

**This Opinion is Not a
Precedent of the TTAB**

Mailed: October 9, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Internet Promise Group LLC
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Serial No. 85637772
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Tara Chand for Internet Promise Group LLC, *pro se*.¹

Kate DuBray, Trademark Examining Attorney, Law Office 118,
Thomas G. Howell, Managing Attorney.

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Before Quinn, Kuhlke and Taylor,
Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Internet Promise Group LLC (“Applicant”) seeks registration on the Principal Register of the mark STEP BREATHING (in standard characters) for “Instructing others in a specific breathing technique, specifically, instructions in successive short inhalation and holding breath steps and then exhalation to enhance life force

¹ Tara Chand is Applicant’s president.

energy in the human body as part of teaching Yoga practice,” in International Class 41.²

The Trademark Examining Attorney has refused registration of Applicant’s mark on the ground that STEP BREATHING is merely descriptive of Applicant’s services under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). In addition, the Examining Attorney has refused Applicant’s requested amendment to her identification of services as being beyond the scope of the identification of services as previously amended.

When the refusal was made final, Applicant appealed and twice requested reconsideration. After the Examining Attorney denied the requests for reconsideration, the appeal was resumed. We affirm the refusal to register.

Amendment to the Identification of Services

We begin by addressing the refusal to accept Applicant’s proposed amendment to the identification of services. As a preliminary matter, we note that Applicant offered the amendment “to alleviate issues concerning ‘Merely Descriptive’ and to put the mark in a condition of allowance.” Second Req. for Recon. p. 3 (January 13, 2014). However, the proposed amendment would not have “alleviated” the refusal based on mere descriptiveness. As the Examining Attorney explained, it would “still be broad enough to include the step breathing technique described in the proposed amendment ‘a series of successive short inhalation followed by a long inhalation.’”

² Application Serial No. 85637772 was filed on May 29, 2012, based upon Applicant’s allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

We further observe that the tactical move to specifically delete those aspects of an applicant's actual services for which a term may be merely descriptive, may not assist the applicant. *Cf In re DNI Holdings Ltd.*, 77 USPQ2d 1435, 1438 (TTAB 2005) (“[D]espite applicant's tactical decision to carve them out of its recitation of services, we find that the relevant genus of services herein includes wagering on sporting events.”)

In the original application, the services were listed as:

A breathing technique that enhances life force energy in the human body.

This identification prompted a refusal based on failure to function under Sections 1, 2, 3 and 45 of the Trademark Act, 15 U.S.C. §§ 1051-53, 1127, because, as identified, “they only refer to a technique or process and not to a real activity performed primarily for the benefit of someone other than the applicant.” First Office Action (September 21, 2012). On March 1, 2013, Applicant provided the following amendment which was accepted and entered by the Examining Attorney once it was correctly reclassified in International Class 41:

Instructing others in a specific breathing technique, specifically, instructions in successive short inhalation and holding breath steps and then exhalation to enhance life force energy in the human body as part of teaching Yoga practice.

App. Response (March 1, 2013).

In its first request for reconsideration filed on September 20, 2013, Applicant included the following amendment which was denied along with the reconsideration of the mere descriptiveness refusal:

Services relating to instructing others in a specific breathing technique that enhances life force energy in the human body for health and wellness. (September 20, 2013).

On January 13, 2014, Applicant filed a second request for reconsideration and proposed the following amendment which was rejected by the Examining Attorney as being beyond the scope of the accepted March 1, 2013 amendment:

Services relating to 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. (January 13, 2014).

It is this last amendment that is the subject of appeal. In rejecting the proposed amendment, the Examining Attorney asserts that it is beyond the scope of the amended application “because it includes yoga instruction, and not just instruction on a particular breathing technique.” Ex. Att. Br. p. 6.

Applicant responds that it is “within the scope of the original identification because, the amended identification addresses the same aspects of goods.” App. Br. p. 3. Applicant argues that its amendment is not broader than the Examining Attorney’s proposed amendment “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” because “yoga’ is equivalent to ‘health and wellness’ and yoga practice is commonly used to imply health and wellness.” App. Br. p. 4.

