

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Mailed: October 27, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Everett W. James
v.
Andrea Gallagher

Opposition No. 91191941
to Application Serial No. 77585517

Martin E Hsia of Cades Schutte LLP, for Everett W. James.
Evan Anderson of Patel & Alunit PC, for Andrea Gallagher.

Before Holtzman, Taylor, and Ritchie, Administrative
Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

On October 3, 2008, applicant, Andrea Gallagher, applied to register the mark RETHINKING YOUR FUTURE, in standard character format, on the Principal Register for "pre-recorded DVDs in the field of life planning, career changes and retirement," in International Class 9; "printed material, namely, brochures, pamphlets, surveys and assessments in the field of life planning, career changes and retirement," in International Class 16; and "education, namely, seminars regarding life planning, career changes

and/or retirement; personal coaching services in the fields of life-mapping services, career changes and the non-financial aspects of retirement," in International Class 41.¹

On September 15, 2009, opposer, Everett W. James, opposed the registration of applicant's mark on the ground that applicant's mark is likely to cause confusion in violation of Section 2(d) of the Trademark Act with, among other registered marks,² opposer's previously used and registered mark CREATING YOUR FUTURE³ (Registration No. 2840859), as shown below, for "recordings, namely, prerecorded compact discs featuring lectures relating to self-improvement," in International Class 9; opposer's previously used and registered mark CREATING YOUR FUTURE⁴ (Registration No. 2778363), as shown below, for "printed materials, namely, books relating to self-improvement, and printed instructional, educational and teaching materials relating to self-improvement," in International Class 16; and opposer's previously used and registered mark CREATING

¹ Application Serial No. 77585517, based on a bona fide intent to use in all classes.

² Opposer additionally pleaded several marks for CREATING YOUR FUTURE for various other goods and services, and for THE SECRET OF CREATING YOUR FUTURE. As noted herein, however, we need not consider all of the pleaded registrations. Rather, we will focus on the most relevant.

³ Registered May 11, 2004. Sections 8 and 15 affidavits accepted and acknowledged.

⁴ Registered October 28, 2003. Sections 8 and 15 affidavits accepted and acknowledged.

YOUR FUTURE⁵ (Registration No. 2778362), as shown below,
for "educational services, namely, conducting seminars
relating to self-improvement and distributing course
materials in connection therewith" in International Class
41:

CREATING YOUR FUTURE

Applicant denied the salient allegations of the
amended notice of opposition. Both parties filed briefs and
opposer filed a reply brief.

The Record

The record consists of the pleadings; the file of the
involved application; and the following:

1. Opposer's testimonial deposition of Everett W. James,
dated August 31, 2010.
2. Applicant's testimonial deposition of Andrea
Gallagher, dated December 16, 2010.
3. Opposer's two notices of reliance on
 - a. Status and title copies of its pleaded
registrations.
 - b. Dictionary definitions of the terms "create,"
"think," and "think up."
 - c. Third-party registrations that include both the
goods and services in the pleaded registrations

⁵ Registered October 28, 2003. Sections 8 and 15 affidavits

and the goods and services in the application.

4. Applicant's notice of reliance on

- a. Copies of third-party registrations containing the term "your future."
- b. Dictionary definitions of the terms "create" and "rethink."

Standing and Priority

As a result of opposer's submission of status and title copies of his CREATING YOUR FUTURE registrations (Nos. 2778362, 2778363, and 2840859), among others, showing that opposer is the owner of the registrations and that they are currently subsisting, opposer has established his standing as well as his priority. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) and *King Candy Co. v. Eunice King's Kitchen*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Likelihood of Confusion

Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all of the relevant, probative evidence in the record. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315

accepted and acknowledged.

F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). We discuss the *du Pont* factors for which there is evidence and argument. To the extent we do not discuss them, we consider the other *du Pont* factors to be neutral.

