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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85365741
Applicant	Savvier, LP
Applied for Mark	TABATA BOOTCAMP
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Trademark App. Serial No. 85/365741

) Examiner: Edward Fennessy

Filed: July 7, 2011

) Docket No. 021542.0373T1US

Applicant: Savvier, LP

) Services: Educational services namely, conducting live classroom and on-line seminars and workshops for introducing professional fitness instructors to training protocols in the field of fitness.

Mark: TABATA BOOTCAMP

APPLICANT'S REPLY APPEAL BRIEF

In accordance with TBMP § 1203.02(c) and 37 CFR § 2.142(b)(1), Applicant hereby submits its Reply brief:

I. INTRODUCTION AND SUMMARY OF ARGUMENT

The Examining Attorney's Response ("Response") rests on a fundamental misapprehension of the services on which Applicant is using the TABATA BOOTCAMP mark. To be clear, Applicant seeks to register the mark for use in connection with "[e]ducational services namely, conducting live classroom and on-line seminars and workshops for introducing professional fitness instructors to training protocols in the field of fitness." Notwithstanding this clear description, the Examining Attorney frames the first issue on appeal as "whether the applicant's proposed mark, TABATA BOOTCAMP, is generic in relation to *applicant's high intensity physical fitness training services* specifically featuring a type of fitness training known as 'tabata.'" (Emphasis added, footnote omitted). But Applicant does not offer "high intensity physical fitness training services;" it offers classes to professional instructors on *how* to provide high-intensity physical training.

¹ Applicant acknowledges that this Reply is optional, and, in consideration of the Board's limited resources, does not re-address issues already adequately covered in its Appeal Brief.

Thus, the entire premise of the Examining Attorney’s genericness denial rests upon an incorrect understanding of the nature of Applicant’s services. In other words, accepting, *arguendo*, the Examining Attorney’s position that TABATA “refers to a form of high intensity interval fitness training named after researcher Izumi Tabata” and that BOOTCAMP “refers to intense physical fitness training or exercise completed over a relatively short duration,” then it does not follow that the combination of those two terms is descriptive of, let alone generic for, the services offered by Applicant: Applicant’s seminars *neither involve* a fitness training of high intensity nor do they consist of performing high intensity interval training. Put simply, Applicant’s seminars are neither a Tabata workout nor are they a bootcamp.²

The Response also, for the first time on appeal, raises new criticisms of Applicant’s Stewart Survey. Not only is it inappropriate for the Examining Attorney to “sandbag” Applicant with new arguments on appeal (at a time when the Applicant can no longer submit evidence), the criticisms are also unfounded.³ As described in the Survey itself (Exhibit 3, *et seq.*) and in Applicant’s opening brief, the Stewart survey demonstrates that, among the consumers of Applicant’s services (namely professional fitness trainers), Applicant’s TABATA BOOTCAMP mark is (1) viewed as a brand name, and (2) to the extent the mark may have been merely descriptive, has acquired distinctiveness.

Finally, Applicant’s specimen is adequate. Applicant’s specimen has been used in the course of rendering and performing the services for which Applicant seeks registration. Accordingly, the specimen is sufficient.

² The Examining Attorney’s citations to evidence that some demonstrations of the exercise are given during Applicant’s classroom instruction “while being instructed on how to train others in the exercises” does not transform Applicant’s seminars from a classroom instruction into a “bootcamp” workout, as the Examining Attorney defines that term.

³ The only criticism raised by the Examining Attorney in the final office action related to the survey respondents not understanding the difference between a “common” name and a “brand” name. *See* Dec. 12, 2014 Office Action at 27.

II. ARGUMENT

A. TABATA BOOTCAMP Is Not Generic For Applicant's Services

1. Applicant Does Not Seek To Register Its Mark For Use In Connection With Providing High Intensity Interval Workouts Or Intense Workout Programs Over a Relatively Short Time Period

