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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Men's Fitness Unlimited, LLC

Serial No. 76640536

Myron Amer of Myron Amer, P.C. for Men's Fitness Unlimited, LLC.

Nakia D. Henry, Trademark Examining Attorney, Law Office 111
(Craig D. Taylor, Managing Attorney).

Before Grendel, Holtzman and Zervas, Administrative Trademark
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Men's Fitness Unlimited, LLC (applicant) filed an application to register on the Principal Register the standard character mark THE FITNESS SNEAKER for goods identified, as amended, as "footwear, namely, sneakers with structural features to contribute to fitting comfort during use thereof" in Class 25.

The application (Serial No. 76640536) was filed on June 10, 2005 based on an allegation of a bona fide intent to use the mark in commerce. On November 5, 2007, applicant filed an allegation

of use, asserting dates of first use and first use in commerce of February 14, 2007, which was accepted by the trademark examining attorney on October 20, 2009.¹

Before the allegation of use was filed, the examining attorney had refused registration on the ground that the mark is merely descriptive of the goods under Section 2(e)(1) of the Trademark Act. Applicant appealed from that refusal and subsequently filed both an amendment of the application to the Supplemental Register and its allegation of use. Then, the examining attorney refused registration under Section 23 of the Act on the ground that the mark is generic for the goods.

Both refusals were ultimately made final, and applicant appealed. Both applicant and the examining attorney have filed briefs.²

Two preliminary matters require our attention. First, we note that applicant's amendment to the Supplemental Register was unequivocal and clearly not made in the alternative, and should

¹ The amendment to allege use was filed after applicant had filed an appeal to the Board based on the examining attorney's initial refusal, discussed *infra*, but was ultimately accepted following remand of the application to the examining attorney, for consideration of applicant's amendment to seek registration on the Supplemental Register, also discussed *infra*.

² The record includes two sets of appeal briefs. Applicant briefed the Section 2(e)(1) refusal before the Board remanded the application to the examining attorney to consider the amendment to the Supplemental Register. In the second set of briefs, applicant and the examining attorney have addressed both refusals. Any citation to the briefs in this decision will be identified by the date on which the particular brief was filed.

have rendered the Section 2(e)(1) refusal moot. However, inasmuch as the examining attorney treated it as an alternative amendment by continuing to maintain the refusal under Section 2(e)(1), and since applicant then proceeded to argue in the alternative for registration on either the Principal or Supplemental Register, we will decide both issues.

We also note that an additional issue on appeal, as framed by the examining attorney, concerns a requirement that applicant withdraw its disclaimer of "FITNESS SNEAKER." The basis for this requirement was applicant's response to the Section 2(e)(1) refusal wherein applicant requested "Reconsideration of...the issue refusing registration of the word THE separate and apart from the disclaimed FITNESS SNEAKER." Resp., October 10, 2006. When the requirement was made final, applicant responded, "the disclaimer of SNEAKER is no longer warranted, and the requirement for the disclaimer should be overruled." Paper titled "Reply Brief" dated May 14, 2007. We are perplexed by what applicant meant by those statements. The examining attorney of course never refused registration of the word THE apart from the rest of the mark; and at no time did she require a disclaimer. At the same time, however, we do not view applicant's statement as a proffered disclaimer of FITNESS SNEAKER. Therefore, we do not consider any disclaimer to be properly of record and the requirement to withdraw a disclaimer is moot.

We turn then to the question of genericness. The test for determining whether a mark is generic involves a two-step inquiry. First, what is the genus (category or class) of goods or services at issue? Second, is the term sought to be registered understood by the relevant public primarily to refer to that genus (category or class) of goods or services? See *In re Reed Elsevier Properties Inc.*, 482 F.3d 1376, 82 USPQ2d 1378, 1380 (Fed. Cir. 2007) (quoting *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986)).

The Office has the burden of proving the genericness of a term by "clear evidence" of the public's understanding thereof. *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987).

