

This Opinion is Not a
Precedent of the TTAB

Mailed: June 21, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Surf Ready Fitness

Serial No. 90548268
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Tyler K. Berger of Berger Law Firm, PLLC,
for Surf Ready Fitness.

James MacFarlane, Trademark Examining Attorney, Law Office 104,
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Before Shaw, Larkin and English,
Administrative Trademark Judges.

Opinion by English, Administrative Trademark Judge:

Surf Ready Fitness (“Applicant”) seeks registration on the Principal Register of

the mark  for “providing physical fitness training services with multifunctional movements and exercises for comprehensive cardiovascular and strength training; publication of information, namely, publication of blog posts and newsletters in the fields of fitness, sports, exercise and nutrition via the internet, websites, and social media; publication of information, namely, providing online, non-downloadable

videos in the fields of fitness, sports, exercise and nutrition via the internet, websites, social media and online industry publications” in International Class 41.¹

The Examining Attorney refused registration of the mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with the following standard-character marks owned by the same individual (the “Registrant”):

- SRF for “tote bags” in International Class 18 and “shirts, sweatshirts, jackets, hoodies, hats, pants, sweatpants, sweaters, pullovers, headwear” in International Class 25;² and
- SRF LA (LA disclaimed) for “hoodies; shirts; sweatshirts” in International Class 25.³

When the refusal was made final, Applicant appealed. Both Applicant and the Examining Attorney filed appeal briefs.⁴ For the reasons explained, we affirm the refusal to register.

¹ Application Serial No. 90548268; filed on February 26, 2021 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(b), claiming July 26, 2018 as the date of first use anywhere and in commerce. The application includes the following description of the mark: “The mark consists of the lettering ‘S R F’ contained within a single-line circle.” Color is not claimed as a feature of the mark.

The application, as originally filed, also included “t-shirts; hoodies; sweaters; pants” in International Class 25. February 26, 2021 Application, TSDR 4. Applicant subsequently deleted these goods from the application. February 24, 2022 Office Action Response, TSDR 3.

² Registration No. 6180845; registered October 20, 2020.

³ Registration No. 5579419; registered October 9, 2018.

⁴ Applicant attached to its appeal brief evidence that it introduced during prosecution. This was improper. *In re Info. Builders Inc.*, 202 USPQ2d 10444, at *2 n.4 (TTAB 2020) (attaching previously submitted evidence to an appeal brief is unnecessary and impedes efficient disposition of the appeal by the Board), *appeal dismissed*, No. 20-1979 (Oct. 20, 2020); *In re Michalko*, 110 USPQ2d 1949, 1950-51 (TTAB 2014) (“Parties to Board cases occasionally seem to be under the impression that attaching previously-filed evidence to a brief and citing

I. Analysis

“The Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion [or] mistake, or to deceive.” *In re Charger Ventures LLC*, 64 F.4th 1375, 2023 USPQ2d 451, at *2 (Fed. Cir. 2023) (cleaned up). Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on likelihood of confusion. *In re E. I. DuPont de Nemours & Co*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”) cited in *B&B Hardware, Inc. v. Hargis Ind., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015); *see also Charger Ventures*, 2023 USPQ2d 451, at *4.

We consider each *DuPont* factor for which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019); *M2 Software, Inc. v. M2 Commc’ns., Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”). Varying weight, however, may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Cap. City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any

to the attachments, rather than to the original submission is a courtesy or a convenience to the Board. It is neither.”).

particular determination”). Moreover, “each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relatedness of the goods and services. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”); *see also In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)). We address these two factors and other relevant *DuPont* factors below.

We focus our Section 2(d) analysis on the cited standard-character mark SRF (referred to as the “cited mark”) because we find it is the most similar to Applicant’s mark. *Sock It To Me, Inc. v. Fan*, 2020 USPQ2d 10611, at *6 (TTAB 2020) (confining 2(d) analysis to most similar pleaded mark); *See N. Face Apparel Corp. v. Sanyang Indus. Co.*, 116 USPQ2d 1217, 1225 (TTAB 2015) (focusing likelihood of confusion analysis on most similar pleaded mark). If we find confusion likely between the cited mark and Applicant’s mark, we need not consider the likelihood of confusion with the

mark SRF LA. Conversely, if we find no likelihood of confusion between the standard-character cited mark SRF and Applicant's mark, we would not find a likelihood of confusion with the mark SRF LA.