“A ‘generic’ term is one that refers, or has come to be understood as referring to the genus of which the particular product or service is a species. It cannot become a trademark under any circumstances.” *Surgicenters of America, Inc. v. Medical Dental Surgeries Co.*, 202 USPQ 401, 601 F.2d 1011, 1014 (9th Cir. 1979) (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9-10 (2d Cir. 1976)). There is no general rule that the combination of two generic terms renders the composite mark generic. *In re Dial-A-Mattress Operating Corp.*, 57 USPQ 2d 1807, 1810, 240 F.3d 1341, 1345 (Fed. Cir. 2001) (“[W]here the proposed mark is a phrase (such as “Society for Reproductive Medicine”), the board ‘cannot simply cite definitions and generic uses of the constituent terms of a mark’; it must conduct an inquiry into ‘the meaning of the disputed phrase as a whole.’” (quoting *In re Am. Fertility Soc’y*, 51 USPQ 2d 1832, 188 F.3d 1341, 1347 (Fed. Cir. 1999)); *see also Filipino Yellow Pages, Inc. v. Asian Journal Pubs., Inc.*, 53 USPQ 2d 1001, 1007, 198 F.3d 1143, 1148-1150 (9th Cir. 1999) (“*Surgicenters* should not be read overbroadly to stand for the simple proposition that ‘generic plus generic equals generic.’”). Rather, “generic individual terms can be combined to form valid composite marks” and the “ultimate test” of genericness is “how a term is understood by the consuming public.” *Filipino Yellow Pages, Inc.*, 198 F.3d at 1148-49.

Here, the Examining Attorney asserts that TABATA BOOTCAMP is a generic phrase for Applicant's service, i.e., it is generic for “Educational services namely, conducting live classroom and on-line seminars and workshops for introducing professional fitness instructors to training protocols in the field of fitness.” He bases this conclusion on his determination that the words Tabata and Bootcamp are separately generic. More specifically, the Examining Attorney asserts that the word Tabata is “a form of high intensity interval fitness training named after researcher Izumi Tabata.” Response at 6. Further, he asserts that the term “Bootcamp” is generic for “intense physical fitness training or exercise completed

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over a relatively short duration.” Response at 8. On this basis he concludes that “combining the words ‘tabata,’ and ‘bootcamp’ does not create a unique, incongruous, or non-descriptive meaning in relation to the services.” Response at 11-12.

This conclusion, however, is not supported by the Examining Attorney’s cited evidence or legal authority. Not a single reference cited by the Examining Attorney reflects the use of “Tabata” or “Bootcamp” for the type of classroom instruction provided by Applicant. To the contrary, with the exception of the Examining Attorney’s citation to Applicant’s own website, www.tabatabootcamp.com, each of the cited references relate to actual fitness classes and not to the classroom instruction on *how* to give those fitness classes, which is what is at issue in this appeal.⁴ See Response at 7-10.

In fact, this case is analogous to the situation in *Boston Duck Tours, LP v. Super Duck Tours, LLC*, 87 USPQ 1385, 531 F.3d 1 (1st Cir. 2008). There, the First Circuit concluded (like the examiner here) that the phrase “duck tours” is generic for the party’s services, and the composite mark, BOSTON DUCK TOURS, is highly descriptive of the services Boston Duck offers. *Id.* at 23. Although the Board found BOSTON DUCK TOURS, as a composite mark, to be conceptually weak, it had obtained significant secondary meaning as a result of its continuous use in the Boston area, which the Board found overcame the mark’s initial weakness. *Id.*

Here, TABATA BOOTCAMP is used in connection with classroom instruction where:

you [professional fitness instructors] will learn 1) how to lead your own 8 week total body transformation program, 2) how to teach the principles in small groups and through personal training (both in person and on-line virtual training) and 3) how to use Tabata Bootcamp™ to generate revenue for you and/or the facility for which you work.

Exhibit 4 at p. 2, Feb. 19, 2014 Resp. to Office Action. Indeed, Applicant’s entire Instructor’s Manual is directed to professional fitness trainers and makes it clear that the purpose of the program is to offer those

⁴ One citation, <https://www.acefitness.org/>, is to an organization that provides classes to instructors. Response at 20. However, the site does not use “bootcamp” to describe its services, but rather to describe services that professional fitness trainers would provide to their clients. See, e.g., <https://www.acefitness.org/blog/4965/try-this-45-minute-boot-camp-workout>. Thus, the reference also fails to support the Examining Attorney’s argument that BOOTCAMP describes the type of classroom instruction services offered by Applicant.