Trademark Rule 2.71(a) allows applicants “to amend the application to clarify or limit, but not to broaden, the identification of goods and/or services.” Trademark

Mark Rule 2.71(a), 37 C.F.R. § 2.71(a). Once an applicant amends the identification of goods or services in a manner that is acceptable to the examining attorney, the amendment replaces all previous identifications and restricts the scope of goods or services to that of the amended language. Further amendments that would add to or expand the scope of the recited goods or services, as amended, will not be permitted. *In re Swen Sonic Corp.*, 21 USPQ2d 1794 (TTAB 1991); TMEP § 1402.07(e). Thus, we must consider the question of scope in reference to the accepted amendment and not to the original identification. In determining whether the proposed amendment is outside of the scope of an identification, the examining attorney considers the ordinary meaning of the wording. *In re Fiat Grp. Mktg. & Corporate Commc'ns S.p.A.*, 109 USPQ2d 1593 (TTAB 2014); TMEP § 1402.07(a).

The identification, as amended, covers a breathing technique. The proposed amendment clearly broadens that scope by including yoga practice in general which includes more than just a breathing technique, in violation of Trademark Mark Rule 2.71(a). In view thereof, the refusal to accept the amendment is appropriate.

Mere Descriptiveness

The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *See, e.g., In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (internal citations omitted). *See also In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370,

1371 (Fed. Cir. 2004), quoting, *Estate of P.D. Beckwith, Inc. v. Commissioner*, 252 U.S. 538, 543 (1920) (“A mark is merely descriptive if it ‘consist[s] merely of words descriptive of the qualities, ingredients or characteristics of the goods or services related to the mark.”) The determination of whether a mark is merely descriptive must be made in relation to the goods or services for which registration is sought. *Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219. It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant ingredient, quality, characteristic, function, feature, purpose or use of the goods or services. *Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219; *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

Where a mark consists of multiple words, the mere combination of descriptive words does not necessarily create a nondescriptive word or phrase. *In re Phoseon Tech., Inc.*, 103 UPQ2d 1822, 1823 (TTAB 2012); and *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1662 (TTAB 1988). If each component retains its merely descriptive significance in relation to the goods or services, the combination results in a composite that is itself merely descriptive. *Oppedahl & Larson LLP*, 71 USPQ2d at 1371. However, a mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a unique, nondescriptive meaning, or if the composite has a bizarre or incongruous meaning as applied to the goods or services. See *In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968); *In re Shutts*, 217 USPQ 363 (TTAB 1983).

The Examining Attorney asserts that the proposed mark STEP BREATHING is merely descriptive of the services in that it describes a significant feature of the services consisting of instruction in a breathing technique that involves a series of steps. In response to Applicant's statement that its breathing technique is a trade secret, the Examining Attorney contends that "STEP BREATHING still describes a feature of the technique, and this term is widely used by third parties to describe a variety of breathing techniques, all involving breathing in different steps." Denial of Req. for Recon. (October 15, 2013).

In support of her position, the Examining Attorney relies on the following dictionary definitions³ of the words "step" and "breathing":

One of series of actions, processes, or measures taken to achieve a goal; and a stage in a process;

The act or process of respiration.

The Examining Attorney concludes from these definitions that "[t]he natural definition of the term STEP BREATHING is of a particular process of respiration that takes place in stages. This definition matches the information that the applicant has provided about the services." *Id.*

She also relies on printouts from various third-party websites showing use of the term STEP BREATHING in connection with breathing techniques. For example on the website Our Life Force, www.ourlifeforce.com, the article titled "Our Life Force Step Breathing" describes a breathing technique that involves "twenty IN and

³ AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (5th ed. 2011), submitted in Applicant's Request for Reconsideration (September 20, 2013).

