

This Opinion is Not a
Precedent of the TTAB

Mailed: May 8, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re QuickPayNet, Ltd.

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Serial No. 85925162

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Patrick R. Roche of Fay Sharp LLP,
for QuickPayNet, Ltd.

David Yontef, Trademark Examining Attorney, Law Office 118,
Thomas G. Howell, Managing Attorney.

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Before Cataldo, Lykos and Adlin,
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

On May 7, 2013, QuickPayNet, Ltd. (“Applicant”) filed an application to register on the Principal Register the mark **STAYFIT PLAN** in standard character format for the following services in International Class 44:¹

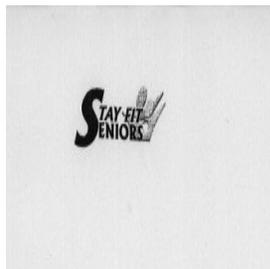
¹ Application Serial No. 85925162, filed under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging August 24, 2007 as the date of first use anywhere and in commerce. Applicant has disclaimed the word “PLAN” apart from the mark as shown.

During *ex parte* prosecution, Applicant amended the mark from **STAY FIT PLAN** to **STAYFIT PLAN** in order to overcome a refusal under Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127, that Applicant’s specimen fails to show the applied-for mark used in direct connection with the sale or advertising of the recited services.

Health care services, namely, wellness programs; Providing a website featuring information about health, wellness and nutrition; Providing a website featuring information and advice in the fields of diet, weight loss, diet planning and lifestyle wellness; Providing a website featuring information regarding healthy living and lifestyle wellness; Providing assistance, fitness evaluation and consultation to corporate clients to help their employees make health, wellness and nutritional changes in their daily living to improve health; Providing assistance, fitness evaluation and consultation to individuals to help them make health, wellness and nutritional changes in their daily living to improve health; Providing information, news and commentary in the field of nutrition, health and wellness; Providing wellness services, namely, personal assessments, personalized routines, maintenance schedules, and counseling; Providing wellness services, namely, weight loss programs offered at a wellness center; Wellness and health-related consulting services.

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles the following registered marks that, when used on or in connection with Applicant's identified services, it is likely to cause confusion or mistake or to deceive:

Registration Nos. 3776977 and 3574131 on the Principal Register owned by Stay Fit Seniors, Inc., for the mark **STAY FIT SENIORS** in standard characters and the mark displayed below,



for services identified as

Business management, billing and marketing program for chiropractic and health care services; retail and wholesale store services in the field of health care products and health care printed materials; franchising,

namely, offering technical assistance in the establishment and/or operation of pain treatment and chiropractic clinics, and business consultation services related thereto in International Class 35; and

Chiropractic consultation services; chiropractic and health care services; physical therapy; massage therapy in International Class 44.²

Registration Nos. 4133936 and 4196636 on the Principal Register owned by TA Operating LLC for the mark **STAY FIT** in standard characters and the mark displayed below



for goods and services identified as

Magazines featuring topics relating to health, wellness and nutrition to truck drivers and other drivers; Jogging and walking trail maps” in International Class 16; and

Providing a website featuring information about health, wellness, nutrition and jogging and walking trails to truck drivers and other drivers” in International Class 44.³

² Issued April 20, 2010 and February 10, 2009 respectively with a disclaimer of the word “SENIORS” apart from the mark as shown.

The description of the design mark is as follows: “The mark consists of the wording ‘Stay Fit Seniors’ on two lines with a common large ‘S’ shared by ‘Stay’ and ‘Seniors’, with two stylized and shaded figures in the upper right corner of the mark.” Color is not claimed as a feature of the mark.

³ Issued May 1, 2012 and August 28, 2012 respectively.

The description of the design mark is as follows: “The mark consists of the words ‘STAY FIT’ in white capital letters outlined in black depicted within a red heart with white highlights that is positioned over a black and white curved road leading from the lower right section to the middle of the heart.” The colors red, white and black are claimed as a feature of the mark.

When the refusal was made final, Applicant appealed and requested reconsideration based on amending the identification of services to the following:

Providing a subscription-based website for employees of insurance company subscribers featuring information about health, wellness and nutrition relating to diets, weight loss, diet planning, lifestyle wellness and assistance, fitness evaluation and consultation for corporate clients to help their employees make health, wellness and nutritional changes in their daily living to improve health.

The Trademark Examining Attorney accepted and entered Applicant's amendment but denied the Request for Reconsideration, maintaining the final refusal. Thereafter, the appeal was resumed, and the case is now fully briefed.

For the reasons explained below, we affirm the refusal to register.

Likelihood of Confusion Analysis

We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*du Pont*”). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and services. See *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). These factors and others are discussed below.