instructors the best method by which they can institute an effective exercise routine for others, not actually offering the workout itself. *See, e.g., id.* at 2 (indicating that Applicant is providing professional fitness trainers “a turnkey program”), at 3 (noting that “[a]s trainers, our role is not *just* to lead an exercise class” (original emphasis)) and at 9 (noting that “[y]our *clients* will follow a 6-minute HIIT [High Intensity Interval Training] workout ...” (emphasis added)). In other words, Applicant uses TABATA BOOTCAMP in connection with instruction on *how* to provide bootcamps to the *clients* of professional fitness trainers. Pursuant to the “ultimate test” of genericness – how TABATA BOOTCAMP is understood by the consuming public – TABATA BOOTCAMP is not generic, because Applicant does not offer “high intensity interval fitness training” (the services for which the Examining Attorney contends TABATA is generic) nor does it offer “intense physical fitness training or exercise completed over a relatively short duration” (the services for which the Examining Attorney contends BOOTCAMP is generic). Thus, accepting (for purposes of this appeal) that the Examining Attorney is correct regarding the services for which TABATA and BOOTCAMP are generic, Applicant’s mark is not generic. On this record, the Board must resolve this factor in favor of Applicant.⁵ *In re DNI Holdings Ltd.*, 77 USPQ 2d 1435, 1437 (TTAB 2005) (“doubt on the issue of genericness is resolved in favor of the applicant.”); *see also In re Gourmet Bakers, Inc.*, 173 USPQ 565(TTAB 1972) (any doubt in determining the registrability of a mark is resolved in favor of applicant “on the theory that any person who believes that he would be damaged by the registration will have an opportunity . . . to oppose the registration of the mark and to present evidence, usually not present in the ex parte application, to that effect.”)

2. At Most, The Examining Attorney Has Established That TABATA BOOTCAMP Is Highly Descriptive, But The Mark Is Still Entitled To Protection Because It Has Acquired Distinctiveness Among The Relevant Consuming Public

The Examining Attorney asserts that registration should be denied because “marks that describe the subject matter of seminars or workshops have been held incapable for such educational services.”

⁵ For these reasons, the Examining Attorney’s appeal to public policy is inapposite because it is not germane to the issue presented on this appeal, i.e., whether TABATA BOOTCAMP is generic *as to the services for which registration is sought*.

Response at 5. In support of this proposition, the Examining Attorney relies on four cases, but only one of these cases actually found the mark at issue was generic (*In re The Am. Acad. of Facial Plastic & Reconstructive Surgery*, which is distinguishable on the facts here, *see infra*), and the others rely on a now-disfavored doctrine that allowed for “highly descriptive” marks to be denied protection even where they are not generic.⁶

But current practice for refusing registration of such matter is explained in *In re Women’s Publ’g Co. Inc.*, 23 USPQ 2d 1876, 1877 n.2 (TTAB 1992) (“*Womens*”), and discussed in the Trademark Manual of Examining Procedure (“TMEP”). Specifically, the Board found that “[t]he Examining Attorney’s refusal that applicant’s mark is ‘so highly descriptive that it is incapable of acting as a trademark’ is not technically a statutory ground of refusal.” *Id.* The Board explained that an Examining Attorney can refuse registration on the Principal Register under Section 2(e)(1) of the Act, 15 U.S.C. 1052(e)(1), on the basis that the applicant’s mark is (1) generic or (2) merely descriptive and lacking acquired distinctiveness. *Id.*

While the Board’s decision in *Women’s* does not hold that use of the terminology “so highly descriptive that it is incapable of acting as a trademark” is barred as a grounds for refusal, the TMEP says that the case “illustrates that the use of this terminology may lead to confusion and should be avoided.” TMEP 1209.01(c)(ii). In fact, the TMEP asserts that examining attorneys must not state that a mark is

⁶ See *In re Harcourt Brace Jovanovich, Inc.*, 222 USPQ 820 (TTAB 1984) (LAW & BUSINESS held unregistrable because it is so highly descriptive for seminars conducted in the fields of law and business); *In re Indus. Relations Counselors, Inc.*, 224 USPQ 309, 311 (TTAB 1984) (INDUSTRIAL RELATIONS COUNSELORS INC. held “an apt name or... so highly descriptive of those services as to be incapable of exclusive appropriation and registration as a service mark, notwithstanding any de facto source recognition capacity”); *In re Inst. Investor, Inc.*, 229 USPQ 614, 617 (TTAB 1986) (INTERNATIONAL BANKING INSTITUTE held “so highly descriptive as to be incapable of acquiring distinctiveness as a mark,” because “conducting of seminars in a subject such as ‘international banking’ is an accepted and normal means of teaching this kind of subject matter.”); and *In re Nat’l Shooting Sports Found., Inc.*, 219 USPQ 1018, 1020 (TTAB 1983) (SHOOTING, HUNTING, OUTDOOR TRADE SHOW AND CONFERENCE held to be a common descriptive name of applicant’s services and “no quantity of promotion assertedly demonstrating distinctiveness or de facto secondary meaning [could] make this apt descriptive phrase a registrable mark”).

