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

Proceeding	85677969
Applicant	Now Yoga, LLC
Applied for Mark	NOW YOGA AND FITNESS
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I. INTRODUCTION

COMES NOW the Applicant Now Yoga, LLC (hereinafter “Applicant”), by counsel Matthew H. Swyers, Esq., The Trademark Company, PLLC, and submits the instant Brief of the Applicant in support of Applicant’s contention that the instant mark should be permitted to register.

II. STATEMENT OF THE CASE

On or about July 16, 2012 Applicant applied to register the service mark NOW YOGA AND FITNESS in connection with Yoga instruction in International Class 41. On or about September 19, 2012 the Office conducted its initial review of the application. As a result thereof, the Office refused registration of the applied-for mark on the grounds that, if registered, Applicant’s NOW YOGA AND FITNESS would create a likelihood of confusion with NOWYOGA as more fully set forth in U.S. Reg. No. 2,703,257.

Through a series of responses and, most specifically, by and through an Office Action Response dated April 29, 2014, Applicant sought to address the Office’s concerns in regard to U.S. Reg. No. 2,703,257. Notwithstanding this fact, the Office has maintained the instant refusal prompting the appeal at issue.

III. ARGUMENT

A determination of likelihood of confusion between marks is determined on a case-specific basis. *In re Dixie Restaurants Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). The examining attorney is to apply each of the applicable factors set out in *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). The relevant *DuPont* factors are:

- (1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
- (2) the similarity or dissimilarity and nature of the services as described in an application or registration or in connection with which a prior mark is in use;
- (3) the similarity or dissimilarity of established, likely-to-continue trade channels;
- (4) the conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing;
- (5) the number and nature of similar marks in use on similar services; and
- (6) the absence of actual confusion as between the marks and the length of time in which the marks have co-existed without actual confusion occurring.

See id.

The examining attorney is required to look to the overall impression created by the marks, rather than merely comparing individual features. *Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1029, 10 USPQ2d 1961 (2d Cir. 1989). In this respect, the examining attorney must determine whether the total effect conveyed by the marks is confusingly similar, not simply whether the marks sound alike or look alike. *First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d at 645, 653, 40 USPQ2d 1865, 1870 (10th Cir. 1996) (recognizing that while the dominant portion of a mark is given greater weight, each mark still must be considered as a whole)(citing *Universal Money Centers, Inc. v. American Tel. & Tel. Co.*, 22 F.3d 1527, 1531, 30 USPQ2d 1930 (10th Cir. 1994)). Even the use of identical dominant words or terms does not automatically mean that two marks are similar. In *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627, 3 USPQ2d 1442 (8th Cir. 1987), the court held that “Oatmeal Raisin Crisp” and “Apple Raisin Crisp” are not confusingly similar as trademarks. Also, in *First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d at 645, 653, 40 USPQ2d 1865, 1874 (10th Cir. 1996), marks for “FirstBank” and for “First Bank Kansas” were found not to be confusingly similar. Further, in *Luigino’s Inc. v. Stouffer Corp.*, 50 USPQ2d 1047, the mark

“Lean Cuisine” was not confusingly similar to “Michelina’s Lean ‘N Tasty” even though both marks use the word “Lean” and are in the same class of services, namely, low-fat frozen food.

Concerning the respective services with which the marks are used, the nature and scope of a party’s services must be determined on the basis of the services recited in the application or registration. *See, e.g., Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); *J & J Snack Foods Corp. v. McDonald’s Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (C.C.P.A. 1973). *See generally* TMEP § 1207.01(a)(iii).

If the 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 similar confusion is not likely. *See, e.g., Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER and design for advertising services, namely the formulation and preparation of advertising copy and literature in the plumbing field); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cable held not confusingly similar to QR for various products (*e.g.*, lamps, tubes) related to the photocopying field). *See generally* TMEP § 1207.01(a)(i).

Moreover the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are immune from source confusion. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983). However, circumstances suggesting care in purchasing may tend to minimize likelihood of confusion. *See generally* TMEP § 1207.01(d)(vii).

Applying the legal standards as enumerated above, it is clear that confusion is not likely to exist and Applicant's mark is entitled to register despite the existence of the cited marks.

A. Similarity of the Parties' Services, Trade Channels, and Marketing

From the onset, Applicant must concede the identical nature of the services of the involved marks. Further, as the services are identical without limitation there is little applicant can do before this forum to challenge the presumption that an overlap will exist as between the marketing and trade channels of the parties and the marks. As such, it is conceded that these three *du Pont* factors favor refusal of the instant registration.

However, even with this concession, and the fact that the lack of actual confusion is not relevant insofar as Applicant's mark is based upon an intent-to-use, Applicant remains steadfast that given the differences in the marks at issue its application should still be entitled to register.

