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

ATTORNEY DOCKET NO: T-92235

Applicant : Timezone Trademark Management Limited
Serial No. : 78/523,456
Filed : November 29, 2004
Mark : TIMEZONE & design

TO THE TRADEMARK TRIAL AND APPEAL BOARD

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

APPLICANT'S APPEAL BRIEF

Pursuant to Notice of Appeal filed August 7, 2006, the Applicant has appealed the Trademark Examining Attorney's FINAL refusal to register Applicant's mark, claiming likelihood of confusion with Registration No. 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.

FACTS

Applicant's application is to register the mark TIMEZONE & Design, which appears as : TimeZone for retail stores; import and export

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agencies; advertising, marketing and promotion services; business information services; dissemination of advertising matter; demonstration of products; distribution of samples; shop window dressing; arranging exhibitions for business and advertising purposes; business advisory and consultancy services; all of the above featuring watches, clocks, horological and chronometric instruments in International Class 35.

On June 30, 2005 the examining attorney issued an office action refusing registration of Applicant's mark under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d) based on likelihood of confusion with U.S. for TIME ZONE & Design, which appears as: TimeZone (Reg. No. 1,227,379), for electronic watches and electronic clocks in International Class 14, and **TIMEZONE** (Reg. No. 2,892,691) for: advertising agencies and business management services in International Class 35; and commercial art design including graphic design and packaging design for others; computer programming for others; application services provider (ASP) featuring software in the field of database accessing, computer services, namely, designing and implementing internet web pages for others; and creating and maintaining websites for others in International Class 42.

Applicant responded on January 9, 2006, arguing that Applicant's unique design mark creates a distinctive commercial impression which, when applied to the highly specialized nature of the services, and in consideration of the high degree of sophistication of the customers, warrants against a finding of likelihood of confusion.

On February 7, 2006, the Examiner issued a subsequent office action, consisting of a final refusal to register Applicant's mark under Section 2(d), likelihood of confusion, based on the previously cited marks.

On August 7, 2006, Applicant filed a Request for Reconsideration, reiterating that, the entire appearance of Applicant's mark, especially when viewed in the context of the services marketed under the mark, creates a unique commercial impression and is marketed to sophisticated clientele.

On September 7, 2006, examining attorney denied the request for reconsideration, rejecting Applicant's arguments, and stating that, when the relevant consumer is comprised of both professionals and the general public, the standard of care when purchasing the goods is equal to that of the least sophisticated purchaser in the class.

ARGUMENTS

In support of Applicant's claim that confusion as to the source of the goods/ services is not likely, Applicant submitted arguments that the marks are highly different in appearance, meaning, and overall commercial impression created when applied to the goods and services in question, and that the goods and services are marketed under such conditions to buyers as to avoid a likelihood of confusion.

Applicant's Design Mark is Unique and Leaves a Distinct Commercial Impression

Applicant's mark is presented in a highly unique and stylized form where the wording in the mark merely suggests the word TIMEZONE, and appears as follows: TimeZone. The round image of the clock is repeated three times, and at first glance, the mark reads TIMOZONO, which creates an entirely different commercial impression from either of the cited marks. It is an unusual design because the round image simultaneously represents both the letter "E" and the letter "O." When these letters are viewed in their traditional form, they look very different from one another and therefore the

use of one image to represent both letters is innovative, clever and distinctive.

It is well settled that the Patent and Trademark Office considers all relevant factors in determining whether there is likelihood of confusion. *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984). The Trademark Office has consistently relied on the factors set forth in the *In re E.I. DuPont & Nemours* case, where relevant, in making a likelihood of confusion determination. A stylized mark should be examined as a whole in the context of stylization and design and 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 mark is not primarily spoken but viewed by the consumer. The incorporation of letters and designs in the Applicant's mark creates a unique and lasting commercial impression.

The cited mark, TimeZone (Reg. No. 1227379), for electronic watches and electronic clocks, is limited in its protection to that for their stylization and design of the mark. The two designs create entirely unique commercial impressions. When compared side by side, their fonts and

designs make obvious the fact that the goods of the cited mark originate from a different source from the services of the Applicant.

The Goods/Services are Able to Coexist in the Marketplace

Similar or even identical marks in the same or closely related fields can co-exist without confusion. 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 coexistence of several marks containing the elements "TIME" and "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 cited mark TimeZone (Reg. no. 2,892,691) was required to disclaim "TIME" in the mark. Therefore, only the "ZONE" portion of the mark remains protectable. Thus, given the relative commonplace nature of marks using the elements "TIME" and "ZONE", subtle differences in appearance and goods or services marketed under the mark will suffice to differentiate the marks in commerce. Furthermore, 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).

The Goods/Services are Not Likely to be Encountered by the Same Customers

The TIMEZONE (Reg No. 2,892,691) mark is owned by Scenario Communications Inc, a corporation headquartered in New Zealand. Its only offices are located in Auckland and Wellington New Zealand. The services offered under this mark are not likely to be confused with the services offered by Applicant, a Virgin Islands-based business. The customer base will be vastly different. The consumers encountering the goods and services in question only have to be knowledgeable about the goods and services provided under the marks, they do not have to be knowledgeable about trademarks. Advertising and business services are not everyday purchases. Such purchasers will not likely be lay persons or the general public. They will be businesses and professionals requiring assistance with their respective businesses. As such, potential consumers will exercise a high degree of care and consideration in acquiring these services.

Applicant's retail services are specialized for the field of watches, clocks, horological and chronometric instruments. A professional or business considering the services of an advertising agency, requiring business management services or commercial art design, computer programming, or web page services will not confuse such services with those of the Applicant. A professional or business requiring these services would not consider that these services originate from the same source as a company that specializes in watches and chronometric instruments.

The "TimeZone" mark, Registration No. 1,227,379 is also unlikely to be encountered in the same channels of trade. Although both marks deal in watches and electronic, the Applicant's mark is for professional services, whereas this cited mark is for goods purchased by the general consuming public. The services offered by the Applicant will not be encountered, nor will they be required by the general purchasing public. Given the unique design elements of each mark, as well as the vast difference between the goods and services, professionals and businesses purchasing retail services are not going to consider the watches of the cited owner and be confused as to the source of Applicant's services. Conversely, the general consuming public will not confuse the cited goods with the Applicant's services. The

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By: Kayra Di Rosa Date: May 24, 2007