“so highly descriptive that it is incapable of acting as a trademark” in issuing refusals.⁷ *Id.* Rather, the TMEP says that the terminology “generic name for the goods or services” must be used in appropriate refusals, and use of the terminology “so highly descriptive” must be discontinued when referring to incapable matter. *Id.* Thus, the Examining Attorney’s reliance on these cases, which applied the now disfavored “highly descriptive doctrine” was inappropriate, and only supports a finding of descriptiveness, not that Applicant’s mark is generic.

Unlike the other cases relied upon by the Examining Attorney, in *In re The American Academy of Facial Plastic and Reconstructive Surgery*, 64 USPQ 2d 1748 (TTAB 2002) (“*Facial Plastic Surgery*”), the Board concluded that the applicant’s asserted mark (FACIAL PLASTIC SURGERY) was generic for its training, association, and collective membership services related to plastic facial and reconstructive surgery. *Id.* at 1750. However, *Facial Plastic Surgery* is distinguishable from TABATA BOOTCAMP because, unlike the applicant in *Facial Plastic Surgery*, Applicant has substantial evidence of acquired distinctiveness and its mark is aimed at a limited, professional group of consumers.

In *Facial Plastic Surgery*, applicant’s evidence showed that the phrase “FACIAL PLASTIC SURGERY” is a recognized field of surgical specialization, which has been widely used by the relevant public as designating a type of plastic surgery. *Id.* at 1752-53. “As used in connection with training in the field of facial plastic surgery, promoting the interest of facial plastic surgeons and research in this field, as well as indicating membership of facial plastic surgeons,” the Board held FACIAL PLASTIC SURGERY to be generic, because the words indicate only the field of specialty in which these services are rendered. *Id.* at 1753. Critically, unlike the facts at issue here, there was reason to believe that the mark was being used, not just with professional plastic surgeons, but that it could have been aimed at the public in general. *Id.* 1757, n. 5. The Board thus noted that, “the general public looking for surgeons specializing in facial plastic surgery as well as plastic surgeons who limit their practice to this field, may

⁷ Indeed, denying registration on this basis is contrary 15 U.S.C. section 1052(f), which provides that a descriptive term can be a subject for trademark protection when it has acquired “secondary meaning” in the minds of consumers, i.e., it has “become distinctive of the [trademark] applicant’s goods in commerce.”

well be drawn to members of applicant's organization and to applicant's training and research services by the intrinsic information conveyed in applicant's asserted mark." *Id.*; *see also id.*, n. 2 (noting that the applicant's own evidence showed that it was used with ultimate patients, and not just professional plastic surgeons). Accordingly, the "relevant public" for the generic analysis there included the general public at large.

Here, on the contrary, Applicant's services are aimed only at "professional fitness instructors." Indeed, as discussed above, Applicant's Instructor's guide shows that Applicant's services for which registration is sought are directed exclusively at fitness instructors, not at the individuals who would ultimately engage in a workout implementing Tabata-style exercise. *E.g.*, Exhibit 4 at 2, 3 and 9, Feb. 19, 2014 Resp. to Office Action. Moreover, Applicant's advertising is at "most USA and Canadian Fitness conventions" and it has "certified over 4,000 trainers" as of February 2014. Exhibit 1 at ¶¶ 10 & 16, Feb. 19, 2014 Resp. to Office Action. Thus, unlike in *Facial Plastic Surgery*, the only "relevant public" here are the professional trainers and, as revealed by the Stewart survey, professional fitness trainers view TABATA BOOTCAMP as a brand name.⁸ *See* Exhibit 3, p. 14, Feb. 19, 2014 Resp. to Office Action; *see also* Section II.A. of Applicant's Appeal brief, which addresses acquired distinctiveness. Indeed, there is *no* record evidence that Applicant has spent any money on advertising or marketing toward the public at large. In other words, because the relevant consuming public, professional fitness trainers, does not view Applicant's mark as generic, the Examining Attorney's showing that the mark may be generic to the general public is insufficient to carry the burden of proving genericness here. *See Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ 2d 1551, 1552-53 (Fed. Cir. 1991) ("Thus, a proper genericness inquiry focuses on the description of services set forth in the [application]"); *In re Montrachet S.A.*, 878 F.2d 375, 11 USPQ 2d 1393, 1394 (Fed. Cir. 1989) ("Whether a term is entitled to trademark status

