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

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

CARTIER INTERNATIONAL A.G.,

Opposer,

v.

LANCE COACHMAN,

Applicant.

Opposition No. 91/209815

**OPPOSER CARTIER INTERNATIONAL A.G.'S REPLY TRIAL BRIEF**

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## PRELIMINARY STATEMENT

The question to be answered in this proceeding is whether Applicant's application to register its TRINITY mark in connection with handbags should be rejected based on a likelihood of confusion with Cartier's federally-registered TRINITY mark. As set forth in its Trial Brief, Cartier has used the TRINITY mark since 1983 in connection with a variety of goods and owns four federal trademark registrations for the mark covering jewelry, watches, clocks, diaries, and writing instruments. Applicant has applied to register the identical TRINITY mark for use in connection with leather handbags, which are highly related to the variety of goods covered by Cartier's TRINITY registrations. Moreover, Cartier has demonstrated that Cartier itself has previously used its TRINITY mark on handbags, and is doing so currently, leaving no doubt that handbags are within the zone of natural expansion for Cartier. Finally, Cartier has submitted substantial evidence that bags and jewelry are often produced by the same company under identical marks. On this record, and given Cartier's clear priority in the TRINITY mark for jewelry, watches, clocks, diaries, and writing instruments, we submit that Applicant's application should be rejected based on a finding that confusion is likely.

Rather than addressing Cartier's central argument, Applicant has devoted his Trial Brief to arguing that Cartier abandoned rights in TRINITY for handbags, so Applicant's application should be granted. To be clear, Cartier has not brought this proceeding alleging priority in handbags *per se*. Cartier has submitted evidence of its historical and current uses of TRINITY on handbags to support its contention that handbags are within the ambit of its natural expansion.

Applicant also submits a number of other irrelevant arguments in his Trial Brief, such as that Cartier's TRINITY mark is descriptive (Cartier owns two incontestable registrations for TRINITY), that the marks are not similar because Cartier supposedly uses its TRINITY mark

with its CARTIER house mark (Cartier's registrations are for TRINITY standing alone), and that confusion is unlikely because the parties' purchasers are sophisticated and the trade channels do not overlap (Cartier's registrations and Applicant's application do not restrict the purchasers or trade channels in any way).

Putting aside all the distractions, Cartier believes that there is only one conclusion that can be drawn in this proceeding—Applicant's proposed registration of the TRINITY mark in connection with handbags is likely to cause confusion with Cartier's TRINITY mark. As such, Cartier's opposition to Applicant's application should be sustained.

## **ARGUMENT**

### **A. Cartier Has Established Priority in the TRINITY Mark**

Cartier owns four trademark registrations for its TRINITY mark covering jewelry, watches, clocks, diaries, and writing instruments. These registrations prove priority with respect to the identified goods. (Opposer Cartier International A.G.'s Trial Brief ("Cartier Tr. Br."), dkt. no. 50, at 21-22 (citing *L'Oreal S.A. v. Marcon*, 102 U.S.P.Q.2d 1434, 1436 n.7 (T.T.A.B. 2012); *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 U.S.P.Q.2d 1066, 1072 (T.T.A.B. 2011)). Moreover, Cartier registered and used its TRINITY mark long before any priority date upon which Applicant can rely. (Cartier. Tr. Br. at 22).

Applicant essentially ignores Cartier's registrations, arguing that Cartier has not established priority for the TRINITY mark for leather goods. (Applicant Lance Coachman's Trial Brief ("App. Tr. Br."), dkt. no. 52, at 22-31). But Cartier never has argued that it has priority based on its use of TRINITY on leather goods *per se*. Rather, its priority is based on its trademark registrations, which, as Applicant concedes, prove priority with respect to the goods identified in those registrations. (*Id.* at 21-22).

