

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing:
07 February 2008

Mailed:
31 March 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Timezone Trademark Management Limited

Serial No. 78523456

Michelle Morris and Jane F. Collen of Collen IP for
Timezone Trademark Management Limited.

Christopher Wells, Trademark Examining Attorney, Law Office
106 (Mary I. Sparrow, Managing Attorney).

Before Seeherman, Drost, and Taylor, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On November 29, 2004, Timezone Trademark Management
Limited (applicant) filed an application to register the
mark shown below on the Principal Register for the
following services:

Retail stores; import and export 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;

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all of the above featuring watches, clocks,
horological and chronometric instruments in Class 35.¹

The logo for 'Timozono' is displayed in a bold, black, sans-serif font. The letters 'i', 'o', 'o', and 'o' are replaced by stylized clock faces. Each clock face is a circle with a checkmark inside, positioned as if the hands of a clock are pointing to the top-right. The 'i' has a dot above it. The 'z' is a simple, thick, blocky letter.

The examining attorney has refused to register applicant's mark under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) because of two registered marks. The first registration is for the mark TIMEZONE (in typed or standard character form) for "advertising agencies and business management services" in Class 35. Registration No. 2892691 issued October 12, 2004.² The second registration is for the mark TIMEZONE and design shown below for "electronic watches and electronic clocks" in Class 14.³

¹ Serial No. 78523456. The application is based on an allegation of a bona fide intention to use the mark in commerce.

² The registration is owned by Scenario Communications Limited. The registration also includes services in Class 42 that are not relevant to this appeal.

³ Registration No. 1227379, issued February 15, 1983, renewed. As a result of partial Section 8 and 15 affidavits, goods and services in Classes 9, 28, and 42 were deleted. The registration contains a disclaimer of the word "Time" and it is owned by Calconix, Inc.



When the refusal was made final, applicant filed this appeal. A hearing was held on February 7, 2008.

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003) and *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

"The first *DuPont* factor requires examination of 'the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.'" *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73

USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973)). We begin by addressing applicant's argument that 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." Brief at unnumbered p. 4. We disagree. In the section of its application entitled "Literal Element," applicant inserted the word "TIMEZONE." The header of applicant's brief (first page) identifies the mark as TIMEZONE. Consistent with applicant's own references to its mark, most consumers are also likely to view the mark as a stylized version of the common words "time zone" rather than an invented word with no apparent meaning. Indeed, the three clock faces, which are used to indicate the time, are more likely to reinforce the "time zone" meaning instead of representing stylized letters "O." Therefore, applicant's and registrants' marks are for the identical word "TIMEZONE." They would have the identical pronunciation and meaning. Furthermore, inasmuch as the '691 registration is shown in typed or standard character form, we must assume that it can be used in the same stylized form as applicant's mark (without the design element). *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ

937, 939 (Fed. Cir. 1983) (“[T]he argument concerning a difference in type style is not viable where one party asserts rights in no particular display. By presenting its mark merely in a typed drawing, a *difference* cannot legally be asserted by that party. Tomy asserts rights in SQUIRT SQUAD regardless of type styles, proportions, or other possible variations. Thus, apart from the background design, the displays must be considered the same”). See also *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000) (“Registrations with typed drawings are not limited to any particular rendition of the mark and, in particular, are not limited to the mark as it is used in commerce”). Therefore, while the addition of the clock faces is a difference, nonetheless the appearance of the marks TIMEZONE and TIMEZONE and clock face design are still similar.

Finally, the commercial impressions of the marks are likewise very similar inasmuch as they are for the identical word and the only additional feature in applicant’s mark is the presence of clock faces, which would certainly be suggestive of applicant’s retail stores featuring watches, clocks, horological and chronometric instruments. See *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (The Federal

Circuit held that, despite the addition of the words "The" and "Cafe" and a diamond-shaped design to registrant's DELTA mark, there still was a likelihood of confusion). See also *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988) (BIGG'S (stylized) for grocery and general merchandise store services found likely to be confused with BIGGS and design for furniture). Therefore, we conclude that the marks TIMEZONE and TIMEZONE and clock face design are similar in sound, appearance, meaning, and commercial impression.

Regarding the '379 registration, the marks are again identical in pronunciation and meaning inasmuch as they would be pronounced the same and their meaning would be the same. As to their appearance and commercial impression, the designs in the marks are different but both marks feature various symbols associated with clocks. Applicant's design includes clock faces and the '379 registration seems to include a symbol "suggesting sound or vibration" (examining attorney's brief at 3) such as a clock's "alarm sounding" (applicant's reply brief at unnumbered p. 3). Both symbols are suggestive of the clock-related goods and services in the application and registration. Inasmuch as the words in the marks are identical and the designs are suggestive of clock-related

goods and services, we do not agree with applicant's argument that they "create wholly divergent commercial impressions" (reply brief at 4). Rather, we hold that the appearances and commercial impressions of the marks would be similar. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) ("We agree with the Board that the words dominate these marks, and that their differences in script and arrow design do not diminish their substantial identity when viewed as a whole"). Therefore, applicant's mark and the mark in the '379 registration are dominated by the word TIMEZONE and they are similar in sound, appearance, meaning, and commercial impression.

We add that the identical nature of the word portion of the marks is a significant factor in our likelihood of confusion analysis. *Id.* ("Without a doubt the word portion of the two marks are identical, have the same connotation, and give the same commercial impression. The identity of the words, connotation, and commercial impression weighs heavily against the applicant").