⁸ In fact, as the dissent in *Facial Plastic Surgery* makes clear, the issue of who the relevant consuming public was critical to the outcome in that case. *See, Facial Plastic Surgery*, 64 USPQ 2d at 1757-58 ("Even if the USPTO makes a strong, substantial showing that a mark is perceived as generic by a majority of the American public, that strong, substantial showing is, by itself, insufficient unless the USPTO likewise makes a strong, substantial showing that the mark is perceived as generic by the relevant purchasing public of the services for which applicant seeks to register its mark.").

turns on how the mark is understood by the purchasing public.”); *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985) (“The descriptiveness of the term is determined from the viewpoint of the relevant purchasing public.”).

When confronted with a mixed record on the issue of genericness, the Federal Circuit has instructed the Board to side with applicant. *See In re America Online Inc.*, 77 USPQ 2d 1618, 1623 (TTAB 2006). Thus, where, as here, “the evidence of generic use is offset by applicant's evidence that shows not only a significant amount of proper trademark use but also trademark recognition” by third parties, the Board cannot sustain a genericness refusal. *Id.*

Here, the Examining Attorney has, at most, shown that TABATA BOOTCAMP is a descriptive mark. But, unlike in the other cases, Applicant here has provided substantial evidence of acquired distinctiveness among the relevant consuming public. Accordingly, even if the Board agrees with the Examining Attorney that TABATA BOOTCAMP is “highly descriptive,” it is still entitled to protection because of its acquired distinctiveness.⁹

B. The Stewart Survey Followed Appropriate Protocols And The Board Should Disregard The Examining Attorney’s “New” Criticisms

Despite only raising a single critique of Applicant’s survey in his Final Office Action (related to whether the survey respondents understood the difference between a common and brand name), the Examining Attorney raises three new criticisms, for the first time, in the Response: (1) That the incorrect universe was surveyed, (2) that the survey did not follow an acceptable format and (3) that the location of the survey was prejudicial to the results. Response at 22-24. As an initial matter, these new criticisms are untimely and should not be considered by the Board. *See, e.g., In re Dietrich*, 91 USPQ 2d 1622, 1624 (TTAB 2009) (to the extent examining attorney attempted to reject Trademark Act § 2(f) claim for the first time in appeal brief, rejection untimely and not considered); *In re Moore Business Forms Inc.*, 24

⁹ Moreover, in the event the Board is not persuaded that the mark has acquired distinctiveness, Applicant submitted a Proposed Amendment to the Supplemental Register.

USPQ 2d 1638, 1638n.2 (TTAB 1992) (ground for refusal first raised in examining attorney's appeal brief given no consideration).

But even if these bases for rejection were timely (and they are not), they are not legitimate and do not support the Examining Attorney's affording the survey virtually no weight. As demonstrated below, the Stewart Survey identified the appropriate universe of respondents, followed accepted protocols and was performed at appropriate locations. Thus, the Board must give the Stewart Survey substantial weight, especially given that over 90% of respondents acknowledged that they mainly, or sometimes, use TABATA BOOTCAMP as a brand name.

1. The Stewart Survey Addressed The Appropriate Universe

The Examining Attorney asserts that the Stewart Survey was underinclusive because it was limited to certified fitness trainers. Response at 22. But, as Applicant has repeatedly asserted (including expressly in the descriptions of its services in its application), the only consumers to whom it offers its services are "professional fitness trainers." See Application; Exhibit 1 at ¶¶ 7-16, Feb. 19, 2014 Resp. to Office Action (describing the services being provided to professional fitness trainers); Exhibit 2 at ¶¶ 10-13, Feb. 19, 2014 Resp. to Office Action (describing Applicant's marketing efforts aimed at professional fitness trainers); see also Exhibit 4 at 2, 3 and 9, Feb. 19, 2014 Resp. to Office Action (Applicant's course manual showing that it is aimed at professional instructors of fitness classes, not participants in the classes).¹⁰ The appropriate universe for a trademark survey "is that part of the population whose perceptions are relevant to the issues in the case." 3-8 Gilson on Trademarks § 8.03[f][ii] (Matthew Bender 2015). "In genericness or secondary meaning surveys, the question is whether the term is understood to denominate the general category of the goods or services with which it is used or whether it is associated with a particular source." *Id.* at § 8.03[f][ii][B] (footnotes omitted).

