

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Mailed: July 22, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Intrafitt, Inc.

Serial No. 77644949

Intrafitt, Inc., pro se.

Kim Teresa Moninghoff, Trademark Examining Attorney,
Law Office 113 (Odette Bonnet, Managing Attorney).

Before Quinn, Holtzman and Cataldo,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

An application was filed by Intrafitt, Inc. to register in standard characters on the Principal Register the mark INTRAFITT INDIVIDUALIZED NUTRITION AND EXERCISE PROGRAMS for the following services: "weight reduction diet planning and supervision and physical fitness consultation" in International Class 44.¹

¹ Application Serial No. 77644949 was filed on January 7, 2009, based upon applicant's assertion of November 12, 1992 as a date of first use of the mark in commerce in connection with both classes of services (see amended identification, *infra*). In response to a requirement by the trademark examining attorney,

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, as used in connection with its services, so resembles the mark INTERFIT, previously registered on the Principal Register in typed or standard characters for "health spa services for corporate employees" in International Class 42², as to be likely to cause confusion. In addition the examining attorney, inter alia, required applicant to amend its application to reclassify "physical fitness consultation" in International Class 41. Applicant complied with this requirement; however, with its request for reconsideration of the Section 2(d) refusal, applicant submitted the following amendment to its recitation of services:

individualized exercise programs include [sic] a wide variety of physical conditioning services including[:] physical fitness consultation; personal fitness training services featuring aerobic and anaerobic activities combined with resistance and flexibility training; personal trainer services; personal training services, namely, strength and conditioning training; physical fitness conditioning classes; physical fitness instruction; physical fitness studio services, namely, providing group exercise instruction, equipment, and facilities; physical fitness training services; physical fitness training of individuals and groups

applicant disclaimed the exclusive right to use "INDIVIDUALIZED NUTRITION AND EXERCISE PROGRAMS" apart from the mark as shown.

² Registration No. 1623043 issued on November 13, 1990. Section 8 affidavit accepted; Section 15 affidavit acknowledged. Renewed.

in International Class 41; and

individualized nutrition programs include [sic] a wide variety of nutrition and dietary services including[:] weight reduction diet planning and supervision; dietary and nutritional guidance; nutrition counseling; nutritional therapy services; weight management services and/or weight maintenance programs; clinical and sports nutrition programs and counseling

in International Class 44.

The examining attorney rejected applicant's proposed amendment as falling outside the scope of the original recitation of services and issued a requirement that applicant either submit an acceptable amendment or revert to its original recitation of services. The examining attorney also continued the refusal to register under Section 2(d). When both the refusal and requirement were made final, applicant appealed. Applicant and the examining attorney filed briefs on the issue under appeal.

Evidentiary Matters

Before turning to the substantive grounds for refusal, we note that applicant has submitted for the first time as an exhibit to its brief the filing receipt from its September 25, 2010 communication to the examining attorney, as well as other materials previously made of record. Materials already of record should not be resubmitted with a brief on appeal. See TBMP §§ 1203.02(e) and 1207.01 (3d

ed. 2010). With regard to the filing receipt that was not previously made of record, Trademark Rule 2.142(d), 37 C.F.R. §2.142(d), provides that the record in an ex parte proceeding should be complete prior to appeal, and exhibits submitted for the first time with an appeal brief are untimely and generally will not be considered. See TBMP § 1207.01.

Accordingly, applicant's exhibit consisting of its September 25, 2010 filing receipt will be given no consideration. We note nonetheless that had we considered this exhibit in our determination, the result would be the same inasmuch as the filing receipt no probative value on the issues before us.

Proposed Amendment to Recitation of Services

We turn first to our determination with regard to applicant's proposed amendment to its recitation of services. Section 7(c) of the Trademark Act provides, in part, as follows:

Contingent on the registration of a mark on the principal register provided by this Act, the filing of the application to register such mark shall constitute constructive use of the mark, conferring a right of priority, nationwide in effect, on or in connection with the goods or services specified in the registration...

15 U.S.C. § 1057. Thus, the identification of goods or services in an application defines the scope of those

rights established by the filing of an application for registration on the Principal Register. See TMEP §1402.06 (7th ed. 2010). An applicant may not expand those rights through amendment of the identification of goods or services. See TMEP §1402.06(b) (7th ed. 2010).