We note at the outset that applicant submitted various amendments to the identification of goods, originally identified as "sneakers," in an apparent attempt to avoid a finding of genericness. After amending its application to the Supplemental Register and in response to the examining attorney's refusal to register on the ground of genericness, applicant amended the identification to read "footwear, namely sneakers with structural features to contribute to fitting during use." Following the final refusal on that ground, applicant again amended the identification, this time to its present form, "footwear, namely,

sneakers with structural features to contribute to fitting comfort during use thereof."

The genus or category of goods in this case is the wording used in the identification, i.e., sneakers. See *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991). The fact that the sneakers are structured to fit a certain way does not change the nature of the goods as sneakers or the name of the category of goods as sneakers.

The relevant public for applicant's sneakers includes ordinary members of the general public, and we determine the meaning of THE FITNESS SNEAKER to that class of purchasers. Evidence of the relevant public's understanding of a term may be obtained from any competent source including consumer surveys, dictionary definitions, newspapers and other publications. See *Reed Elsevier Properties Inc.*, supra at 1380. In addition, third-party websites are competent sources to show what the relevant public would understand a term to mean. *Id.* at 1381.

The examining attorney has submitted dictionary definitions of the word "fitness" as: "2. Good health or physical condition, especially as the result of exercise and proper nutrition"; and a definition of "sneaker" as: "2. A sports shoe usually made of canvas and having soft rubber soles. Also called *tennis shoe*."³

³ Both definitions are from *The American Heritage® Dictionary of the English Language* (Fourth Edition 2000) (bartleby.com).

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Based on the definitions, the combined term "fitness sneaker" indicates a sports shoe used for physical activity or physical fitness.

The examining attorney has introduced printouts from various retail websites showing that sneakers used for fitness activities are typically referred to as a "fitness sneaker," and that they are advertised and promoted by others as a "fitness sneaker." Some examples are as follows (emphasis added):

Yahoo! Shopping

Nike "Air Zoom Danzante" Dance Fitness Shoe (Women)
Stylish **fitness sneaker** is perfect for dancing.
Midfoot construction provides flexibility for
pointing and arch support while standing.
\$89.95
shopping.yahoo.com

CBS SPORTS STORE

New Balance WX716 Fitness Shoe Womens
Our Price: \$69.99
The women's New Balance® WX716 **fitness sneaker** is
designed to provide an optimal blend of speed and
comfort for the athlete looking for a competitive
edge. Abzorb® in the heel and forefoot provide
exceptional shock absorption, while N-Lock® enhances
midfoot support.
cbs.sportsline.com

ARKAMIX For the Love of the Swoosh

Nike Air Elite Performance High 1990
Women['s] very simple **fitness sneaker**
arkamix.com

Men's Fila Original Fitness 11F16LT/970

Price: \$64.95
Product Description:
A comfortable **fitness sneaker** that offers great
support and comfort.
amazon.com

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Marty's Shoes
Womens Avia 644 Fitness
Category: Women's Sneakers Fitness.
Style: Super light **fitness sneaker** with seven eyelet
lacing.
shop.com

Other online retailers, such as macys.com; shopzilla.com; zappos.com; amazon.com; and dickssportinggoods.com, list "fitness sneakers" as a category of goods. For example, the website shopwiki.com includes a category for "Women[']s Fitness Sneakers"; and the website like.com states "Shop for fitness sneakers - Men's Shoes like Brooks - Infiniti 2 - ...and more..." followed by pages displaying various brands of fitness sneakers, including Brooks, Reebok, Fila and New Balance.

The evidence also shows that other producers of sneakers, including Reebok, one of applicant's direct competitors,⁴ use "fitness sneaker(s)" as part of the brand names to designate the type of sneaker, for example, Reebok Cardio Craze Low Women[']s Fitness Sneaker (boddit.com); and Nike Air Max Fitness Sneakers (thisnext.com). Thus, the term FITNESS SNEAKER in applicant's mark could not identify the source of sneakers as emanating solely from applicant.

