

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

East Health Development Group, Inc.
v.
Sound Vitality, LLC

Opposition No. 91165143
to application Serial No. 76975262

East Health Development, Group, Inc., *pro se*.

David Z. Ribakoff, Enenstein & Ribakoff APC for Sound
Vitality, LLC.

Before Walters, Bucher and Bergsman,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Sound Vitality, LLC ("applicant") seeks to register
the mark CHI and design, shown below, on the Principal
Register, for an "electric massage apparatus for
therapeutic use, and related replacement parts," in Class
10.¹

¹ During the course of the proceeding, the original applicant China Healthways, Inc. assigned its entire right, title and interest in its mark and application to Sound Vitality, LLC. In its June 8, 2010 order, the Board substituted Sound Vitality, LLC as the defendant.



Applicant provided the following translation statement in its application: "The English translation of 'CHI' is 'Vital energy force thought to be inherent in all things.'"

East Health Development Group, Inc. ("opposer") opposed the application on the ground that the word "Chi" is generic and that applicant must disclaim the exclusive right to use the word "Chi" if the mark is registered. Applicant, in its answer and amended answer, denied the salient allegations in the notice of opposition.

Preliminary Issues

A. Whether the word "Chi" is descriptive was tried by implied consent?

As indicated above, opposer alleged that the word "Chi" is generic when used in connection with an "electric massage apparatus for therapeutic use, and related replacement parts." However, in its brief, opposer argued that the word "Chi" is both generic and merely descriptive. During the trial, opposer introduced very little relevant evidence. Applicant, in its brief, essentially ignored the issue(s) before us and argued that opposer's arguments were

rejected by the Court of Appeals for the Federal Circuit in a different opposition between the parties when it held that applicant owns the mark CHI and design at issue with respect to electric therapeutic massagers.²

In its brief, applicant did not expressly consent to try the issue of whether the word "Chi" when used in connection therapeutic massagers is merely descriptive, nor did applicant object to opposer's assertion that the word "Chi" is merely descriptive. Thus, we must determine whether that issue was tried by implied consent. Implied consent to the trial of an unpleaded issue can be found only where the nonoffering party (1) raised no objection to the introduction of evidence on the issue, and (2) was fairly apprised that the evidence was being offered in support of the issue. *Morgan Creek Productions Inc. v. Foria International Inc.*, 91 USPQ2d 1134, 1138 (TTAB 2009); *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1720-1721 (TTAB 2008); TBMP § 507.03(b) (3rd ed. 2011). Fairness dictates that in deciding whether an issue has been tried by consent, there must be an absence of doubt that the non-moving party is aware that the issue is being tried. *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031, 1034-35 (TTAB 2010) (applicant was not aware opposer intended to rely on

² Applicant's Brief, pp. 4-5.

registration to prove likelihood of confusion until opposer filed rebuttal notice of reliance); *Morgan Creek Productions Inc. v. Foria International Inc.*, 91 USPQ2d at 1139.

Implicit in a finding that the evidence establishes that the word "Chi" is generic for applicant's goods is a holding that that the word "Chi" is at least merely descriptive of applicant's goods under Section 2(e)(1). "The generic name of a thing is in fact the ultimate in descriptiveness." *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). Accordingly, under the circumstances presented in this opposition, we find that the issue of whether the word "Chi" in applicant's mark is merely descriptive was tried by implied consent and we deem the notice of opposition to be amended to include opposer's claim that the word "Chi" is merely descriptive.

B. Evidence attached to opposer's brief.

Opposer attached thirteen exhibits to its brief. Exhibits and other evidentiary materials attached to a party's brief on the case can be given no consideration unless they were properly made of record during the time for taking testimony. See, e.g., *Syngenta Crop Protection, Inc. v. Bio-Chek, LLC*, 90 USPQ2d 1112, 1116 (TTAB 2009);

Bass Pro Trademarks LLC v. Sportsman Warehouse, Inc., 89 USPQ2d 1844, 1848 (TTAB 2008); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1955 (TTAB 2008). See also Trademark Rule 2.123(1), 37 CFR §2.123(1) ("Evidence not obtained and filed in compliance with these sections will not be considered"). Accordingly, to the extent that the evidence attached to the briefs was not made of record during opposer's testimony period, it has been given no consideration.

The Record

By rule, the record includes applicant's application file and the pleadings. Trademark Rule 2.122(b), 37 CFR §2.122(b).

A. Opposer's testimony and evidence.

1. The testimony deposition of Xiaoming Wang, opposer's Director, taken upon written questions, with attached exhibits;

2. Opposer's first notice of reliance;³ and

3. Opposer's second notice of reliance.

³ Pursuant to the Board's September 30, 2009 Order, six of the fifteen documents attached to the notice of reliance were stricken. We are not listing the individual documents comprising the notices of reliance because, as noted above, most of the documents are not relevant to the issue of whether applicant's mark is generic or merely descriptive.

