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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Esther Yang

Serial Nos. 88708065 and 88708080

Esther Yang, pro se.

Kerry A. Nicholson, Trademark Examining Attorney, Law Office 120,
David Miller, Managing Attorney.

Before Kuhlke, Taylor and Lebow,
Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Esther Yang, a United States citizen and resident of New York, NY ("Applicant") seeks registration on the Principal Register of the wording HOT KARATE (in standard characters) for, as amended, the following services:

> Fitness boot camps; Charitable services in the nature of providing fitness instruction in the field of martial arts, yoga, pilates; Conducting fitness classes; Consulting services in the fields of fitness and exercise; Counseling services in the field of physical fitness; Education services, namely, providing panel discussions in the field of karate; Educational services, namely, providing cognitive fitness programs for seniors; Entertainment in the nature of providing an informational and entertainment website in the fields of celebrity gossip, entertainment, sports and

> fitness; Personal fitness training services; Personal fitness training services and consultancy; Personal fitness training services featuring aerobic and anaerobic activities combined with resistance and flexibility training; Personal trainer services; Physical fitness assessment services; Physical fitness conditioning classes; Physical fitness consultation; Physical fitness instruction; Physical fitness studio services, namely, providing exercise classes, body sculpting classes, and group fitness classes; Physical fitness studio services, namely, providing group exercise instruction, equipment, and facilities; Physical fitness training of individuals and groups; Physical fitness training services; Providing fitness and exercise studio services, namely, pilates instruction and training; Providing fitness training services in the field of health and wellness; Providing a web site featuring information on exercise and fitness; Providing a website featuring information on exercise and fitness; Providing an interactive website featuring information and links relating to fitness; Providing an on-line computer database featuring information regarding exercise and fitness; Providing classes, workshops, seminars and camps in the fields of fitness, exercise, boxing, kick boxing and mixed martial arts; Providing general fitness and mixed martial arts facilities that require memberships and are focused in the fields of general fitness, exercise, and mixed martial arts; Providing physical fitness and exercise service, namely, indoor cycling and yoga instruction

in International Class 41; and the wording HOT SELF DEFENSE (in standard characters) for, as amended:

> Fitness boot camps; Charitable services in the nature of providing fitness instruction in the field of pilates, yoga, martial arts, karate, health and wellness self-defense; Conducting fitness classes; Consulting services in the fields of fitness and exercise; Counseling services in the field of physical fitness; Education services, namely, providing panel discussions in the field of pilates, yoga, martial arts, karate, health and wellness self defense; Educational services, namely, providing cognitive fitness programs for seniors; Entertainment in the nature of providing an informational and entertainment website in the fields of celebrity gossip, entertainment, sports and fitness;

> Personal fitness training services; Personal fitness training services and consultancy; Personal fitness training services featuring aerobic and anaerobic activities combined with resistance and flexibility training; Personal trainer services; Physical fitness conditioning classes; Physical fitness consultation; Physical fitness instruction; Physical fitness studio services, namely, providing group exercise instruction, equipment, and facilities; Physical fitness training of individuals and groups; Physical fitness training services; Providing fitness training services in the field of health and wellness; Providing a web site featuring information on exercise and fitness; Providing a website featuring information on exercise and fitness; Providing an interactive website featuring information and links relating to fitness; Providing an on-line computer database featuring information regarding exercise and fitness before and after pregnancy; Providing classes, workshops, seminars and camps in the fields of fitness, exercise, boxing, kick boxing and mixed martial arts; Providing physical fitness and exercise service, namely, indoor cycling and yoga instruction

in International Class 41.[1]

The Trademark Examining Attorney refused registration of Applicant's marks on the ground that they are merely descriptive of a feature of the services under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1).

When the Examining Attorney made the refusals final, Applicant appealed in each case and requested reconsideration, which was denied. Applicant and the Examining Attorney filed briefs in each case. We affirm the refusals to register.