A. Similarity or Dissimilarity of the Marks

The first *DuPont* factor focuses on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *Stone Lion Cap. Partners, L.P. v. Lion Cap. LLC*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014); *DuPont*, 177 USPQ at 567. "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff'd mem.*, 777 F. App'x 516 (Fed. Cir. 2019) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)).

The issue is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression such that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). We must focus on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

We do not predicate our analysis on a dissection of the involved marks; we consider the marks in their entireties. *Stone Lion*, 110 USPQ2d at 1160; *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.”). But one feature of a mark may be more significant than another, and it is not improper, for rational reasons, to give more weight to a dominant feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *Stone Lion*, 110 USPQ2d at 1161 (finding that the Board did not err in reasoning that the term LION was dominant in both applicant’s mark STONE LION CAPITAL and opposer’s marks LION CAPITAL and LION); *In re Chatam Int’l*, 71 USPQ2d at 1946.

The literal portion of Applicant’s mark differs from the cited mark only by the presence of spaces between the letters “S,” “R” and “F.” We find that the spaces are “an inconsequential difference that even if noticed by consumers would not serve to distinguish these marks.” *Chutter, Inc. v. Great Mgmt. Grp., LLC*, 2021 USPQ2d 1001, at *37 (TTAB 2021), *appeal docketed*, No. 22-1212 (Fed. Cir. 2021) (finding the marks DANTANNA’S and DAN TANA’S for restaurant services to be very similar in all means of comparison); *In re Iolo Tech., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010) (finding ACTIVECARE and ACTIVE CARE confusingly similar); *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1025 (TTAB 2009) (finding that petitioner’s mark DESIGNED2SELL is phonetically identical to respondent’s mark DESIGNED TO SELL and the “marks are also highly similar visually” in part because “the spaces

that respondent places between the words do not create a distinct commercial impression from petitioner's presentation of his mark as one word"); *Seaguard Corp. v. Seaward Int'l, Inc.*, 223 USPQ 48, 51 (TTAB 1984) (SEA GUARD and SEAGUARD are "essentially identical").

Applicant argues that the "spaced out" letters in its mark "indicat[e] that the letters are to be read and spoken individually, with the pronunciations 'ess,' 'are,' and 'eff'" whereas the cited mark, with no spaces between the letters, "can be read and spoken as 'Surf[.]'"⁵ This argument is unpersuasive. There is no proper way to pronounce a mark. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1912 (Fed. Cir. 2013). The spaces between the letters in Applicant's mark are not prominent and are not likely to be noticed by consumers. In addition, Applicant's business name is **Surf** Ready Fitness. For these reasons, consumers may perceive and pronounce both the literal element of Applicant's mark and the cited mark as the word "surf."

Applicant further argues that its mark "is in a sleek font within a circle to create a modern impression" whereas the cited mark "only consist[s] of 'SRF' ... without a claim to font stylization or color."⁶ Because Registrant's mark is in standard characters, there are no limitations on how Registrant may display its mark. *See Viterra*, 101 USPQ2d at 1909; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937,

⁵ Appeal Brief, 4 TTABVUE 9.

Citations in this opinion to the briefs refer to TTABVUE, the Board's online docket system. Citations to documents contained in the Trademark Status & Document Retrieval (TSDR) database are to the downloadable .pdf versions of the documents.

⁶ Appeal Brief, 4 TTABVUE 10.

939 (Fed. Cir. 1983); *In re RSI Sys., LLC*, 88 USPQ2d 1445, 1448 (TTAB 2008); *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1998) (citing *Citigroup v. Capital City Bank*, 98 USPQ2d at 1259). We must consider that Registrant could display its mark in the same “sleek font” as Applicant’s mark. *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1186 (TTAB 2018) (“Since Registrant’s mark is a standard character mark, we must consider that the literal elements of the mark (the words and the letters) may be presented in any font style, size or color, including the same font, size and color as the literal portions of Applicant’s mark. This is because the rights associated with a standard character mark reside in the wording per se and not in any particular font style, size, or color.”); *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1823 (TTAB 2015) (a standard character mark “could be used in any typeface, color, or size, including the same stylization actually used ... [in the cited mark], or one that minimizes the differences or emphasizes the similarities between the marks.”).