The law is clear that to establish priority an opposer need not show priority for the exact goods identified in the opposed application. It is “well established” that the parties’ respective goods “need not be similar or competitive, or even move in the same channels of trade, to support a holding of likelihood of confusion.” *Black & Decker Corp. v. Emerson Electric Co.*, 84 U.S.P.Q.2d 1482, 1492 (T.T.A.B. 2007). Accordingly, where Cartier has established that it owns four trademark registrations for the TRINITY mark and that it registered and used the TRINITY mark before Applicant’s priority date, there is no requirement that Cartier prove that it has priority for leather goods *specifically* to establish priority in this proceeding.<sup>1</sup>

This legal principle is well established, and is reiterated in the very cases that Applicant cites. For example, in *Zanella Ltd. v. Saroyan Lumber Co.*, the opposer owned several registrations for the mark ZANELLA for apparel products, and, based on such registrations, it opposed an application to register an identical mark for wooden flooring. Opp. No. 91153249, 2005 WL 1787248, at \*1 (T.T.A.B. June 23, 2005). Despite the opposer making no claim that it had priority in the ZANELLA mark for wooden flooring, the Board disposed of priority in two sentences: “In view of Opposer’s ownership of valid and subsisting registrations, there is no issue regarding Opposer’s priority. Thus, the only issue to decide herein is likelihood of confusion.”<sup>2</sup> *Id.* at \*2 (citing *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 182 U.S.P.Q. 108, 110 (C.C.P.A. 1974)). The same is true here.

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<sup>1</sup> Applicant also argues that Cartier cannot establish priority based on the zone of natural expansion doctrine. (App. Tr. Br. at 26-30). As discussed herein, Cartier is relying on its four trademark registrations to prove priority and thus the doctrine of natural expansion has no bearing on priority. Cartier otherwise addresses the zone of natural expansion doctrine in its discussion of the relatedness of the goods factor below. (*See* Section B.3.d, *supra*).

<sup>2</sup> Several other cases cited by Applicant deal with priority in the same way. *See, e.g., Eminence, LLC v. Kelly*, Opp. No. 91205286, 2014 WL 5361386, at \*1 (T.T.A.B. Oct. 8, 2014) (holding that opposer had established priority based on its registration despite the fact that the



In sum, Applicant's entire argument on priority is irrelevant and the Board should disregard it.

**B. Cartier Has Established A Likelihood of Confusion**

**1. Cartier's TRINITY Mark is Strong**

In its Trial Brief, Cartier established both the inherent strength and the marketplace strength of its TRINITY mark. (Cartier. Tr. Br. at 29-32).

In the face of this evidence, Applicant relies primarily on an argument that is barred, asserting that Cartier's TRINITY mark is descriptive. (App. Tr. Br. at 33-34). The case law is very clear that Applicant cannot, without having pleaded a counterclaim for invalidity, attack Cartier's TRINITY mark as descriptive. Such an argument "constitutes a direct attack on the validity of opposer's pleaded registration and as such may not be considered in the absence of a counterclaim to cancel." *Alpharma Inc. v. Advanced Animal Nutrition*, Opp. No. 91164763, 2009 WL 273252, at \*2 (T.T.A.B. Jan. 27, 2009)<sup>3</sup> (rejecting applicant's argument that opposer's mark was descriptive where opposer owned a registration for the mark and applicant did not counterclaim to cancel (citing *Sealed Air Corp. v. Scott Paper Co.*, 190 U.S.P.Q. 106, 109 (T.T.A.B. 1976)); see also *Bennett Law Office, PC v. Burrus Intellectual Prop. Law Grp.*, Opp. No. 91177164, 2009 WL 1017290, at \*2 (T.T.A.B. Mar. 26, 2009). Here, Applicant did not assert a counterclaim to cancel Cartier's TRINITY registrations (see dkt. no. 6), and thus Applicant cannot challenge the TRINITY mark as descriptive.

Moreover, as set forth in Cartier's Trial Brief, two of Cartier's TRINITY registrations are incontestable and therefore cannot be challenged as descriptive under any circumstances. (See

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goods covered by the registration were different from the applied-for goods); *7-Eleven, Inc. v. HEB Grocery Co.*, 83 U.S.P.Q.2d 1257, 1258 (T.T.A.B. 2007) (same).

<sup>3</sup> Applicant cited this very case, so he should be aware that his argument is barred.

Cartier Tr. Br. at 29-30 (citing *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 196, 224 U.S.P.Q.2d 327, 330 (1985)).