B. Applicant's testimony and evidence.

1. Pursuant to the Board's June 8, 2010 order, applicant introduced the testimony deposition of Richard H. Lee, applicant's President, opposer in the previous opposition, with attached exhibits taken in Opposition No. 91157392;

2. The April 21, 2010 testimony deposition of Richard H. Lee.⁴

Evidence

In its application, applicant translated the word "Chi" as the "vital energy force thought to be inherent in all things."

According to The American Heritage Dictionary of the English Language (4th ed. 2000), the word "Chi" is defined as follows:

The vital force believed in Taoism and other Chinese thought to be inherent in all things. The unimpeded circulation of chi and a balance of its negative and positive forms in the body are held to be essential to good health in traditional Chinese medicine. [Chinese (Mandarin) *qi*, air, spirit, energy of life]⁵

⁴ Although the witness identified and authenticated exhibits, the exhibits were not attached to the transcript filed with the Board. We will not require applicant to provide the exhibits because, based on the testimony, the exhibits do not appear to be relevant to any of the issues before us.

⁵ Applicant's notices of reliance, Exhibit B.

A copy of Registration No. 2655359 for the mark CHI LITE for an "acupuncture instrument, namely, electric acupuncture point stimulator device." The registration has the following translation statement: "The word "Chi" means 'life energy' in Chinese." Registrant disclaimed the exclusive right to use the word "Chi."

In a "Release and Settlement Agreement" (June 28, 2004)⁶ between the parties resolving an action in the United States District Court, Central District of California, Case No. CV 02-03137 LGB (JWJx), and "certain actions, applications and appeals ... presently pending before the United States Patent and Trademark office ("USPTO") and the Trademark Trial and Appeals [sic] Board ("TTAB") ... involving the Parties and relating to trademarks and related intellectual property rights related to [therapeutic massage devices]," the parties agreed, *inter alia*, to the following:⁷

3.1 The Parties agree that [applicant] owns, and may use and retain the following marks, and [opposer] agrees not to use the following" mark **CHI** .

* * *

⁶ Wang Dep., Exhibit 3

⁷ Paragraph No. 4.2 provides that this agreement does not resolve any actions regarding "Chi" marks filed by the parties including, *inter alia*, the application at issue in this opposition.

3.7 The Parties agree that they are not restricted, as to each other, from using terms in their generic sense such as "chi", or "chaos" (such as to describe a chaotic or chaos or random frequencies of infrasonic waves or signals and a chaotic or chaos energy patterns) or "qi gong", regardless of the case, font or font attributes used to express such terms.

Excerpts from applicant's advertising newsletters shown below.⁸

Pain Management with *Regenerative Chaos*

CHI

ACCELERATES RECOVERY BY:

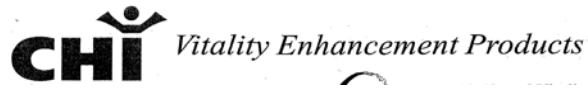
DECREASING PAINFUL EDEMA
REDUCING PAIN IN JOINTS, MUSCLES AND BONES
RELAXING MUSCLE ARMORING AND SPASMS
IMPROVING MICROCIRCULATION
RELIEVING PAIN WITHOUT DRUGS



Infratonic QGM 4.0

If it doesn't say CHI
it's not an
Infratonic QGM

⁸ Lee Dep., Exhibit 7.



Gua Sha
Meridian Therapy

Gua Sha is an extraordinary traditional Chinese system of promoting Qi⁹ and blood circulation while removing toxins and stagnant fluids for the rapid relief of pain and discomfort. Our kit includes a training video, Gua Sha tool that grabs and quickly removes stagnant Qi, and a detailed instruction booklet, all, in a handy carrying case.

* * *

Books:

**Bioelectric Vitality - Exploring the
Science of Human Energy**

By Richard H. Lee

Discover the electromagnetic tenets that underlie Qi in a way that is both understandable to the western scientist and consistent with the traditional Chinese principles of vital energy.

⁹ "Qi" is defined as "chi." The Random House Dictionary of the English Language (Unabridged), pp. 356 and 1576 (2nd ed. 1987). The Board may take judicial notice of dictionary evidence. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). See also The American Heritage Dictionary of the English Language, *supra*.

Pain Relief Breakthrough

New Hope for Chronic Pain

The effect of this massage activity is pain management through muscle relaxation, and enhanced local circulation of Qi, blood, and endocrine fluids.

Why Energy Medicine Works

by Yuan Zhi Fu, L.Ac.

Traditional Chinese Medicine teaches that good health and vitality depend on the abundance and unobstructed flow of Qi (vital energy) in the body.

In other words, strong Qi (which has the force to flow freely and encourage good lymph and blood flow) equals high energy and good health. Weak or low Qi which can easily become blocked and stagnant means low energy, and often, pain and disease.

The Infratonic QGM works because it is a *Qi-based therapy* which encourages the body's natural ability to heal itself.