Fame

We turn first to the factor of fame because this factor plays a dominant role in cases featuring a famous or strong mark. *Kenner Parker Toys Inc. v. Rose Arts Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). Famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark. *Id.* A famous mark is one "with extensive public recognition and renown." *Id.* See also *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). Opposer claims that it is "well-known by everybody . . . in the field." (James depo. at 46).

As described by opposer, "we're an adult education business." *Id.* at 8. Despite having been in the business for decades, opposer testified to sales in 2008, as an example, of about "\$18,000" for seminars, "about 3,000 books" at "\$19.95 per book" and "50 CD sets" at "\$199.95" each. *Id.* at 25-27. This adds up to a gross of about \$88,000 total. Presumably out of this amount, opposer

testified to advertising expenses of \$10,000 to \$20,000 on "Google advertising." *Id.* at 29. Opposer did not put these numbers in context for the industry. However, it is difficult to imagine in what context such low sales and revenue figures would cause us to find fame. Opposer offered no substantiating testimony or documentation to back up his assertion of fame. *See Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002); *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d 1811, 1817 (TTAB 2005). Rather, he said, "So it's not that we're famous. We're a legend in our own mind." (James depo. at 47). We conclude that opposer has not shown significant market exposure or overall fame amongst the relevant public. The fifth *du Pont* factor is neutral.

The Goods and Services and Channels of Trade

The goods and services listed in the application are "pre-recorded DVDs in the field of life planning, career changes and retirement," in International Class 9; "printed material, namely, brochures, pamphlets, surveys and assessments in the field of life planning, career changes and retirement," in International Class 16; and "education, namely, seminars regarding life planning, career changes and/or retirement; personal coaching services in the fields of life-mapping services, career changes and the non-financial aspects of retirement," in International Class 41.

The goods and services listed in opposer's most relevant pleaded registrations are for "recordings, namely, prerecorded compact discs featuring lectures relating to self-improvement," in International Class 9 (Registration No. 2840859) "printed materials, namely, books relating to self-improvement, and printed instructional, educational and teaching materials relating to self-improvement," in International Class 16 (Registration No. 2778363), and "educational services, namely, conducting seminars relating to self-improvement and distributing course materials in connection therewith," in International Class 41 (Registration No. 2778362).

Opposer submitted copies of use-based, third-party registrations covering goods and services of the type in both the application and the pleaded registrations. These include, for example, Registration No. 3660076 for "educational and entertainment services, namely, providing interactive live presentations in the field of self-improvement and life planning . . ."; Registration No. 3813446 for "life coaching services in the field of various general topics, namely, personal finance and self-improvement"; and "educational services, namely, providing seminars and training in the field of self improvement and finance"; Registration No 3738643 for "life coaching services in the field of self-improvement"; Registration No.

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3691833 for "career counseling; life coaching in the field of personal and professional development"; and "counseling in the field of personal development, namely self-improvement"; Registration No. 3659281 for "conducting seminars, classes, workshops, individual coaching in the field of personal and leadership development and self-help; and "life coaching services in the field of personal and leadership development"; Registration No. 363555 for "life coaching services in the field of self improvement"; Registration No. 3605834 for "life coaching services in the field of personal and professional development, finances, investments, self-improvement and other self-help topics"; Registration No. 3556541 for "educational services, namely, providing seminars, speeches, and tele-conferences in the field of self-help, self improvement, self-motivation, personal empowerment, life coaching, and human potential"; Registration No. 3553307 for "life and executive coaching services in the field of personal development, namely, self-improvement"; Registration No. 3110318 for "printed publications, namely, a series of books in the fields of personal and professional life coaching, and personal and business planning, growth, development, and improvement"; Registration No. 3368698 for "printed materials . . . featuring self awareness, self improvement" and "educational, training . . . in the fields of self

awareness, self improvement . . . ; professional coaching services" Copies of use-based, third-party registrations may serve to suggest that the goods and/or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993). We note further that it is settled law that a likelihood of confusion may result from the use by different parties of the same or similar marks in connection with goods, on the one hand, and services which deal with or are related to those goods, on the other. *Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1639-49 (TTAB 2007). As such, although applicant argues that none of the third-party registrations captures the exact wording of both the application and the pleaded registrations, we find that the goods and services covered by these third-party registrations are the legal equivalents of those identified by the application and the pleaded registrations, respectively.