It is clear from the evidence that "fitness sneaker" is a generic term, commonly used by others and understood by the public to denote a particular type of sneaker. The genus of

⁴ See Resp., October 10, 2006 and accompanying declaration discussed infra.

applicant's goods, which is defined as "sneakers," albeit sneakers structured to fit a certain way, encompasses the type of sneaker known as a "fitness sneaker," and thus identifies at least one category of sneaker.

Applicant's own evidence shows that "fitness sneakers" are literally the goods sold by applicant. Applicant submitted the declaration of Gail A. Hill Williams, an "executive member" of applicant, stating that "one of applicant's best-selling products is a sneaker, the sale of which is in direct competition with major sneaker manufacturers selling under the brand names of Reebok, Fila and Avia." Resp., October 10, 2006; Decl., ¶3. Ms. Williams also acknowledges "the common effort in the trade of the brands to promote their product as 'a fitness sneaker'" and that the advertising of the major competitive brands typically "extols the virtue of the sneakers to improve fitness." Id., at ¶¶4-5.

The question is whether the addition of the word "THE" turns the unregistrable term FITNESS SNEAKER into a trademark. We find that it does not. As discussed in a number of cases, the article "THE" has no source-indicating capacity when added to an otherwise descriptive or generic term. See, e.g., In re The Place Inc., 76 USPQ2d 1467, 1468 (TTAB 2005) (THE GREATEST BAR laudatory and merely descriptive of restaurant and bar services, stating that "the definite article THE and the generic term BAR...add no source-indicating significance to the mark as a

whole."). See also *S.S. Kresge Company v. United Factory Outlet, Inc.*, [Fed. cite unavailable], 209 USPQ 924, 928 (D. Mass. 1980) ("The Mart" generic for retail stores; "The addition of the prefix 'The' as indicating a possible uniqueness cannot change the basic meaning of the term [Mart]"); *The Conde Nast Publications Inc. v. The Redbook Publishing Company*, 217 USPQ 356, 357 (TTAB 1983) (THE MAGAZINE FOR YOUNG WOMEN generic for magazines; "The fact that the slogan also includes the article 'The' is insignificant. This word cannot serve as an indication of origin."); and *In re The Computer Store, Inc.*, 211 USPQ 72 (TTAB 1981) ("The Computer Store").

We acknowledge that, technically, THE FITNESS SNEAKER is a unitary phrase, and under a literal reading of *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999) by our primary reviewing Court, the evidence would have to demonstrate use of "the fitness sneaker" as a whole in order to find it generic. However, we do not believe that *American Fertility* can be read to allow an applicant to take a clearly generic term and add to it a non-source identifying article such as "the" or "a" and thereby create a trademark. This is true even in the absence of proof that others have used "fitness sneaker" in conjunction with the article "the" just as they have used it with the article "a." See *In re Wm. B. Coleman Co.*, 93 USPQ2d 2019, 2025 (TTAB 2010) (finding ELECTRIC CANDLE COMPANY a

combination of two generic terms, ELECTRIC CANDLE and COMPANY, joined to create a compound term, but also finding it generic even if considered a phrase, and even in the absence of evidence of use of ELECTRIC CANDLE COMPANY as a phrase: "There is no logical basis upon which to conclude that Gould would have yielded a different result if the mark had been SCREEN WIPE rather than SCREENWIPE.").

We find that the article THE contributes nothing of significance to the composite term, THE FITNESS SNEAKER. The evidence is clear that consumers would view FITNESS SNEAKER as a generic term, and it is also clear that consumers encountering THE FITNESS SNEAKER, a slight variation of FITNESS SNEAKER, would similarly understand the term to identify a type of sneaker.

We note applicant's argument that FITNESS SNEAKER does not "simply promote [applicant's] sneaker as just another one being as good as a brand-name sneaker, but rather as being THE, emphasis on 'the' FITNESS SNEAKER, the emphasis being intended by [applicant] to indicate [applicant's] sneaker is the 'best'...."⁵ Decl. October 5, 2006, ¶5. Such an argument was previously rejected by the Board in *In re J.D. Searle & Co.*, 143 USPQ 220, 222-23 (TTAB 1964), *aff'd*, 360 F.2d 650, 149 USPQ 619 (CCPA

⁵ Applicant's subsequent claim in its reply brief (April 5, 2010) that "'THE' as used by applicant, is not 'puffing'" is directly contradicted by the above statement by Ms. Williams. Furthermore, in light of this statement by Ms. Williams, applicant's claim that the examining attorney "misstates applicant's use of the term 'THE' to indicate that the goods are 'the best'" is not understood.