Similarity of the Marks

The first *du Pont* likelihood of confusion factor involves an analysis of the similarity or dissimilarity of the marks in their entirety as to appearance, sound,

connotation and commercial impression. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). Our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). *See also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). “On the other hand, 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. Indeed, this type of analysis appears to be unavoidable.” *In re Nat’l Data Corp.*, 224 USPQ at 751.

At the outset, we note that Applicant’s and Registrants’ marks are comprised, either in whole or in part, of the compound word mark **STAYFIT** or the two word phrase **STAY FIT**. Because **STAYFIT** appears first in Applicant’s mark **STAYFIT**

PLAN, it constitutes the dominant portion. Consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. *See id.* *See also Presto Prods. Inc. v. Nice-Pak Prods. Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (stating that “it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”). We further observe that the descriptive word **PLAN** in Applicant’s mark is disclaimed. Disclaimed matter generally will not constitute the dominant part of a mark. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (quoting *In re Nat’l Data Corp.*, 224 USPQ at 752); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”).

Applicant agrees that the dominant portion of its mark **STAYFIT PLAN** is **STAYFIT**. Applicant argues, however, that its mark as a whole “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.” Applicant’s Reply Brief, p. 4; 10 TTABVUE 5.⁴ Applicant then focuses on the literal distinctions in the involved marks in arguing that the marks are dissimilar. Vis-à-vis the **STAYFIT SENIORS** Marks, Applicant contends that **STAYFIT PLAN** “evokes a health and wellness strategy, declining to make consumers really think

⁴ For the citations to the record in TTABVUE throughout the decision, the number preceding “TTABVUE” corresponds to the docket entry number; the number(s) following “TTABVUE” refer to the page number(s) of that particular docket entry. *See, e.g., Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473 (TTAB 2014).

about what **STAYFIT** alone provides or evoking thoughts of health plans for seniors as in **STAFYFIT SENIORS**.” Applicant’s Brief, p. 10; 7 TTABVUE 10. As to the **STAYFIT** Marks, Applicant argues that the connotation is distinct from its applied-for mark insofar as it implies “a device, a diet, a supplement, or a plan of maintaining fitness and health without suggesting health care services.” Applicant’s Reply Brief, p. 4; 10 TTABVUE 5.

Applicant’s arguments are unconvincing. First, in comparing Applicant’s mark with the **STAY FIT SENIORS** Marks, the additional descriptive wording **SENIORS** does little to alter the connotation and commercial impression vis-à-vis Applicant’s mark. Disclaimed matter that is descriptive of or generic for a party’s services is typically less significant or less dominant when comparing marks. *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat’l Data Corp.*, 24 USPQ at 752. As noted above, the Board has the discretion to place more weight on a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re Nat’l Data*, 224 USPQ at 751. *See, e.g., In re Dixie Rests., Inc.*, 41 USPQ2d at 1533-34. While we acknowledge the difference in meaning between the descriptive terms **PLAN** and **SENIORS**, we think that prospective consumers encountering Applicant’s mark will focus primarily on the first portion of each mark which is nearly identical. As to the additional design element in Registration No. 3574131, we find that it fails to mitigate the identical sound and nearly identical appearance of the phrase “stay fit” in the involved marks. The shaded figures in Registration

No. 3574131 serve merely as a backdrop for the literal element of the mark which appears in a darker shade. Applicant is reminded of the often-recited principle that when a mark consists of a literal portion and a design portion, the literal portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods and/or services; therefore, the literal portion is normally accorded greater weight in determining whether marks are confusingly similar. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999). *See also CBS Inc. v. Morrow*, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir 1983); *In re Kysela Pere et Fils, Ltd.*, 98 USPQ2d 1261, 1267-68 (TTAB 2011). Furthermore, Applicant's mark could be perceived as a variation of the **STAYFIT SENIORS** mark, relating to a particular plan or strategy to be employed, or Registrant's mark could be perceived as a variation of Applicant's services targeted to seniors.

Turning now to the registered **STAY FIT** Marks, the dominant portion of Applicant's mark is virtually identical to the sole literal element of each of these marks. As to the red heart and black and white curved road depicted in the **STAY FIT** design mark, we find that in this particular case, the presence of these design elements fails to mitigate the highly similar sound, appearance, and connotation of the involved marks. The wording **STAY FIT** appears prominently in large letters inside the red heart and at the "end of the road." Thus, it is likely that prospective consumers will pay less attention to these design elements which serve more as a carrier for the wording **STAY FIT**. Indeed, the inclusion of the heart and road

design, if anything, reinforce the suggestive meaning of the mark “stay fit” as maintaining a healthy heart or cardiovascular system while driving long distances.

