

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77637050
LAW OFFICE ASSIGNED	LAW OFFICE 112
MARK SECTION (no change)	
ARGUMENT(S)	
<p>This request for reconsideration is submitted in response to the Office Action mailed May 19, 2013, which the Applicant and Applicant's attorney have carefully considered.</p>	
<p><b><u>Likelihood of Confusion Analysis</u></b></p>	
<p>The examining attorney has refused Applicant's application for registration on the basis that Applicant's mark, when used in connection with the identified services, allegedly so closely resembles the mark in U.S. Registration No. 3897590 (the "<u>Cited Registration</u>") as to be likely to cause confusion, to cause mistake, or to deceive. The Cited Registration, owned by Inspire Health, Inc. ("<u>Registrant</u>"), is for the single compound word <b>InspireHealth</b> accompanied by the design of an apple with a human figure representation in the middle (the "<u>Cited Mark</u>"), as applied to "CDs and DVDs featuring information about benefits, health and wellness; computer software used to provide individuals with education and tracking tools in the fields of benefits, health and wellness," in Class 9; "Printed educational materials, namely, books, workbooks, pamphlets, pocket guides and planners related to benefits, health and wellness," in Class 16; "Business management consulting and providing information about healthcare business plan development; business consulting in the fields of clinical trend analysis and cost management of health benefit and wellness plans; website used to provide individuals with information and tracking tools in the field of employee benefits," in Class 35; "Educational services, namely, facilitating, monitoring and coaching workshops and training sessions related to benefits, health and wellness," in Class 41; and "Website used to provide individuals with information and tracking tools in the field of health and wellness," in Class 44.</p>	
<p>In the Office Action, the examining attorney analyzes the three factors he determines most relevant: "similarity of the marks, similarity and nature of the goods and/or services, and similarity of the trade channels for the goods and/or services." See Office Action (internal citations omitted).</p>	
<p>Applicant respectfully submits that the Cited Mark and the Applicant's mark are sufficiently distinguishable so as to not cause a likelihood of confusion on the basis of their appearance, sound, connotation and commercial impression. Applicant further contends that the Examining Attorney fails</p>	

to give ample consideration to the differences in the goods to which each mark is applied.

### Comparison of the Marks

The points of comparison for a word mark are appearance, sound, meaning, and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369 (Fed. Cir. 2005). “Even close similarity between two marks is not dispositive of the issue of likelihood of confusion. Similarity itself is not an acid test. Whether the similarity is likely to provoke confusion is the crucial question.” *McGregor-Doniger Inc. v. Drizzle Inc.*, 599 F.2d 1126, 1133 (2d Cir. 1979) (citation omitted), overruled on other grounds, *Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033, 1043-44 (2d Cir.1992). We note that in *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459 (Fed Cir. 1998), the court concluded that the mark **CRYSTAL CREEK** was unlikely to cause confusion with the registered mark **CRISTAL**, for the addition of the word “creek” made the two marks differ not only in appearance and pronunciation, but also with regards to their connotation (that of a very clear stream/creek v. the clarity of the wine in the bottle, or the bottle itself). The court reached this determination in spite of the fact that (i) the marks contained a common phonetic element (“crystal” and “cristal”), (ii) the class of goods for which the marks were used were the same (wine, including champagne), (iii) the goods traveled in the same trade channels, and (iv) the goods were purchased by the same or similar customers.

In the present matter, the Cited Mark differs both visually from Applicant’s mark. A preliminary matter, Applicant’s **INSPIRE HEALTH** trademark consists of two distinct words. In contrast, the verbal element of the Cited Mark is a unitary mark consisting of a single word. This is demonstrated by the fact that the term HEALTH was required to be disclaimed in the Applicant’s application, whereas no disclaimer of the descriptive term HEALTH was required in the Cited Registrations. If the literal elements INSPIRE and HEALTH had been deemed to create a unitary commercial impression, then a disclaimer for HEALTH would have been necessary for the same reasons the disclaimer was required by the examining attorney in the Applicant’s application.

