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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Day-Timers, Inc.
v.
Medley & Associates, Inc.

Opposition No. 101,705
to application Serial No. 74/686,830
filed on June 12, 1995

William G. Pecau and Kelly D. Talcott of Pennie & Edmonds, LLP, for Day-Timers, Inc.

Leroy D. Medley for Medley & Associates, Inc.

Before Hairston, Wendel and Bucher, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

An application has been filed by Medley & Associates, Inc. to register the mark NIGHT-TIMER for "cushioned note pad holder with illuminated writing device for use in bed or during other times of darkness," in International Class 16.[1]

Registration has been opposed by Day-Timers, Inc. on the ground that applicant's mark, when applied to applicant's goods, so resembles opposer's previously used and registered mark DAY-TIMER, registered alone and in

[1] Serial No. 74/686,830, filed on June 12, 1995, alleging a *bona fide* intention to use the mark in commerce.

conjunction with other matter, for binders, fillers, writing pads, note pads, organizers and other stationery, as well as a wider array of other home and office supplies and services, as to be likely to cause confusion, to cause mistake or to deceive under Section 2(d) of the Trademark Act. In addition to its trade name usage of Day-Timers, and its common law rights, opposer pled ownership of the following incontestable federal trademark registrations:

- DAY-TIMER, as shown below, for "binders and fillers therefor" [2]

DAY-TIMER

- WEEKLY DAY-TIMER, for "binders and fillers therefor" [3]

- POCKET DAY-TIMER, as shown below, for "binders and fillers therefor" [4]

Pocket
DAY-TIMER

- DAY-TIMER TIME-SAVER, as shown below, for "blank or partially printed forms – namely, letters, memos, telephone pads, invoices, purchase orders, receipts and record forms" [5]

DAY/TIMER
time-Saver

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[2] Reg. No. 706,673, issued on November 1, 1960; second renewal.
[3] Reg. No. 846,278, issued on March 19, 1968; renewed.
[4] Reg. No. 873,025, issued on July 15, 1969; renewed.
[5] Reg. No. 879,092, issued on October 21, 1969; renewed. The term "time-saver" is disclaimed apart from the mark as shown.

- DAY-TIMER TRACKER, for “blank and partially printed forms” [6]

and

- DAY-TIMER COMPANION, for “time planner book” [7]

Applicant, in its answer, denied the salient allegations of the notice of opposition.

The record consists of the pleadings; the file of the involved application; the testimony, with exhibits, of opposer’s vice president and general manager of the product team, David K. Clark; and opposer’s notice of reliance on seven federal registrations for DAY-TIMER marks, the discovery deposition testimony of Leroy B. Medley and the exhibits thereto, and certain of applicant’s responses to opposer’s first set of interrogatories. Applicant neither took testimony nor introduced any other evidence. Only opposer filed a brief on the case and no oral hearing was requested.

According to Mr. Clark, opposer’s vice president, Day-Timers, Incorporated has been in business for more than fifty years, and has been marketing a broad line of planners, organizers and accessories under the DAY-TIMER

[6] Reg. No. 1,411,294, issued on September 30, 1986; §8 affidavit accepted and §15 affidavit acknowledged.
[7] Reg. No. 1,699,805, issued on July 7, 1992; §8 affidavit accepted and §15 affidavit acknowledged.

mark for more than forty years. As seen above, its federal registrations also date back more than forty years.

We turn, then, to the issues of priority and likelihood of confusion.

In view of opposer's ownership of valid and subsisting registrations for its pleaded marks, there is no issue with respect to opposer's priority. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our determination under Section 2(d) of the Lanham Act is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The factors deemed pertinent in this proceeding now before us are discussed below.

We begin our analysis with the finding that opposer's DAY-TIMER mark is famous. As our primary reviewing court, the Court of Appeals for the Federal Circuit, has stated on a number of occasions, the fame of the prior mark plays a dominant role in cases featuring a famous or strong mark. *Kenner Parker Toys Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). This is because a mark with extensive public recognition and renown deserves

and receives more legal protection than an obscure or weak mark.

In the instant case, we find that opposer has established the fame of its marks. The DAY-TIMER marks have been used extensively throughout the United States for forty years, the annual volume of sales is extremely large, and in recent years, opposer has spent extensive amounts on advertising and promotion, including an annual volume of more than twenty-five million pieces of direct mail sent to current and prospective customers. Finally, Mr. Clark's summary of the results of consumer surveys (conducted by opposer through an independent research organization) support our finding of fame.