Further, consumers are unlikely to perceive the circle design element in Applicant’s mark as a source identifier as it is a common geometric shape that services merely as an outline or carrier for the literal element of Applicant’s mark. *In re Ocean Tech., Inc.*, 2019 USPQ2d 450686, at *5 (TTAB 2019) (circular design around wording in proposed mark found to be “a common geometric shape that consumers likely would perceive as a background design or carrier to the enclosed wording, rather than as a separable design element with trademark significance”); *see also In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (finding

that the word DELTA was the dominant portion of applicant's mark THE DELTA CAFE and design in part because "the design is an ordinary geometric shape that serves as a background for the word mark."); *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *32 (TTAB 2021) ("The rectangular exterior shape outlined in the mark ... is nothing more than a non-descript 'carrier' for the words and design.").

With respect to connotation and commercial impression, Applicant argues that when considered in connection with Applicant's fitness-related services, "the thin, smooth letters of [Applicant's] Mark prompt a connection to toned, athletic bodies, and the circle surrounding the Mark prompts a connection to wholeness. ... In contrast, the Cited Registration[], when viewed with the Cited Goods, invoke[s] a voguish, stylish impression that is on par with current minimalist trends in the fashion industry."⁷ Applicant's argument is without merit. As explained, the cited mark is in standard characters such that it may be displayed in any number of fonts, including the font used in Applicant's mark. Moreover, the cited registration, covering "shirts, sweatshirts, jackets, hoodies, hats, pants, sweatpants, sweaters, pullovers, [and] headwear," is broad enough to encompass athleticwear versions of these goods. Accordingly, the cited mark may evoke the same "connection to toned, athletic bodies" that Applicant argues its mark conveys.

For all of these reasons, we find that Applicant's mark in its entirety is very similar to the cited mark in appearance, sound, connotation and commercial

⁷ Appeal Brief, 4 TTABVUE 10-11.

impression. The first *DuPont* factor weighs heavily in favor of finding a likelihood of confusion.

B. Similarity or Dissimilarity of the Goods and Services

Under the second *DuPont* factor, we consider “[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration[.]” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051-52 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567). It is “well established that ‘confusion may be likely to occur from the use of the same or similar marks for **goods**, on the one hand, and for **services** involving those goods, on the other.’” *Detroit Athletic*, 128 USPQ2d at 1052 (quoting TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1207.01(a)(ii) (July 2022)).

We must base our comparison of the goods and services on the identifications in the cited registration and Applicant’s application.⁸ *Charger Ventures*, 2023 USPQ2d 451, at *6 (“The relevant inquiry in an ex parte proceeding focuses on the goods and services described in the application and registration.”) (emphasis omitted); *Sabhnani*, 2021 USPQ2d 1241, at *19 (“In making our determination regarding the relatedness of the goods, we must look to the goods as identified in the parties’

⁸ It is sufficient for a finding of likelihood of confusion if relatedness is established for any goods and services encompassed in the identifications in a particular class in an application. *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1409 (TTAB 2015), *aff’d*, 123 USPQ2d 1744 (“Likelihood of confusion must be found if there is likely to be confusion with respect to any item in a class that comes within the identification of goods in the application and cited registration.”); *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015); *see also, e.g., Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Double Coin*, 2019 USPQ2d 377409, at *6.

registrations.”) (quoting *Double Coin Holdings*, 2019 USPQ2d 377409, at *5 (TTAB 2019)); see also *Stone Lion*, 110 USPQ2d at 1162; *Dixie Rests.*, 41 USPQ2d at 1534; *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Because Applicant’s and Registrant’s marks are highly similar, the necessary degree of similarity between the goods and services for confusion to be likely declines. *Shell Oil*, 26 USPQ2d at 1689 (“[E]ven when goods or services are not competitive or intrinsically related, the use of identical marks can lead to the assumption that there is a common source.”); *Orange Bang, Inc. v. Ole Mexican Foods, Inc.*, 116 USPQ2d 1102, 1117 (TTAB 2015).

Applicant argues that “[t]he Cited Goods are for specific fashion items, but the Cited Registration[] do[es] not identify an intended function for the Cited Goods within [the] descriptions. As a result, it is improper for the Examining Attorney to assume that the Cited Goods would have any purpose or use within the fitness or exercise industry.”⁹ This argument is misplaced. As stated, we are bound to compare the goods and services as identified in the cited registration and Applicant’s application. See, e.g., *Charger Ventures*, 2023 USPQ2d 451, at *6; *Sabhnani*, 2021 USPQ2d 1241, at *19.

Further, we must construe the goods in the cited registration as broadly as reasonably possible “to include all goods of the nature and type described therein.” *In re Solid State Design Inc.*, 125 USPQ2d 1409, 1413 (TTAB 2018) (quoting *In re Jump Design LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006)); see also *Monster Energy Co. v. Lo*,

⁹ Appeal Brief, 4 TTABVUE 12.