In addition, none of Cartier's registrations are limited to products with "three rings, three metals, three colors, and/or three finishes," which is the crux of Applicant's argument regarding descriptiveness. (App. Tr. Br. at 34-35). Cartier's U.S. Registration No. 1,927,987 is for "jewelry made of precious metal or coated therewith" in International Class 14, U.S. Registration No. 2,243,233 is for "watches" in International Class 14, U.S. Registration No. 3,864,480 is for "watches, clocks" in International Class 14, and U.S. Registration No. 4,263,072 is for "diaries, writing instruments" in International Class 16. (Hallerman Decl. ¶ 6; Ex. CT 19).<sup>4</sup> Thus, that some of Cartier's TRINITY products include a three-ring design element is irrelevant.<sup>5</sup> See *Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 110 U.S.P.Q.2d 1157, 1162 (Fed. Cir. 2014) (stating it was "proper . . . for the Board to focus on the application and registrations rather than on real-world conditions"); *Cunningham v. Laser Golf Corp.*, 55 U.S.P.Q.2d 1842, 1846 (Fed. Cir. 2000) ("Proceedings before the Board are concerned with registrability and not use of a mark."); *In re Total Quality Grp. Inc.*, 51 U.S.P.Q.2d 1474, 1476 (T.T.A.B. 1999) ("It is well settled that the issue of likelihood of confusion between applied-for and registered marks must be determined on the basis of the goods as they are identified in the involved application and cited registration, rather than on what any evidence may show as to the actual nature of the goods.").

Finally, Applicant argues that Cartier's evidence of marketplace strength of the TRINITY mark is inadequate because Cartier allegedly did not provide context for its sales and advertising

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<sup>4</sup> Cartier uses the same abbreviations for the trial declarations as it used in its Trial Brief. (See Cartier Tr. Br. at 8-9).

<sup>5</sup> Moreover, as set forth in Cartier's Trial Brief, not all of Cartier's TRINITY products have the three-ring design element. (Cartier Tr. Br. at 30 n.3 (citing Ex. CT 6; Rebuttal Cohen Decl. ¶ 3; Ex. TW 17 (Cohen Disc. Dep.) at 13:16-18)).

figures. (App. Tr. Br. at 35-36). But Cartier’s evidence shows that the TRINITY collection is [REDACTED] (Cohen Decl. ¶ 11). This is enough context to make Cartier’s marketplace strength of its TRINITY mark quite clear. Moreover, Cartier does not rely solely on sales and advertising figures to establish marketplace strength. As set forth in its Trial Brief, the TRINITY mark receives significant unsolicited press and many celebrities wear TRINITY jewelry products to events where they are photographed. (Cartier Tr. Br. at 32). Applicant does not attempt to refute this evidence.

## **2. The Parties’ Marks are Identical**

Cartier owns four trademark registrations for the mark TRINITY in standard character format. That is an identical mark to the one applied for by Applicant.

Despite the clarity of this point, Applicant argues that the marks are “dissimilar.” (App. Tr. Br. at 38-39). In doing so, Applicant conflates the marks at issue, arguing that the presence of Cartier’s house mark differentiates the marks. (App. Tr. Br. at 39). But Cartier owns four trademark registrations for TRINITY standing alone, not TRINITY DE CARTIER. (Hallerman Decl. ¶ 6; Ex. CT 19). Thus, any use of TRINITY DE CARTIER is irrelevant.

The case *Cooper Industries, Inc. v. Repcoparts USA, Inc.*, 218 U.S.P.Q. 81 (T.T.A.B. 1983) is instructive. In that case, the applicant argued that confusion was unlikely because the opposer consistently used its registered mark METALMASTER with its house mark WISS. The Board rejected this argument:

As regards the second argument concerning consistent use of “METALMASTER” with the “WISS” house or umbrella mark, applicant appears to overlook the fact that opposer's registration is for “METALMASTER” alone and we must therefore accept, in view of the presumptions afforded by Section 7(d) of the Act and in the absence of a counterclaim attacking the registration's validity, that it performs a trademark function in and of itself. . . . We are being asked here, in the words of Section 2(d) of the Act, to evaluate applicant's mark against “a

mark registered in the Patent and Trademark Office.” Thus, the fact that opposer's house mark appears, either occasionally or invariably, with opposer's registered mark “METALMASTER” must be considered immaterial to the issue of likelihood of confusion.

*Id.* at 85 (citations omitted). As such, Applicant’s argument that Cartier allegedly uses TRINITY DE CARTIER has no bearing on whether the marks are similar.<sup>6</sup>

Applicant also argues that Cartier’s TRINITY mark is descriptive or highly suggestive of products consisting of three metals, colors, or finishes, and his TRINITY mark is not. (App. Tr. Br. at 39). But, as set out above, Cartier’s registrations are not limited to use on products featuring three of anything (section B.1, *infra*), and there is no evidence suggesting that consumers would impart separate commercial meaning to two identical marks. Indeed, the only case that Applicant cites found that despite a difference in meaning, the marks in question were similar in sight and sound and therefore “more similar than dissimilar.” *Alpharma*, 2009 WL 273252, at \*3-4 (finding that the similarity of the marks factor favored opposer).