A number of the third-party registrations submitted by opposer include "self-help" or "self improvement" as a sub-topic or target of the "life planning" or "personal coaching" services included in applicant's identification of goods and services. Opposer also, in his deposition, gave the following definition of "self-improvement."

Q: "Now, how do you define the concept of self-improvement to yourself?

A: Assisting people in improving their lives and having a better idea of their future,
(James depo. at 62)

Although self-serving, this testimony is consistent with the evidence presented by the third-party registrations, including "self-help" or "self improvement" as a topic or target of applicant's life planning and coaching. Accordingly, we find the goods and services to be related.

Regarding the channels of trade, it is apparent from the identification of goods and services in the application that they are, as to all classes, directed toward life planning in "retirement." The pleaded registrations, on the other hand, have no specific limitations on their target audience or age group. In the absence of specific limitations in the registration, we must presume that opposer's goods and services will travel in all normal and usual channels of trade and methods of distribution.

Squirtco v. Tomy Corporation, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983). See *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992) (because there are no limitations as to channels of trade or classes of purchasers in either the application or the cited registration, it is presumed that the registration and the application move in all channels of trade normal for those services, and that the services are available to all classes of purchasers for the listed

services). Accordingly, there is some overlap in the channels of trade between the goods and services identified in the application and the pleaded registrations. However, the goods and services in the application are directed to a more narrow audience. Accordingly, we find that these *du Pont* factors weigh in favor of finding a likelihood of consumer confusion.

The Marks

We next consider and compare the appearance, sound, connotation and commercial impression of the marks in their entireties. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). In comparing the marks, we are mindful that the test 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 so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the

marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Opposer's relevant marks consist of the words "CREATING YOUR FUTURE" in a slightly stylized font:

CREATING YOUR FUTURE

The stylization is minimal and does not significantly detract from the wording. *CBS Inc. v. Morrow*, 708 F.2d 1579, 1581-82 (Fed. Cir. 1983); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1596 (TTAB 2001); *In re Appetito Provisions Co., Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987). Applicant's mark consists of the words "RETHINKING YOUR FUTURE" in standard character format.⁶

Both marks contain a word ("creating" or "rethinking") followed by the term "your future." Applicant argues that this shared term is highly suggestive of the goods and services in both the application and the pleaded registrations, thereby rendering the first words of each mark the dominant terms. In support of this argument, applicant submitted approximately two dozen use-based, third-party registrations in Class 41 that incorporate the

⁶ Opposer's evidence focuses largely on the use of the mark as presented on applicant's website, which includes the design element of a star. However, we must compare the marks as they appear in the pleaded registrations and the application, and not how applicant's mark may appear on her website.

term "your future." The list includes: INVENT YOUR FUTURE; YOUR FUTURE PAYCHECK, and design; RIGHTPATHING YOUR FUTURE, and design; FUEL YOUR FUTURE; THERE'S A JOB IN YOUR FUTURE; TAKE CHARGE OF YOUR FUTURE; YOUR FUTURE . . . OUR PASSION; YOUR FUTURE, YOUR WAY; THERE'S A JOB IN YOUR FUTURE!; MY PLAN AFTER 50 - NAVIGATING YOUR FUTURE; MY PLAN AFTER 50 - NAVIGATING YOUR FUTURE, and design; FINANCING YOUR FUTURE; BUILDING YOUR FUTURE ON EXPERIENCE; YOUR FUTURE: YOUR TERMS; GARANTICE SU FUTURO; HOW WILL YOU SPEND YOUR FUTURE?; SAVE FOR YOUR FUTURE; SHAPING YOUR FAMILY'S FUTURE; ENVISION YOUR FUTURE; and THE BEELINE TO YOUR FUTURE.