2023 USPQ2d 87, at *15-16 (TTAB 2023) (“If an application or registration describes goods or services broadly, and there is no limitation as to their nature, it is presumed that the ‘registration encompasses all goods or services of the type described.’”) (quoting *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 107 USPQ2d 1167, 1173 (Fed. Cir. 2013)); *In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *5-6 (TTAB 2019) (“It is well established that the Board may not read limitations into an unrestricted registration or application.”); *see also In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”). The cited registration covers, among other goods, “shirts, sweatshirts, jackets, hoodies, hats, pants, sweatpants, sweaters, pullovers, headwear.” Because there is no limitation on the purpose or use of these goods we must construe the cited registration as encompassing athletic clothing of the type identified in the registration.


Next, Applicant argues that “there are no overlapping or related class descriptions” between Applicant’s identification of services and the goods in the cited registration. The goods and services, however need not overlap for there to be a likelihood of confusion. The evidence need only establish that the goods and services are related in some manner, or the conditions surrounding their marketing are such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the services come from a common source.¹⁰

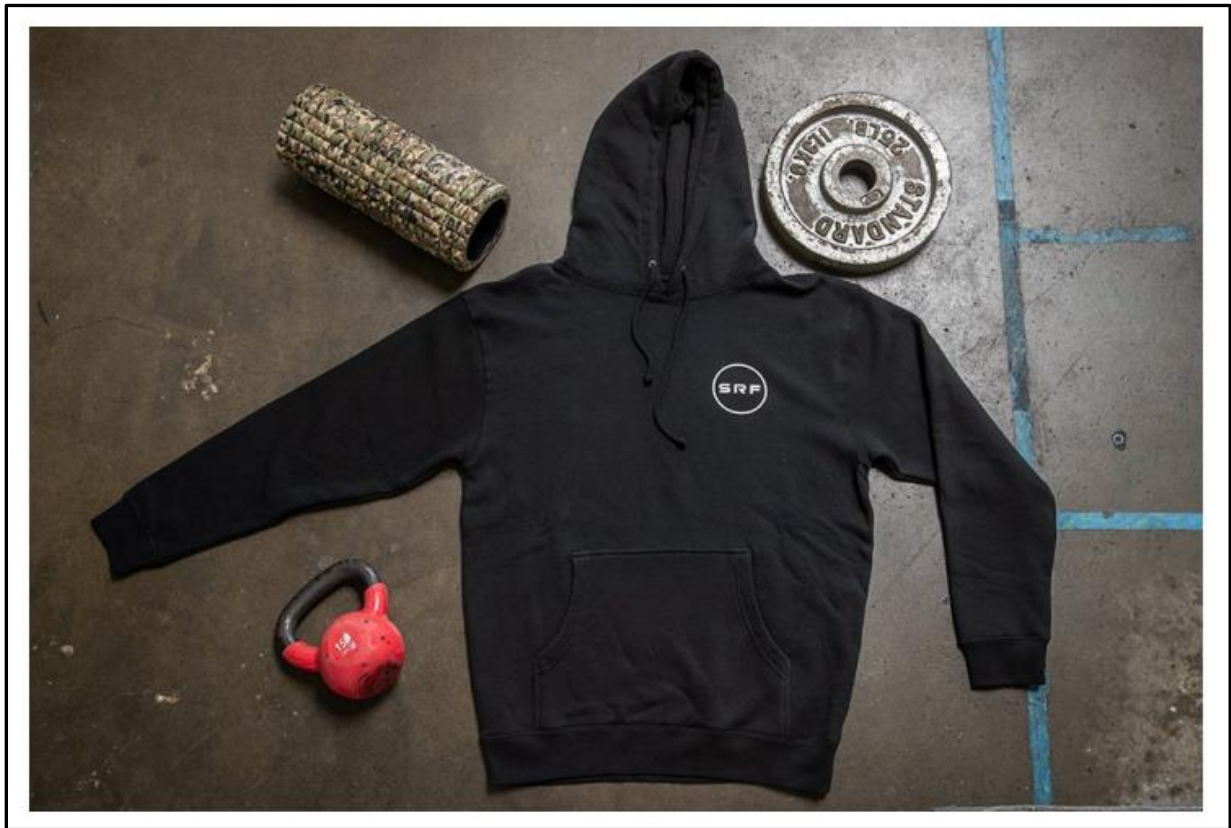
¹⁰ Appeal Brief, 4 TTABVUE 13 (emphasis omitted).

