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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Timex Group USA, Inc.

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Serial No. 85164601

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J. Allison Strickland and Karen Lim of Fross Zelnick Lehrman & Zissu, P.C. for Timex Group USA, Inc.

Kelly Trusilo, Trademark Examining Attorney, Law Office 107  
(J. Leslie Bishop, Managing Attorney).

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Before Quinn, Bergsman and Lykos,  
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Timex Group USA, Inc. ("applicant") filed an intent-to-use application on the Principal Register for the mark INTELLIGENT QUARTZ, in standard character form, for "watches," in Class 14. Applicant disclaimed the exclusive right to use the word "Quartz."

The Trademark Examining Attorney refused to register applicant's mark under Section 2(e)(1) of the Trademark Act of 1946, 15 U.S.C. § 1052(e)(1), on the ground that applicant's mark is merely descriptive. The examining argues that INTELLIGENT QUARTZ merely describes applicant's watches because

"the term 'intelligent' is well understood in the watch industry to refer to the use of multiple functions including micro processing. ... Thus, ... applicant is using the term 'intelligent' to mean a watch containing microprocessors which enable multiple functionality."<sup>1</sup>

"A term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used." *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). Whether a particular term is merely descriptive is determined in relation to the goods and services for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). In other words, the question is not whether someone presented only with the mark could guess the products listed in the description of goods. Rather, the question is whether someone who knows what the products are will understand the mark to convey information about them. *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-1317 (TTAB 2002); *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d

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<sup>1</sup> Examining Attorney's Brief, p. 4 (unnumbered).

Serial No. 85164601

1313, 1317 (TTAB 1990); *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

When two or more merely descriptive terms are combined, the determination of whether the composite mark also has a merely descriptive significance turns on the question of whether the combination of terms evokes a new and unique commercial impression. If each component retains its merely descriptive significance in relation to the goods or services, the combination results in a composite that is itself merely descriptive. See *In re Tower Tech, Inc.*, 64 USPQ2d 1314 (SMARTTOWER merely descriptive of commercial and industrial cooking towers); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) (AGENTBEANS merely descriptive of computer programs for use in developing and deploying application programs); *In re Putman Publishing Co.*, 39 USPQ2d 2021 (TTAB 1996) (FOOD & BEVERAGE ONLINE merely descriptive of news and information services in the food processing industry). In this regard, we must consider the issue of descriptiveness by looking at the mark in its entirety. Common words may be descriptive when standing alone, but when used together in a composite mark, they may become a valid trademark. See *Concurrent Technologies Inc. v. Concurrent Technologies Corp.*, 12 USPQ2d 1054, 1057 (TTAB 1989) (CONCURRENT TECHNOLOGIES CORPORATION found not merely descriptive of printed electronic circuit boards because, while

"concurrent" had meaning in the computer field, "concurrent technologies" had no established meaning in relation to computer hardware or software).

Finally, "if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive." *In re Tennis in the Round, Inc.*, 199 USPQ 496, 498 (TTAB 1978). See also, *In re Shutts*, 217 USPQ 363, 364-365 (TTAB 1983); *In re Universal Water Systems, Inc.*, 209 USPQ 165, 166 (TTAB 1980). In this regard, "incongruity is one of the accepted guideposts in the evolved set of legal principles for discriminating the suggestive from the descriptive mark." *In re Shutts*, 217 USPQ at 365.

The concept of mere descriptiveness, it seems to us, must relate to general and readily recognizable word formulations and meanings, either in a popular or technical usage context, and should not penalize coinage of hitherto unused and somewhat incongruous word combinations whose import would not be grasped without some measure of imagination and "mental pause."

*Id.* at 364-365 (SNO-RAKE is not merely descriptive for a snow removal hand tool). See also, *In re Tennis in the Round, Inc.*, 199 USPQ at 498 (the association of applicant's mark TENNIS IN THE ROUND with the phrase "theater-in-the-round" creates an

incongruity because applicant's tennis courts are not analogous to a theater-in-the-round).