[1] Both application Serial No. 88708065 ("the '065 application") and application Serial No. 8870808 ("the '808 application") were filed on November 26, 2019, based upon Applicant's allegation of a bona fide intention to use each mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

I. Appeals Consolidated

Initially we note that the issues presented in both appeals are essentially the same, and the arguments and evidence advanced by Applicant and the Examining Attorney are very similar in each case. We accordingly consolidate the two appeals and will decide them in a single opinion. *See In re Binion*, 93 USPQ2d 1531, 1533 (TTAB 2009); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE § 1214 (2021). Unless otherwise stated, all references to the briefs and evidentiary record are to application Serial No. 88708065.[2]

II. Mere Descriptiveness

A. The Arguments and Evidence

The Examining Attorney contends that the phrases HOT KARATE and HOT SELF DEFENSE are merely descriptive, specifically arguing that the individual terms and their composite result in each mark merely describe a feature of Applicant's identified physical fitness and training services common to both applications. In support of this position the Examining Attorney submitted the following:

- A definition taken from the MERRIAM-WEBSTER online dictionary, defining "hot" as "having a relatively high temperature."[3]

[2] Page references herein to the application record are to the downloadable .pdf version of the USPTO's Trademark Status & Document Retrieval (TSDR) system. References to the briefs and orders on appeal are to the Board's TTABVUE docket system. Where applicable, complete URLs can be found at the TSDR cite.

[3] March 4, 2020 Office Action, TSDR 6 (www.merriam-webster.com).

- Web page captures from various websites showing that "third parties in the fitness industry use the term 'hot' to inform consumers that the services will be provided in rooms with temperatures ranging from 90 to 108 degrees Fahrenheit and to refer to heated workouts." For example:

  > An article from VERYWELL FIT (www.verywellfit.com) titled "Temperatures of Hot Yoga Studios" explains "[a] popular style of yoga class, hot yoga is essentially a regular yoga workout in a hot and sometimes humid room. The different types of hot yoga classes range in temperature from 90 degrees F to 108 degrees F, with varying levels of humidity";[4]
  >
  > The Melt House of Fitness website (www.melthouseoffitness.com) touts that its facilities are "DARK. LOUD. HOT.";[5]
  >
  > An article from U.S. NEWS & WORLD REPORT (www.health.usnews.com) titled "Are Hot Workouts Healthier?" recounts an experience of at The Sweat Shoppe, a heated spin studio in North Hollywood and, under the sub-heading "Hot and Beneficial or Hot and Bothered?," discusses why heated fitness classes may be healthier than their cooler counterparts;[6]
  >
  > The Body Alive website (www.alivefitness.com) highlights their yoga studio, explaining that "Nothing has been accomplished without a little sweat. That's why we always bring the heat, whether that comes from within or inside of our 102 degree, 40% humidity room."[7]

- Four third-party registrations of marks registered on the Supplemental Register for services the same as or similar to those of Applicant, some

[4] *Id*. at TSDR 21-22.

[5] August 31, 2020 Final Office Action, TSDR 5.

[6] *Id*. at TSDR 10-14.

[7] *Id*. at TSDR 20.

which include disclaimers of generic components. These registrations include:[8]

Registration No.	Mark	Relevant Services
4829215	HOT STRETCH	Yoga instruction
5450391	CLASSIC HOT PILATES (PILATES disclaimed)	Pilates instruction [and] providing fitness instruction in the field of pilates
5466538	HOT YOGA BRICKELL (YOGA disclaimed)	Health and fitness, namely, yoga instruction
5510200	HOT HIIT (HIIT disclaimed)	Physical fitness instruction

- Statements made by Applicant in each application in response to the Examining Attorney's request for information (discussed more fully below).

The Examining Attorney also requests that we take judicial notice of a definition of "exercise" from the AMERICAN HERITAGE DICTIONARY.[9] However, the Examining Attorney only provided the definition embedded in her brief and a link to the webpage where the definition presumably resides.[10] Applicant did not object to the inclusion of the definition in the record, and it is well-established that "[t]he Board may take judicial notice of definitions from printed dictionaries that were not made of record prior to appeal, and may do so either sua sponte or upon request of the applicant or examining attorney." TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 710.01(c) (July 2021). Despite the Examining Attorney's procedural shortcomings,

[8] March 21, 2021 Denial of Request for Reconsideration, TSDR 4-14.