The parties’ marks are identical, and this factor strongly favors a finding of confusion.

### **3. The Parties’ Respective Goods are Related**

Cartier established in its Trial Brief that the goods identified in Cartier’s four trademark registrations for TRINITY are related to Applicant’s leather handbags because (1) numerous companies offer jewelry and handbags under the same marks, and thus consumers expect that bags and jewelry offered under the same marks originate from the same company and that brands that offer jewelry will also offer a handbag line under the same name (Cartier Tr. Br. at 26-27 and evidence and cases cited therein); (2) Cartier itself has offered handbags under the TRINITY

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<sup>6</sup> In the case that Applicant sets forth as “instructive” (App. Tr. Br. at 39), the applied-for mark *included* the house mark. *See Knight Textile Corp. v. Jones Inv. Co.*, 75 U.S.P.Q.2d 1313, 1316 (T.T.A.B. 2005). Thus, that case is hardly instructive.

mark, and thus consumers will believe that Applicant's leather handbags are part of Cartier's TRINITY collection (*id.* at 27 and evidence and cases cited therein); (3) Applicant has considered adding necklaces to his line of TRINITY products, thus further demonstrating that these types of products tend to come from the same source (*id.* at 27-28 and evidenced cited therein); and (4) handbags are within Cartier's zone of natural expansion for the reasons already stated, namely that Cartier has sold and is currently selling handbags under the TRINITY mark and other companies offer both handbags and jewelry under the same marks (*id.* at 28-29 and evidence and cases cited therein). This evidence is more than sufficient where the parties' marks are identical, as they are here. (Cartier Tr. Br. at 26 and cases cited therein holding that when the parties' marks are identical, the degree of similarity between the parties' goods that is required lessens).

*a. Cartier Has Established that Numerous Companies Offer Jewelry and Handbags Under the Same Marks Such that Consumers Expect that Jewelry and Handbags Offered Under the Same Marks Originate from the Same Company*

Cartier has shown that a number of similar companies, such as Chanel, Chloe, Tiffany, Coach, Gucci, Guess? and others, sell both jewelry and handbags under the same mark, and thus consumers expect that jewelry and handbags offered under the same mark come from the same company. (Cartier Tr. Br. at 26 (citing (Cohen Decl. ¶¶ 27, 29; Cross-Examination Cohen Decl., response nos. 1-3; Exs. CT 27-CT 37))

In response, Applicant first asserts that the fact that jewelry and handbags are sold in the same store or appear on the same website does not mean that the products are related. (App. Tr. Br. at 41). But Cartier never argued to the contrary. Cartier submitted evidence to demonstrate that it is commonplace for companies to sell both jewelry and handbags under the *same marks*, regardless of whether they are sold side by side. As such, the case *Interstate Brands Corp. v.*

*Celestial Seasonings, Inc.*, 198 U.S.P.Q. 151 (C.C.P.A. 1978), which Applicant cites to support his misplaced argument, is irrelevant.

Applicant also argues that Alison Cohen’s testimony that consumers expect that bags and jewelry offered under the same mark originate from the same company should be given little weight because “her experience in merchandising focused on forecasting and managing inventory” and “she is not responsible for marketing strategy or research studies.” (App. Tr. Br. at 41-42). Applicant is mistaken. To start, Applicant does not explain why involvement with Cartier’s marketing efforts is required for Ms. Cohen to testify on the accessories market in general. Ms. Cohen testified that she is involved with all of Cartier’s strategic planning, which includes developing a three-year plan for all of Cartier’s products. (Ex. TW 17 (Cohen Disc. Dep.) at 9:7-22). Such responsibilities require her to be familiar with the consumers that tend to purchase jewelry and handbags and the products that other brands within the industry offer. (*See* Cross-Examination Cohen Decl., response nos. 1, 3). Thus, the fact that she is not in the marketing department is meaningless.

