

From: Gartner, John

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Subject: U.S. TRADEMARK APPLICATION NO. 85360663 - THE MAXX FITNESS CLUBZZ - 021373.0200 - Request for Reconsideration Denied - Return to TTAB

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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

**APPLICATION SERIAL NO.** 85360663

**MARK:** THE MAXX FITNESS CLUBZZ



**CORRESPONDENT ADDRESS:**

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**GENERAL TRADEMARK INFORMATION:**  
<http://www.uspto.gov/main/trademarks.htm>

**APPLICANT:** First Maxx, LLC

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

021373.0200

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**REQUEST FOR RECONSIDERATION DENIED**

**ISSUE/MAILING DATE: 9/17/2012**

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. *See* 37 C.F.R. §2.64(b); TMEP §§715.03(a), 715.04(a). The refusal made final in the Office action dated February 21, 2012 is maintained and continue to be final. *See* TMEP §§715.03(a), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issues, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issues in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

Although most of applicant's arguments have been previously addressed by the examining attorney, applicant raised some new arguments that the examining attorney will briefly address here.

Applicant argues that "the Examining Attorney's dissection of the marks into parts, i.e. finding similarity by comparing MAX to MAXX and MAXX FITNESS to MAX FITNESS, is improper."

It is true that marks must be compared in their entireties and should not be dissected; however, a trademark examining attorney may weigh the individual components of a mark to determine its overall commercial impression. *In re Chatam Int'l Inc.*, 380 F.3d 1340, 1342, 71 USPQ2d 1944, 1946-47 (Fed. Cir. 2004); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985) (“[I]n articulating reasons for reaching a conclusion on the issue 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 . . . .”); *In re Kysela Pere et Fils, Ltd.*, 98 USPQ2d 1261, 1267 (TTAB 2011). That is what the examining attorney did in this case.

Applicant argues that the registered marks are not “companion marks” because even though they were originally owned by the same individual, that individual has since transferred ownership of one of the registrations to a limited liability company. Applicant argues that the registered marks must therefore be considered to be owned by separate entities, and if those two very similar marks can co-exist then applicant’s mark should be able to co-exist with them as well.

The recent assignment of one of the registered marks to a third party limited liability company has no relevance to this proceeding. At the time the marks were registered they were owned by the same party, so the issue of likelihood of confusion between the marks was never brought before the examining attorney. The fact that one of those two registrations was subsequently assigned to a third party LLC (one that, apparently, is related to the original registrant, given that both share the same mailing address) has no effect whatsoever on the issue of likelihood of confusion, the relative strength or weakness of the mark or any other issue bearing on the registration of this application.

Applicant argues that “a gym in Rhode Island simply will not be competing for customers with a gym in Indiana or Texas, nor will it be advertising in the same channels. The rule applies here that ‘in the absence of actual confusion or bad faith, substantial geographic separation remains a significant indicator that likelihood of confusion is slight’” (citing *Brennan's, Inc. v. Brennan's Rest., L.L.C.*, 360 F.3d 125, 135 (2d Cir. N.Y. 2004).

In fact that is not the applicable rule here. The case cited by applicant involved an appeal from a denial of a preliminary injunction. As the court explained, “although registration presumptively creates nationwide protection, the Lanham Act only permits an injunction against a party where that party's use of a similar mark is likely to cause confusion.” *Brennan's*, at 134. In other words, there are two separate applicable rules, one for a likelihood of confusion analysis, where a valid registration creates nationwide protection, and another for injunctions, where a showing of actual confusion is required. In this case, registrants, as the owners of registrations without specified limitations, enjoy a presumption of exclusive right to nationwide use of the registered marks under Trademark Act Section 7(b), 15 U.S.C. §1057(b), regardless of their actual extent of use. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1568, 218 USPQ 390, 393 (Fed. Cir. 1983).

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. *See* 37 C.F.R. §2.64(b); TMEP §§715.03, 715.03(a), (c).

If time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to comply with and/or overcome any outstanding final requirements and/or refusals and/or to file an appeal with the Board. TMEP §715.03(a), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal when the time for responding to the final Office action has expired. *See* TMEP §715.04(a).

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