[9] 8 TTABVUE 7 (The Examining Attorney's brief).

[10] We make clear "that providing hyperlinks to Internet materials is insufficient to make such materials of record." *In re Powermat Inc.*, 105 USPQ2d 1789, 1791 (TTAB 2013) (citing *In re HSB Solomon Assocs. LLC*, 102 USPQ2d 1269, 1274 (TTAB 2012) ("a reference to a website's internet address is not sufficient to make the content of that website or any pages from that website of record.")).

we sua sponte take judicial notice of the definition from the AMERICAN HERITAGE DICTIONARY which defines "exercise," in pertinent part, as "[a] specific activity performed to develop or maintain fitness or a skill."[11]

Applicant, by contrast, maintains that her proposed marks enjoy other meanings and, thus, are registrable.[12] Applicant relies on alternate definitions of "hot" in making this argument, i.e., "currently popular or in demand," "very good," "eager," "zealous," "close to something sought," "unusually lucky or favorable," and "temporarily capable of unusual performance (as in sport)."[13] Applicant's brief, p. 1-2.[14]

B. Applicable law

Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), prohibits registration of a mark which, when used on or in connection with an applicant's services, is merely descriptive of them. A term is merely descriptive of services if it conveys an immediate idea of a quality, characteristic, feature, function, purpose or use of the services. *See, e.g., In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). A term need only describe a single significant quality or property of the services. *Gyulay*, 3

[11] www.ahdictionary.com, last visited October 25, 2021.

[12] Although Applicant argues that her marks have "secondary meaning" (and has relied on cases involving the issue of acquired distinctiveness), Applicant is not arguing acquired distinctiveness but, rather, that the application of another meaning of the word "hot" to her marks results in marks with a double entendre.

[13] March 4, 2020 Office Action, TSDR 7-8 (www.merriam-webster.com).

[14] 6 TTABVUE 2-3.

USPQ2d at 1009; *Methanide Metal Corp. v. Int'l Nickel Co.*, 262 F.2d 806, 120 USPQ 293, 294 (CCPA 1959).

Whether a term is merely descriptive is determined not in the abstract, but in relation to the services for which registration is sought, the context in which it is being used on or in connection with those services, and the possible significance that the term would have to the average purchaser of the services because of the manner in which the mark is used or intended to be used. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007). The question is whether someone who knows what the services are will understand the term to convey information about them. *DuoProSS Meditech Corp. v. Inviro Med. Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012).

With respect to the breadth of services covered by an applicant's identification, if an applicant's mark is merely descriptive for any of the listed services in a single class in the application it cannot be registered, even if it is not merely descriptive with respect to other of the listed services [in that class]. "A descriptiveness refusal is proper 'if the mark is descriptive of any of the services for which registration is sought.'" *In re Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219 (quoting *In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005)). *See also In re Franklin Cnty. Historical Soc'y*, 104 USPQ2d 1085, 1089 (TTAB 2012).

Last, when two or more merely descriptive terms are combined, the determination of whether the composite mark also has a merely descriptive significance turns on whether the combination of terms evokes a new and unique commercial impression.

If each component retains its merely descriptive significance in relation to the goods, the combination results in a composite that is itself merely descriptive. *See, e.g., DuoProSS*, 103 USPQ2d at 1757 (SNAP SIMPLY SAFER merely descriptive of "medical devices, namely, cannulae; medical, hypodermic, aspiration and injection needles; medical, hypodermic, aspiration, and injection syringes").

C. **Analysis**

Initially we note that a mark comprising more than one element must be considered as a whole and should not be dissected. Nonetheless, we may consider the significance of each element separately in the course of evaluating the mark as a whole. *See DuoProSS* 103 USPQ2d at 1756-57 (noting that "[t]he Board to be sure, can ascertain the meaning and weight of each of the components that makes up the mark").

