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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85637772
Applicant	Internet Promise Group LLC
Applied for Mark	STEP BREATHING
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Date	07/03/2014

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re: INTERNET PROMISE GROUP®, LLC

Applicant

Mark: STEP BREATHING  
Application Ser. No.: 85/637,772  
Filed: 05/29/2012

**REPLY BRIEF**

Honorable Commissioner of Trademarks  
P O Box 1451  
Alexandria, VA 22313-1451

Examiner Attorney having filed Examiner Appeal Brief, Applicant files the attached Reply Brief. The Reply Brief is timely filed within 20 days of the Examiner Brief dated 06/14/2014 that is on or before 07/04/2014.

Respectfully submitted,

Date: July 03, 2014

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**REPLY BRIEF**

**INTRODUCTION**

The Arguments advanced by the Examining Attorney in the Examiner Attorney Appeal Brief are responded to as follows:

**Issue of Identification of the Goods/Services:**

The mark is STEP BREATHING and the current identification of the goods/services that had been proposed by the Examiner that Applicant finds unsatisfactory and that is proposed to be amended by the Applicant, is:

“instructing others in a specific breathing technique for use with yoga practice that includes a series of successive short inhalation followed by long

inhalation that enhances life force energy in the human body for health and wellness”

The proposed amended identification by the Applicant is:

“instructing others in yoga practice that enhance life force energy in the human body for health and wellness; the yoga practice includes performing in different body postures, a series of successive short inhalation followed by a long inhalation”.

Examiner Attorney in her Appeal Brief has objected to this proposed amended identification of the goods/services. Examiner Attorney takes issue at Applicant’s attempt to amend the identification multiple times and her interest appears to be in providing her version of the identification of the goods be controlling.

The question on the issue of identification of goods here is whose goods are these and who has knowledge of what the goods are and who has the right to decide how the goods would be identified.

Applicant submits that these are not generic goods. They are trade secret proprietary goods and the applicant has provided at the request of the Examiner full and complete information on the goods. Given this requirement of the Examiner, Applicant has amended the identification multiple times and provides a currently proposed identification that is satisfactory to the Applicant and should be to the Examiner.

The goods are not generic as the specific techniques for enhancing life force energy in the human body are not identified in any book on yoga. These specific techniques for enhancing life force energy in the human body came out of Applicant's own intuitive knowledge during meditation on the Self.

Examiner Attorney has confused the identification of the goods with traditional Yoga practices and in general with breathing. Normal act of breathing includes an inhalation followed by an exhalation. Others have used the words of step breath and or step breathing as Examiner had cited numerous examples of, normal process of breathing including deep breathing as is commonly taught in Yoga practice.

Applicant submits that these are Applicant's Goods and Applicant has the right to decide how they will be identified. Applicant submits that this proposed amended identification of goods is no-more broader than the original identification as had already been argued in the Applicant's Appeal Brief.

Addressing the first issue of amended identification of the mark, Applicant submits that the amended identification is within the scope of the original identification because, the amended identification addresses the same aspects of goods.

Examiner has objected to this proposed amendment as beyond the scope of the amended application because it includes yoga instruction and not just instruction on a particular breathing technique.

At the same time, Examiner proposes and finds acceptable alternate identification of goods and services:

“instructing others in a specific breathing technique for use with yoga practice that includes a series of successive short inhalation followed by long inhalation that enhances life force energy in the human body for health and wellness”

For an objective person, “yoga” is equivalent to “health and wellness and yoga practice is commonly used to imply health and wellness.

For the above stated reasons, the amended identification is no-more broader than the original identification and is a narrower identification to comply with the TMEP regulations.

Therefore Applicant submits that the proposed amended identification by the Applicant as follows:

“instructing others in yoga practice that enhance life force energy in the human body for health and wellness; the yoga practice includes performing in different body postures, a series of successive short inhalation followed by a long inhalation”,

be accepted as the identification of the goods in view of arguments as provided above.

**The second issue is that the mark is merely descriptive**

Examiner has argued that the mark is merely descriptive and cites multiple examples of use of words similar to Step Breathing from websites of others.

Applicant submits that the based on the proposed amended identification of the goods, the mark is not merely descriptive, as has been argued in detail in the Applicant's Appeal Brief.