We note that third-party registrations are not evidence of use. *See Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) (the purchasing public is not aware of registrations reposing in the U.S. Patent and Trademark Office). *See also In re Hub Distributing, Inc.*, 218 USPQ 284, 285 (TTAB 1983).

[I]t would be sheer speculation to draw any inferences about which, if any of the marks subject of the third party (sic) registrations are still in use. Because of this doubt, third party (sic) registration evidence proves nothing about the impact of the third-party marks on purchasers in terms of dilution of the mark in question or conditioning of the purchasers as to their weakness in distinguishing source.

In re Hub Distributing, Inc., 218 USPQ at 286.

Applicant did not submit any supporting evidence of third-party use of the term "your future" in connection with DVDs, printed materials or seminars regarding self-improvement or life planning services. Nevertheless, third-party registrations may be used in the manner of a dictionary to show that a term has a meaning or significance in a particular industry. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987) ("[T]hird-party registrations [may] tend to demonstrate that a mark or a portion thereof is suggestive or descriptive of certain goods and hence is entitled to a narrow scope of protection."). In addition, we take judicial notice of the term "your" as meaning "a person's; one's" and "future" as meaning "something that will happen in time to come."⁷ We find these terms to be highly suggestive of the goods and services offered by applicant and opposer in both the pleaded registrations and the application, which are clearly targeted toward shaping the future of those who purchase their goods and services.

Accordingly, while examining and comparing the marks in their entireties, it is appropriate for us to compare as dominant portions of the respective marks the words "creating" and "rethinking." See *In re National Data Corp.*, 224 USPQ 749, 751 (Fed. Cir. 1985) ("there is nothing improper in stating that, for rational reasons, more or less

⁷ Definitions from American Heritage (4th Ed. 2009). The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd* 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties."). Clearly the words "creating" and "rethinking" do not look or sound alike. Although, as opposer argues, they are both gerunds, ending in -ing, the first two syllables of the words are significantly different.

Opposer argues that the connotation and commercial impression of the marks is similar. In this regard, opposer submitted with its first notice of reliance a definition of "create" as meaning "to bring into existence."⁸ A number of synonyms are listed for "create," including "beget, breed, bring about, bring on, catalyze, cause, effect, do, draw on, effectuate, engender, generate." The word "rethink" is not among them. Opposer also submitted definitions in its notices of reliance of the words "think" and "think up." However, we do not find these to be probative, since "rethink" is a separate and distinct word, with its own definition. Applicant, meanwhile, did submit a definition of the word "rethink"⁹ as meaning "to engage in reconsideration." Synonyms are listed as including "readdress, reanalyze, reconceive, redefine, reevaluate, reexamine, reexplore, reconsider, reconsider, review, revisit, and reweigh."

⁸ Merriam-Webster online dictionary (2010).

⁹ Merriam-Webster online dictionary (2011).

We find the commercial impression of opposer's mark in the slightly stylized "CREATING YOUR FUTURE" to be one of inviting participant's to invent their own path in self-improvement. By contrast, we find the commercial impression generated by applicant's mark "RETHINKING YOUR FUTURE" to be one of asking participants to reconsider and possibly change decisions they have already made regarding retirement and other life planning.

We find that the dissimilarities between opposer's and applicant's marks in connotation and commercial impression outweigh the similarities in sight and sound. Accordingly, this *du Pont* factor weighs against finding a likelihood of confusion.

Balancing the Factors

Considering all of the evidence of record as it pertains to the relevant *du Pont* factors, we conclude that although the goods and services are related, in relevant part, and are likely to be marketed through some of the same channels of trade, opposer's CREATING YOUR FUTURE mark is not famous or shown to be well-known, such that the mark would be accorded greater protection. The marks do not look or sound alike, and the shared term "your future," is highly suggestive of the goods and services. We find the connotation and commercial impression of the marks to be sufficiently different that, on the balance, consumer

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confusion is unlikely between opposer's stylized mark
CREATING YOUR FUTURE and applicant's mark, RETHINKING YOUR
FUTURE for the goods and services at issue in this
proceeding.

DECISION: The opposition is dismissed.