Turning first to the HOT component that is common to both of Applicant's applied-for marks – HOT KARATE and HOT SELF DEFENSE –, we find that the definition "having a relatively high temperature" together with the third-party registrations and Internet evidence demonstrate that Applicant's identified physical fitness instruction and training services, including providing fitness instruction in the field of martial arts and the identified "[p]rovi[sion of] classes … in the fields of fitness, exercise, boxing, kick boxing and mixed martial arts," are conducted at a relatively

high temperature, which the record shows to exceed 100 degrees F. Indeed, Applicant, in response to the Examining Attorney's request for information,[15] explained that:

> The wording "HOT" in the mark [HOT KARATE] has specific meaning and significance in the relevant trade or industry because my method of teaching the martial art of karate is performed in controlled high temperatures exceeding 100 degrees Fahrenheit, to enhance the physical exercise and weight loss experience which I endeavor to impart to my students. For your information, I have been practicing karate for over 20 years and enjoy second degree black belt status in this martial art.[16]

Similarly, in application Serial No. 88708080, Applicant again responds to an information query that:

> The wording "HOT" in the mark [HOT SELF DEFENSE] has specific meaning and significance in the relevant trade or industry because my method of teaching self-defense modalities is performed in controlled high temperatures exceeding 100 degrees Fahrenheit, to enhance the physical exercise and weight loss experience which I endeavor to impart to my students.[17]

As to the word KARATE in HOT KARATE and the term SELF DEFENSE in HOT DEFENSE, they are used in the recitations of services and merely describe the nature of the identified physical fitness instruction and training services, i.e., a specific martial arts discipline as to the word "karate" or, in the case of the term "self defense," an umbrella term covering Applicant's specifically identified "health and wellness self

[15] The Examining Attorney specifically requested Applicant to "[1] Explain whether the wording 'HOT' in the mark[s have] any meaning or significance in the trade or industry in which applicant's services are provided, any meaning or significance as applied to applicant's services, or if such wording is a term of art within applicant's industry. March 4, 2020 Office Action, TSDR 3.

[16] Applicant's August 24, 2020 Response to Office Action, TSDR 5.

[17] Applicant's August 24, 2020 Response to Office Action (Serial No. 88708080), TSDR 5.

defense." More particularly, and as highlighted by the Examining Attorney in her brief:

> [A]pplicant has identified various fitness classes using broad language, which encompass the teaching of self-defense. *See, e.g., In re Solid State Design Inc*., 125 USPQ2d 1409, 1412-15 (TTAB 2018); *Sw. Mgmt., Inc. v. Ocinomled, Ltd*., 115 USPQ2d 1007, 1025 (TTAB 2015). Applicant stated that its "method of teaching self-defense modalities is performed in controlled high temperatures exceeding 100 degrees Fahrenheit, to enhance the *physical exercise*" … The American Heritage Dictionary shows that "exercise" is "a specific activity performed to develop or maintain fitness or a skill." Thus, since applicant's teaching of self-defense is a type of "physical exercise," it is encompassed by applicant's broadly-worded fitness services.

The Examining Attorney's brief (emphasis added in the brief, internal citations to the record omitted).[18] In fact, Applicant stated that the word "Karate" in the phrase "Hot Karate" and the words "Self Defense" in the phrase "Hot Self Defense" are "clearly intended to refer to the notion of physical fitness …."[19]

In this case, both the wording "HOT KARATE" and "HOT SELF DEFENSE," as whole terms, immediately describe features of Applicant's services. Nothing in the combination of terms is incongruous, indefinite or ambiguous when considered in relation to Applicant's services and, consequently, no imagination, thought or gathering of further information would be necessary in order for customers to perceive the merely descriptive significance of either HOT KARATE or HOT SELF DEFENSE. That is, both terms merely describe features of Applicant's services,

[18] 6 TTABVUE 7-8 (Serial No. 88708080).

[19] 6 TTABVUE 3 (Applicant's brief, p. 3 fn. 2) [Same citation in both proceedings.].

namely that Applicant's self-defense services and fitness instruction and fitness instruction in the field of martial arts and karate, will take place in "hot" rooms with temperatures exceeding 100 degrees Fahrenheit.