Next, we look at whether the goods and services in the application and registrations are related. It "has often been said that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods

or services are related in some manner or that circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services." *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991). *See also Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1661 (TTAB 2002).

Here, applicant's retail stores and advertising and marketing and business advisory services all feature watches, clocks, horological and chronometric instruments. The '379 registration is for electronic watches and electronic clocks while the '691 registration is for advertising agencies and business management services. We start by noting that the '691 registration's advertising and business management services are not limited to any industries or types of businesses so they would include applicant's advertising services featuring watches, clocks, and horological and chronometric instruments. Therefore, these services overlap because they are identical in part. Applicant's business advisory services and the '691

registrant's business management services would also be closely related, if not overlapping, to the extent that they both include business advisory services and business management services featuring watches and clocks.

Concerning the '379 registration's electronic watches and electronic clocks, we note that these items would be items sold in retail stores featuring watches and clocks that are included within applicant's identification of services. In a similar situation, the Federal Circuit has held that "retail grocery and general merchandise store services" and furniture are related.

The only aspect of this case which is unusual is that the marks sought to be registered are for services while the prior registration on which their registration is refused is for wares. Considering the facts (a) that trademarks for goods find their principal use in connection with selling the goods and (b) that the applicant's services are general merchandising -- that is to say selling -- services, we find this aspect of the case to be of little or no legal significance.

Hyper Shoppes, 6 USPQ2d at 1026.

In this case, the relationship between applicant's services and registrant's goods is even more direct because applicant's stores specifically sell the goods identified in registrant's registration.

The examining attorney has also included several use-based registrations to show that a common mark has been

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registered by the same entity for, inter alia, watches and/or clocks and retail store services. See, e.g., Registration No. 3122537 ("watches, clocks" and "retail store services in the field of jewelry, watches..."); No. 3106335 ("watches, watch chains, clocks" and "retail store, computerized online retail and retail distributorship services all featuring... watches, clocks..."); No. 3136453 ("jewelry, namely watches..." and "retail store, wholesale and mail-order catalog services featuring jewelry") and No. 2863810 ("watches" and "retail store services"). Although third-party registrations are "not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may nonetheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source." *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). See also *In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d 1214, 1217-18 (TTAB 2001).

Based on the nature of the goods and services and the evidence of record, we conclude that these goods and services are closely related. Consumers are likely to assume that there is some association or relationship between watches and clocks and stores that sell these same

products. In addition, the potential customers of applicant and registrant would overlap to the extent that purchasers of watches and clocks would use retail store services featuring watches and clocks. *Schieffelin & Co. v. Molson Companies Ltd.*, 9 USPQ2d 2069, 2073 (TTAB 1989) (“[M]oreover, since there are no restrictions with respect to channels of trade in either applicant's application or opposer's registrations, we must assume that the respective products travel in all normal channels of trade for those alcoholic beverages”).

Purchasers seeking to purchase a watch or clock are obviously likely to patronize a retail store featuring watches and clocks. Thus, the purchasers of these goods and services would overlap. We also point out that we do not read limitations into the identification of goods and services. *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods [or services] set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods [or services], the particular channels of trade or the class of purchasers to which the sales of goods [or

services] are directed"). Therefore, we must assume that registrant's clocks and watches and applicant's retail stores both feature clocks and watches in various price ranges. We add that while some purchasers of these goods may be careful and sophisticated purchasers, there is no evidence that would dissuade us from concluding that some of these purchasers would simply be ordinary purchasers who were not particularly careful in making these purchases.

Regarding the advertising services of both applicant and the '691 registrant, we must consider these services to be overlapping and therefore the channels of trade and purchasers would be identical. *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers"). While the purchasers of advertising services may be more sophisticated purchasers, even sophisticated purchasers are likely to be confused when the marks TIMEZONE and TIMEZONE and design are used on the same services. *In re Hester Industries, Inc.*, 231 USPQ 881, 883 (TTAB 1986) ("While we do not doubt that these institutional purchasing agents are for the most part sophisticated buyers, even sophisticated purchasers are not immune from confusion as to source where, as here,

substantially identical marks are applied to related products").

Finally, applicant has attached four registrations to its reply brief. While we normally do not consider new evidence submitted with appeal briefs, the examining attorney, at oral argument, stated that he did not object to our consideration of these registrations. We agree that they do not support applicant's argument that there is no likelihood of confusion here. The "third party registrations relied upon by applicant cannot justify the registration of another confusingly similar mark." *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987), quoting *Plus Products v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983). These registrations for marks consisting of or containing the words TIME ZONE or variations thereof are for unrelated goods and services such as leisure centers and arcade facilities services, electronic controllers for controlling volume and radio programs. The only registration that is even remotely relevant is one for business advertising cards and brochures and flyers in the field of advertising (No. 3145669). These registrations hardly demonstrate that the word TIMEZONE is weak or entitled only to a narrow scope of protection.

Therefore, we conclude that there would be a likelihood of confusion if applicant's mark TIMEZONE and design was used in association with the identified services in view of the registered marks TIMEZONE and TIMEZONE and design for the identified goods and services.⁴

Decision: The examining attorney's refusal to register applicant's mark under Section 2(d) of the Trademark Act is affirmed.

⁴ A refusal under Section 2(d) is proper if there is a likelihood of confusion involving any of the goods and/or services set forth in the application and cited registration. See, e.g., *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); and *Shunk Mfg. Co. v. Tarrant Mfg. Co.*, 318 F.2d 328, 137 USPQ 881, 883 (CCPA 1963).