

ESTTA Tracking number: **ESTTA645712**

Filing date: **12/18/2014**

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
Submission	Appeal Brief
Attachments	HUMM-50006US01-AppealBrief.pdf(57969 bytes)
Filer's Name	Patrick R. Roche
Filer's e-mail	proche@faysharpe.com, jeanne.liptay@faysharpe.com
Signature	/Patrick R. Roche/
Date	12/18/2014

TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant : QuickPayNet, Ltd.
Mark : **STAYFIT PLAN**
Serial No. : 85/925162
Filed : May 7, 2013
Examining Attorney : David Yontef
Law Office : 118
Attorney Docket No. : HUMM 5 00006US01

ATTN: TTAB
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

APPLICANT APPEAL BRIEF

TABLE OF CONTENTS

TABLE OF CONTENTS..... i

INDEX OF CASES..... ii

INTRODUCTION 1

BACKGROUND 1

APPELLANT’S TRADEMARK 2

THE REJECTION 3

THE ISSUE 3

ARGUMENTS 3

CONCLUSION 10

INDEX OF CASES

CASES

<i>In re Bentley Motors, Ltd.</i> , No. 85325994 (TTAB 2013)	8, 9
<i>In re Dixie Restaurants, Inc.</i> , 105 F.3d 1405, 1406-07 (Fed. Cir. 1997)	4
<i>In re E.I. DuPont de Nemours & Co.</i> , 476 F.2d 1357 (CCPA 1973)	4
<i>In re Majestic Distilling Co.</i> , 315 F.3d 1311, 1315 (Fed. Cir. 2003)	4
<i>In re National Data Corp.</i> , 753 F.2d 1056, 1058 (Fed. Cir. 1985)	4
<i>In re Novice Hockey League, Inc.</i> , 222 USPQ 638, 640 (TTAB 1984)	4

INTRODUCTION

Pursuant to the Request for Reconsideration filed with the Trademark Trial and Appeal Board on September 24, 2014 concurrently with a Notice of Appeal, Applicant hereby appeals the Examining Attorney's Final Office Action mailed March 24, 2014 and the Examining Attorney's denial of the Request for Reconsideration mailed October 16, 2014 to refuse to register the captioned trademark on the Principal Register. Applicant (now Appellant) respectfully requests the Trademark Trial and Appeal Board to reverse the Examining Attorney's decision.

BACKGROUND

An application to register STAYFIT PLAN on the Principal Register was filed May 7, 2013, based on Section 1(a) of the Lanham Act. By an Office Action dated August 28, 2013 the Examining Attorney initially refused registration alleging the mark was highly similar to other registered marks, creating a likelihood of confusion under TMEP § 1207.01. The Examining Attorney also refused registration on the basis that the specimen did not show the applied for mark in commerce as a service mark under TMEP § 904. Further, the Examining Attorney required Applicant to file a disclaimer with respect to the mark component "PLAN" under TMEP § 1213. The Examining Attorney provided Attachments 1-99.

In a response dated February 28, 2014, Appellant substituted the drawing and disclaimed the word "PLAN." On March 24, 2014, the Examining Attorney again refused registration based on likelihood of confusion but asserted that the requirement to disclaim the word "PLAN" had

been satisfied and that refusal based on the differences between the specimen and the drawing had been obviated.

On September 24, 2014, Applicant filed a Request for Reconsideration with a notice of appeal and amended the description of services to restrict the channels of trade for classes of purchasers, thereby making the Applicant's recited services unrelated to those services in the cited registrations.

The Examining Attorney amended the application with respect to the restricted services and denied the Request for Consideration on October 16, 2014, continuing the Section 2(d) refusal. Notably, the Examining Attorney alleged that the services of the parties need only be related in some manner in order to find a likelihood of confusion. The Examining Attorney provided Attachments 1-19. Appellant appeals from this final refusal mailed March 24, 2014 and the denial of the Request for Reconsideration mailed October 16, 2014.

APPELLANT'S TRADEMARK

Appellant seeks registration of its mark STAYFIT PLAN in association with providing a subscription-based website featuring information about health, wellness and nutrition to employees of an insurance plan subscriber, featuring information and advice in the fields of diet, weight loss, diet planning and lifestyle wellness, including 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 in Class 044.

THE REJECTION

The Examining Attorney has refused registration on the Principal Register of Appellant's mark STAY FIT as applied to a website featuring information about health as recited above based on the allegation that the application uses broad wording to describe services, making the mark identical to those already on the register and resulting in a likelihood of confusion pursuant to Section 2(d).

THE ISSUE

The issue presented on this appeal is whether Appellant's mark STAYFIT PLAN, used in association with websites featuring information about health and wellness to employees of an insurance plan subscriber, results in a likelihood of confusion within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d). Appellant asserts it does not.

