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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/250125

APPLICANT: Balance Spa & Fitness, Inc.

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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD ON APPEAL

MARK: BALANCE SPA & FITNESS

CORRESPONDENT'S REFERENCE/DOCKET NO: 23105.TUS

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2. Date of this Office Action.
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EXAMINING ATTORNEY'S APPEAL BRIEF

Procedural History

Applicant applied to register the mark BALANCE SPA & FITNESS (in typed form) on May 15, 2003, alleging a *bona fide* intent to use the mark in commerce for "Clothing, namely tee-shirts, robes, towels, water bottles and the like associated with health, fitness and spa services" in Class 25 and "Health and Fitness Club Services including spa services, massage services and beauty salon services" in Class 41.

In the first Office action, dated October 28, 2003, the previously assigned examining attorney referenced prior-filed pending application Serial No. 78183224 and noted that registration might be refused under Section 2(d) of the Trademark Act on the grounds that the applicant's mark, when used on or in connection with the identified goods and

services would so resemble the mark in the prior-filed application as to be likely to cause confusion, or to cause mistake, or to deceive. In addition, the examining attorney objected to the identification of goods and services as indefinite and required disclaimer of "spa & fitness." By amendment dated April 28, 2004, the applicant adopted an acceptable identification of services, as follows:

> Health and fitness club services, namely providing instruction and equipment in the field of physical exercise, in Class 41; and
>
> Heath spa services, namely, cosmetic body care services, massage services, beauty salon services, in Class 44.

On July 20, 2004, the referenced prior pending Application Serial No. 78183224 matured into Registration No. 2864824. Accordingly, in a non-final Office action dated November 12, 2004, registration was refused under Section 2(d) in light of Registration No. 2864824 for the mark BALANCE A FITNESS STUDIO and design. Following final refusal on June 9, 2005, the applicant noted this appeal and submitted its brief together with a request for oral hearing on February 23, 2007.

Issue on Appeal

The sole issue on appeal is whether the applicant's mark, when used on or in connection with the identified services so resembles the mark in U.S. Registration No. 2864824 as to be likely to cause confusion, or to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Argument

I. Applicable Law - Generally

The Court in *In re E.I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), listed the principal factors to be considered in determining whether there is a likelihood of confusion under Section 2(d). Any one of the factors listed may be dominant in any given case, depending upon the evidence of record. *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). Taking into account the relevant *Du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. First, the marks are compared for similarities in appearance, sound, connotation and commercial impression. *In re E .I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Second, the goods or services are compared to determine whether they are similar or related or whether the activities surrounding their marketing are such that confusion as to origin is likely. *In re National Novice Hockey League, Inc*., 222 USPQ 638 (TTAB 1984); *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re Int'l Tel. and Tel. Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Prods. Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); TMEP §§1207.01 *et seq*. The overriding concern is to prevent buyer confusion as to the source of the goods and/or services. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (C.C.P.A. 1974).

The test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is unnecessary to show actual confusion in establishing likelihood of confusion. *See Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990), and cases cited therein. *See also In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984), wherein the Board stated as follows:

> [A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and registrant has no chance to be heard (at least in the absence of a consent agreement, which applicant has not submitted in this case). *Id*. at 1026-1027.

The Trademark Act not only guards against the misimpression that the senior user is the source of the junior user's goods or services, but it also protects against "reverse confusion," that is, that the junior user is the source of the senior user's goods or services. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993); *Banff Ltd., v. Federated Department Stores*, 6 USPQ2d 1187 (2d Cir. 1988); *Fisons Horticulture v. Vigoror Industries*, 31 USPQ2d 1592 (3d Cir. 1994).

II. Comparison of Marks

The marks are compared for similarities in sound, appearance, meaning or connotation. *In re E .I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1536 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *In re Mack*, 197 USPQ 755

(TTAB 1977); TMEP §1207.01(b). When applicant's mark is compared to a registered mark, "the points of similarity are of greater importance than the points of difference." *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 40, 108 USPQ 161 (D.C. Cir. 1956) (internal citation omitted).

