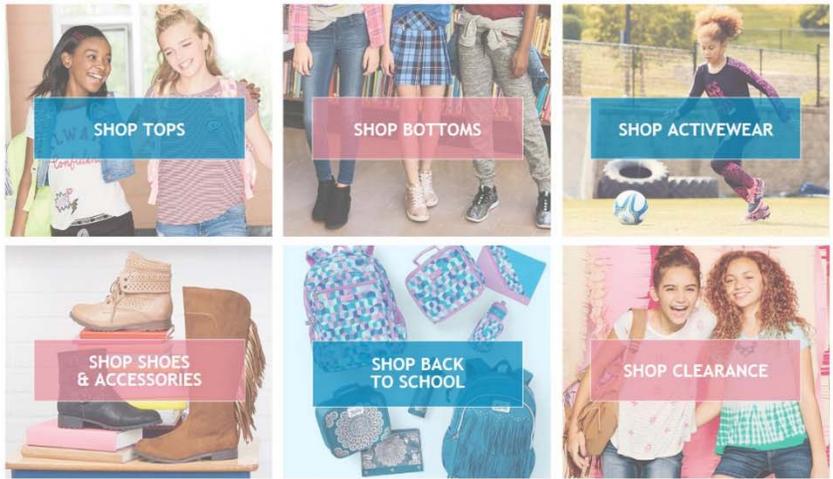
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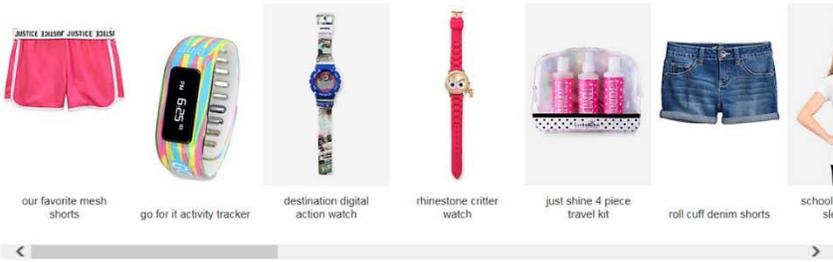
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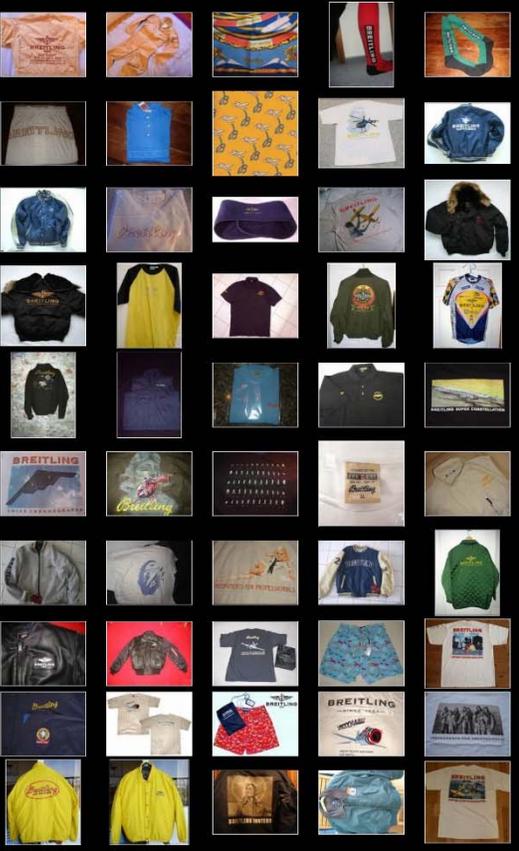
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