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

Proceeding	85925162
Applicant	QuickPayNet, Ltd
Applied for Mark	STAYFIT PLAN
Correspondence Address	PATRICK R ROCHE FAY SHARPE LLP 1228 EUCLID AVENUETHE HALLE BUILDING, 5TH FLOOR CLEVELAND, OH 44115 UNITED STATES proche@faysharpe.com, jeanne.liptay@faysharpe.com
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Filer's Name	Patrick R. Roche
Filer's e-mail	proche@faysharpe.com, jeanne.liptay@faysharpe.com, docketing@faysharpe.com
Signature	/Patrick R. Roche/
Date	01/12/2015

**TRADEMARK**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant : QuickPayNet, Ltd  
Mark : **STAYFIT PLAN**  
Serial No. : 85/925,162  
Filed : May 7, 2013  
Examining Attorney : David Yontef  
Law Office : 118  
Attorney Docket No. : HUMM 500006US01  
  
Cleveland, Ohio 44115  
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ATTN: TTAB  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**APPLICANT'S REPLY BRIEF**

Applicant replies to the Examining Attorney's Appeal Brief dated December 31, 2014.

**1. THE MARKS OF THE APPLICANT AND REGISTRANTS DO NOT CAUSE A LIKELIHOOD OF CONFUSION**

The Examining Attorney would have us believe that the mark STAYFIT PLAN creates a likelihood of confusion with respect to the marks of the registrants. In support of this, the Examining Attorney asserts that the applicant's mark is identical and virtually

identical to the dominant wording “STAY FIT” and “STAYFIT” in the registered marks. The Examining Attorney further argued that adding the descriptive word “PLAN” to the applicant’s mark did not obviate the similarities between the compared marks and that similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar.

Applicant agrees that the dominant portion of the mark is STAYFIT, however as both the Federal Circuit and the Examining Attorney asserted, “in 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, *provided the ultimate conclusion rests on consideration of the marks in their entireties.*” *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985); TMEP § 1207.01(b)(viii). Further, “if the common element of two marks is “weak” in that it is generic, descriptive, or highly suggestive of the named goods or services, it is unlikely that consumers will be confused unless the overall combinations have other commonality.” *See, e.g., In re Bed & Breakfast Registry*, 791 F.2d 157, 159 229 USPQ 818, 819 (Fed. Cir. 1986) (reversing TTAB’s holding that contemporaneous use of BED & BREAKFAST REGISTRY for making lodging reservations for others in private homes, and BED & BREAKFAST INTERNATIONAL for room booking agency services, is likely to cause confusion, because, *inter alia*, the descriptive nature of the shared wording weighed against a finding that the marks are confusingly similar); *U.S. Shoe Corp. v. Chapman*, 229 USPQ 74 (TTAB 1985) (holding COBBLER’S OUTLET for shoes, and CALIFORNIA COBBLERS (in typed and stylized forms) for footwear and women’s shoes, not likely to cause confusion); *In re Istituto Sieroterapico E Vaccinogeno*,

*Toscano* “SCLAVO” S.p.A., 226 USPQ 1035 (TTAB 1985) (holding ASO QUANTUM (stylized, with “ASO” disclaimed) for diagnostic laboratory reagents, and QUANTUM I for laboratory instruments for analyzing body fluids, not likely to cause confusion).

Moreover, “[a]dditions or deletions to marks may be sufficient to avoid a likelihood of confusion if: (1) the marks in their entireties convey significantly different commercial impressions; or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted.” TMEP § 1207.01(b)(iii).

It seems that the Examining Attorney has taken more time to parse the portions of the Applicant’s mark in his evaluation than evaluating it in its entirety. Applicant acknowledges that the dominant portion of the mark is the same in sound alone as those of the registered marks and identical or virtually identical to the registered marks as well. On page 5 of its appeal brief, the Applicant cited an analogous situation: WHISKEY TANGO (Reg. No. 86188577) and WHISKEY TANGO FOXTROT (Reg. No. 85978008) are both registered under International Class 016 and are related to paper goods. Both marks have identical components in appearance and sound but coexist on the Principal Register. See *also* CANDY CRUSH SODA (Reg. No. 86363741) and HARD CANDY CRUSH (Reg. No. 86092964) and CANDY CRUSH (Reg. No. 85966585) (claiming cosmetics and fragrances under IC 003). Similarly, STAYFIT PLAN and the Registrants’ marks may coexist on the Principal Register in the same classes.

