

This Opinion is not a  
Precedent of the TTAB

Hearing: January 12, 2017

Mailed: January 25, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Breitling SA*

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Serial No. 79152818

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Glenn A. Gundersen of Dechert LLP,  
for Breitling SA

Fred Carl III, Trademark Examining Attorney, Law Office 108,  
Andrew Lawrence, Managing Attorney.<sup>1</sup>

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Before Mermelstein, Adlin and Pologeorgis,  
Administrative Trademark Judges.

Opinion by Pologeorgis, Administrative Trademark Judge:

Breitling SA (“Applicant”) seeks registration on the Principal Register of the mark MERLIN (in standard characters) for “timepieces and chronometric instruments” in International Class 14.<sup>2</sup>

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<sup>1</sup> Fred Carl III examined this application during prosecution. Andrea Hack represented the United States Patent and Trademark Office (“USPTO”) at oral hearing.

<sup>2</sup> Application Serial No. 79152818, filed July 7, 2014, seeking an extension of protection of International Registration No. 1217921 under Trademark Act § 66(a), 15 U.S.C. § 1141f(a).

Applicant's goods were originally identified as "Precious metals and alloys thereof and goods made of precious metals or coated therewith, included in this class; jewelry, precious stones; timepieces and chronometric instruments." On July 6, 2016, the day after filing its Reply Brief in support of this appeal, Applicant filed a "motion to amend application," seeking to delete "jewelry" from the identification of goods. *See* 13 TTABVue. Applicant later filed a supplemental amendment, via the Office's Trademark Electronic Application System ("TEAS"), on August 10, 2016, to delete all goods from the identification except for "timepieces and chronometric instruments," the currently identified goods.

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground of likelihood of confusion with the registered mark MERLIN (also in standard characters) for, among other goods and services:

"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; headwear" in International Class 25.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal resumed. We affirm the refusal to register.

### **Likelihood of Confusion**

Our determination under Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

#### **A. Comparison of the Marks**

We first address the *du Pont* likelihood of confusion factor focusing on “the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). Here, the marks are identical in every way, which “weighs heavily” in support of finding a likelihood of confusion. *In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir.

1984). And because the marks are identical, the degree of similarity between the goods that is required to support a finding of likelihood of confusion is reduced. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1661 (TTAB 2002); and *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001).

**B. Strength of Registrant's Mark**

Applicant argues that the term MERLIN is weak and should be afforded a narrow scope of protection. In support of its argument, Applicant submitted numerous third-party registrations for the mark MERLIN. See Applicant's December 21, 2015, request for reconsideration. None of these third-party registrations, however, identify goods related to the goods at issue and, therefore, have no bearing on the determination of the strength of Registrant's mark.<sup>3</sup> 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) (third-party registrations found to be of limited value because goods identified in the registrations appeared to be in fields which were far removed from the involved products). Accordingly, these third-party registrations do not support a finding that the term MERLIN is weak for the goods identified in the cited registration.

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<sup>3</sup> We also note that some of these third-party registrations have been canceled. As discussed *infra*, canceled registrations have no probative value since they only evidence that the registration issued.

**C. Comparison of the Goods, Trade Channels and Consumers**

We next compare Applicant's and Registrant's goods. In making our determination under this second *du Pont* factor, we look to the goods as identified in the involved application and cited registration. *See Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed."). *See also Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.").

In this case, Applicant's goods are identified as "timepieces and chronometric instruments," which obviously encompasses watches.<sup>4</sup> Registrant's relevant goods are clothing items. It is only necessary that there be a viable relationship between the two to support a finding of likelihood of confusion. *In re Concordia International Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983). Further, as a general rule, it is not necessary that the respective goods be competitive, or even that they move in the same trade channels to support a finding of likelihood of confusion. It is sufficient that the respective goods are related in some manner, or that the conditions and

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<sup>4</sup> As noted *supra*, Applicant intends to use its MERLIN mark to identify a watch model.

activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originated from the same producer. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991).

The Examining Attorney and Applicant have introduced competing third-party registration evidence in support of their opposing arguments regarding the relatedness of the goods. The Examining Attorney submitted registrations showing that several third-parties registered a single mark for both clothing and watches. Applicant countered with pairs of registrations showing that the Office has registered the same or similar marks for clothing offered by one party and watches offered by another.<sup>5</sup>

“Third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, although not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, may nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source.” *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988), *aff’d*, 864 F.2d 149 (Fed. Cir. 1988). *See also In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993).