Moreover, Ms. Cohen is involved with marketing, despite Applicant’s argument to the contrary. Ms. Cohen testified that as part of the strategic planning process, she determines which products to advertise in certain years and has knowledge of Cartier’s marketing budgets. (Ex. TW 17 (Cohen Disc. Dep.) at 25:23-26:18, 27:12-28:5, 28:19-29:6). The Board has allowed lay witnesses with Ms. Cohen’s type of experience to testify about market conditions. *See, e.g., Allagash Brewing Co. v. Pelletier*, Opp. No. 91214028, 2015 WL 6121774, at \*7 n.44 (T.T.A.B. Sept. 22, 2015) (admitting testimony from president of opposer, a brewing company, on

consumers' perceptions of beer products because president had gained knowledge of the craft brewing industry through his position).<sup>7</sup>

Finally, Applicant argues that the mere fact that many famous fashion designers have lent their famous marks to a wide range of products does not establish relatedness of goods without more. (App. Tr. Br. at 28-29, 40-41). In making this argument, Applicant cites the *7-Eleven* and *Zanella* cases. But those cases are quite different from this one in that in neither case did the opposer offer evidence that it had offered or had an intention to offer the applicant's products under the same mark.<sup>8</sup> *7-Eleven*, 83 U.S.P.Q.2d at 1261 (noting that the opposer had begun to use its mark in connection with other products, but not the frozen food entrees offered by the applicant); *Zanella*, 2005 WL 1787248, at \*8 ("Clothing and wooden flooring are not naturally related, and opposer has neither expanded its use beyond clothing nor exhibited any intention to do so"). Here, Cartier has not only relied on industry practice, but has established its own past and present use of the TRINITY mark in connection with leather goods. (See Cartier Tr. Br. at 27; Section B.3.b, *supra*).

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<sup>7</sup> Applicant's own perceptions on this issue should be excluded, as Cartier sought to exclude them for his lack of industry experience (dkt. no. 51), and Applicant did not file a response. Opposer also notes that Applicant states that Chanel is well-known for fragrances, but not handbags. (Coachman Decl. ¶ 20). The Board, however, recently held that the CHANEL mark is famous for handbags. See *Chanel, Inc. v. Makarczyk*, 110 U.S.P.Q.2d 2013, 2021 (T.T.A.B. 2014) (noting that CHANEL is among the ten most searched handbag brands on the Internet).

<sup>8</sup> Applicant also cites *Fruit of the Loom Inc. v. Fruit of the Earth, Inc.*, No. 87-1621, 1988 WL 26058 (Fed. Cir. Mar. 30, 1988). (App. Tr. Br. at 40). In that case, the Board merely "acknowledged a trend for apparel and cosmetic and toiletry products to be sold or sponsored by the same entities," but noted that such a link was important mainly for the names of well-known designs and FRUIT OF THE LOOM was not a high-fashion mark. *Id.* at \*1. Here, Applicant has presented no evidence showing a difference between the third parties that offer both jewelry and handbags under the same mark and Cartier.

*b. Cartier Has Established that It Sells Leather Goods and Jewelry Under its TRINITY Marks as Well as Other Marks*

Cartier has established that it uses TRINITY itself, not just Cartier, across a broad array of products, including leather goods, and that it does this with several of its secondary marks, such as LOVE, JEANE TOUSSAINT, and SANTOS DE CARTIER, as well. (Cohen Decl. ¶¶ 7-8, 12-15; Exs. CT 1-CT 11). The combination of industry practice and Cartier's past and present practices of offering a wide array of goods under its secondary marks, such as TRINITY, establishes the relatedness of the goods here.

Despite the clarity of the evidence, Applicant argues that Cartier has provided no evidence of use of the TRINITY mark for handbags. (App. Tr. Br. at 22-24, 32). Ms. Cohen, however, testified that Cartier offered TRINITY handbags in the United States from 2004 to 2008. (Cohen Decl. ¶ 14). Applicant does not question the veracity of Ms. Cohen's testimony, and instead focuses on the various exhibits introduced through her Trial Declaration. (App. Tr. Br. at 22-24, 32). None of Applicant's issues with the exhibits cast any doubt on her statement that Cartier sold handbags under the TRINITY mark in the past. Most importantly, Exhibit CT 16, which Ms. Cohen testified was kept in the ordinary course of Cartier's business, shows sales of TRINITY handbags in each year from 2004 to 2008. (Ex. CT 29 (Cohen Disc. Dep.) at 75:1-76:2; Supp. Cohen Decl. ¶ 5).

