

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

In re Application of: Levlad, Inc.

Serial No.: 78/648,101

Filed: June 10, 2005

Mark: TONE BACK THE CLOCK

Examiner: Tracy Whittaker-Brown

Law Office: 111

Commissioner of Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451
MS: Trademark Trial and Appeal Board

I hereby certify that this correspondence is, on the date shown below, being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to the Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451.

Jean Bove

Date: 5-22-07

BRIEF FOR APPLICANT

Pursuant to a Notice of Appeal filed with the Trademark Trial and Appeal Board on January 24, 2007, Applicant files its brief on appeal from the Examining Attorney's final refusal to register TONE BACK THE CLOCK on the grounds that the Applicant's mark is likely to be confused with U.S. Registration No. U.S. Registration No. 0915202 and 2890054 for TONE for "bath and toilet soap in International Class 003" and "hand and body lotion in International Class 003", respectively. Applicant respectfully requests the Trademark Trial and Appeal Board to reverse the Examining Attorney's decision.

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E.I. Dupont De Nemours & Co., 476 F.2d 1357 (C.C.P.A. 1973)

E. Remy Martin & Co. v. Shaw-Ross Int'l Imports, Inc., 756 F.2d, 1525, 1533, 225 U.S.P.Q. 1131.

Entrepreneur Media, Inc. v. Smith, 279 F.3d 1135 (9th Cir. 2002)

General Mills, Inc., v. Kellogg Co. 824 F.2d 622, 627, 3 U.S.P.Q. 2d 1442, 1445 (8th Cir. 1987).

Jellibeans v. Skating Clubs, Inc., 716 F.2d 833, 841 (11th Cir. 1983)

Knapp-Monarch Co. v. Poloron Products, Inc., 134 U.S.P.Q. 412 (T.T.A.B. 1962).

National Novice Hockey League, Inc., 222 U.S.P.Q. 638 (T.T.A.B. 1984)

Sure-Fit Products Co. v. Saltzson Drapery Co., 117 U.S.P.Q. 295 (C.C.P.A. 1958)

Spoons Restaurants, Inc. v. Morrison, Inc. 23 U.S.P.Q.2d 1735 (T.T.A.B. 1991);

The Lucky Co., 209 U.S.P.Q. 422 (T.T.A.B. 1980)

United Foods v. J.R. Simplot Co., 4 U.S.P.Q.2d 1172 (T.T.A.B. 1987)

Universal Money Centers, Inc. v. American Tel. & Tel. Co., 22 F.3d 1527, 30 U.S.P.Q. 2d 1930, 1933 (10th Cir. 1994).

Wooster Brush Co. v. Prager Brush Co., 231 U.S.P.Q. 316 (T.T.A.B. 1986)

DESCRIPTION OF THE RECORD

Trademark application filed on June 10, 2005

First Office Action of December 30, 2005

Reply to Office Action of June 30, 2006

Final Rejection Office Action on August 8, 2006

Reply to Final Office Action including submission of evidence documenting dictionary definitions and third party use on November 14, 2006

Reconsideration Letter January 4, 2007

Notice of Appeal filed on January 24, 2007

STATEMENT OF ISSUES

Is there a likelihood of confusion between Applicant's mark TONE BACK THE CLOCK in International Class 003 and U.S. Registration Nos. 0915202 and 2890054 for TONE for "bath and toilet soap in International Class 003" and "hand and body lotion in International Class 003", respectively

RECITATION OF THE FACTS

On June 10, 2005 Applicant filed an application to register the word mark TONE BACK THE CLOCK with the U.S. Patent and Trademark Office, on the Primary Register under Section 1(B) of the Trademark Act, 15 U.S.C. § 1051(b). This application was filed in International Class 3 for cosmetics and cleaning preparations, namely, soaps, perfumery, essential oils, cosmetics, hair lotions, and dentifrices, and was assigned Serial No. 78/648,101.

In an initial office action dated December 30, 2005, the Examining Attorney refused to register TONE BACK THE CLOCK in International Class 003 contending that the mark is likely to be confused with U.S. Registration Nos. 0915202 and 2890054 for TONE for “bath and toilet soap in International Class 003” and “hand and body lotion in International Class 003”, respectively. In response, Applicant argued that confusion is unlikely because of dissimilarities between Applicant’s and cited marks in terms of sound, appearance, meaning, and connotation.

In the final Office Action of April 29, 2002, the Examining Attorney FINALLY refused registration, contending: (a) the marks are confusingly similar and (b) Applicant’s and Registrant’s goods and services are related. In response Applicant submitted further arguments and evidence to show that first TONE is a relatively weak mark and should be offered a narrow scope of protection. On January 4, 2007, the Examiner maintained the rejection of Applicant’s application because of a likelihood of confusion over the cited mark. On January 24, 2007, Applicants filed a Notice of Appeal.