According to the Encyclopedia Britannica, the application of quartz crystals to timekeeping, "was probably the greatest contribution to precision time measurement."<sup>2</sup>

The timekeeping element of a quartz clock consists of a ring of quartz about 2.5 inches (63.5 mm) in diameter, suspended by threads and enclosed in a heat-insulated chamber. Electrodes are attached to the surfaces of the ring and connected to an electrical circuit in such a manner as to sustain oscillations. Since the frequency of vibration, 100,000-hertz, is too high for convenient time measurement, it is reduced by a process known as frequency division or demultiplication and applied to a synchronous motor connected to a clock dial through mechanical gearing. If a 100,000 hertz frequency, for example, is subjected to a combined electrical and mechanical gearing reduction of 6,000,000 to 1, then the second hand of the synchronous clock will make exactly one rotation in 60 seconds. The vibrations are so regular that the maximum error of an observatory quartz-crystal clock is only a few ten-thousandths of a second per day, equivalent to an error of one second every 10 years.<sup>3</sup>

The word "intelligent" has several meanings. For example,

1. Having intelligence;

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<sup>2</sup> "Clock" Encyclopedia Britannica, *Encyclopedia Britannica Online Academic Edition* (2012). The Board may take judicial notice of information from encyclopedias. *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 n.6 (TTAB 2011).

<sup>3</sup> *Id.*

2. *Computer Science*: Having certain data storage and processing capabilities;<sup>4</sup> and
3. Equipped with a microprocessor computer.<sup>5</sup>

*Thefreeonlinedictionary.com* thesaurus identified "smart," "reasoning," and "rational," among other words, as synonyms for the word "intelligent."<sup>6</sup>

The blog "Watches Corner" ([watchescorner.blogspot.com](http://watchescorner.blogspot.com)) in an article "Watch Brands History - Article 7 (Seiko)" reports that the Seiko Company developed the first quartz watch, as well as the "first intelligent analog quartz watch with alarm and time functions controlled by an IC computer on a chip."<sup>7</sup> See also the Seiko website ([seikowatches.com](http://seikowatches.com)) which touts that company's "cutting edge innovations," including the "world's first intelligent analog quartz watch controlled by CPU-IC."<sup>8</sup>

An article entitled "Seiko" published in the *ClassicWatch.com* website noting that Seiko introduced "the first Intelligent Quartz Watch - a chronograph with alarm, calendar, and 1/10<sup>th</sup> second timer functions, controlled by an IC 'computer chip.'"<sup>9</sup>

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<sup>4</sup> *Thefreeonlinedictionary.com*, December 15, 2010 Office action and applicant's January 10, 2011 response. See also *Dictionary.com* attached to the February 5, 2011 Office action.

<sup>5</sup> *Yourdictionary.com* attached to the February 5, 2011 Office action.

<sup>6</sup> Applicant's January 10, 2011 response.

<sup>7</sup> December 15, 2010 Office action.

<sup>8</sup> *Id.*

<sup>9</sup> February 5, 2011 Office action.

An excerpt from the eBay.com website displayed an advertisement for the sale of a "Vintage Seiko Intelligent Quartz Chrono/Alarm in Box!!"<sup>10</sup> The watch is described as a "Rare Vintage Seiko Intelligent Quartz Model 8M25-6000 ... These Pieces Are Highly Collectible And Getting Very Difficult to Find!!"

The examining attorney submitted articles from two industry websites reporting on applicant's introduction of the "Intelligent Quartz Technology."<sup>11</sup> The pertinent part of the Moodie Report website (moodiereport.com) is displayed below.<sup>12</sup>

**Timex Introduces Intelligent Quartz  
innovation at Basel fair**

**US.** Timex launches its Intelligent Quartz technology, a revolutionary new proprietary movement, at the BaselWorld watch fair last month.

Intelligent Quartz was developed in Timex's state-of-the art engineering facility in Pforzheim, Germany, and is the result of a 156-year history of timekeeping technology innovation.

Intelligent Quartz encompasses independent motors, digital sensors and microprocessor technology making it flexible and capable of displaying an array of information. This flexibility allows Timex to quickly

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<sup>10</sup> *Id.*

<sup>11</sup> August 16, 2011 Office action. We note that the article indicated that it was "Published 11/04/11."

