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

Proceeding	85981686
Applicant	Jonathan Roche Fitness Ventures LLC
Applied for Mark	NO EXCUSES DIET
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Date	09/16/2015

**In the United States Patent & Trademark Office  
Before the Trademark Trial and Appeal Board**

Applicant/Appellant:	<b>Jonathan Roche Fitness Ventures LLC</b>
Serial No.:	<b>85/981686</b>
Filing Date:	<b>July 25, 2012</b>
Mark:	<b>NO EXCUSES DIET</b>
Class:	<b>016</b>
Description of Goods:	<b>books in the field of food in health and wellness</b>
Docket:	<b>SBT0.T0201US</b>
Examining Attorney:	<b>Jessica Hilliard</b>
Law Office:	<b>120</b>
Appeal no.	<b>ESTTA669401</b>

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**Reply Brief**

Commissioner for Trademarks  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear TTAB:

The present Reply Brief is submitted in support of the Appeal Brief of June 29, 2015 and the Notice of Appeal filed electronically on April 29, 2015. This Reply Brief is timely filed within 20 days of the Examining Attorney's Brief of August 27, 2015.

I. **Applicant's/Appellant's Mark Functions as a Trademark**

For this particular case, we start with that point that it is now completely acceptable that what may in some senses appear to be a book title can nevertheless be a trademark under particular circumstances. A different analysis must be made, not merely determining whether a title of a single work is found, or even whether or not a series appears. The ultimate question is what the consumers are confronted with; would they see a trademark or a mere book title?

In this case, Appellant has noted in detail that the circumstances of this particular case indicate that this mark acts as a mark on a portal to numerous – i.e., a series – of other works accessible through this singular portal labeled with the mark in question. The appearance on a conventional book is not the end of the analysis.

Indeed, the issue about the specimens (see below also) is really about this first, ultimate determination that here, what may of otherwise been thought of as a title of a work (single or not), does actually function as trademark in this case. Here the prior argument and specimens show all necessary features of trademark functioning and thereby the use of the phrase “No Excuses Diet” is appropriately functioning as a trademark on Appellant’s products, including the book and webpage specimens provided. Consumers are made aware of the purveyors of, the source and origin of, the plurality of materials at issue. The fact that it also appears in the title of the book is not determinative of whether it is actually functioning as a mark and as such should be registered.

The rejections are thus in error and must be reversed.

**II. Series of Works**

Contrary to the conclusory findings of the Examining Attorney, the current mark is used on a series of materials.

The webpage linked to the book as well as the additional internet materials disposed on the webpage or linked thereto do constitute additional materials sufficient to constitute a series.

Indeed, Applicant has alleged that the webpage with the list of web links, articles, and checklists are additional materials in the series of works available through and via this trademark.

Applicant also notes that these are not limited to an audio book version – thus *Mattel v. Brainy Baby Co* is not apposite. See also TMEP 1202.08(c). Indeed, this may be where Applicant and Examiner have diverged in appreciation of the issues. Rather, the issue of TMEP1202.08(c) and the *Mattel* case relied upon there is that: use of another form of the same underlying creative work is not a series; in the *Mattel* case, a CD and a DVD having substantially the same material thereon. Rather, rather, the question is content – is it substantially the same or different? And, the mere fact that another form of publication (here webpage vs. book) is

not the question, i.e., not the determining factor. Here, Applicant's webpage content is different; it is not a mere change of format, and thus TMEP1202.08(c) does not apply.

In sum, the difference in material substantively is what causes the material to constitute a series.

Indeed, Applicant notes that the Examiner's Brief cites no authority for this allegation that the different form of publication is the determining factor. Again, TMEP 1202.08(c) is directed to the same material in different forms; not to the question of different material in different forms.

Appellant's different material regardless of form constitutes a series.

The rejection is thus in error and must be reversed.

### **III. Specimens**

The issue about the specimens was not about mere specimen acceptability (i.e., not about whether a particular specimen is acceptable under the separate/discrete rules of whether a specimen should be accepted in the registration process); but, rather, the discussion of specimens by Appellant was about the ultimate conclusion of whether a title of a work (single or not) actually functions as trademark. Here the prior argument and specimens show all the necessary minimum features of trademark functioning and thereby the use of the phrase

“No Excuses Diet” is appropriately functioning as a trademark on Appellant’s webpage specimen provided. Consumers are directed to and made aware of the provider of the combined series of materials offered through the NO EXCUES DIET mark. The fact that it also appears in the title of the book is not determinative of whether it is actually functioning as a mark and as such should be registered.

The Appellant thus respectfully requests that the issue of specimens be reviewed as it was meant to be understood, as part of the ultimate question of whether the mark appropriately functions as a mark. Here, it does and should thus be found so.

**IV. Conclusion**

For the reasons set forth in detail above, inter alia, the refusal of registration based on the mark allegedly not functioning as a trademark are not supported and thereby refusal of registration should be reversed and the allowance of the present application is warranted and requested. Favorable action is respectfully requested. Appellant respectfully submits that all outstanding issues have been addressed; and that no waiver for any alleged failure to address may be found. If any additional issues not appearing thus far may find want of address, Appellant respectfully requests being given an appropriate opportunity to respond.

Respectfully submitted this 16th day of September 2015.

/peterbscull/  
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