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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Advance Watch Co., Ltd.

Serial No. 75/352,880

Mark A. Cantor and Maria Franek Angileri of Brooks & Kushman P.C. for Advance Watch Co., Ltd.

Douglas M. Lee, Trademark Examining Attorney, Law Office 108 (David Shallant, Managing Attorney)

Before Simms, Seeherman and Bucher, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Advance Watch Co., Ltd. has appealed from the final refusal of the Trademark Examining Attorney to register the mark shown below for "watches and clocks" and the "manufacture of watches to order and specification of others."¹

¹ Application Serial No. 75/352,880, filed September 8, 1997, based on an asserted bona fide intention to use the mark in commerce.



Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the stylized mark I.D., shown below, and registered for watches,² that, if used in connection with applicant's identified goods or services, it would be likely to cause confusion or mistake or to deceive.

I.D.

Applicant and the Examining Attorney have filed briefs; an oral hearing was not requested.

We affirm the refusal of registration.

Before turning to the substantive issue in this appeal, we must address an objection raised by the Examining Attorney. Applicant has referred to a registration it owns for the word mark IDENTITY for "manufacture of watches to order and specification of

² Registration No. 1,510,884, issued November 1, 1988; Section 8 affidavit accepted; Section 15 affidavit received.

others.”³ The Examining Attorney has objected to our consideration of this registration, stating that applicant has not properly made it of record. In general, if an applicant indicates reliance on a registration, whether its own or a third party’s, during the course of prosecution, the Examining Attorney must raise a timely objection thereto, i.e., at a point where the applicant has an opportunity to cure the objection, or the objection will be deemed to be waived. In this case, not only did applicant claim ownership of the registration during the course of prosecution, but the Examining Attorney himself submitted a copy of the registration with the first Office action in connection with his query as to whether applicant was the owner of the registration. Accordingly, the Examining Attorney’s objection is overruled.

This brings us to a consideration of the issue of likelihood of confusion. Our determination is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in **In re E.I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. **Federated Food, Inc.**

³ Registration No. 1,819,232.

v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

With respect to the goods and services, the goods are in part identical, in that the identifications in both the cited registration and the application include watches. Moreover, applicant's other identified goods and services, clocks and the manufacture of watches to the order and specification of others, are closely related to the registrant's identified watches. In this connection, the Examining Attorney has submitted excerpts from the "Thomas Register of American Manufacturers," (1997), listing individual companies' advertisements for both watches, clocks and timepieces with personalized messages. Moreover, applicant has not disputed the fact that its goods and services and the registrant's goods are legally identical or related, its brief being devoid of any discussion of this factor.⁴

⁴ In its response to the first Office action applicant asserted that its watches were not sold to the same customers as the registrant's because its watches were directed to consumers seeking specific engraved or engraveable products, while registrant's watches would be purchased by impulse buyers of fashion watches. The Examining Attorney correctly pointed out in his final Office action that the identifications of goods and services in the respective application and registration did not contain any restriction on the channels or trade or classes of purchases, and therefore they must be deemed to be sold in all appropriate channels of trade to all of the usual classes of purchasers for such goods or services.

When goods would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines. **Century 21 Real Estate Corp. v. Century Life of America**, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). With this principle in mind, we turn to a consideration of the marks.

Although applicant asserts that its mark is the word IDENTITY, because of the manner in which it is depicted, it is the letters ID which create the dominant visual impression. They are shown in very thick, dark type, and are substantially larger than the letters "ENTITY." Moreover, because these two portions of the mark are in different fonts and sizes, with the letters "ENTITY" totally encompassed within the lower horizontal bar of the letter "D," the connotation of the mark is of two words, ID and ENTITY, rather than of the single word IDENTITY. Further, because of the relative sizes of the words, it is the word ID which is more likely to be noted and remembered by purchasers.

As applicant points out, marks must be considered in their entireties. However, it is well established that there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular

feature of a mark. See **In re National Data Corp.**, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Therefore, when we compare the marks in their entireties, we find that both applicant's stylized mark and the cited mark, I.D., convey similar commercial impressions, that of the letters or abbreviation ID. Although there are certain differences in the marks, they do not serve to distinguish applicant's mark from the registrant's. Instead, to the extent that these differences are noted, applicant's mark would be regarded as merely a variation of the registered mark. Accordingly, consumers aware of registrant's mark I.D. for watches are likely to believe, upon encountering applicant's stylized mark for the identical goods, watches, or for such closely related goods and services as clocks and the custom manufacture of watches, that the marks identify goods and services emanating from the same source.

Finally, we have considered, but are not persuaded by, applicant's arguments that consumers will associate its applied-for mark, the stylized ID ENTITY, with its mark IDENTITY which has been registered in typed form, and that the coexistence of the cited mark and applicant's registered IDENTITY mark on the Register indicates that there is no likelihood of confusion between its stylized

Ser. No. 75/352,880

mark and the cited mark. As we stated previously, the commercial impression of the applied-for mark is not that of the word IDENTITY, but of the separate elements ID and ENTITY, with the primary emphasis on the abbreviation ID.

Decision: The refusal of registration is affirmed.

R. L. Simms

E. J. Seeherman

D. E. Bucher
Administrative Trademark Judges
Trademark Trial and Appeal Board