1966). The Board refused to give any weight to applicant's arguments concerning "the 'unique' effect created by the utilization of the article 'THE' in association with the mark 'PILL' and by the use of quotation marks around the unitary phrase":

Manifestly, the utilization of the article "the" and of quotation marks cannot convert a simple notation comprising ordinary words of the English language used in their ordinary sense into a registrable trademark.

See also *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999) (addressing the concept of touting a particular product as "the best," and finding THE BEST BEER IN AMERICA for beer to be "so highly laudatory and descriptive of the qualities of [applicant's] product that the slogan does not and could not function as a trademark to distinguish Boston Beer's goods and serve as an indication of origin."); and *S.S. Kresge Company*, *supra*.

To further support its position that THE FITNESS SNEAKER is not generic, applicant argues that FITNESS in the mark refers to the way the sneakers "fit"; that applicant's focus is "on the fitting of the sneaker as measured by its comfort on the user's foot"; and that the meaning consumers would give to the word FITNESS "is in association with the attributes of the sneaker and not with their health and end use of the sneaker." Brief,

February 20, 2007, p.2; Decl., ¶5; Reply Brief, May 14, 2007; Decl., ¶3.

These arguments are unpersuasive. First, Ms. Williams' earlier statement that "applicant's primary line of products is equipment which enhances the physical fitness of its customers" tends to undercut applicant's subsequent claim that THE FITNESS SNEAKER refers to or would be perceived as something other than a sneaker for physical fitness. Resp., October 10, 2006; Decl, ¶2. Furthermore, the claimed attributes of fitness and comfort are obviously not unique to applicant's sneakers; these are necessary attributes of any "fitness sneaker." Indeed, the evidence shows that others similarly promote the comfort and fit of their own "fitness sneakers."

Finally, there is no evidence that the word "fitness" in this mark would be perceived by consumers as meaning a sneaker that fits well. The examining attorney has submitted entries for "fitness" from a number of dictionaries, not one of which indicates that the term has, or even suggests, that meaning. Applicant, however, claims that the *Random House Webster's College Dictionary* includes a definition for "fitness" as "18. something that fits; the coat is a poor fit." See, e.g., Resp., October 29, 2009; Brief, p. 2 (December 29, 2009). Applicant has failed to submit a copy of the relevant page from this dictionary and we do not take judicial notice of it. In fact, applicant's

characterization of this entry as a definition of "fitness" is not accurate. The illustrative example in the cited definition shows the context of use for a different word, "fit" ("the coat is a poor fit"), not "fitness."

The term THE FITNESS SNEAKER is generic and incapable of distinguishing applicant's goods from similar goods of others. Thus, the designation is not registrable on either the Principal Register or the Supplemental Register. In view of applicant's "alternative amendment" to the Supplemental Register, we will now assume that THE FITNESS SNEAKER is not generic and decide the question of whether the mark is merely descriptive.

If THE FITNESS SNEAKER is not generic, then the term is certainly descriptive of applicant's goods. The dictionary definitions, website printouts and applicant's own statements show that the term is highly descriptive of a type of sneaker, or a significant feature or characteristic of sneakers, i.e., that they are or can be used for fitness. There is no doubt that consumers would immediately, and without the exercise of any imagination, understand the descriptive meaning of THE FITNESS SNEAKER in relation to sneakers.

Decision: The refusal to register under Section 23 of the Trademark Act on the ground that the mark is generic for the goods is affirmed; and the refusal to register on the ground that

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the mark is merely descriptive of the goods under Section 2(e) (1)
of the Act also is affirmed.