We are not persuaded by Applicant's contention that the combination of the words "HOT KARATE" and "HOT SELF DEFENSE" are registrable because they create terms with "double meanings." We appreciate Applicant's possible suggested other meanings in that "hot" as defined by MERRIAM-WEBSTER dictionary also means "currently popular or in demand" (as well as the other meanings noted above), and that the "secondary [or other] meaning[s]" are "precisely the image intended to be purveyed by the Applicant through the use of the term 'HOT KARATE' (and the term 'HOT SELF DEFENSE') … directed at both young and old consumers of fitness services which Applicant intends to purvey and has purveyed through the use of the subject term[s]."[20] However, these suggested other meanings, which are not recognized idioms, are simply too tenuous to be readily perceived and understood by relevant purchasers who encounter the marks in connection with Applicant's physical fitness instruction and training services. *See, e.g., In re Wells Fargo & Co.*, 231 USPQ 95 (TTAB 1986) (EXPRESSERVICE merely descriptive of banking services; alleged "Pony Express" double entendre would not be readily recognized).

We find that purchasers would immediately perceive "hot" as "having a relatively high temperature" in connection with Applicant's exercise classes, physical fitness instruction and training services, for the following reasons: firstly, the widely

[20] 6 TTABVUE 3 (Applicant's brief p. 2) [Same citation in both proceedings].

accepted meaning of "hot" as "having a relatively high temperature" to Applicant's services; secondly, the Examining Attorney's evidence that the word is commonly used in connection with such services; and lastly, the absence of evidence that relevant purchasers are familiar with or would readily recognize double entendres suggested by Applicant. Moreover, it is clear from the evidence of record that others in the physical fitness instruction and training field, and the self-defense field, have a competitive need to use the term "hot" descriptively in connection with their services.

Finally, we find unpersuasive Applicant's argument that it would be inconsistent to deny registration of Applicant's mark since the Office has already registered the mark "HOT HIIT" (the subject of Registration No. 5510200) for "physical fitness instruction."[21] Apart from the fact that each case must be decided on its own merits, *see In re Midwest Gaming,* 106 USPQ2d at 1165 n.3 *(*citing *In re Nett Designs, Inc.,* 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)), Registration No. 5510200 is a Supplemental Register registration. Registration on the Supplemental Register

[21] 6 TTABVUE 4 (Applicant's brief, p. 3). Applicant specifically argues:

> [T]he Office has already approved the name "HOT HIIT" (Serial No. 87-629,824; Registration No. 5,510,200) (submitted to the Office). As that registration indicates, that name also was approved in connection with "Class 041: Physical fitness instruction." Both words are descriptive of the services for that name, because the instruction furnished under that name entail both heat (hence the word "HOT") and high intensity interval training (hence the word "HIIT"). There is no logical reason why that name was approved, while the Applicant's name "HOT KARATE" was not.

constitutes an admission that the mark is descriptive at the time of registration.[22] *See In re Clorox Co.*, 578 F.2d 305, 198 USPQ 337, 340 (CCPA 1978). As such, rather than support Applicant's contention that its mark is entitled to registration, Registration No. 5510200 (HOT HIIT, HIIT disclaimed) supports a finding of mere descriptiveness.

D. Conclusion

After careful consideration of all of the evidence and arguments presented, we conclude that when applied to Applicant's identified fitness instruction and physical fitness training services, the phrases HOT KARATE and HOT SELF DEFENSE immediately describe, without any multi-step thought process, a characteristic or feature of those services, namely, that Applicant's physical fitness instruction and training services, especially fitness instruction in the field of martial arts and karate, will take place in "hot" rooms with temperatures exceeding 100 degrees Fahrenheit.

Decision: The refusals to register HOT KARATE (Serial No. 88708065) and HOT SELF DEFENSE (Serial No. 88708080) pursuant to Section 2(e)(1) of the Trademark Act are affirmed.

[22] In addition, we note that registrations on the Supplemental Register are entitled to no statutory presumptions under Section 7(b) of the Trademark Act. *See* Section 26 of the Trademark Act ("registrations on the supplemental register shall not be subject to or receive the advantages of [Section 7(b) of the Act]"; *In re Federated Department Stores Inc.*, 3 USPQ2d 1541, 1543 (TTAB 1987) (a Supplemental Register registration is evidence of nothing more than the fact that the registration issued on the date printed thereon).