Coach Servs., 101 USPQ2d at 1721; *In re Embiid*, 2021 USPQ2d 577, at *22 (TTAB 2021); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); *In re Rexel, Inc.*, 223 USPQ 830, 831 (TTAB 1984).

Evidence of relatedness may include news articles or evidence from computer databases showing that the relevant goods are used together or used by the same purchasers; advertisements showing that the relevant goods are advertised together or sold by the same manufacturer or dealer; or copies of prior use-based registrations of the same mark for both applicant's goods and the goods listed in the cited registration. *Embiid*, 2021 USPQ2d 577, at *22-23 (citing *In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, at *5 (TTAB 2020)). In addition, the identifications in the application and registration themselves may support a finding that the goods and services are related. *In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *6 (TTAB 2019); *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1310 (Fed. Cir. 2002) (“On the face of the registrations themselves, QSC’s product and the ACOUSTIC WAVE product are related.”); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002) (finding the Board erred in concluding that there was insufficient evidence of relatedness, because it “did not consider the important evidence already before it, namely the ITU application and [opposer’s] registrations”).

Applicant’s assertion that the marks are registered for goods and services in “different classes,” *id.*, is not relevant. The classification of goods and services by the USPTO is a purely administrative determination. *Detroit Athletic*, 128 USPQ2d at 1051 (“Classification is solely for the ‘convenience of Patent and Trademark Office administration,’ and ‘is wholly irrelevant to the issue of registrability under section 1052(d).’”).

The involved application, as originally filed, included “t-shirts; hoodies; sweaters; pants” in International Class 25 and a claim of use in commerce of the mark on such goods.¹¹ Applicant’s specimen for these goods, reproduced below, consists of a photograph showing a hoodie bearing the applied-for mark  together with a free weight, foam roller and kettle bell.



During prosecution, Applicant deleted the goods in International Class 25 from the application, but the inclusion of clothing items in Applicant’s own application as originally filed strongly suggests that the “t-shirts; hoodies; sweaters; pants” identified in the cited registration are related to Applicant’s personal training

¹¹ February 26, 2021 Application, TSDR 4.

services and blog posts, newsletters and videos in the fields of fitness, sports, exercise and nutrition.

To further demonstrate relatedness, the Examining Attorney introduced Internet printouts showing seven third-parties using a single mark to identify the types of clothing covered by the cited mark, namely, “shirts, sweatshirts, jackets, hoodies, hats, pants, sweatpants, sweaters, pullovers, headwear,” as well as Applicant’s services, namely, physical fitness training services and blog posts, newsletters, and videos all in the fields of fitness, sports, exercise and nutrition:¹²

- BLINK – identifying personal training services, on-demand workout videos, a blog about fitness and nutrition, and t-shirts, jogger pants, and hoodies;
- BBS – identifying personal training services, a blog providing workouts and information about nutrition and healthy lifestyles, and sweatshirts, tank tops, and a tote bag;
- GOLD’S GYM – identifying personal training services, workout videos and clothing, namely, t-shirts, hoodies, and sweatshirts;
- LIFE TIME – identifying personal training services and fitness classes on demand in addition to various apparel items, including tank tops, t-shirts, leggings, yoga pants, hoodies, and sweatshirts;

¹² October 5, 2022 Final Office Action, TSDR 11-238.

Citations to the record refer to the USPTO Trademark Status and Document Retrieval (TSDR) system by page number in the downloadable .pdf format.

- PLANET FITNESS – identifying personal training services, workout videos, and clothing, including hoodies, tank tops, t-shirts, and jogger pants;
- TA and TRACY ANDERSON – identifying personal training services and t-shirts; and
- ZUMBA – identifying fitness classes, both live and recorded, as well as tote bags, t-shirts, leggings, and tank tops.

Evidence showing that the involved goods and services are sold by companies under the same mark supports a finding of relatedness. *See, e.g., Detroit Athletic*, 128 USPQ2d at 1050 (crediting relatedness evidence showing that third parties use the same mark for the goods and services); *Hewlett-Packard v. Packard Press*, 62 USPQ2d at 1004 (evidence that “a single company sells the goods and services of both parties, if presented, is relevant to a relatedness analysis”); *Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *46 (TTAB 2022) (third-party websites promoting sale of both parties’ goods showed relatedness); *L’Oreal v. Marcon*, 102 USPQ2d at 1140-41 (evidence that “companies have marketed cosmetics and beverages under the same mark” supported finding goods related); *Wet Seal, Inc. v. FD Mgmt., Inc.*, 82 USPQ2d 1629, 1640 (TTAB 2007) (finding retail women’s clothing store services and cosmetics, including fragrances, related where opposer introduced evidence of clothing stores selling both clothing and beauty care products and fragrances either under the same marks or variations of the store marks).