ARGUMENT

1. STANDARD OF EXAMINATION

Determining the absence or presence of likelihood of confusion typically revolves around the similarity or dissimilarity of the marks and the relatedness of the goods or services. Other factors, such as third party use must be considered. In re E.I. Dupont DeNemours & Co., 476 F.2d 1357, 1361 (C.C.P.A. 1973); In re National Novice Hockey League, Inc., 222 U.S.P.Q. 638, 640 (T.T.A.B. 1984); TMEP §1207.01. Here, the weakness of the cited mark, and the

differences between Applicant's and the cited mark in appearance, sound, meaning and commercial impression, all make confusion unlikely.

2. THE EXAMINING ATTORNEY HAS NOT GIVEN PROPER WEIGHT TO THE WEAKNESS OF THE REGISTRANT'S TONE MARK

- a. "TONE" IS A WEAK MARK BECAUSE THERE IS A LOGICAL CORRELATION BETWEEN THE MEANING OF THE MARK AND THE PRODUCT

Where there is no logical correlation between the meaning of the mark and the product, the mark is "strong" and will receive broad protection. Jellibeans v. Skating Clubs, Inc., 716 F.2d 833, 841 (11th Cir. 1983). Where the descriptive nature of the mark makes it a natural choice for a particular product or service, it may be deemed "weak" and may not receive broad protection. Entrepreneur Media, Inc. v. Smith, 279 F.3d 1135 (9th Cir. 2002) ("entrepreneur" for business opportunity publications given limited protection because it is a descriptive, widely used word); Con Agra, Inc. v. George A. Hormel & Co., 990 F.2d 368 (8th Cir. 1993) (HEALTHY CHOICE for microwave food products relatively weak mark and entitled to less protection).

Here, Applicant has submitted four dictionary definitions of TONE, all of which clearly demonstrates that TONE was a natural choice for Registrant's bath soap and hand and body lotion products (see attached Exhibit A attached to applicant's response dated November 14, 2006). For instance, the Cambridge On line dictionary defines TONE as the healthy tightness of the body, especially the muscles. Clearly, the logical correlation between Registrant's TONE mark and its products is that using their TONE products will improve or maintain the tightness of

a person's body. Accordingly, TONE should be considered a weak mark and entitled to less protection.

b. "TONE" IS A WEAK MARK DUE TO THIRD PARTY USE

Trademark rights are not static; a mark may lose its distinctiveness, or its strength may change over time. E. Remy Martin & Co. v. Shaw-Ross Int'l Imports, Inc., 756 F.2d, 1525, 1533, 225 U.S.P.Q. 1131. A portion of a mark may be "weak" in the sense that such portion is in common use by many other sellers in the market. Knapp-Monarch Co. v. Poloron Products, Inc., 134 U.S.P.Q. 412 (T.T.A.B. 1962). Evidence of widespread third-party use in a particular field, obtained from sources such as telephone directories or registrations of marks containing a certain shared term, are competent to suggest that purchasers have been conditioned to look to the other elements of the marks as a means of distinguishing the source of goods or services in the field. In re Dayco Products-Eagle Motive Inc., 9 U.S.P.Q. 2d 1910, 1911 n1912 (TTAB 1988) "This means that competitors in the field may come closer to such weak marks without violating the owner's rights therein, than would be the case with a stronger mark". In re the Lucky Co., 209 U.S.P.Q. 422 (T.T.A.B. 1980)(Striped shoe logos); Also see, Sure-Fit Products Co. v. Saltzson Drapery Co., 117 U.S.P.Q. 295 (C.C.P.A. 1958) ("Rite-Fit" vs. "Sure Fit" for slipcovers; 11 third party registrations). Similar third party usage on products in the same "field" as Registrant's products tend to prove the weakness of the Registrant's mark; the closer the product and their channels of trade, the more probative the evidence is of weakness. Spoons Restaurants, Inc. v. Morrison, Inc. 23 U.S.P.Q. 2d 1735, 1740 (T.T.A.B. 1991); Cabot Corp. V. Titan Tool, Inc., 209 U.S.P.Q. 338, 344 (T.T.A.B. 1980).

Applicant has submitted print-outs of 69 third party registrations (of these twenty-eight are live; of the remaining forty-one dead registrations, eighteen of these registrations predated the TONE registrations) showing that others not only use the word TONE but use them on similar products, or products sold in the same channels of trade. (See TARR printouts of these marks attached as Exhibit B to applicant's response dated November 14, 2006). Illustrative are seven of the following live registrations:

Trademark	Owner	Goods
FRESHTONE Registration No. 2939769	de Gunzburg, Terry	Include shower and bath soaps and .skin lotions.
NATUARAL TONE Registration No. 3101225	Hale, Ronald	Includes lotions and gels for sun care, skin care, personal care.
CLEARTONE Registration No. 2851453	CBG Enterprises, LLC	Includes skin soaps, skin creams and skin gels.
ESTROTONE Registration No. 2480845	New Chapter Inc.	Skin cream
ALPHA TONE Registration No. 2163990	Keystone Laboratories, Inc.	Includes cosmetic and skin care products
CLINITONE	G and M Management Corp.	Includes soaps, lotions.

Registration No. 2099335		
MAXI-TONE	Obioha, Iheatu	Skin lotion
Registration No. 2071818		

Such evidence of third party use clearly shows that these registrations are able to coexist on the Principal Register with the cited mark without a likelihood of confusion. Accordingly, applicants' mark should also be able to coexist with the cited mark without a likelihood of confusion.