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<sup>5</sup> Applicant states that it has submitted marketplace use evidence demonstrating that different entities use the same mark on clothing and watches. *See* Applicant’s July 5, 2016, reply brief. The record demonstrates, however, that Applicant has only submitted websites showing use of a mark on watches but no marketplace evidence demonstrating that the same mark is used on clothing by a different entity.

The Examining Attorney's use-based third-party registration evidence favors a finding that the goods are related. The registrations do not appear to be for house or designer marks covering a wide range of products.<sup>6</sup> Rather, the identifications of goods in the registrations are generally focused on watches and clothing.

As for Applicant's evidence, some the third-party registrations are canceled. These canceled registrations have no probative value inasmuch as a canceled registration is evidence only of the fact that the registration issued. *In re Pedersen*, 109 USPQ2d 1185, 1197 (TTAB 2013); *In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1286 n.3 (TTAB 2006). Other third-party registrations submitted by Applicant are not based on use in commerce and, therefore, Applicant cannot rely on these third-party registrations as suggesting what consumers would see in the marketplace. *Cf. In re 1st USA Realty Professionals Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007) (third-party registrations not based on use in commerce have no probative value in showing the

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<sup>6</sup> The Examining Attorney also submitted pages from the websites of Calvin Klein, Ralph Lauren, Michael Kors and Kate Spade to demonstrate that these trademark owners sell both clothing and watches under the same mark. *See* Office Actions dated October 22, 2014 and May 22, 2015. These websites, however, belong to well-known fashion designers. It is commonly known that fashion designers use their marks on a variety of goods. Accordingly, this evidence has less probative value than it would if the trademark owners were not well-known designers.

The Examining Attorney also submitted additional use-based third-party registrations, as well as "real world" evidence in his September 7, 2016, Office Action. The "real world" evidence is composed of pages from various websites that allegedly demonstrate use of a mark on both clothing and watches. Applicant has objected to this website evidence on the ground that the submitted pages do not include URL designations or the date on which this material was downloaded from the Internet. *See* Applicant's September 27, 2016, response. Applicant's objection is sustained. *See In Re White*, 73 USPQ2d 1713, 1716 (TTAB 2004) ("Internet evidence would be acceptable in an ex parte case when the full address for the page, and the date the page was accessed and downloaded, are provided."). Accordingly, this website evidence has been given no consideration in our determination herein.

relatedness of the goods or services). Furthermore, some of the pairs of registrations for clothing in one instance and watches in the other are not for identical or virtually identical marks while other registrations identify goods that are not related to the goods at issue.

In any event, Applicant has submitted a number of probative pairs of use-based third party registrations for the same mark that are used on clothing on one hand and watches on the other. This evidence does not, however, disprove the Examining Attorney's evidence that watches and clothing may be sold under the same mark. It merely reduces the weight to which the Examining Attorney's evidence is entitled. We find that Applicant's and the Examining Attorney's evidence, considered as a whole, tends to establish that there is some, but not a strong, relationship between watches and clothing.

Moreover, it is common knowledge that watches and clothing may be complementary products in that consumers may purchase watches as a fashion accessory. Accordingly, some consumers would expect that watches and clothing identified by identical marks emanate from the same source.

In view of the above, we find that the similarity of the goods weighs slightly in favor of finding that there is a likelihood of confusion.

Because there are no limitations as to trade channels or classes of purchasers in the involved application or cited registration, it is presumed that the application and registration encompass all goods of the type described, that the goods move in all trade channels normal for those goods, and that the goods are available to all classes

of purchasers. *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992); and *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). The Examining Attorney's evidence from the websites of Calvin Klein, Ralph Lauren, Michael Kors and Kate Spade — notwithstanding that these are well-known designers — demonstrates that at least some clothing and watches may be sold in the same channels of trade. *See* Office Actions dated October 22, 2014 and May 22, 2015. *Cf. In re Melville Corp.*, 18 USPQ2d at 1388 (shoes vs. clothes).

Further, because there are no restrictions or limitations in the identifications of goods in either the application or cited registration, the identifications encompass inexpensive watches and clothing, which may be sold in mass merchandise or discount stores to consumers who may exercise nothing more than ordinary care in making their purchase. Accordingly, we find that the trade channels, classes of purchasers and conditions under which sales are made also weigh in favor of finding a likelihood of confusion.

Based on all evidence and arguments bearing on the *du Pont* factors, including the evidence and arguments that we have not specifically discussed herein, we conclude that Applicant's mark, as used in connection with the goods identified in the application, so resembles the identical cited mark as to be likely to cause confusion or mistake, or to deceive under Section 2(d) of the Trademark Act.

**Decision:** The refusal to register Applicant's MERLIN mark is affirmed.