Examining attorney has advanced numerous arguments in support of her position as the mark being merely descriptive. In all of these arguments Examiner Attorney has confused the identification of the goods with traditional Yoga practices and in general with breathing that involves respiration or inhalation and exhalation in any order. Normal act of breathing includes an inhalation followed by an exhalation.

Examiner had cited numerous examples of websites of others for the normal process of breathing including deep breathing as is commonly taught in Yoga practice and has cited websites of others that have used the words of step breath and or step breathing for mere act of breathing that includes inhalation followed by exhalation as implying steps of breathing.

Applicant disagrees with the Examiner's characterization and positions using other's websites as related to normal breathing patterns as step breathing. Applicant also specifically disagrees with the Examiner statement:



“While the identical term “STEP BREATHING” may not appear in the dictionary, its meaning may be ascertained from the dictionary definitions provided by the Applicant. That is, the ordinary meaning of the term STEP BREATHING would be of a particular process of respiration (or breathing) that takes place in stages (or steps)”

because, Examiner misunderstands the nature of the goods as the identification of the goods have nothing to do with normal breathing or normal process of respiration requiring an inhalation and an exhalation and including deep breathing that also requiring inhalation and exhalation in any order as may be taught in yoga practices.

The following arguments are reproduced from the Applicant’s Appeal Brief.

**Applicant submits that the mark STEP BREATHING based on the identification of the good/services fits in the continuum in “suggestive” identification and not “merely descriptive”.**

**Based on a fair and equitable reading of the TMEP Section 1209 and it many cites, the mark is not “merely descriptive” because:**

An objective person being exposed to the mark “STEP BREATHING” alone cannot come up with any sensible identification of the goods; and vice versa, an

objective person reading the identification of the goods alone cannot come up with the mark. Thus the mark cannot be “merely descriptive” and

the mark is suggestive because: suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought, or perception to reach a conclusion as to the nature of those goods or services. Thus, a suggestive term differs from a descriptive term, which immediately tells something about the goods or services. *See In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985); the mark STEP BREATHING requires imagination, thought or perception to reach a conclusion as to the nature of the goods or services.

With this mark an objective person requires imagination, thought or perception as to the nature of the goods, which are instructions for a specific kind yoga practice. The mark therefore is suggestive and not merely descriptive.

**Further, based on a fair and equitable reading of the TMEP Section 1209 and it many cites therein, the mark is not “merely descriptive” because:**

An objective person being exposed to the mark STEP BREATHING alone cannot come up with any sensible identification of the goods; and vice versa, an objective person reading the identification of the goods alone cannot come up with the mark. Thus the mark cannot be “merely descriptive” and

the mark is incongruent because: the Board has described incongruity in a mark as “one of the accepted guideposts in the evolved set of legal principals for discriminating the suggestive from the descriptive mark.”

And has noted that the concept mere descriptiveness “should not penalize coinage of hitherto unused and somewhat incongruous word combinations whose import would not be grasped without some measure of imagination and “mental pause”.

The mark STEP BREATHING has word combinations whose import cannot be grasped without some measure of imagination and mental pause. Each of the words in the mark STEP and BREATHING individually are common English language words and thus an incongruent combination of them cannot be merely descriptive.

From the American Heritage® Dictionary of the English Language, Fifth Edition copyright ©2011 by Houghton Mifflin Harcourt Publishing Company;

The word ‘STEP’ has the following different and distinct meanings in the English language:

**step**

n.

