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Subject: U.S. TRADEMARK APPLICATION NO. 79152818 - MERLIN - N/A - Request for Reconsideration Denied - Return to TTAB

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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:
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GENERAL TRADEMARK INFORMATION:

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

APPLICANT: Breitling SA

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE:

INTERNATIONAL REGISTRATION NO. 1217921

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the 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 May 22, 2015 is maintained and continues to be final. *See* TMEP §§715.03(a)(ii)(B), 715.04(a).

In this case, applicant's request 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.

Furthermore, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues.

Applicant has provided over 200 pages of evidence, including background information on the character Merlin of Arthurian legend and information on other legendary characters' names that have been adopted as trademarks for other products. Most, if not all, of this is of little relevance.

Applicant has provided an abundance of existing applications and registrations for trademarks that include the name MERLIN, but applicant has not provided any evidence of wide use of the mark MERLIN in use on similar goods or services to its goods or the goods on which the registered mark is used. The sixth *DuPont* factor requires looking at the field of other marks in use to determine whether consumers are accustomed to seeing an element of a trademark so frequently as to require greater discrimination between these similar marks. "The number and nature of similar marks in use **on similar goods**" may be considered when determining likelihood of confusion (emphasis added). *In re E. I. du Pont de Nemours & Co.,* 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Unfortunately for applicant, none of the trademark records provided are used on similar goods. For this reason, the evidence does not show such widespread use of this element to make the mark "relatively weak and entitled to only a narrow scope of protection." *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). For this reason, the evidence of other MERLIN marks is of little value. Similarly, the information on the origins of the legendary character Merlin or the existence of other trademarks based on other characters of legend, while entertaining, fails to show that confusion is not likely between the registered mark MERLIN and applicant's MERLIN.

The additional information about the owner of the registered mark conducting an amusement park fails to narrow the scope of the goods on which the mark is used. The goods on which the question of likelihood of confusion is determined are based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of use. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

Absent restrictions in an application or registration, the identified goods are "presumed to travel in the same channels of trade to the same class of purchasers." *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally, unrestricted identifications are presumed to encompass all goods of the type described. *See In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

Because of this, applicant's evidence about theme parks and "magical" entertainment is again entertaining, but fails to alter the facts on which this case must be determined.

Accordingly, the request is denied.

Applicant has already filed a timely notice of appeal with the Trademark Trial and Appeal Board. Accordingly, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

/Fred Carl III/

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