ARGUMENTS

THE TERM STAYFIT PLAN DOES NOT CREATE A LIKELIHOOD OF CONFUSION.

The Examining Attorney refuses to register STAYFIT PLAN on the Principal Register alleging that the mark creates a likelihood of confusion. It is hereby submitted that the applied-for mark does not create a likelihood of confusion with marks containing the STAYFIT formative and therefore, reversal of the final refusal is respectfully requested.

The following are the most relevant to identify if a particular term creates a likelihood of confusion under Trademark Act Section 2(d):

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
- (2) The relatedness of the goods or 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 goods; and
- (6) A valid consent agreement between the applicant and the owner of the previously registered mark.

In re E.I. DuPont de Nemours & Co., 476 F.2d 1357 (CCPA 1973); *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315 (Fed. Cir. 2003); *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 1406-07 (Fed. Cir. 1997); *In re Novice Hockey League, Inc.*, 222 USPQ 638, 640 (TTAB 1984); TMEP § 1207.01.

Particularly, the Federal Circuit has provided the following guidance with regard to determining and articulating likelihood of confusion:

The basic principle in determining confusion between marks is that marks must be compared in their entireties and must be considered in connection with the particular goods or services for which they are used (citations omitted). It follows from that principle that likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark (footnote omitted). 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 (footnote omitted). Indeed, this type of analysis appears to be unavoidable.

In re National Data Corp., 753 F.2d 1056, 1058 (Fed. Cir. 1985).

In the present case, we are faced with an ex parte refusal of registration. In such a situation, it is the Examining Attorney's burden to show that the mark sought to be registered is

so confusingly similar that consumers would be mistakenly led to believe that the services come from a common source. Numerous factors are relevant to the determination of likelihood of confusion, however, typically the Examining Attorney focuses on the similarity of the marks and goods. Particularly, an Examining Attorney must show that the mark sought to be registered is similar in its entirety, as to appearance, sound, connotation and commercial impression from the perspective of the average purchaser of the applicant's services. The comparison is limited to the mark as drawn in the application and as shown in any cited registrations.

Appellant submits that mark sought to be registered does not create a likelihood of confusion.

1. IN ITS ENTIRETY, STAYFIT PLAN IS DISSIMILAR TO REGISTERED MARKS.

STAYFIT PLAN is dissimilar enough from the Examining Attorney's cited marks so as not to create a likelihood of confusion. Under the first *DuPont* factor, the Examining Attorney must take into account the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. Applicants acknowledge that with respect to appearance and sound, the first component "STAYFIT" is identical to 29 registered marks, including four registered marks within the Applicant's designated class. However, use of identical words does not automatically mean that two marks are confusingly similar. Indeed, even identical words of marks in the same class do not preclude registration.

For example, WHISKEY TANGO (Reg. No. 86188577) and WHISKEY TANGO FOXTROT (Reg. No. 85978008) are both registered under International Class 016. Both have an identical components both in appearance and sound, yet both marks are registered on the

Principal Register. In their entireties, WHISKEY TANGO and WHISKEY TANGO FOXTROT have related yet dissimilar connotations and commercial impressions. Clearly both are related to paper goods, yet the marks cater to different consumers and denote different sources.

Similarly, STAYFIT PLAN may coexist within the same class as STAYFIT, STAYFIT, STAYFIT SENIORS, and STAYFIT SENIORS. Applicant agrees with the Examining Attorney that the likelihood of confusion concerns source rather than services, but the Applicant's mark in its entirety denotes a different source other than those previously mentioned. Overall, STAYFIT PLAN evokes a health and wellness strategy, declining to make consumers really think about what STAYFIT alone provides or evoking thoughts of health plans for seniors as in STAYFIT SENIORS. While STAYFIT PLAN provides related services to those marks containing STAYFIT formatives, the overall appearance, sound, connotation, and commercial impression evoke a different source of health and wellness services.

2. THE SERVICES OF STAYFIT PLAN ARE NOT SO RELATED SO AS TO PRECLUDE REGISTRATION.

As stated above, Applicant amended the services of STAYFIT PLAN to reflect providing a subscription-based website featuring information about health, wellness and nutrition to employees of an insurance plan subscriber, featuring information and advice in the fields of diet, weight loss, diet planning and lifestyle wellness, including 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 in Class 044. As such, the mark now identifies a corporate fitness plan to promote health and wellness that is available to corporate subscribers.

Applicant acknowledges that its mark is related to the marks the Examining Attorney has cited; however, the marks are geared toward providing services to different and separate groups of consumers. While the Examining Attorney argues that the wording used to describe the Applicant's services is broad and encompasses all services of the type described "including providing a subscription-based website for young and old employees and motorists employed by corporate subscribers," making the services commercially-related to the registrants' services. However, respectfully the Examining Attorney has read the provided services of the Applicant's mark too broadly.