As for the 2004 and 2005 press books, Applicant has fixated on their supposed lack of evidentiary value, arguing that they were not used to offer handbags for sale to consumers. (App. Tr. Br. at 23, 32). But Cartier never argued that they were. Ms. Cohen stated very clearly that they were distributed to Cartier's press contacts, not to buyers. (Supp. Cohen Decl. ¶ 3). Cartier has submitted them here to show representative pictures of the TRINITY products that



were offered for sale in those years. (*Id.* (testifying that the books were sent to press contacts in the United States to show what products would be offered in those years)).

As for evidence of use of TRINITY in connection with other products, namely jewelry, cufflinks, key rings, diaries, organizers, travel clocks, pens, and eyewear, Cartier has submitted testimony from Ms. Cohen, printouts from its website, sales figures since 2006, and advertisements for TRINITY products that show that Cartier has used the TRINITY mark in connection with a wide variety of goods. (Cohen Decl. at ¶¶ 12-15; Exs. CT 4, CT 7-CT 12, CT 15-CT 16, CT 42, CT 46). Applicant argues that some of these exhibits show use of the mark TRINITY DE CARTIER, not TRINITY. However, several of the exhibits show the TRINITY mark standing alone. (*See, e.g.*, Exs. CT 8, CT 12, CT 42, CT 46). In any event, that TRINITY can be used with the CARTIER mark does not diminish the fact that TRINITY is used with a wide variety of goods.

Finally, Applicant argues that Cartier cannot rely on its prior or current sale of handbags to show that the parties' goods are related because Cartier's current sales are small and its past sales are too old to be of any consequence. (App. Br. at 42). But the Board has previously found goods related based, in part, on evidence that one of the parties sold both, regardless of when or in what amounts. *See also Orange Band, Inc. v. Ole Mexican Foods, Inc.*, Opp. No. 91189001, 2015 WL 5675641, at \*16 (T.T.A.B. Sept. 10, 2015) (finding goods related in part because the defendant used to offer both parties' goods under its marks, "thus showing that both [products] could emanate from a single source"); *Wolverine Outdoors, Inc. v. Marker Volkl (Int'l) GmbH*, Consol. Opp. No. 91161363, 2013 WL 5655832, at \*16-18 (T.T.A.B. Sept. 30, 2013) (holding that bags and footwear were related based in part on opposer's own entry into the bag market); *Hasbro, Inc. v. Pinkett*, Opp. No. 91123661, 2004 WL 1427395, at \*7 (T.T.A.B. June 18, 2004)

(holding that certain goods were related where opposer had offered such goods for sale five years before).

*c. Applicant Himself Has Considered Selling Both Jewelry and Handbags Under the Trinity Mark*

Applicant admits that he considered adding jewelry to his line of TRINITY handbags, but discounts this concession by arguing that he never actually went through with the plan. (App. Br. at 42). But the point is that he considered adding jewelry to his TRINITY line of handbags, precisely because many companies do exactly that, sell jewelry and handbags. The two are naturally complementary products, and certainly related.

*d. The Doctrine of Natural Expansion Further Establishes Relatedness*

Cartier has argued that the zone of natural expansion doctrine further establishes the relatedness of handbags and jewelry. (Cartier Tr. Br. at 28-29). Applicant responds that the doctrine is only relevant in establishing priority, not relatedness of goods. (App. Tr. Br. at 26.) But this is not so. In fact, that argument is contradicted by the cases on which Applicant relies, which address the doctrine in the context of the relatedness of the goods factor. *See Eminence*, 2014 WL 5361386, at \*5 (discussing doctrine in context of relatedness of goods factor, not priority); *7-Eleven*, 83 U.S.P.Q.2d at 1262-63 (same); *Zanella*, 2005 WL 1787248, at \*5 (same).

Applying the Board's four factors for determining whether products are within the zone of natural expansion, handbags are within the zone of expansion from Cartier's other TRINITY products. First, handbags are not a distinct departure from Cartier's prior business. Cartier submitted evidence that it offers a variety of handbags under many different trademarks. (Cohen Decl. ¶¶ 7-8; Exs. CT 1- CT 3). Second, the nature and purpose of the goods are the same— jewelry and watches are fashion products, and, when sold by Cartier, are well-crafted luxury goods. (Cohen Decl. ¶ 5). Third, Cartier and other companies offer jewelry and handbags in the

same channels of trade, establishing that the channels of trade for these goods are similar. (Cohen Decl. ¶¶ 7-8, 26-27; Exs. CT 1-CT 3, CT 27-CT 37). Fourth, as discussed in Cartier’s Trial Brief and above, there are many companies that offer both jewelry and handbags, including Cartier. (*See* Section B.3.a, *infra*).

