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

Attorney Docket: T-92235

Applicant : Timezone Trademark Management Ltd.
Serial No. : 78/523,456
Filed : November 29, 2004
Mark : TIMEZONE AND DESIGN

08-14-2006
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #32

TO THE TRADEMARK TRIAL AND APPEAL BOARD:

Applicant hereby appeals to the Trademark Trial and Appeal Board from the decision of the Examiner of Trademarks refusing registration.

Filed together with this notice is the Applicant's Request for Reconsideration.

Respectfully submitted,
COLLEN *IP*

By: _____

08/17/2006 GTHOMAS2 00000126 78523456
01 FC:6403 100.00 OP

Jane F. Collen
Thomas P. Gulick
Telephone: (914) 941 5668
The Applicant's attorney

JFC/TPG/MC:kdr
Enclosure: - Authorization Charge in the amount of $100.00 appeal fee per class
DATED: August 7, 2006

COLLEN *IP*
Intellectual Property Law, P.C.
The Holyoke-Manhattan Building
80 South Highland Avenue
Town of Ossining
Westchester County, New York 10562

SHOULD ANY OTHER FEE BE REQUIRED, THE PATENT AND TRADEMARK OFFICE IS HEREBY REQUESTED TO CHARGE SUCH FEE TO OUR DEPOSIT ACCOUNT 03-2465.

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO: **UNITED STATES PATENT AND TRADEMARK OFFICE**, Trademark Trial and Appeal Board , P.O. Box 1451, Alexandria, VA 22313-1451

COLLEN *IP* Intellectual Property Law, P.C.

By: _____ Date: August 7, 2006

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

ATTORNEY DOCKET NO: T-92235

Applicant : Timezone Trademark Management Ltd.
Serial No. : 78/523,456
Filed : November 29, 2004
Mark : MISC. DESIGN

ATTENTION

Examining Attorney: Christopher William Wells
Law Office: 106

RESPONSE AFTER FINAL REFUSAL: REQUEST FOR RECONSIDERATION FILED WITH NOTICE OF APPEAL

The Applicant acknowledges receipt of the FINAL Office Action dated February 7, 2006 issued in association with the trademark application captioned above. The Examining Attorney's comments have been duly noted.

REMARKS

The Examiner has continued and made FINAL the refusal to register claiming likelihood of confusion with registration Nos. 1,227,379 for the word mark TIME ZONE in International Class 014 for *inter alia* electronic watches and

electronic clocks and registration No. 2892691 for the mark TIMEZONE and design for advertising agencies and business management services.

Applicant respectfully disagrees with the Examiner's FINAL refusal that in this instance the marks, the goods and the services are similar as to create a likelihood of confusion among consumers. Applicant submits that the marks are different in appearance, meaning and in the overall commercial impression created when applied to the goods and services in question, and are marketed under such conditions to buyers as to avoid a likelihood of confusion.

In reviewing the similarities of the mark the Examiner finds that the marks have a single literal element, TIMEZONE and this creates a likelihood of confusion.

As previously argued, in the two cited marks the wording "TIMEZONE" is highly emphasized, appears in its entirety and is the central element of the marks. The Applicant's mark is presented in a stylized form where the wording in the mark appears in a way that is merely suggestive of the word TIMEZONE. A better description of the literal element in the mark is TIMOZONO since the letters in the mark are TIMZ and N with the clocks for the letter O. Applicant's mark therefore, is not a word mark but rather a design mark, which creates an entirely different commercial impression from either of the cited word marks. In fact,

Applicant only submitted the word when required to submit the literal element for purposes of describing the design mark not as an indication of the mark itself.

The Applicant's mark consists of a combination of letters and designs of clocks which as a result is a different mark from the cited registrations. The Applicant's mark will not be encountered in the marketplace with the literal element next to it as it appears in the application papers. The stylized presentation of the term in the mark already sets the Applicant's mark apart. The entire appearance of the mark, especially when viewed in the context of the services marketed under the mark, creates a unique commercial impression and appearance. Applicant submits that it is this distinguishing characteristic which completely differentiates Applicant's mark from the cited registrations.

It is well established that a stylized mark should be examined as a whole in the context of stylization and design. The commercial impressions created by the marks are of primary significance. *In re Johnson Products Co., Inc.,* 220 U.S.P.Q. (BNA) 539, 540 (TTAB 1983). The interplay of letters and designs in the Applicant's mark creates a unique and lasting commercial impression.The mark is not spoken but viewed in advertisements, brochures, publicity clips, and billboards. The focus should not be just on the letter elements of the mark but on

the overall impression the stylized design mark creates on the consumer. The appearance of the mark becomes even more powerful and distinctive when viewed in association with the goods and services.

There is no per se rule that similar or even identical marks in the same or closely related fields cannot co-exist. In addition to the existence of the two cited registrations, there are numerous other registrations containing the term "TIME ZONE" alone or in association with other terms. The existence of several marks containing the term "TIME ZONE" shows that where the goods and services and the channels of trade are different the public will not be confused, as consumers already distinguish between these marks.

The Applicant has already amended its services to make them more specific and to indicate the field in which they are offered.

If the goods and services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely. TMEP 1207.01(a)(i).

Consumers encountering the goods and services in question don't have to be knowledgeable about trademarks they have to be knowledgeable about the goods and services they are looking for. Electronic watches and electronic clocks or advertisement services are not everyday purchases as such potential consumers are expected to exercise care in acquiring these goods and services.

In light of the above, the Applicant submits that the parties' goods/services are sufficiently different for the relevant consumer to distinguish the source of the respective goods/services. Applicant's mark is different in appearance and overall commercial impression and as applied to the services from the cited marks.

Therefore, Applicant respectfully requests that the Examiner withdraw the refusal to register under Trademark Act §2(d).

The Applicant submits that this application is now in proper condition for publication. Accordingly, the Applicant respectfully requests that the above-captioned trademark be passed to publication in the Official Gazette of the United States Patent and Trademark Office.

Respectfully submitted,
COLLEN *IP*

By: _____
Jane F. Collen
Thomas P. Gulick
Telephone: (914) 941 5668
The Applicant's attorney

JFC/TPG/MC:kdr
Dated: August 7, 2006
COLLEN *IP*
Intellectual Property Law, P.C.
The Holyoke-Manhattan Building
80 South Highland Avenue
Town of Ossining
Westchester County, New York 10562

SHOULD ANY OTHER FEE BE REQUIRED, THE PATENT AND TRADEMARK OFFICE IS HEREBY REQUESTED TO CHARGE SUCH FEE TO OUR DEPOSIT ACCOUNT 03-2465.

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO: UNITED STATES PATENT AND TRADEMARK OFFICE, TRADEMARK TRIAL AND APPEAL BOARD, P.O. BOX 1451, ALEXANDRIA, VA 22313-1451.

By: _____ Date: August 7, 2006