In accordance therewith, amendments to the identification of goods or services are governed by Trademark Rule 2.71(a), which provides as follows: "The applicant may amend the application to clarify or limit, but not to broaden, the identification of goods and/or services." 37 C.F.R. §2.71(a). Accordingly, an applicant may not amend an identification of goods or services to add or substitute a term that is not logically included within the scope of the terms originally identified or that is otherwise qualitatively different from the goods and services as originally identified. See TMEP §1402.06(a) (7th ed. 2010). In addition, TMEP §1402.07(d) (7th ed. 2010) provides, in part, as follows:

If the applicant proposes an amendment to the identification of goods and services, and the examining attorney determines that the amendment is unacceptable, the examining attorney should refer to the identification of goods before the proposed amendment to determine whether any later amendment is within the scope of the identification. In such a case, the applicant is not bound by the scope of the language in the proposed amendment but, rather, by the language

of the identification before the proposed amendment.

Thus, the scope of the goods or services as originally identified or as amended by an express amendment, establishes the outer limit for any later amendments. See Id.

In this case, applicant's services originally were identified in its application as "physical fitness consultation" in Class 41 and "weight reduction diet planning and supervision" in Class 44. In accordance with the above authorities, applicant is limited in any proposed amendment to its recitation of services solely to narrowing or clarifying those services as originally recited. Applicant's proffered amendment of its recitation of services retains the original services recited in both Classes; however, the proposed amendment also recites numerous additional services that fall outside the scope of the original. As discussed above, it is settled that once the extent of an identification has been established, it cannot be expanded later. See *In re Swen Sonic Corp.*, 21 USPQ2d 1794 (TTAB 1991); and *In re M.V Et Associes*, 21 USPQ2d 1628 (Comm'r Pats. 1991). Applicant therefore is limited in any amendment solely to narrowing or clarifying the nature and type of the applied-for "physical fitness

consultation" and "weight reduction diet planning and supervision" with greater particularity. See TMEP §1402.03(a), *supra*. Inasmuch as the proposed recitation of services neither narrows nor clarifies the original, it was unacceptable and properly rejected.

In view thereof, the "physical fitness consultation" and "weight reduction diet planning and supervision" originally recited in the application are the operative services herein.

Likelihood of Confusion

Our determination of the issue of likelihood of confusion 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, 567 (CCPA 1973). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 27 (CCPA 1976). See also *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).

The Marks

We turn to the first *du Pont* factor, i.e., whether applicant's INTRAFITT INDIVIDUALIZED NUTRITION AND EXERCISE PROGRAMS mark and registrant's INTERFIT mark are similar or dissimilar when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The test, under the first *du Pont* factor, 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.

In this case, applicant's mark, INTRAFITT INDIVIDUALIZED NUTRITION AND EXERCISE PROGRAMS, consists of the distinctive term INTRAFITT and the highly descriptive, disclaimed wording INDIVIDUALIZED NUTRITION AND EXERCISE PROGRAMS. For this reason we find that INTRAFITT is the dominant portion of applicant's mark. It is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for

rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). In view of the descriptive, if not generic, nature of INDIVIDUALIZED NUTRITION AND EXERCISE PROGRAMS, this wording has little, if any, source-indicating significance, and is entitled to less weight in the likelihood of confusion analysis.

Moreover, the significance of INTRAFITT in applicant's mark INTRAFITT INDIVIDUALIZED NUTRITION AND EXERCISE PROGRAMS is reinforced by its location as the first word in the mark. *Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed in the mind of a purchaser and remembered"). *See also Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers must first notice the identical lead word).

In comparing the marks we find that registrant's INTERFIT mark is highly similar to INTRAFITT, which as discussed above is the distinctive and dominant portion of applicant's mark. INTERFIT and INTRAFITT are highly

similar in appearance and sound and, to the extent the terms convey any meaning, both may suggest fitness within or among members of a group or organization. We further observe that the similarities between the marks are enhanced because consumers are often known to use shortened forms of names, and it is foreseeable that applicant's services will be referred to as INTRAFITT. *Cf. In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 219 (CCPA 1978) [Rich, J., concurring: "the users of language have a universal habit of shortening full names - from haste or laziness or just economy of words"].

Finally, we note that both applicant and registrant display their marks in typed or standard character form. Thus, we are not concerned with the possibility that either may present its mark in stylized form or as part of a logo inasmuch as both may display their marks in any stylized font or format, including an identical manner. *See* Trademark Rule 2.52(a). *See also, e.g., In re Melville Corp.*, 18 USPQ2d 1386, 1387-88 (TTAB 1991); and *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988).

As a result, we find that, taken as a whole, applicant's INTRAFITT INDIVIDUALIZED NUTRITION AND EXERCISE PROGRAMS mark and registrant's INTERFIT mark are more similar than dissimilar in appearance, sound and

connotation and that, taken as a whole, the marks convey highly similar overall commercial impressions.

