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Subject: U.S. TRADEMARK APPLICATION NO. 85677969 - NOW YOGA AND FITNESS - N/A - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85677969 MARK: NOW YOGA AND FITNESS	
CORRESPONDENT ADDRESS: MATTHEW H SWYERS 344 MAPLE AVE WEST PMB 151 VIENNA, VA 22180	GENERAL TRADEMARK INFORMATION: http://www.uspto.gov/trademarks/index.jsp TTAB INFORMATION: http://www.uspto.gov/trademarks/process/appeal/index.jsp
APPLICANT: Now Yoga, LLC	
CORRESPONDENT'S REFERENCE/DOCKET NO: N/A CORRESPONDENT E-MAIL ADDRESS: admin@thetrademarkcompany.com	

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the trademark examining attorney's final refusal to register the trademark "NOW YOGA AND FITNESS" for "Yoga instruction" on the grounds that the mark, under Trademark Act Section 2(d), is likely to be confused with U.S. Registration No. 2,703,257.

I. FACTS

Applicant applied to register the proposed mark, "NOW YOGA AND FITNESS," on the Principal Register for yoga instruction on July 16, 2012. On September 19, 2012, the examining attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), because the proposed mark is likely to be confused with the mark NOWYOGA for "yoga instruction." On March 18, 2013, applicant submitted arguments against the Section 2(d) refusal. An additional non-final Office action was issued on April 7, 2013, to which applicant responded on October 9, 2013. A final refusal to register the mark was issued on October 29, 2013, under Section 2(d). Applicant instituted this appeal regarding the Section 2(d) refusal on April 29, 2014.

II. ARGUMENT

THE MARKS OF THE APPLICANT AND REGISTRANT ARE HIGHLY SIMILAR AND THE SERVICES ARE IDENTICAL SUCH THAT THERE EXISTS A LIKELIHOOD OF CONFUSION UNDER SECTION 2(d) OF THE TRADEMARK ACT.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of

record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003). In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the services, and similarity of the trade channels of the services. See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); TMEP §§1207.01.

A. THE APPLIED-FOR MARK “NOW YOGA AND FITNESS” IS HIGHLY SIMILAR IN COMMERCIAL IMPRESSION TO THE REGISTERED MARK “NOWYOGA.”

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); TMEP §1207.01(b).

In the present case, the marks are highly similar in sound, appearance and connotation. Both applicant and registrant use the words “NOW” and “YOGA” in their marks, with the same spelling, pronunciation, meaning and overall connotation. The only differences between the applied-for mark and the registration is that that applicant has a space between “NOW” and “YOGA” where registrant does not and that the applied-for mark contains the additional wording “AND FITNESS.” However, these differences do not obviate the refusal.

With regard to the first difference, the compared marks are identical in-part except for a slight difference in appearance between registrant’s mark, which appears as a compound word with no space separating the words, that is, NOWYOGA; and applicant’s mark, which appears as multiple word with space separating the words, that is, NOW YOGA AND FITNESS. As such, the marks are identical in-part in sound and near virtually identical in-part in appearance, and are thus confusingly similar for the purposes of determining likelihood of confusion. See, e.g., *Seaguard Corp. v. Seaward Int’l, Inc.*, 223

USPQ 48, 51 (TTAB 1984) (“[T]he marks ‘SEAGUARD’ and ‘SEA GUARD’ are, in contemplation of law, identical [internal citation omitted]. As a result, the inclusion of a space does not alter the commercial impression of the applied-for mark in order to avoid confusion with the registration.

Likewise, the second difference between the applied-for mark and the registration, being applicant’s additional wording “AND FITNESS,” does not obviate the refusal. Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985). Disclaimed matter that is descriptive of or generic for an applicant’s services is typically less significant or less dominant when comparing marks. See *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997). Here, the wording “AND FITNESS,” being highly descriptive of applicant’s services, is disclaimed in the application, as well as the word “YOGA.” As such, “AND FITNESS” does little to distinguish applicant’s and registrant’s marks.

Given that the dominant portion of the applied-for mark, being “NOW YOGA,” is nearly identical to the registration in its entirety, the marks are similar under Section 2(d).