Applicant argues that its applied-for mark can co-exist on the Register, contending that “the first component ‘STAYFIT’ is identical to 29 registered marks, including four registered marks within the Applicant’s designated class.” Applicant’s Brief, p. 5; 7 TTABVue 9. That is to say, Applicant contends that the common matter to each mark is diluted or weak. Applicant, however, did not submit any evidence that the phrase “stay fit” is weak when used in connection with Applicant’s or Registrant’s services either by way of introduction of third-party registrations or third-party uses. Thus, on the record before us, we cannot find that “stay fit” is weak or undeserving of protection.

Hence, in comparing Applicant’s mark as a whole to each of the registered marks, we find that Applicant’s mark is similar in sound, connotation and commercial impression to each of the cited registered marks. This first *du Pont* factor weighs in favor of finding a likelihood of confusion.

The Services and Channels of Trade

We turn now to the second and third *du Pont* factors, a comparison of Applicant’s and Registrant’s respective services as they are identified in the application and the cited registration (*see Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014)) as well as the established, likely-to-continue channels of trade. The examining attorney must provide evidence showing that the goods and/or services are related to support a finding of likelihood

of confusion. *See, e.g., In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009) (finding Office had failed to establish that wine and vodka infused with caffeine are related goods). Evidence of relatedness may include news articles and/or evidence from computer databases showing that the relevant goods/services are used together or used by the same purchasers; advertisements showing that the relevant goods/services are advertised together or sold by the same manufacturer or dealer; and/or copies of prior use-based registrations of the same mark for both applicant's goods/services and the goods/services listed in the cited registration. *See, e.g., In re Davia*, 110 USPQ2d 1810, 1817 (TTAB 2014) (finding pepper sauce and agave related where evidence showed both were used for the same purpose in the same recipes and thus consumers were likely to purchase the products at the same time and in the same stores).

Applicant argues that its amendment to the recitation of services obviates any likelihood of confusion because it “now identifies a corporate fitness plan to promote health and wellness that is available to corporate subscribers.” Applicant's Brief, p. 6; 7 TTABVUE 10. Applicant maintains that its services are directed to different consumers, namely those employed by corporate subscribers, and that its amended recitation of services does not encompass either truck drivers or senior citizens. In Applicant's view, its services fall in a distinct trade channel insofar as the recitation is limited to “those employees working with a corporate subscriber using the STAYFIT PLAN services.” Applicant's Brief, p. 9; 7 TTABVUE 13. Applicant further argues that “[t]o maintain that all older citizens and truck drivers are covered by

corporate subscribers, or that all corporate subscribers cover older citizens and truck drivers, is too inclusive and fails to address the separate trade channels of both corporate and general business practices.” *Id.*

The fact that Applicant restricted its recitation of services by deleting many of the originally identified services altogether and narrowing the scope of its online content provision services is of no matter. This is because Applicant’s amended services, when compared to the services identified in the **STAY FIT SENIORS** Registrations of “[c]hiropractic consultation services; chiropractic and health care services; physical therapy; massage therapy,” continue to be related in nature. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000). *See also Coach Servs.*, 101 USPQ2d at 1722 (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). Specifically, the Examining Attorney has made of record use-based third-party registrations (see Registration Nos. 4369805, 4349392, 4367444, and 4383726 from August 28, 2013 Office Action) which suggest that Applicant’s services and those of Stay Fit Senior’s Class 44 services are of a kind that may emanate from a single source. *See In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 at n.6 (TTAB 1988). We find this evidence sufficient to show a commercial relationship between Applicant’s services and Stay Fit Senior’s Class 44 services.

As to the **STAY FIT** Registrations, Applicant's amended recitation of services is sufficiently broad to encompass TA Operating's online content provision services directed toward "truck drivers" and "other drivers." Both Applicant and TA Operating are providing online content on the same subject matters such as health and wellness. As worded, the trade channels may indeed overlap. Applicant's consist of "a subscription-based website for employees of insurance company subscribers" and Registrant's consist of "truck drivers and other drivers." Some "employees of insurance company subscribers" may also be "truck drivers" or "other drivers." So Applicant's identified services could encompass Registrant's truck drivers who are "employees of insurance company subscribers." As such, the trade channels and potential purchasers are partially overlapping. Accordingly, the second and third *du Pont* factors also favor a likelihood of confusion.

To the extent that there are any other *du Pont* factors which may be relevant, we treat them as neutral.

In conclusion, after considering all of the evidence properly of record and arguments pertaining to the *du Pont* likelihood of confusion factors, we find that there is a likelihood of confusion between Applicant's applied-for and Registrants' registered marks.

Decision: The Section 2(d) refusal to register Applicant's mark is affirmed.