The Examining Attorney also introduced ten use-based registrations owned by different entities covering at least some of the clothing items identified in the cited registration and Applicant's physical fitness-related services.¹³ "As a general proposition, third-party registrations that cover goods and services from both the cited registration and an Applicant's application are relevant to show that the goods and services are of a type that may emanate from a single source under one mark." *Country Oven*, 2019 USPQ2d 443903, at *8 (ten third-party registrations buttressed the Board's conclusion that the involved goods and services were related); *see also*, e.g., *Made in Nature*, 2022 USPQ2d 557, at *45 ("[U]se-based, third-party registrations, although not evidence that the marks shown therein are in use or that the public is familiar with them, nonetheless have probative value to the extent that they serve to suggest that the goods listed therein are of a kind which may emanate from a single source under a single mark.") (citing *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1432 (TTAB 2013)); *Embiid*, 2021 USPQ2d 577, at *22-23 (evidence of relatedness may include prior use-based registrations covering both parties' goods or services) (citing *Ox Paperboard*, 2020 USPQ2d 10878, at *5); *Albert Trostel*, 29 USPQ2d at 1785-86; *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988), *aff'd* (unpublished), No. 88-1444, 864 F.2d 149 (Fed. Cir. Nov. 14, 1988).

In an attempt to rebut the Examining Attorney's evidence, Applicant submitted ten pairs of third-party registrations showing the same or a similar mark registered

¹³ September 22, 2021 Office Action, TSDR 12-42.

by one entity for clothing and another entity for personal fitness services.¹⁴ Applicant argues that this evidence “contradict[s] the Examining Attorney’s finding of ... ‘relatedness’” and “support[s] that purchasers are capable of distinguishing marks between the fitness industry and fashion market.”¹⁵

We give no consideration to the pairs of registrations for the marks CRUSH, HAPPY CAMPER and STRONG LIKE BULL because one registration in each of these pairs has been cancelled (Reg. Nos. 5052746, 4124936 and 4215375). *Made in Nature*, 2022 USPQ2d 557, at *26 (“A cancelled or expired registration has no probative value other than to show that it once issued and it is not entitled to any of the statutory presumptions of Trademark Act Section 7(b).”). The seven remaining pairs of registrations have limited probative value for a number of reasons.

First, we lack important marketplace information such as whether the registrants entered into any coexistence agreements or whether the marks themselves have

¹⁴ Applicant attached “soft copies” of the registration certificates as Exhibit B to its April 5, 2022 Office Action Response, TSDR 18-37. Generally such evidence is insufficient to make registrations of record because it does not reflect the current status and title of the registrations. TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1208.02 (June 2022) (“[T]o make a third-party registration of record ... a copy of the registration (from either the electronic records of the Office or the paper USPTO record) showing the current status and title of the registration must be submitted.”). Nonetheless, the Examining Attorney did not object to the third-party registrations and has treated them as if they are properly of record, so we deem the third-party registrations stipulated into the record. *In re Olin Corp.*, 124 USPQ2d 1327, 1335 n.22 (TTAB 2017) (although the Board does not take judicial notice of registrations, because the examining attorney addressed applicant’s registrations in her brief and neither objected to the discussion of the other, Board treated both registrations as though they are of record).

¹⁵ Appeal Brief, 4 TTABVUE 16. Applicant includes this argument in its discussion of the fourth *DuPont* factor, which concerns the sophistication of the relevant purchasers and sales conditions but we address it here because Applicant states that the evidence is intended to “contradict” the evidence that the goods and services are related under the second *DuPont* factor.

actually coexisted in the marketplace without confusion. *In re Thomas*, 79 USPQ2d 1021, 2028 (TTAB 2006) (fact that marks co-existed on register does not prove that they coexisted in the marketplace without confusion); *In re Morinaga Nyugyo K. K.*, 120 USPQ2d 1738, 1745 (TTAB 2016) (third-party registrations are not evidence of use in the marketplace).