B. APPLICANT’S IDENTIFIED SERVICES ARE IDENTICAL TO REGISTRANT’S IDENTIFIED SERVICES.

In the present case, the services listed in both the application and the registration are identical, both being for “yoga instruction.” When analyzing an applicant’s and registrant’s services for similarity and relatedness, that determination is based on the description of the services stated in the application and registration at issue, not on extrinsic evidence of actual use. See *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); see also *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002). Absent restrictions in an application and/or registration, the identified services are presumed to travel in the

same channels of trade to the same class of purchasers. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d at 1268, 62 USPQ2d at 1005. Additionally, unrestricted and broad identifications are presumed to encompass all services of the type described. *See In re Jump Designs*, 80 USPQ2d 1370, 1374 (TTAB 2006); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

Applicant concedes the identical nature of the services in the marks. *See Applicant's Brief* at p. 8. Further, the identifications set forth in the application and registration are identical and have no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these services travel in all normal channels of trade, and are available to the same class of purchasers. *See Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012). Accordingly, the services of applicant and the registrant are considered related for purposes of the likelihood of confusion analysis under Section 2(d) of the Trademark Act.

C. APPLICANT'S CITED THIRD-PARTY REGISTRATIONS DO NOT SHOW DILUTION IN ORDER TO AVOID A LIKELIHOOD OF CONFUSION.

Applicant has submitted printouts of third-party registrations for marks containing the wording NOW to support the argument that this wording is weak, diluted, or so widely used that it should not be afforded a broad scope of protection. *See Applicant's Brief* at p. 10. The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks *in use in the marketplace* in connection with *similar* goods and/or services. *See Nat'l Cable Television Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991).

Evidence of weakness or dilution consisting solely of third-party registrations, such as those submitted by applicant in this case, is generally entitled to little weight in determining the strength of a mark, because such registrations do not establish that the registered marks identified therein are in

actual use in the marketplace or that consumers are accustomed to seeing them. *See AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973). Therefore, applicant's current reliance on three third-party registrations to prove dilution of a portion of the marks is entitled to little weight and therefore not probative in the present case.

Furthermore, each of the third-party marks cited by applicant use the word "NOW" in the context of a phrase that carries a different commercial impression than applicant's and registrant's usage of the word. For example, the mark NOW & ZEN STRENGTH TRAINING AND YOGA CONDITIONING uses NOW in a phrase that is a play on "now & then"; the mark SERENITY NOW YOGA uses NOW as part of a commonly used phrase, "serenity now," to mean bring me calmness; and the mark HAPPY NOW YEAR! uses NOW in a phrase that is a play on "happy new year." *See Applicant's Brief* at p. 10. As a result, the meanings present in the three cited marks have different commercial impressions than the marks at issue.

D. APPLICANT'S ASSERTION THAT ITS CONSUMERS ARE SOPHISTICATED PURCHASERS IS INSUFFICIENT TO OVERCOME A LIKELIHOOD OF CONFUSION.

In the present case, applicant asserts that the relevant consumers for its services are sophisticated. *See Applicant's Brief* at p. 10. Applicant supports this assertion by claiming in an affidavit that its "yoga instruction, massage, acupuncture, and other holistic services" are aimed to attract different consumers than that of registrant, whose mark is "used to attract those seeking Buddhism based yoga and QiGong classes." *Id.* As previously noted, these restrictions are not set forth in the identification of services of either applicant or registrant. Absent restrictions in an application and/or registration, the identified services are presumed to travel in the same channels of trade to the same class of purchasers. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d at 1268, 62 USPQ2d at 1005.

Given the identical nature of the services in the application and registration, the trade channels and the consumers are presumed to be the same for both parties.

Furthermore, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see, e.g., Stone Lion Capital Partners, LP v. Lion Capital LLP*, ___ F.3d. ___, ___, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014)(Affirming that the TTAB properly considered all potential investors for recited services, which included sophisticated investors, but that precedent requires TTAB decision to be based “on the least sophisticated potential purchasers.”).

Finally, while applicant’s affidavit asserts that there are no known instances of actual confusion, it is well settled that the relevant test is likelihood of confusion, not actual confusion; thus, it is unnecessary to show actual confusion to establish likelihood of confusion. *See Weiss Assocs. Inc. v. HRL Assocs. Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990).

III. CONCLUSION

Applicant’s mark, “NOW YOGA AND FITNESS,” creates a similar commercial impression to the prior Registrant’s mark, “NOWYOGA,” because the marks are similar in sound, appearance and meaning. Further, the services identified by applicant and registrant are identical. Therefore, consumers encountering applicant’s mark and the cited mark in the marketplace are likely to mistakenly believe that the services emanate from a common source. As a result, the refusal to register the applied-for mark under Section 2(d) of the Trademark Act should be affirmed.

Respectfully submitted,

/ Zachary B. Cromer /

Trademark Attorney

Law Office 104

Phone: (571) 272-6089

Fax: (571) 273-6089

zachary.cromer@uspto.gov

Chris Doninger

Managing Attorney

Law Office 104