The applicant's mark is BALANCE SPA & FITNESS (in typed form):

The cited mark is:

When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services. Therefore, the word portion is normally accorded greater weight in determining likelihood of confusion. *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976); TMEP §1207.01(c)(ii). Furthermore, disclaimed matter is typically less significant or less dominant when comparing marks. Although a disclaimed portion of a mark certainly cannot be ignored, and the marks must be compared in their entireties, one feature of a mark may be more significant in creating a commercial impression. *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); and *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553 (TTAB 1987). *See also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261,

62 USPQ 2d 1001 (Fed. Cir. 2002); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976); *In re El Torito Rests. Inc.*, 9 USPQ2d 2002 (TTAB 1988); *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986).

In this case, the applicant's mark consists of the wording BALANCE SPA & FITNESS and "SPA & FITNESS" has been disclaimed. Since "SPA & FITNESS" is descriptive of the applicant's health spa and fitness club services and has been disclaimed, the dominant portion of the applicant's mark is the term BALANCE. Likewise, the dominant portion of registrant's mark is BALANCE because "A FITNESS STUDIO" has been disclaimed in the context of the registrant's fitness and exercise facilities services. Marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant's and registrant's mark. *See e.g., Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986), *aff'd* 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH); *In re Phillips-Van Heusen Corp*., 228 USPQ 949 (TTAB 1986) (21 CLUB and "21" CLUB (stylized)); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re Collegian Sportswear Inc*., 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and COLLEGIENNE); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON and MILLTRONICS); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL and LUTEX); TMEP §§1207.01(b)(ii) and (b)(iii). In this case, the applicant's mark and the registrant's mark are similar in appearance because each shares the term "BALANCE."

Further, the registrant's design component is relatively minor and correlates with the dominant term "BALANCE" in that the design consists of a stylized minimalist representation of scales. So as noted in the *Dakin Miniatures* line of cases, and taking into account the disclaimer of record, the dominant portion of registrant's mark is the term BALANCE. While the two marks are not identical when compared side-by-side, the term BALANCE is likely to be most significant in creating a commercial impression. Given the relatedness of services in this case as discussed below, the close similarity in commercial impression of the marks serves as a particularly strong basis for the finding of likelihood of confusion.

Applicant has argued that "trademarks should be considered in their entirety in the way consumers encounter them." (Brief at 2.) However, the argument that follows that statement suggests, in effect, placing applicant's mark and the cited mark next to each other and plucking out the distinctions. Indeed the marks must be considered in their entireties when determining whether there is likelihood of confusion. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984); *In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d 1214 (TTAB 2001); *In re MCI Communications Corp*., 21 USPQ2d 1534 (Comm'r Pats. 1991). As important, however, is the fact that in a likelihood of confusion analysis, the question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods/services they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558 (C.C.P.A. 1972). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected

to a side-by-side comparison. The question is whether the marks create the same overall impression. *Recot, Inc. v. M.C. Becton,* 214 F.2d 1322, 54 USPQ2d 1894, 1890 (Fed. Cir. 2000); *Visual Information Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP §1207.01(b). Thus, the term BALANCE is the term most likely to be recalled by the average purchaser and used to call for the respective services.

Registration of a mark in typed or standard character form means that the mark may be displayed in any lettering style. 37 C.F.R. §2.52(a). The rights associated with a mark in typed or standard character form reside in the wording itself, and registrant is free to adopt any style of lettering, including lettering identical to that used by applicant. Therefore, registrant's presentation of its mark in special form will not avoid likelihood of confusion with applicant's mark that is presented in typed form because the marks could be used in the same manner of display. *See In re Melville Corp.*, 18 USPQ2d 1386, 1387-88 (TTAB 1991); *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988); *Sunnen Prods. Co. v. Sunex Int'l Inc.*, 1 USPQ2d 1744, 1747 (TTAB 1987); *In re Hester Indus., Inc.*, 231 USPQ 881, 882, n.6 (TTAB 1986); *United Rum Merchants, Ltd. v. Fregal, Inc.*, 216 USPQ 217, 220 (TTAB 1982); *Frances Denney, Inc. v. Vive Parfums, Ltd.*, 190 USPQ 302, 303-04 (TTAB 1976); TMEP §1207.01(c)(iii). That is, the presumption must be that the applicant here could present its mark in identical form to the registrant's mark and confusion under those circumstances is likely.