Second, the fact that the respective goods and services may sometimes emanate from different sources does not negate the evidence, including the inclusion of clothing in Applicant's application as originally filed, supporting that other times the goods and service may emanate from a common source. *Made in Nature*, 2022 USPQ2d 557, at *46 ("For Applicant's and Registrant's identified goods to be related, it is not necessary that they **always** emanate from the same source under the same mark.").

Third, the pairs of third-party registrations do not justify the registration of Applicant's mark if confusion with the cited mark is likely. *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1272 (TTAB 2009) (citing *Plus Prods. v. Star-Kist Goods, Inc.*, 220 USPQ 541, 544 (TTAB 1983)). Each case must be decided on its own merits; we are not bound by the prior determinations and actions of examining attorneys on different factual records. *See, e.g., In re Shinnecock Smoke Shop*, 571 F.3d 1171, 91 USPQ2d 1218, 1221 (Fed. Cir. 2009); *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); *In re Davey Prods. Pty.*, 92 USPQ2d 1198, 1206 (TTAB 2009) ("Previous decisions by examining attorneys in approving other marks are without evidentiary value and are not binding on the agency or the Board");

Hilson Rsch. Inc. v. Soc’y for Human Res. Mgmt., 27 USPQ2d 1423, 1439 (TTAB 1993)
(Board is not bound by an examining attorney’s determination).

As a final matter, Applicant argues that “it is highly unlikely for consumers in search of clothing items to accidentally engage a fitness provider.”¹⁶ The issue, however, is not whether the goods and services are likely to be confused but whether there is likely to be confusion as to the source of the goods and services. *Ox Paperboard*, 2020 USPQ2d 10878, at *5; *L’Oreal v. Marcon*, 102 USPQ2d at 1439; *Rexel Inc.*, 223 USPQ at 831.

In sum, we find the evidence of record sufficient to demonstrate that the clothing items in the cited registration are related to Applicant’s personal training services, and blogs, newsletters and videos in the fields of fitness, exercise, sports and nutrition. Thus, the second *DuPont* factor supports that confusion is likely.

C. Similarity or Trade Channels and Classes of Purchasers

We next consider the third *DuPont* factor, namely, the similarity or dissimilarity of established, likely-to-continue channels of trade. “We also discuss the portion of the fourth *DuPont* factor that addresses the ‘buyers to whom sales are made.’” *Sabhnani*, 2021 USPQ2d 1241, at *19 (quoting *DuPont*, 177 USPQ at 567).

Applicant argues that it and Registrant “operate within different channels of trade that are encountered by different consumers” because “Applicant’s Services are marketed and sold to individuals that are interested in health and fitness” whereas

¹⁶ Appeal Brief, 4 TTABVUE 16. Applicant also raises this argument under the fourth *DuPont* factor but it concerns the second *DuPont* factor.

Registrant's goods "are for everyday clothing items that have no relation to the fitness industry whatsoever" and "are sold to anyone in need of clothing, regardless of their health habits or predilection for exercise."¹⁷ As with the relatedness of the goods and services, the similarity or dissimilarity of the trade channels must be determined based on the identifications of goods and services in the cited registration and involved application rather than current real-world conditions. *Id.* at *20. Because there are no restrictions as to trade channels or classes of purchasers in the cited registration and the involved application, we presume that Registrant's goods and Applicant's services travel through all usual channels of trade for such goods and services and are offered to all normal potential purchasers for such goods and services, including the general public interested in physical fitness and fitness-related clothing. *Stone Lion*, 110 USPQ2d at 1161; *see also, e.g., Coach Servs.*, 101 USPQ2d at 1722; *Embiid*, 2021 USPQ2d 577, at *31 (citing *DeVivo v. Ortiz*, 2020 USPQ2d 10153, at *13-14 (TTAB 2020)).

The same Internet evidence discussed above demonstrating relatedness supports that Applicant's services and Registrant's goods may be encountered by the same classes of consumers under the same marks in at least one common trade channel, namely, the websites of physical fitness businesses offering clothing as well as online fitness instruction and related blogs, newsletters and videos. *Charger Ventures*, 2023 USPQ2d 451, at *3, 5-6 ("Because the record shows that companies are known to offer both residential and commercial services under the same mark and, often, on the

¹⁷ Appeal Brief, 4 TTABVUE 14.

same website, we find that substantial evidence supports the Board's finding[s]" that they are related and that there is "some overlap" in trade channels). Again, Applicant's attempt to criticize this evidence on the ground that the third-parties offer clothing "tied to fitness" whereas Registrant has a "fashion brand" with "no ties to the fitness or exercise industry"¹⁸ is without merit because the goods in the cited registration are unrestricted and broad enough to encompass clothing designed for physical fitness activities, of the sort sold by Applicant itself.