Applicant’s discussion of the last factor rehashes many of the arguments and case law that Cartier addresses in the preceding sections, but he also relies on Internet printouts to purportedly show that some brands do not offer jewelry and handbags. (App. Tr. Br. at 29 (citing Exs. TW 20, TW 22-TW 33, TW 35)). But this “evidence” is meaningless. At most it shows that some brands, as of the date the screenshots were taken, were not selling both handbags and jewelry on their websites side by side; these brands could have sold both handbags and jewelry on a prior date, or on a later date, or they could do so in their stores and not online.

#### **4. The Sophistication of the Purchasers is Irrelevant Because the Registrations and Application are Not Limited to Such Purchasers**

Applicant asserts that confusion is unlikely because the purchasers of the parties’ goods are sophisticated and therefore will be able to distinguish between Cartier’s TRINITY products and Applicant’s TRINITY products. To start, there is no evidence in the record concerning the sophistication of Cartier’s consumers. Moreover, neither Cartier nor Applicant restricts its goods to sophisticated purchasers in the respective registrations and application (*See* Exs. CT 19, CT 21; Ex. TW 13), so the products could be offered to less sophisticated purchasers.

The Federal Circuit’s decision in *Stone Lion Capital Partners* is on point. In that case, the applicant argued that because both parties were investment management companies that targeted large minimum investments, the parties’ investors were sophisticated and therefore could tell the difference between the two companies. 110 U.S.P.Q.2d at 1162. Because neither party limited its services to high net-worth individuals in the application or registration, however,

the Federal Circuit affirmed the Board's finding that the parties' services "could be offered to, and consumed by, anyone with money to invest, including ordinary consumers seeking investment services." *Id.* (internal quotation marks omitted). Thus, the sophistication of the consumers factor favored the opposer. *Id.*; *see also Bose Corp. v. QSC Audio Prods., Inc.*, 63 U.S.P.Q.2d 1303, 1311 (Fed. Cir. 2002) (rejecting applicant's argument that confusion was unlikely because its products were sold exclusively to the professional market as the application contained no limiting language).

Here, too, any purchaser, regardless of his or her sophistication, could purchase the parties' products and is likely to be confused in doing so.

**5. Applicant's Assertion That Trade Channels Do Not Overlap Is Contradicted by the Parties' Respective Registrations and Application**

Applicant further argues that confusion is unlikely because the parties' trade channels do not overlap. (App. Br. at 42-44). But Applicant never once addresses the case law cited by Cartier that holds that because neither Cartier's TRINITY registrations nor Applicant's TRINITY application contain limitations as to trade channels, it must be presumed that the trade channels for the parties' related goods overlap. (*See Cartier Tr. Br. at 32-33 and cases cited therein*). Both the Federal Circuit and the Board have affirmed this presumption time and time again. *See, e.g., In re Viterra Inc.*, 101 U.S.P.Q.2d 1905, 1908 (Fed. Cir. 2012) (rejecting challenge to Board's reliance on overlapping trade channels and purchasers because it is "well established that absent restrictions in the application and registration, goods and services are presumed to travel in the same channels of trade to the same class of purchasers" (internal quotation marks and citation omitted)); *Packard Press, Inc. v. Hewlett-Packard Co.*, 56 U.S.P.Q.2d 1351, 1356 (Fed. Cir. 2000) (rejecting applicant's argument that Board failed to consider evidence that parties' trade channels and customers differed where the registration and

application contained no restrictions as to channels of trade or consumers); *Venture Out Props. LLC v. Wynn Resorts Holdings, LLC*, 81 U.S.P.Q.2d 1887, 1893 (T.T.A.B. 2007) (same).

Applicant's failure to refute this argument amounts to a tacit concession.

Moreover, even if the Board considered the parties' actual trade channels, Applicant ignores the evidence that shows that the parties' trade channels may overlap in the future. Cartier previously sold leather goods in department stores such as Neiman Marcus and Saks Fifth Avenue, and Cartier currently is considering a wider retail distribution network for its TRINITY handbags (Ex. TW 17 (Cohen Disc. Dep.) at 18:7-14; Cross-Examination Cohen Decl., response no. 6). Applicant intends to have his TRINITY handbags sold at the same retailers. (Coachman Decl. ¶ 17; Cross-Examination Coachman Decl., response no. 8; Ex. CT 38 (Coachman Disc. Dep.) at 80:19-81:5, 83:15-84:5; Ex. CT 47 (Coachman Disc. Dep.) at 110:25-112:20).