The Services

Turning now to our consideration of the identified services, we note that it is not necessary that the services at issue be the same, or even similar or competitive, or even that they move in the same channels of trade, to support a holding of likelihood of confusion. It is sufficient instead that the respective services are related in some manner, and/or that the conditions and activities surrounding the marketing of the services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. *See In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

In this case, applicant's services are identified as "physical fitness consultation" and "weight reduction diet planning and supervision" and registrant's services are "health spa services for corporate employees." We hereby grant the examining attorney's request to take judicial notice of the following definition of "health spa:" "a commercial establishment without accommodations that offers

facilities for health and fitness" or "a commercial establishment similar to a hotel, usually rural, that offers ways of improving health and fitness such as a controlled diet, exercise, and massage."³ Thus, registrant's spa services offer to corporate employees fitness and diet services of the kind offered by applicant. Put another way, applicant's recited services are included among those registrant provides to corporate employees. As such, there appears to be significant overlap between the services as identified.

In addition, the examining attorney has made of record a number of use-based, third-party registrations which show that various entities have adopted a single mark for services of the type that are identified in both applicant's application and the cited registration. See, *for example*:

Registration No. 2684176 for, *inter alia*, health spa and medical clinic services, namely, physical fitness consultation; weight management and diet planning and supervision;

Registration No. 3422681 for, *inter alia*, health spa services for health and wellness of the body

³ Encarta.msn.com. The Board may take judicial notice of online dictionaries available in printed format or online dictionaries that are readily available and capable of being verified, e.g., dictionaries that are available in specifically denoted editions via the Internet and CD-ROM. See 37 C.F.R. §2.122(a); *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828 (Fed. Cir. 2007); and *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

and spirit offered at a health facility; weight reduction diet planning and supervision; providing assistance, namely, one on one group personal training and physical fitness consultation...;

Registration No. 3504495 for, *inter alia*, providing assistance, personal training and physical fitness consultation to corporate clients and individuals...; weight reduction diet planning and supervision; health spa services for health and wellness of the mind, body and spirit offered in or from a remote, mobile or temporary on-site location; and

Registration No. 3035624 for, *inter alia*, health spa services...; weight reduction diet planning and supervision; physical fitness consultation.

Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993).

In addition, the examining attorney submitted evidence from informational and commercial Internet web sites suggesting that the same entities provide both applicant's and registrant's types of services. The following samples are illustrative:

Regency Health Spa offers a variety of diet and fitness programs
(pr.com/press-release/79459);

FitPath health spa offers diet and weight loss supervision and fitness consultation

(weight-loss-spa.com); and

Fit Tours offers spa vacations featuring diet supervision and fitness consultation (fitnesstouring.com).

Based upon the foregoing, we find that applicant's services are related to those provided by registrant, and further are of a type that may be marketed under the same marks.

Channels of Trade

It is settled that in making our determination regarding the relatedness of the parties' services, we must look to the services as identified in the involved application and cited registration. See *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 set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.") See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the

respective descriptions of goods.") Thus, while registrant offers its services solely to corporate employees, applicant's recitation of services contains no such limitations. Accordingly, applicant's services are presumed to move in all normal channels of trade and be available to all classes of potential consumers, including the corporate employees who utilize registrant's services. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). Thus, the same consumers, namely, corporate employees, may use both registrant's spa services and applicant's fitness and dietary services.

Decision of Prior Examining Attorney and Lack of Actual Confusion

Applicant argues that its applied-for mark was previously registered in stylized form for the same services and inadvertently cancelled. We appreciate applicant's frustration over the inconsistent examination given to its two essentially identical applications. Although consistency in examination and the register are commendable goals, we are not bound by the prior actions of examining attorneys. Thus, we are not bound by the previous examining attorney who apparently did not view applicant's mark as confusingly similar to the mark in the registration cited herein. See *In re Davey Products Pty*

Ltd., 92 USPQ2d 1198, 1206 (TTAB 2009) (“applicant is not automatically entitled to a return to the status quo...the Board is not bound by the decision of the prior trademark examining attorney”); *In re Ginc UK Ltd.*, 90 USPQ2d 1472, 1480 (TTAB 2007); and *In re Outdoor Recreation Group*, 81 USPQ2d 1392, 1399 (TTAB 2006). Further, we do not see the Office’s earlier view of applicant’s mark as raising a doubt about likelihood of confusion. See also *In re Nett Designs Inc.*, 236 F.3d 139, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“Even if prior registrations had some characteristics similar to [applicant’s] application, the PTO’s allowance of such prior registrations does not bind the Board or this court.”). Further, any suggestion that there has been no actual confusion between the marks, based on the coexistence of applicant’s previously issued registration and the cited registration, is entitled to little probative value in the context of this ex parte appeal. *In re Majestic Distilling Co., Inc.*, 65 USPQ2d at 1205.

Decision: The refusal of registration on both grounds is affirmed.