<sup>12</sup> The WMR Watch Market Review website (watchmarketreview.com) is substantially similar. We did not consider the article from the Daily Watch News because it is a United Kingdom website and the examining attorney did not submit any evidence to demonstrate that it would be encountered by U.S. consumers.

incorporate new technologies, functions and microprocessors into the Intelligent Quartz platform to deliver new quartz analogue applications.

**Timex enhances Intelligent Quartz technology platform for Fall 2011**

Timex has built on its Intelligent Quartz technology platform with the launch of a "robust and sophisticated" series of timepieces making its debut in Fall 2011. The expanded styles adopting Intelligent Quartz technology has "limitless functional capabilities," the company said.

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Launching in July 2011, the Chronograph Compass adventure instrument is built from Timex's proprietary six-hand Intelligent Quartz movement and features a fly-back four-hour chronograph, electronic compass with magnetic declination compensation and a second time zone in an eye-catching stainless steel case. ...

Intelligent Quartz technology is also incorporated on updates to Timex SL Series and Timex Series Racing collections. ... Timex will also expand the Intelligent Quartz platform into the women's category with the launch of the women's Timex T Series Perpetual Calendar.

Finally, the examining attorney submitted excerpts from three websites, including applicant's website, advertising the sale of Intelligent Quartz watches by applicant.<sup>13</sup>

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<sup>13</sup> August 16, 2011 Office action. The excerpt from the Watch International website (watchinternational.com) (February 5, 2011 Office action) has little probative value because "Intelligent Quartz" is listed as a "tag" among numerous other terms listed as "tags" and it would not make an impression upon consumers. Also, the entry from the website entitled "More on word order and thematic analysis"



1. Watch Exclusive (watchexclusive.com)

Men's Timex T2N500 Intelligent Quartz™ Chronograph Watch

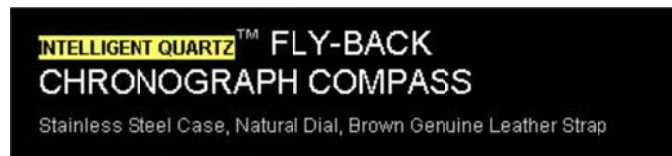
2. Watchesmate (watchesmate.com)

Timex Intelligent Quartz SL Series Multi-functional

\* \* \*

"Intelligent Quartz" is the Timex exclusive patented movement. Such a movement is the technological combination of the separate motor, digital sensor and the microprocessor.

3. Timex (Timex.ca)



If the test for determining whether a term is merely descriptive is whether someone presented only with the mark could guess the products listed in the description of good, INTELLIGENT QUARTZ might be suggestive because consumers presented with that term would pause to consider its meaning. However, as indicated above, the question is whether someone who knows what the products are will understand the mark to convey information about them. *In re Tower Tech, Inc.*, 64 at 1316-1317; *In re Patent & Trademark Services Inc.*, 49 USPQ2d at 1539; *In re Home Builders Association of Greenville*, 18 USPQ2d at

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February 5, 2011 Office action) has little probative value because the term "Intelligent Quartz" is not used in a commercial setting but as part of an exercise in a writing course.

1317; *In re American Greetings Corp.*, 226 USPQ at 366. Thus, we analyze the descriptiveness issue by analyzing how customers and prospective customers for watches would perceive the term INTELLIGENT QUARTZ.

Consumers will perceive the term INTELLIGENT QUARTZ as INTELLIGENT QUARTZ watches. Specifically, consumers and prospective consumers viewing the mark INTELLIGENT QUARTZ as applied to watches will understand the mark to mean that the watch contains a quartz component controlled by a computer chip. The three websites advertising applicant's watches corroborate this finding of fact. As indicated above, applicant's watches were identified as follows:

1. Men's Timex T2N500 Intelligent Quartz™ Chronograph Watch;
2. Timex Intelligent Quartz SL Series; and
3. INTELLIGENT QUARTZ FLY-BACK CHRONOGRAPH COMPASS.

*Cf. In re Central Sprinkler Co.*, 49 USPQ2d 1194, 1197 (TTAB 1998) (the fact that applicant chose not to include the term "sprinkler" in the mark ATTIC does not avoid a finding of genericness, where the good were automatic sprinklers for fire protection of attics).