#### **6. Cartier's Enforcement Efforts Have Been Successful**

Applicant does not dispute the efficacy of Cartier's TRINITY enforcement program, but instead argues that Cartier's enforcement evidence should be discounted because it does not concern handbags. (App. Tr. Br. at 37-38). Applicant does not cite any case holding that enforcement efforts must be for the goods identified in the opposed application. And such a holding would contradict the stated purpose of enforcement: the "ultimate significance" of enforcement "is not how often or how assertively the trademark owner has enforced its mark, but what has been the marketplace loss of strength, if any, resulting from a failure to enforce. The real question is public perception of plaintiff's mark, not a battle count of how often it has threatened to sue or in fact sued." 2 J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* § 11:91 (4th ed. 2016).

Here, there is no evidence that Cartier's TRINITY mark is anything but robust. Cartier has established that it actively monitors the trademark registry for applications for marks that are

confusingly similar to its TRINITY mark, and, as a result, successfully opposed three applications for TRINITY-inclusive marks.<sup>9</sup> (Hallerman Decl. ¶ 10; Ex. CT 22). Applicant has not cited a single registration for TRINITY standing alone for handbags (or other goods for that matter) that Cartier has failed to oppose. Applicant cites Registration No. 4,688,159 for the mark TRINITY RANCH for handbags, purses, and wallets as evidence of the weakness of Cartier’s TRINITY mark. (App. Tr. Br. at 37). TRINITY RANCH, however, conveys a different commercial impression than TRINITY standing alone. Moreover, a different registration for TRINITY RANCH blocked Cartier’s application to register TRINITY for leather goods, and that registration is for a highly stylized version of the mark, further distinguishing it from Cartier’s TRINITY mark. (See Ex. CT 21 at CART 583). A single registration for a highly stylized mark is not evidence of the loss of marketplace strength, and Applicant has cited no case holding so.

Applicant also relies on three third parties’ purported use of TRINITY or TRINITY-inclusive marks in connection with bags. (App. Tr. Br. at 36). But this “evidence” is meaningless because Applicant does not provide any information on the extent to which the goods have been sold or marketed and because the three examples are hardly sufficient to show that consumers have become conditioned to seeing TRINITY or TRINITY-inclusive marks in connection with handbags. (See Cartier Tr. Br. at 34-36 and cases cited therein).

#### **7. Lack of Actual Confusion Has No Bearing Given Applicant’s Meager Sales**

Applicant states that the actual confusion factor “strongly favors” Applicant because neither party is aware of any actual confusion. (App. Tr. Br. at 44). Applicant once again does

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<sup>9</sup> Applicant takes issue with the fact that Cartier prevailed in two of the opposition proceedings by default (App. Tr. Br. at 37), but he does not explain why that is significant. In any event, Applicant does not dispute that Cartier successfully prevented the registration of the opposed marks.

not respond to Cartier's argument with respect to this factor. As set forth in Cartier's Trial Brief and the cases cited therein, this factor is largely irrelevant given that Applicant has sold [REDACTED] TRINITY handbags in the past four years mostly to friends and acquaintances and has engaged in very limited marketing. (See Cartier Tr. Br. at 23 n.2 and evidence and cases cited therein; see also Cartier Tr. Br. at 19 and evidence cited therein). By failing to respond, Applicant has tacitly conceded that this factor has no bearing on whether there is a likelihood of confusion.

### CONCLUSION

There is nothing in Applicant's Trial Brief or in his evidence that refutes Cartier's clear showing in its opening Trial Brief and herein that there is a likelihood of confusion between the parties' marks. Accordingly, Cartier respectfully requests that registration of Application Serial No. 85/604,000 be denied and that judgment for Cartier be entered in this proceeding.

Dated: New York, New York  
May 31, 2016

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**CERTIFICATE OF SERVICE**

I hereby certify that I caused, on this 31st day of May 2016, a copy of the foregoing **OPPOSER CARTIER INTERNATIONAL A.G.'S REPLY TRIAL BRIEF** to be sent by First Class Mail, postage prepaid, in an envelope addressed to counsel for Lance Coachman:

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