STAYFIT is at the very least a suggestive word, and in addition to the term PLAN, creates an overall combination that lacks in commonalities with the registered

marks. STAYFIT implies maintaining fitness or overall general health, and the addition of PLAN implies a design or scheme of arrangement or a specific project or definite purpose. As a result, STAYFIT PLAN conveys a significantly different commercial impression from STAYFIT or STAYFIT, either of which may imply a device, a diet, a supplement, or a plan of maintaining fitness and health without suggesting health care services. STAYFIT PLAN also conveys a different commercial impression from STAYFIT SENIORS, which may imply the same products as goods and services as those of STAYFIT but geared toward seniors.

Therefore, unlike STAYFIT or STAY FIT SENIORS, STAYFIT PLAN specifically suggests a method or scheme of maintaining fitness and health, and in its entirety, STAYFIT PLAN is dissimilar to the Examining Attorney's cited marks.

## **2. THE SERVICES ARE NOT RELATED**

The Examining Attorney would also have us believe that the identification of services is unrestricted as to channels of trade and classes of purchasers, declining to restrict the services as to nature, type, channels of trade, or classes of purchasers. The Examining Attorney further asserts that the application uses broad wording which is commercially-related, if not identical, to the Registrants' services.

While the Examining Attorney acknowledges that Applicant restricted its services to "employees of a corporate subscriber," the Examining Attorney refuses to honor that restriction, instead arguing that the marks of STAYFIT, STAYFIT, STAYFIT SENIORS, and STAYFIT SENIORS employ such broad wording so as to describe the services addressed in the application. However, under this same reasoning, the registrations

STAYFIT SENIORS and STAYFIT SENIORS should have precluded the registrations of STAYFIT and STAYFIT, which arguably has a broader range of services, providing a website featuring information about “health, wellness, and nutrition,” including chiropractic and health services as covered by STAYFIT SENIORS.

The scope of Applicant’s mark is specifically directed to a corporate fitness plan to promote health and wellness that is available to corporate subscribers. Therefore the Applicant has restricted its mark to specific trade channels and classes of purchasers. Further, Applicant has specifically identified the nature and type of services offered as a subscription-based website. See *In re Bentley Motors, Ltd.*, Serial No. 85325994 (December 3, 2013) (finding that the applicant’s amended identification for BENTLEY with respect to perfume products sold at “authorized vehicle dealers and vehicle service outlets” did not overlap or suggest an overlap with those of the Registrants).

With respect to the twenty-six third-party registrations of marks used in connection with the same or similar services as those of Applicant and Registrants, Applicant does not dispute that the services listed in the printouts may emanate from a single source, however, these printouts are irrelevant, as evidence of third-party use falls under the sixth *du Pont* factor (“the number and nature of similar marks in use on similar goods”). TMEP § 1207.01(d)(iii). For example, the Examining Attorney provided printouts of marks such as ICAN, CHI-MEDICINE, CINCINNATI CHIROPRACTIC, and ALEVIA, all of which Applicant acknowledges provide health and health care related services but none of which are even remotely similar to Applicant’s mark or those of the Registrants. Therefore, these marks submitted in the printouts do not provide any probative evidence.

It is, therefore, respectfully requested that the Examining Attorney's refusal be withdrawn and the appeal be determined in favor of Applicant.

Respectfully submitted,

FAY SHARPE LLP

/Patrick R. Roche/  
Patrick R. Roche  
Rachel A. Smoot  
The Halle Building, 5<sup>th</sup> Floor  
1228 Euclid Avenue  
Cleveland, Ohio 44115  
Phone: (216) 363-9000

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