**1.**

**a.** The single complete movement of raising one foot and putting it down in another spot, as in walking.

- b. A manner of walking; a particular gait.
- c. A fixed rhythm or pace, as in marching: **keep step**.
- d. The sound of a footstep.
- e. A footprint: **steps in the mud**.
- 2.
  - a. The distance traversed by moving one foot ahead of the other.
  - b. A very short distance: **just a step away**.
  - c. **steps** Course; path: **turned her steps toward home**.
- 3. One of a series of rhythmical, patterned movements of the feet used in a dance: **diagrammed the basic steps to the mambo**.
- 4.
  - a. A rest for the foot in ascending or descending.
  - b. **steps** Stairs.
  - c. Something, such as a ledge or an offset, that resembles a step of a stairway.
  - d. A low platform used for exercise, as in step aerobics.
- 5.
  - a. One of a series of actions, processes, or measures taken to achieve a goal.
  - b. A stage in a process: **followed every step in the instructions**.
- 6. A degree in progress or a grade or rank in a scale: **a step up in the corporate hierarchy**.
- 7. Music
  - a. The interval that separates two successive tones of a scale.
  - b. A degree of a scale.
- 8. Nautical The block in which the heel of a mast is fixed.
- v. **stepped, step-ping, steps**
  - v.intr.
    - 1. To put or press the foot: **step on the brake**.
    - 2. To shift or move slightly by taking a step or two: **step back**.
    - 3. To walk a short distance to a specified place or in a specified direction: **step over to the corner**.
    - 4. To move with the feet in a particular manner: **step lively**.
    - 5. To move into a new situation by or as if by taking a single step: **stepping into a life of ease**.
    - 6. To treat someone with arrogant indifference: **He is always stepping on other people**.
  - v.tr.
    - 1. To put or set (the foot) down: **step foot on land**.
    - 2. To measure by pacing: **step off ten yards**.
    - 3. To furnish with steps; make steps in: **terraces that are stepped along the hillside**.
    - 4. Computers To cause (a computer) to execute a single instruction.
    - 5. Nautical To place (a mast) in its step.

**Phrasal Verbs:**

**step aside**

To resign from a post, especially when being replaced.

**step down**

1. To resign from a high post.

2. To reduce, especially in stages: *stepping down the electric power*.

**step in**

1. To enter into an activity or a situation.

2. To intervene.

**step out**

1. To walk briskly.

2. To go outside for a short time.

3. *Informal* To go out for a special evening of entertainment.

4. To withdraw; quit.

**step up**

1. To increase, especially in stages: *step up production*.
2. To come forward: *step up and be counted*.
3. To improve one's performance or take on more responsibility, especially at a crucial time.

**Idioms:**

**in step**

1. Moving in rhythm.
2. In conformity with one's environment: *in step with the times*.

**out of step**

1. Not moving in rhythm: *recruits marching out of step*.
2. Not in conformity with one's environment: *out of step with the times*.

**step by step**

By degrees.

**step on it** Informal

To go faster; hurry.

Again from the American Heritage® Dictionary in the English Language,

Fifth Edition copyright ©2011 by Houghton Mifflin Harcourt Publishing

Company;

The word ‘BREATHING’ has the following different and distinct meanings for the English language:

**breath-ing**

n.

**1.**

**a.** The act or process of respiration.

**b.** A single breath.

**2.** The time required to take one's breath.

**3.**

**a.** Either of two marks, the rough breathing and the smooth breathing, used in Greek to indicate presence or absence of aspiration.

**b.** The presence or absence of aspiration indicated by either of these marks.

It is clear from the English language dictionary that the word STEP has multiple different and distinct meanings. Which one of these is implied depends

upon the context in which word STEP is used. It should be noted that none of these definitions of STEP relate to an act of breathing or respiration.

It is also clear from the English language dictionary that the word BREATHING has meaning related to respiration.

The word “BREATHING” in STEP BREATHING fails to provide that context as the combined words STEP BREATHING is not part of the English Language as either an idiomatic expression or as any other direct meaning.

No where in these dictionary definitions of the words “STEP” and ‘BREATHING’ there is an English language usage for the combination “STEP BREATHING”

Hence this combination of the words for the mark is not part of the English language. Hence the word STEP by itself cannot be “merely descriptive” when used in the context of BREATHING. Hence also the word “BREATHING” by itself cannot be “merely descriptive” when used in the context of STEP.

Hence the mark STEP BREATHING being an incongruent combination of the common words is not “merely descriptive”.

Applicant respectfully submits that the mark is not merely descriptive but suggestive for the following reasons. First, the words STEP and BREATHING are incongruous terms as these two terms are not used in combination. Second the mark does not convey an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant’s goods and/or services.

Based on the applicable law and regulations above, Applicant argues the applicant’s mark for the identified good/services is suggestive and the mark is also incongruent and thus also suggestive.

Therefore Applicant respectfully submits that based on the foregoing analysis, the mark is not “merely descriptive” as the mark does not satisfy the legal standard of “merely descriptive”.

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Signed/Date: 07/03/2014

//Tara Chand//

President

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