In determining whether an applicant has identified goods very broadly, the Examining Attorney must consider the following guidelines:

1. A term that clearly includes particular items that are classified in more than one class is not acceptable. However, the conclusion that a term would clearly include items in more than one class should not be drawn unless reasonable ;
2. Some terminology is sufficient for purposes of according a filing date but too indefinite to enable proper examination to be made;
3. An identification that can be understood when read in association with the title of the of the class in which it is placed, and that is otherwise satisfactory, should not be required to be further qualified by amendment ;
4. The common understanding of words or phrases used in an identification determine the scope and nature of the goods or services. A basic and widely-available dictionary should be consulted to determine the definition or understanding of a commonly used word ; and
5. Many goods are commonly understood to move in a particular channel of trade or have particular attributes. When those goods are classified in the class that is appropriate for that common understanding, very often no further specification as to the nature of those goods is necessary.

TMEP § 1402.03. Further, "[t]he appropriateness of any broad identification depends on the facts in the particular case. The examining attorney should permit applicants to adopt terms that are as broad as the circumstances justify." *Id.*

The Applicant's mark is specifically directed toward corporate subscribing consumers. While these consumers may be tangentially related to truck drivers and seniors, the description of services is certainly not all encompassing. Certainly the description provided includes items within one class and a common understanding of words or phrases used in the identification determines the scope and nature of the services offered.

Using the same examples cited above regarding WHISKEY TANGO and WHISKEY TANGO FOXTROT, both marks have descriptions including paper goods. WHISKEY TANGO specifically states "including books" while WHISKEY TANGO FOXTROT also includes specific examples of books, including address books, check books, journal books, etc. Likewise, STAYFIT PLAN describes a group of specific services aimed at a specific subset of consumers (i.e. those employed by corporate subscribers) and should be able to coexist on the Principal Register. No further specificity in the description excluding truck drivers or seniors is necessary. Therefore STAYFIT PLAN evokes a health and wellness plan related, but not necessarily identical, to registrants.

3. STAYFIT PLAN CATERS TO DISSIMILAR TRADE CHANNELS.

The Examining Attorney erroneously asserts that the identifications set forth in the applicant's registration has no restrictions as to nature, type, channels of trade, or classes of purchasers. In *In re Bentley Motors, Ltd.*, the TTAB reversed the Office's Section 2(d) refusal of Bentley Motors Ltd.'s ("Bentley") application to register the mark BENTLEY on the Principal Register. Bentley was seeking a standard character format mark for "Perfume, cologne, aftershave, deodorants, cosmetics, hair lotions, soaps, personal hygiene products" in International Class 003 and "articles of glass, crystal, earthenware and bottles and containers of

glass; decanters; perfume bottles” in International Class 021. *Id.* The Examining Attorney refused registration on the grounds that Bentley’s mark so resembled BENTLEY, BENTLEY UNIVERSITY, BENTLEY ORGANIC, and BENTLEY ORGANIC registered to other entities. *Id.* The Examining Attorney noted that as the applicant’s identification did not describe the goods with any limitations as to trade channels, it was presumed that the goods moved in all normal channels of trade. *Id.*

The applicant amended its identification to include that its goods would be and sold through authorized vehicle dealers and vehicle service outlets. *Id.* The TTAB asserted that the “burden is on the Office to show that ordinary trade channels for registrants’ goods overlap with applicant’s very limited trade channel” and found that the trade channels did not overlap with those of the other registrants. *Id.* Moreover there was nothing in the record to suggest that the ordinary trade channels for registrants’ goods include “authorized vehicle dealers and vehicle service outlets.” *Id.*

Similarly, Applicant’s mark uses a distinct trade channel from those of the cited registrations for STAYFIT, STAYFIT, STAYFIT SENIORS, and STAYFIT SENIORS. Applicant’s STAYFIT PLAN services are specific as being available to *employees of a corporate subscriber*. The trade channel is limited to only those employees working with a corporate subscriber using the STAYFIT PLAN services. To 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 channels of both corporate and general business practices. Therefore, STAYFIT PLAN is limited to a particular trade channel outside those of the marks currently on the Principal Register.

CONCLUSION

Appellant submits that STAYFIT PLAN as applied to its stated services does not create a likelihood of confusion. In its entirety, the mark is different in appearance, sound, connotation, and commercial meaning from other marks bearing the STAYFIT formative. STAYFIT PLAN also suggests services related to those offered by registrants but not so related so as to preclude registration or cause source confusion. Further, Applicant's STAYFIT PLAN services utilize distinct trade channels from those of the registrants. Thus, the mark is registerable on the Principal Register. The Board is, therefore, respectfully requested to reverse the Examining Attorney's decision refusing registration.

Respectfully submitted,

FAY SHARPE LLP

Date: December 18, 2014

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

HUMM 500006US01 811522 1