We turn then to consider the relationship between opposer's and applicant's goods, applying the following general principles to this determination. It is not necessary that these respective goods be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods are related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would 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 or connection between the producers of the respective goods. *See In re Melville Corp*., 18 USPQ2d 1386 (TTAB 1991*);* and *In re International Telephone & Telegraph Corp*., 197 USPQ 910 (TTAB 1978).

While many of opposer's partially printed filler pages comprise time management forms, the Day-Timers' catalogues made a part of this record during the testimony of Mr. David K. Clark reveal the wide variety of largely blank pages marketed by opposer. While most fillers are designed to fit the binders originally purchased for time management purposes, opposer markets note pads and note pad holders having purposes ranging from general note-taking to some very specific uses (e.g., keeping track of daily exercise, dietary habits, insurance information, inventories of household contents, etc.). Products are specifically designed for professionals to use in their working lives, for adults in their private lives, for students in recording assignments or even for busy families in staying organized. The note pad holders range from simple desk-top holders and portable binders to elaborate multi-purpose travel systems. Some even incorporate electronic gadgets like clocks, alarms and calculators.

Except for the fact that it will provide its own source of illumination, applicant's note pad holder would necessarily be quite similar to opposer's goods, especially

its binders, fillers, writing pads and note pads. The year-to-year changes in its catalogues demonstrate that opposer is constantly adding new items to its product line. According to opposer's vice president, opposer conducts extensive market research among members of the purchasing public in order to discover what new kinds of products its customers might want. Hence, if there is a market for illuminated note pad holders, adding a source of illumination to its existing note pads would certainly be a logical zone of expansion for opposer. Moreover, given the variety of sizes of note pads put out by opposer, one or more of opposer's DAY-TIMER note pads could certainly be used with applicant's NIGHT-TIMER note pad holder. Accordingly, we find that these products are complementary and otherwise very closely related items.

As to channels of trade, applicant has included no restriction to trade channels or purchasers in its identification of goods. Thus, the Board must consider that the parties' respective goods could be offered and sold to the same class of purchasers through all normal channels of trade, including direct mailings, stationery supply catalogues, and in side-by-side displays in retail stores. *See In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994); and *In re Elbaum*, 211 USPQ 639 (TTAB 1981). In fact, in considering the class of purchasers at issue herein,

applicant's representative testified that applicant intended to seek out "the motivational self-help market." That would appear to be a precise description of a key segment of opposer's established market. Finally, nothing in this record persuades us that purchasers of the types of goods identified in the application and in the registrations are necessarily sophisticated purchasers who might well be immune to source confusion when faced with similar marks on the related goods involved in this case. *See Refreshment Machinery Incorporated v. Reed Industries, Inc.*, 196 USPQ 840 (TTAB 1977).

We turn next to a determination of whether applicant's mark and the registered mark, when viewed in their entireties, are similar in terms of appearance, sound, connotation and commercial impression. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.,* 190 USPQ 106 (TTAB 1975).

The marks DAY-TIMER and NIGHT-TIMER have the same number of syllables and are constructed identically (i.e., the single syllable word DAY or NIGHT, followed by a hyphen and then the word TIMER). The ideas of day and night are logically related and the words are combined in a variety of ways within a single expression in everyday language. Hence, these combined terms have similar connotations. Despite the differences in appearance and sound, we find that these two marks have very similar overall commercial impressions.

Furthermore, night is inextricably related to day. Even those buyers or prospective purchasers of note pads and note pad holders who may notice the differences between applicant’s NIGHT-TIMER mark and any of opposer’s DAY-TIMER marks could still reasonably assume that applicant’s NIGHT-TIMER note pad holder constitutes a new or companion product line from the same source as the DAY-TIMER products with which they are acquainted or familiar. This would be especially true for those knowing that over the years, many of opposer’s DAY-TIMER time management devices have been expanded beyond the traditional work-day hours (e.g., 7:00 AM to 6:00 PM) to include evening hours through 11:00 PM, and even a growing line of twenty-four hour ("midnight to midnight") formats.

Accordingly, upon weighing all of the relevant *du Pont* factors, and particularly on the basis of the fame of opposer's mark, the similarity of the marks and the close relationship of the goods upon which the marks are being, or will be, used, we find the balance to fall in opposer's favor. If any doubt remains, this also must be resolved in favor of opposer as the senior user of its famous mark and against applicant as the newcomer. *See TBC Corp. v. Holsa, Inc*., 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997); and *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp*., 565 F.2d 683 , 196 USPQ 1 (CCPA 1977). We find that there is a likelihood of confusion if applicant were to use his mark NIGHT-TIMER in connection with illuminated memo pad holder, in view of opposer's use of the mark DAY-TIMER on its closely related items.

Decision: The opposition is sustained.