III. Comparison of Services

The applicant's services are described as follows:

> Health and fitness club services, namely providing instruction and equipment in the field of physical exercise, in Class 41; and
>
> Heath spa services, namely, cosmetic body care services, massage services, beauty salon services, in Class 44.

The cited registration lists the following services:

> Providing fitness and exercise facilities, in Class 41.

Evidence of record supports the fact that the services at issue here are closely related. In fact, the services described in Class 41 in each of the two cases are virtually identical. That is, both the applicant and the registrant offer physical fitness/exercise facilities in some form. It has been noted that the goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. Instead, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc*., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc*., 223 USPQ 830 (TTAB 1984); *Guardian Prods. Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re Int'l Tel. & Tel. Corp*., 197 USPQ 910 (TTAB 1978); TMEP §1207.01(a)(i). In the present case, the services are indeed at least closely related, if not the same.

Applicant has argued that "the relevant consumers of the Applicant's and the Registrant's services are significantly different." (Brief at 3.) In support of this assertion, applicant has indicated that it is a large business interest that its consumers "seek out" in various places including the internet and major hotel chains. "By contrast, Registrant apparently only has one location in Minnesota and does minimal advertising of its services apart from its website." (*Id*. at 4.) This argument ignores the critical principle that a determination of whether there is a likelihood of confusion is made solely on the basis of the goods and/or services identified in the application and registration, without limitations or restrictions that are not reflected therein. *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595 (TTAB 1999). If the cited registration describes the goods and/or services broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, then it is presumed that the registration encompasses all goods and/or services of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992); *In re Elbaum*, 211 USPQ 639 (TTAB 1981); TMEP §1207.01(a)(iii). The registration in this case has expressed no limitations on its face as to the types of exercise and fitness facilities offered under the mark, nor are there restrictions as to the channels of trade or potential customers. It must be presumed that registrant's customers can and would encounter applicant's services, and by extension, it is probable that the registrant's potential customers and the applicant's potential customers would be one in the same.

Applicant has further argued that "the relevant consumers are professional or commercial buyers and are assumed to be sophisticated enough not [to] be confused by trademarks that are closely similar." (Brief at 4, citing *In re Arrow Fastener Co. v.*

Stanley Works, 35 USPQ2d 1458 (D.Me 1995), aff'd 41 USPQ2d 1065 (1st Cir. 1996).) The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.,* 221 USPQ 558 (TTAB 1983); TMEP §1207.01(d)(vii). Applicant has proffered that "the relevant consumers in this case are discerning and sophisticated and are…certainly never going to be confused as to the source of the services offered under each." (*Id*. At 5.) In fact, there is nothing on the record to suggest any difference in the types of consumers to which the applicant and registrant would direct their services. Applicant submitted with its Brief a Declaration and Exhibits to support the point that the potential customers here are different. The Examining Attorney objects to entry of these submissions, as they are untimely. The record in any application must be complete prior to appeal. 37 C.F.R. §2.142(d); TMEP §710.01(c); TBMP §§1207.01 *et seq.* *See Rexall Drug Co. v. Manhattan Drug Co.*, 284 F.2d 391, 128 USPQ 114 (C.C.P.A. 1960); *In re Psygnosis Ltd.*, 51 USPQ2d 1594 (TTAB 1999).

Evidence of record in the form of third-party registrations and excerpts from third-party websites *does* suggest, however, that the applicant's services, namely, cosmetic spa and fitness club services are offered under the same mark as the provision of fitness and exercise facilities. That is, these services are of a kind that may emanate from a single source. *See In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-1218 (TTAB 2001); *In re Albert Trostel & Sons Co.,* 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc*., 6 USPQ2d 1467, 1470 at n.6 (TTAB 1988).

IV. Conclusion

In sum, the marks are highly similar and the services are closely related. While this fact and the evidence support the finding of a likelihood of confusion without significant doubt, any doubt regarding a likelihood of confusion is resolved in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); TMEP §1207.01(d)(i).

For the foregoing reasons, it is respectfully submitted that the refusal of registration under Trademark Act §2(d); 15 U.S.C. §1052(d), should be affirmed.

Respectfully submitted,

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