Further, this evidence of the widespread use of TONE by third parties indicates not only that TONE should now be considered a "weak" mark but that purchasers would look to the other elements of the marks (*i.e.* BACK THE CLOCK) as a means of distinguishing the source of goods or services in the field. Moreover, such evidence demonstrates that the Registrant, and others, uses the term TONE descriptively, namely, to merely describe that their product is capable of improving the quality or appearance of the human body. This conclusion is supported by the aforementioned dictionary definitions of TONE. Accordingly, the dilution of the word TONE as a mark for cosmetics mitigates against any likelihood of confusion.

3. THE EXAMINING ATTORNEY HAS NOT GIVEN PROPER WEIGHT TO THE DIFFERENCES IN APPLICANT'S AND REGISTRANT'S MARKS IN THEIR ENTIRETY

The mere fact that the marks in issue share elements, even dominant elements, does not compel a conclusion of likelihood of confusion. General Mills, Inc., v. Kellogg Co. 824 F.2d

622, 627, 3 U.S.P.Q. 2d 1442, 1445 (8th Cir. 1987). Indeed, the non-common matter which is “equally suggestive or even descriptive, may be sufficient to avoid confusion.” Wooster Brush Co. v. Prager Brush Co., 231 U.S.P.Q. 316, 318 (T.T.A.B. 1986); United Foods v. J.R. Simplot Co., 4 U.S.P.Q. 2d 1172, 1174 (T.T.A.B. 1987). Identifying the dominant portion of the mark never ends the analysis. No element of a mark is ignored simply because it is not dominant. The mark must be compared in its entirety. Universal Money Centers, Inc. v. American Tel. & Tel. Co., 22 F.3d 1527, 30 U.S.P.Q. 2d 1930, 1933 (10th Cir. 1994).

Even if TONE is considered the dominant portion of Applicant’s and Registrant’s mark, Applicant’s and Registrant’s mark are significantly different due to the appearance, sound, sight, meaning, connotation and commercial impression when the marks are viewed in their entirety. The sound of Applicant’s entire mark is clearly dissimilar to Registrant’s. Applicant’s mark possesses four distinct and equally emphasized words against the cited mark’s single word. The appearance of Applicant’s entire mark and the cited mark is also very dissimilar, where Applicant’s entire mark has four distinct and equally spaced words against the cited mark’s single word. Their respective appearance on any label has to be distinctively different. Because applicant’s entire mark is a comical phrase, it is not one to be used on several lines where someone will see the word TONE in isolation. Dissimilarity in meaning, is clearly overwhelmingly in applicant’s favor. While there is a dozen or so definition of “tone” to be found in the dictionary, even presuming that the cited mark refers to skin tone, there is nothing in the cited mark that can be defined as turning back the clock, a meaning which is evident in applicant’s entire mark.

Applicant's entire mark and the cited mark are highly dissimilar with regards to connotation. The cited connotes simply a tone, but connotes nothing more. Applicant's entire mark is a play on words, connoting turning back the clock. Because it is most likely that this play on words will leave a strong impression on the average consumer, the entire mark should be considered the dominant portion of applicant's mark.

Finally, applicant's and the cited mark give different commercial impressions on the average consumer. Applicant's mark leaves a strong commercial impression with the average consumer that its products will restore or rejuvenate the body of the individual back to an earlier age. In contrast, the impression left by the cited mark is that it will merely effect the tone, not necessarily reverse it.

4. REJECTING APPLICANT EFFECTIVELY GIVES REGISTRANT THE EXCLUSIVE RIGHTS TO THE USE OF 'TONE' FOR ITS INTENDED MEANING

Not only is Applicant's entire mark a catchy, humorous phrase, but it would be a fundamentally erroneous act to reject it over the cited registrations. One must take into consideration that common words cannot be withdrawn from common usage. Indeed, it must be apparent that the cited mark has to be considered very weak if not invalid as describing a condition of the skin. That the Patent and Trademark Office actually issued a certificate of registration for that simple descriptive word doesn't diminish one bit the fact that it is a descriptive word entitled to be used by anybody in describing skin tones. The Examiner's rejection is tantamount to giving the registrant of TONE exclusive right to use a common English word for its intended meaning. Against this backdrop, consider what applicant's mark is

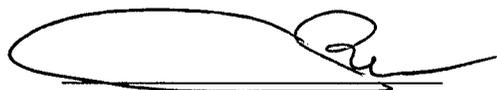
really saying, to wit: "turn back the clock" to obtain a younger tone. The cited marks say nothing of the sort.

SUMMARY

Applicant has shown that the cited mark TONE is a relatively weak mark, in part by presenting evidence of dictionary definitions and third party use. Moreover TONE BACK THE CLOCK is substantially different when compared to TONE, with respect to appearance, sound, sight, meaning, connotation and commercial impression, when the marks are viewed in their entirety. Both issues have been given little, if any, weight by the Examiner when comparing the marks. The mark should be registered in International Class 3.

Please charge any fees required in connection with this Brief to Deposit Account No. 50-3881.

Respectfully submitted,



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