I grew up in China where the tie between Qi and health is readily accepted. But if you have trouble with the concept, you are not alone. I find that although most people believe that chiropractors and massage therapists can relieve pain through touch and manipulation, few people understand (or believe) that these therapies work largely because of Qi.

Qi in the body is much like water in a garden hose. As long as the hose is unobstructed, the water flows freely. But a single kink can stop the water and cause pressure and stiffness to build up. ►

See Why It Works, pg. 2

Whether CHI is generic?

In determining whether a term is generic, the critical issue is whether the record shows that members of the relevant public primarily use or understand the term sought to be registered to refer to the category or class of goods in question. *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986); *In re Women's Publishing Co. Inc.*, 23 USPQ2d 1876, 1877 (TTAB 1992). Making this determination "involves a two-step inquiry: First, what is the genus of

goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?"

Ginn, 228 USPQ at 530. Evidence of the public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers and other publications. See *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1553 (Fed. Cir. 1991); *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987).

We begin by finding that the genus of the goods at issue in this case is adequately defined by applicant's description of goods, namely, "electric massage apparatus for therapeutic use." *Magic Wand Inc. v. RDB Inc.*, 19 USPQ2d at 1552 ("[A] proper genericness inquiry focuses on the description of [goods or] services set forth in the [application or] certificate of registration").

We now turn to the second inquiry: the public's understanding of the term. Based on the limited record described above, the evidence is not sufficient to support a finding that the relevant public, when it considers the word "Chi," readily understands it as identifying a category of therapeutic massagers. For example, there is

nothing in the record that shows a consumer, or anyone else selling a competitive massager, referring to a massager as a "Chi" machine.

In view of the foregoing, we find that opposer has failed to prove that the word "Chi" in applicant's mark is generic when used in connection with therapeutic massagers.


Whether CHI Is Merely Descriptive?


A term is merely descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the products it identifies. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). Whether a particular term is merely descriptive is determined in relation to the goods for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). In other words, the question is not whether someone presented only with the mark could guess the products listed in the description of goods. Rather, the question is whether someone who knows what the products are will understand the mark to convey information about them. *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-1317 (TTAB 2002); *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998);

In re Home Builders Association of Greenville, 18 USPQ2d 1313, 1317 (TTAB 1990); *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

"On the other hand, if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive." *In re Tennis in the Round, Inc.*, 199 USPQ 496, 497 (TTAB 1978); *see also, In re Shutts*, 217 USPQ 363, 364-365 (TTAB 1983); *In re Universal Water Systems, Inc.*, 209 USPQ 165, 166 (TTAB 1980).

After reviewing the evidence, especially the excerpts from applicant's newsletters, we find that the word "Chi" directly informs consumers and potential consumers of applicant's products that its massagers are a chi-based therapy. As noted above, the test of whether a mark is merely descriptive is not whether someone can look at the mark and guess what the goods are; rather, the test is whether the mark informs the relevant consumer about a quality, characteristic, feature, purpose or function of the product.

The word "Chi" means energy or life force. Applicant claims that its  product accelerates recovery by decreasing painful edema, reducing pain in joints, muscles

and bones, relaxing muscle, armoring and spasm, improving microcirculation, and relieving pain without drugs. The commercial impression engendered by applicant's mark in that advertisement is the word "Chi" and, therefore, consumers will interpret applicant's advertisement as "Chi" accelerates recovery. Applicant also advertises  "vitality enhancement products" for improving chi.

In the "Pain Relief Breakthrough" article, applicant explains that the effect of massage therapy is, in part, to improve the circulation of Qi or chi. Finally, in the "Why Energy Medicine Works" article, applicant explains that traditional Chinese medicine teaches that the key to good health is the abundance and unobstructed flow of qi. Applicant also claims that its "Infratonic QGM [QiGong Machine] works because it is a *Qi-based therapy* that encourages the body's natural ability to heal itself." (Emphasis in the original).

Applicant uses the word "Chi" descriptively to identify the purpose or function of its therapeutic massager (*i.e.*, to improve chi). It is patently inconsistent for applicant to tout the purpose of its product as improving chi and, at the same time, claiming the exclusive right to use chi as its mark. In view of the foregoing, we find that the word "Chi" is merely

descriptive when used in connection with therapeutic massagers.

In view of our finding that the word "Chi" is merely descriptive when used in connection with electric massagers for therapeutic use, applicant must disclaim the exclusive right to use the word "Chi."

Decision: The opposition is sustained and registration to applicant is refused.

However, in the event that applicant submits a disclaimer of the exclusive right to use the word "Chi" within thirty days from the mailing date of this decision, the decision sustaining the opposition and refusing registration will be set aside and the application will proceed to registration.¹⁰ See Trademark Rule 2.142(g).

¹⁰ A proper disclaimer reads as follows: "No claim is made to the exclusive right to use Chi apart from the mark as shown."