B. Dissimilarities in the Marks as to their Respective Appearances and the Number and Nature of Similar Marks in Use on Similar Services

The Applicant applied to register the mark NOW YOGA AND FITNESS. The cited mark is NOWYOGA (U.S. Reg. No. 2,703,257.) Copies of the applications for Applicant's mark and for the blocking mark were previously made of record. *See* Office Action Response dated April 29, 2014 (hereinafter "Office Action Response"), Exhibits 1 – 2.

Facially, the applied for mark differs from the cited marks insofar as Applicant's mark consists of the term "NOW" followed by the terms "YOGA AND FITNESS." *See* Office Action

Response, Exhibit 1. In contrast, U.S. Reg. No. 2,703,257 telescopes the terms NOW and YOGA to form one unitary and distinct mark: NOWYOGA. *See* Office Action Response, Exhibit 2. As such, from the onset it is clear that the marks cannot be said to be identical.

As such, when viewed through the eyes of the general consuming public, will the distinctions between the two marks be sufficient to alleviate any concern that a likelihood of confusion would occur should the applied-for mark be permitted to register. Applicant submits that these differences are sufficient to eliminate that likelihood of confusion. Moreover, Applicant believes that other marks existing on the register are evidence of this point.

Generally, the existence of third-party registrations cannot justify the registration of another mark that is so similar to a previously registered mark as to create a likelihood of confusion, or to cause mistake, or to deceive. *E.g.*, *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1272 (TTAB 2009).

However, third-party registrations may be relevant to show that a mark or a portion of a mark is descriptive, suggestive, *or so commonly used that the public will look to other elements to distinguish the source of the goods or services.* *See, e.g.*, *In re Hartz Hotel Servs., Inc.*, 102 USPQ2d 1150, 1153-54 (TTAB 2012)(*emphasis added*); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Dayco Products-Eagle Motive Inc.*, 9 USPQ2d 1910, 1911-12 (TTAB 1988); *Plus Prods. v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983).

There can be no doubt that both the Applicant's mark and that of the registrant contain the terms, or translation equivalents thereto, NOW in connection with yoga instruction services in International Class 41. In this regard, Applicant previously made of record Exhibits 4 through 6 which display 3 registered marks incorporating the term "NOW" and literal equivalents thereof

used in relation to similar services. *See* Office Action Response, Exhibits 4 through 6. The marks are as follows:

NOW & ZEN STRENGTH TRAINING AND YOGA CONDITIONING, U.S. Reg. No. 3,898,082, owned by Barteo, Traci, used in connection with “Educational services, namely, providing classes in the field of yoga and strength training, featuring a fusion of yoga and strength training intervals to achieve a mind and body connection for all physical activities” in International Class 41, *See* Exhibit 4;

SERENITY NOW YOGA, U.S. Reg. No. 3,925,230, owned by Nummy Nums Inc., used in connection with “Yoga instruction” in International Class 41, *See* Exhibit 5;

HAPPY NOW YEAR!, U.S. Reg. No. 4,012,501, owned by Circle Yoga, LLC, used in connection with “Yoga instruction” in International Class 41, *See* Exhibit 6;

Accordingly, based upon the distinctions between the appearance of Applicant’s mark as apart from the cited mark and in consideration of the dilution of the term “NOW” and literal equivalents thereof as they relate to marks in related classes, Applicant respectfully submits that this *du Pont* factor is the most relevant and based upon distinctions as between the marks as well as the numerous other NOW registrations used in connection with yoga instruction a likelihood of confusion is not likely should Applicant’s mark be permitted to register.

C. Sophistication of the Purchasers and Members of the Respective Services

Applicant’s yoga instruction, massage, acupuncture, and other holistic services, bearing the NOW YOGA AND FITNESS mark are used to attract a very specific consumer, namely, adults seeking yoga instruction and other body work and healing services as well as related accessories. In contrast, it can only be assumed that the Leslie Sims’ mark was used to attract those seeking Buddhism based yoga and QiGong classes. *See* Office Action Response, Exhibit E of Exhibit 3, Affidavit of Per Davidson.

As such, the average purchaser or member of the respective services offered under the cited marks would also exercise a high level of sophistication in choosing the cited mark's services as apart from the services of the Applicant's mark, therefore minimizing any likelihood of confusion. *See* TMEP § 1207.01(d)(vii).

As such, it is suggested that this *du Pont* factor also favors registration of the instant mark.

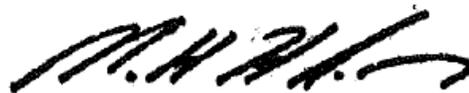
IV. CONCLUSION

In conclusion, based upon the foregoing it is submitted that the *du Pont* factors addressed herein favor registration of the Applicant's mark.

WHEREFORE it is respectfully requested that the Board reverse the decision of the Examining Attorney, remove as an impediment the cited marks, and approve the instant application for publication upon the Principal Register.

Respectfully submitted this 11th day of August, 2014.

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