twenty-five OUT Step Breaths”;⁴ under the title “4-Step Breathing Meditation” the website www.massagemag.com describes a breathing technique from an article titled “Breathwork: How to Increase Life-Force Energy”;⁵ under the title “6 Step Breathing Exercise – Make This Popular Reiki Healing Method a Part of Your Daily Routine” the website <http://ezinearticles.com> describes a breathing exercise involving six steps;⁶ the website <http://katlarsen.com> describing a type of yogic breathwork called “viloma pranayama (breathing) or stair step breathing”;⁷ and an article titled “Golf Tips- Step-Breathe Your Mind Into Focus” describes a breathing technique referred to as step-breathing.⁸ The Examining Attorney also highlights the following passage from the website for Xenergies International, www.xenpod.com/the-basics, describing that company’s own step breathing technique as part of a “low-energy exercise program that strengthens simultaneously on your fluid and energy systems,” and combines “step breathing and meridian activation techniques” intended to be practiced for a few minutes each day. Ex. Att. Br. p. 3.

The Examining Attorney concludes that all “of this information shows that consumers would understand the term STEP BREATHING as descriptive of a breathing technique involving different steps.” Ex. Att. Br. p. 5. “The evidence shows that the relevant public is familiar with the term STEP BREATHING to

⁴ Attached to Office Action (September 21, 2012).

⁵ *Id.*

⁶ *Id.*

⁷ *Id.*

⁸ Attached to Denial of Req. for Recon. (October 15, 2013).

describe breathing techniques used in connection with yoga, meditation, relaxation and other mental and physical activities. Accordingly, the proposed mark STEP BREATHING is merely descriptive of a feature of the applicant's services." *Id.*

Applicant argues:

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 ..."

App. Br. p. 17.

However, this is not the standard. As noted above, we must consider the context in which the mark is used in connection with those goods and services and understand the significance that the mark would have to the average purchaser of the goods or services in the marketplace. *See Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219. In seeking Applicant's services "Instructing others in a specific breathing technique, specifically, instructions in successive short inhalation and holding breath steps and then exhalation to enhance life force energy in the human body as part of teaching Yoga practice," upon seeing the proposed mark STEP BREATHING purchasers would immediately understand it to mean Applicant's services feature a breathing technique that involves different steps. The fact that the word "step" may have other meanings does not obviate the refusal. *See In re RiseSmart Inc.*, 104 USPQ2d 1931, 1933 (TTAB 2012).

Applicant's suggested amendment to its identification of services "Services relating to 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” does not change this result because the term STEP BREATHING continues to describe a feature of “yoga” services, namely Applicant’s breathing technique. *Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219.

Applicant argues that “[n]o where in these dictionary definitions of the words ‘STEP’ and ‘BREATHING’ there is an English language usage for the combination ‘STEP BREATHING’”; however, the fact that a descriptive word or term is not found in a dictionary is not controlling on the question of registrability. *See In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987); *In re Orleans Wines, Ltd.*, 196 USPQ 516 (TTAB 1977). In addition, the fact that Applicant’s breathing technique is unique is not the issue. Even if Applicant’s technique is unique and Applicant is the first to use this particular word combination, if the combination remains merely descriptive of a significant feature of these services, then it is merely descriptive under Section 2(e)(1) of the Trademark Act. *See In re Nat’l Shooting Sports Found., Inc.*, 219 USPQ 1018 (TTAB 1983).

Applicant argues that its proposed mark is incongruous because “the words STEP and BREATHING ... are not used in combination.” App. Br. p. 21. However, STEP BREATHING does not create any double entendre or incongruity in the context of the respective services and, as noted above, being the first to use a merely descriptive word combination does not obviate the refusal.

Finally, Applicant argues that the “Examiner misunderstands the nature of the [services] 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 [sic] inhalation and exhalation in any order as maybe taught in yoga practices.” Reply Br. p. 8. Again, the fact that Applicant’s services include a specific and unique breathing technique does not alter the fact that the wording STEP BREATHING immediately informs the consumer that Applicant’s services feature breathing involving steps.

We find that STEP BREATHING immediately describes a significant feature of the services, namely a breathing technique that involves successive steps.

Decision: The refusal to accept the amendment of Applicant’s services to “services relating to 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” in International Class 42 is affirmed.

The refusal to register Applicant’s mark STEP BREATHING as merely descriptive under Section 2(e)(1) is affirmed.