More important, the Cited Mark includes a prominent design element. As the examining attorney has noted, greater weight is often given to the literal elements of a mark when comparing marks. However, the Federal Circuit has stated that “[t]here is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue.” *In re Electrolyte Laboratories Inc.*, 929 F.2d 645, 647, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (K+ and design for dietary potassium supplement held not likely to be confused with K+EFF (stylized) for dietary potassium supplement). TMEP §1207.01(c)(ii). In the present circumstances, the design element of the Cited Registration is the most prominent part of the mark, and consists of a highly distinctive and arbitrary apple design, which also incorporates a human figure (also arbitrary in the context of the goods and services). Accordingly, the design element should be considered the dominant portion of the mark. The absence of this design services to immediately distinguish the two marks visually when they are encountered by the relevant consumer.

In any event, notwithstanding any similarity between the Applicant’s mark and the Cited Mark, the differences in the goods and services and channels of trade, as discussed below, require a finding of an absence of a likelihood of confusion.

### Comparison of the Goods and Services

The examining attorney alleges that the Cited Registration identifies “workshops and training sessions related to benefits, health and wellness” as services provided by Registrant. This is incorrect. In fact, the identification is for “*Educational services*, namely, facilitating, monitoring and coaching workshops and training sessions related to benefits, health and wellness.” As such, it is clear that Registrant does not *provide* such workshops and training sessions, but instead *facilitates*, *monitors* and *coaches* such workshops and training sessions.

The omission by the Registrant of any reference to providing workshops and training sessions is no accident. In the context of the other services identified in the Registration, it is clear that, together with the business consulting services relating to healthcare business plan development and cost management of health benefit and wellness plans, the Registrant provides services facilitating, monitoring and coaching workshops and training sessions related to benefits, health and wellness provided by employers to employees. In any event, although such inference is clear from the context of the Registration, it is not necessary – the Registrant has not claimed that it actually *provides* such workshops and training sessions, so such workshops and training sessions must be provided by a third party.

Accordingly, a comparison of the services assuming that Registrant renders services not actually identified in the Cited Registration (i.e., “providing workshops and training sessions”) is inappropriate. We note that all of the registrations cited by the examining attorney as evidence involve registrants which actually provided the relevant workshops and training sessions – none limited their identification of services to merely “facilitating, monitoring and coaching.” Similarly, all of the third party websites purporting to show a common source involve third parties actually providing the relevant training sessions, not merely “facilitating, monitoring and coaching” such sessions.

Similarly, the examining attorney has indicated that third party registrations and internet evidence indicates that third parties offer CDs, DVDs, software and other publications pertaining to health and wellness also offer physical fitness instruction services. However, the examining attorney ignores the fact that the Registrant offers “CDs and DVDs featuring information about *benefits*, health and wellness” (emphasis added). Not a single registration or other citation identified by the examining attorney gives any indication that benefits are covered by the subject matter of the CDs, DVDs, software and other publications in question. This serves to demonstrate that a company providing CDs and DVDs featuring information about each of benefits, health and wellness is unlikely to be perceived as a potential source for physical fitness instruction services, or vice versa.

### Comparison of the Channels of Trade

As indicated in TMEP § 1207.01(a)(i), “if the goods or 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.”

As noted by the examining attorney, it is presumed that the goods and/or services identified in the Cited Registration travel in all normal channels of trade. As a service provider which *facilitates, monitors* and *coaches*, but which does not provide, workshops and training sessions, it necessarily follows that the recipient of the services rendered by Registrant under the Cited Mark is not the participants in such classes, but the third party which actually provides such workshops and training sessions. This conclusion is not based upon the improper imposition of restrictions in the Cited Registration, but is instead a natural conclusion based upon the normal channels of trade for services of the nature identified in the Cited Registration (i.e., services consisting of *facilitating, monitoring* and *coaching*, but which not *providing*, workshops and training sessions).

Simply put, no fair reading of the plain language of the identification of services in the Cited Registration leads to the conclusion that the Registrant is claiming to be a provider of health, wellness or fitness services to individuals. Rather, it is abundantly clear from the Registrant’s identification that the Registrant provides business services to employers in support of said employer’s employee benefits, including supporting said employer’s health and wellness programs.