Moreover, the articles posted on industry websites refer to INTELLIGENT QUARTZ as a feature of watch technology (e.g., "Timex launches its Intelligent Quartz technology, a

revolutionary new proprietary movement" and "the Chronograph Compass adventure instrument is built from Timex's proprietary six-hand Intelligent Quartz movement and features a fly-back four-hour chronograph"). See also the postings about Seiko's products (e.g., the Seiko Company developed the first quartz watch, as well as the "first intelligent analog quartz watch with alarm and time functions controlled by an IC computer on a chip."). Thus, the industry writers perceive INTELLIGENT QUARTZ as describing a feature of applicant's watches.

Applicant argues that because the word "intelligent" has many meanings, consumers will "have to stop and consider which of these meanings the word INTELLIGENT and the mark INTELLIGENT QUARTZ as a whole signify."<sup>14</sup> However, based on the evidence of record, INTELLIGENT QUARTZ directly conveys the meaning that the watches have a quartz component controlled by computer chip. The mark does not convey any multiple meanings, double entendre or incongruity.

In this regard, applicant also argues that the composite mark creates an incongruous whole that renders the mark INTELLIGENT QUARTZ suggestive.<sup>15</sup> However, as indicated above, we find that INTELLIGENT QUARTZ will be perceived as an INTELLIGENT QUARTZ watch and, as such, the individual components of the mark, the words "Intelligent" and "Quartz" retain their

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<sup>14</sup> Applicant's Brief, p. 8.

<sup>15</sup> Applicant's Brief, p. 9.

descriptive meaning when used in connection with watches with a quartz component controlled by a computer chip. Under the milieu of purchasing a watch, consumers and prospective consumers will not apply different meanings to the word "Intelligent" when they encounter the composite mark INTELLIGENT QUARTZ.

In addition, applicant referenced three cancelled registrations, listed below, on the Principal Register with no showing of acquired distinctiveness, incorporating the word "Intelligent" for watches issued to Kabushiki Kaisha Hattori Seiko.<sup>16</sup>

1. Registration No. 1648797 for the mark INTELLIGENT QUARTZ in typed drawing form ("Quartz" disclaimed);

2. Registration No. 2397072 for the mark INTELLIGENT CALENDAR in typed drawing form ("Calendar" disclaimed); and

3. Registration No. 1803715 for the mark INTELLIGENT CALENDAR in typed drawing form ("Calendar" disclaimed).

With respect to Seiko's cancelled third-party registrations for INTELLIGENT QUARTZ and INTELLIGENT CALENDAR for watches, we do not have the prosecution history of those applications files before us. Even if we did, they would be of limited probative value because prior registrations do not rebut our finding that INTELLIGENT QUARTZ is descriptive in the context of watches. We

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<sup>16</sup> Applicant's January 10, 2011 response.

must decide each case on its own merits and "[e]ven if some prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the Board." *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

Finally, applicant argues that the evidence of record "underscore[s] the trademark significance of the applied-for INTELLIGENT QUARTZ mark. ... It does not show any competitive need to use this term."<sup>17</sup> Evidence that competitors have used particular words to describe their goods is, of course, persuasive evidence that those words would be perceived by purchasers as descriptive for the goods. Absence of such evidence of competitors' use is, however, not conclusive on the question of whether a term is descriptive. *In re Hunter Fans Co.*, 78 USPQ2d 1474, 1476 (TTAB 2006) (TTAB 2006) (a word need not be in common use in an industry to be merely descriptive); *In re Eden Foods Inc.*, 24 USPQ2d 1757, 1761 (TTAB 1992) (that applicant is the first and/or only user is not dispositive of whether the term is descriptive, nor is it necessary that the term be in common usage; the absence of third-party use does not mean that competitors would not need to use the term in their advertising or promotions). *Cf. Philip Morris Inc. v. Brown & Williamson Tobacco Corp.*, 230 USPQ 172, 176 (TTAB 1986).

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<sup>17</sup> Applicant's Brief, pp. 13-14.

Serial No. 85164601

In view of the foregoing, we conclude that the mark INTELLIGENT QUARTZ, when considered in its entirety, is merely descriptive within the meaning of Section 2(e)(1).

**Decision:** The refusal to register is affirmed.