The fact that the respective goods and services would be offered to and encountered by overlapping classes of consumers through at least one of the same trade channels favors a finding of likelihood of confusion.

D. Sophistication of the Relevant Purchasers and Conditions under which Sales are Made

Under the fourth *DuPont* factor we consider "the conditions under which and buyers to whom sales are made, i.e. 'impulse' v. careful, sophisticated purchasing." *DuPont*, 177 USPQ at 567. A heightened degree of care when making a purchasing decision may tend to minimize likelihood of confusion. *See, e.g., In re N.A.D., Inc.*, 754 F.2d 996, 224 USPQ 969, 971 (Fed. Cir. 1985) (because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED). Conversely, impulse purchases of inexpensive goods or services may

¹⁸ Appeal Brief, 4 TTABVUE 14.

tend to have the opposite effect. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1695 (Fed. Cir. 2005).

Applicant argues without evidence that “[f]itness is inherently personal by nature, as it involves one’s own body and the individualized goals tailored to it” and, therefore, consumers of its services are likely to “take considerable time and effort to research various providers to find the right fit for them.”¹⁹ Attorney argument is no substitute for evidence. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018).

Moreover, even if some consumers of fitness services and clothing are sophisticated, we must base our decision “on the least sophisticated potential purchasers.” *Stone Lion*, 110 USPQ2d at 1163 (quoting *Gen. Mills, Inc. v. Fage Dairy Proc. Indus. S.A.*, 100 USPQ2d 1584, 1600 (TTAB 2011) (internal quotation marks omitted); see also *In re FCA US LLC*, 126 USPQ2d 1214, 1222 (TTAB 2018). Consumers of fitness services may include neophytes who may not be particularly educated about fitness and so may not exercise any particular degree of care in purchasing Applicant’s services.²⁰ Similarly, the clothing items identified in the cited registration are not limited as to their nature or price and, therefore, include inexpensive, “off-the-shelf items” that may be purchased on impulse “by all manners of people.” *In re Embiid*, 2021 USPQ2d 577, at *32 (quoting *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ2d 386 (CCPA 1973) (internal quotation marks


¹⁹ Appeal Brief, 4 TTABVUE 15.


²⁰ October 5, 2022 Final Office Action, TSDR 11 (article titled “The Scary Side of Things” discussing “how to alleviate the fear of working out in a gym ... for the first time”).

omitted); *New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *16 (TTAB 2020) (“Ordinary consumers of headwear and clothing are likely to exercise only ordinary care, and given the lack of price restrictions in the identifications, they may even buy inexpensive items on impulse.”).

Accordingly, we find the fourth *DuPont* factor neutral.

III. Conclusion

Applicant’s mark  and Registrant’s standard-character mark SRF are highly similar in overall appearance, sound, connotation and commercial impression such that the first *DuPont* factor weighs heavily in favor of finding a likelihood of confusion. The record further demonstrates that Applicant’s physical fitness training services and blogs, newsletters and videos in the fields of fitness, sports, exercise and nutrition are related to Registrant’s clothing and that these goods and services may be sold to some of the same purchasers in at least one common trade channel. Accordingly, the second and third *DuPont* factors also weigh in favor of a likelihood of confusion. The fourth *DuPont* factor is neutral.

Because the first, second and third *DuPont* factors support that confusion is likely and no factors weigh in Applicant’s favor, we find that Applicant’s mark  for the applied-for services is likely to cause confusion with the cited standard character mark SRF for the clothing items identified in the cited registration. Indeed, it is likely that consumers familiar with the cited mark who encounter Applicant’s mark may perceive it as a logo version of the cited mark and an extension of the brand into

fitness-related services. *Schieffelin & Co. v. Molson Cos., Ltd.*, 9 USPQ2d 2069, 2073 (TTAB 1989) (“Those consumers who do recognize the differences in the marks may believe that applicant’s mark is a variation of opposer’s mark that opposer has adopted for use on a different product.”); *Toshiba Med.*, 91 USPQ2d at 1271 (VANTAGE TITAN “more likely to be considered another product from the previously anonymous source of TITAN medical diagnostic apparatus, namely, medical ultrasound devices”).

Decision: The refusal to register Applicant’s mark under Section 2(d) of the Trademark Act is affirmed.