As such, the recipients of Applicant’s services and Registrant’s services are two very different categories of consumer. The Applicant’s services, consisting of “Physical fitness consultation; physical fitness instruction and training services; pilates instruction; and Acupuncture; occupational therapy; physical therapy; physical rehabilitation; pain management services; massage therapy services; dietary nutrition counseling; Chinese herbal medicine treatment services; providing assistance, fitness evaluation and consultation to individuals to help them improve personal health and achieve fitness goals;” are provided to individuals, as indicated by their nature and by the express limitation specified in the identification. In contrast, the Registrant’s services, relating to “ *benefits, health and wellness*” (emphasis added) and consisting of consulting services and educational services (consisting of *facilitating, monitoring* and *coaching*, but not providing, employee training sessions) are rendered to organizations rather than individuals.

Accordingly, the channels of trade in which the services are performed are completely different. As such, this factor requires a finding of an absence of a likelihood of confusion.

**Conclusion**

Based on the foregoing, Applicant respectfully requests that the examining attorney’s refusal to register Applicant’s mark be withdrawn and Applicant’s mark be passed to publication.

<b>SIGNATURE SECTION</b>	
<b>RESPONSE SIGNATURE</b>	/scf/
<b>SIGNATORY'S NAME</b>	Sean C. Fifield
<b>SIGNATORY'S POSITION</b>	Attorney of Record, Illinois bar member
<b>SIGNATORY'S PHONE NUMBER</b>	312-443-1787
<b>DATE SIGNED</b>	

<b>DATE SIGNED</b>	11/18/2013
<b>AUTHORIZED SIGNATORY</b>	YES
<b>CONCURRENT APPEAL NOTICE FILED</b>	YES
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Tue Nov 19 01:11:38 EST 2013
<b>TEAS STAMP</b>	USPTO/RFR-67.98.107.2-201 31119011138762284-7763705 0-500a2f2b1673c9f32cdf43a 389f124997bab34818d96bf9d d89e54614cd847e3a-N/A-N/A -20131119005526786026

PTO Form 1930 (Rev 9/2007)  
OMB No. 0651-0050 (Exp. 05/31/2014)

## **Request for Reconsideration after Final Action To the Commissioner for Trademarks:**

Application serial no. **77637050** has been amended as follows:

### **ARGUMENT(S)**

**In response to the substantive refusal(s), please note the following:**

This request for reconsideration is submitted in response to the Office Action mailed May 19, 2013, which the Applicant and Applicant's attorney have carefully considered.

### **Likelihood of Confusion Analysis**

The examining attorney has refused Applicant's application for registration on the basis that Applicant's mark, when used in connection with the identified services, allegedly so closely resembles the mark in U.S. Registration No. 3897590 (the "Cited Registration") as to be likely to cause confusion, to cause mistake, or to deceive. The Cited Registration, owned by Inspire Health, Inc. ("Registrant"), is for the single compound word **InspireHealth** accompanied by the design of an apple with a human figure representation in the middle (the "Cited Mark"), as applied to "CDs and DVDs featuring information about benefits, health and wellness; computer software used to provide individuals with education and tracking tools in the fields of benefits, health and wellness," in Class 9; "Printed educational materials, namely, books, workbooks, pamphlets, pocket guides and planners related to benefits, health and wellness," in Class 16; "Business management consulting and providing information about healthcare business plan development; business consulting in the fields of clinical trend analysis and cost management of health benefit and wellness plans; website used to provide individuals with information

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### Conclusion

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**SIGNATURE(S)**

**Request for Reconsideration Signature**

Signature: /scf/ Date: 11/18/2013

Signatory's Name: Sean C. Fifield

Signatory's Position: Attorney of Record, Illinois bar member

Signatory's Phone Number: 312-443-1787

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 77637050

Internet Transmission Date: Tue Nov 19 01:11:38 EST 2013

TEAS Stamp: USPTO/RFR-67.98.107.2-201311190111387622

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