¹⁰ Thus, the Examining Attorney's assertion that Applicant's identification of services and promotional materials do not suggest or identification of to whom its services are offered is not supported by the record evidence. See Response at 22.

For example, in *Jacob Zimmerman v. National Assoc. of Realtors*, 70 USPQ 2d 1425, 1426 (TTAB 2004) (“*Zimmerman*”), the board was confronted with determining whether REALTOR and REALTORS were generic. In examining one survey, the Board found that it was appropriate for an expert to use as the universe, “full-time licensed real estate agents or brokers who operate from real estate offices in the continental United States and who had been licensed for at least one year.” *Id.* at 1436. The Board approved of the expert’s rationale that this universe was proper because they were “prospective purchasers’ of membership in such associations [i.e., the relevant services].” *Id.*; see also *Schering Corp. v. Pfizer, Inc.*, 2000 U.S. Dist. LEXIS 7071 (S.D.N.Y. May 24, 2000) (finding, in a false advertising case, that the survey universe was properly limited by profession where plaintiff sought to establish that defendant was telling physicians or implying that its product was non-sedating). Here, Applicant’s services are offered to professional fitness trainers and that is the universe of consumers who may understand the term as generic. Thus, the only “prospective purchasers” of Applicant’s services are professional fitness trainers. Accordingly, the Stewart Survey appropriately limited its survey by the profession of those to whom the mark’s use would be relevant.

2. The Stewart Survey Followed Appropriate Protocols

The Stewart Survey used the *Teflon* format, which is based upon the survey used in *E.I. DuPont de Nemours & Co. v. Yoshida Intern., Inc.*, 185 USPQ 597, 393 F. Supp. 502 (E.D. N.Y. 1975). As Professor McCarthy has noted, “[t]he most widely used survey format to resolve a genericness challenge is the ‘Teflon’ format.” *McCarthy on Trademarks*, § 12:16, at page 12-58; see also *id.* at page 12-60 (“The *Teflon* format is the most judicially accepted format for testing genericness”). Nevertheless, the Examining Attorney contends that the Stewart Survey “does not meet the basic requirement established by *Jacob Zimmerman v. National Assoc. of Realtors*.” Response at 22-23 (citing *Zimmerman*).¹¹

¹¹ In *Zimmerman*, the survey suffered from a number of critical flaws, including the fact that it only had 96 respondents, the gate-keeping queries deviated from the “Teflon” format, and it failed to provide survey subjects with a “don’t know” option, which may have forced guessing. See *Zimmerman*, 70 USPQ 2d 1425, 1435-36 (TTAB 2004). Here, survey questions 1a and 1b provided the appropriate gate-keeping questions, question 2 provided the appropriate example questions with an “I don’t know” option and the survey had 339 respondents. See Exhibits 3C1 and 3C2, Feb. 19, 2014 Resp. to Office Serial No. 85/365741: Appeal Brief

First, the Examining Attorney argues that the survey did not appropriately identify examples of what a “common” name is versus a “brand” name. In the Stewart survey, the respondents were given “Kraft” as an example of a brand name and “oatmeal” as an example of a common name. Exhibits 3C1 and 3C2, Feb. 19, 2014 Resp. to Office Action. These example are not materially different than those used in *In re Country Music Ass’n*, 100 USPQ 2d 1824, 1831, (TTAB 2011), where “Bank of America” was used as an example of a brand name and “safe deposit box” was used as an example of a common name. *See also id.* at 1832 (The Board found that the survey methodology was sound). In support, the Examining Attorney points to persons who said that “Butter” and “Computer” could be used as both a common name and a brand name. Response at 23. But over 86% of respondents stated that they use “Butter” mainly as a common name and over 87% use “Computer” mainly as a common name. These extremely small percentages (under 15% in both cases) pale in comparison to the overwhelming majorities that use the terms as common names. *See Exhibit 3d*, Feb. 19, 2014 Resp. to Office Action.

Next, the Examining Attorney questions the use of well-known brands like DOMINO’S, LITTLE CAESAR’S, FOLGER’S, MICROSOFT, and KRAFT. Response at 23. Without citation to any authority, the Examining Attorney speculates that “[t]he results suggest that some respondents may have merely recognized the fame of these terms without understanding their significance as marks.” *Id.* However, in the face of a similar situation, the court in *Eagle Snacks, Inc. v. Nabisco Brands, Inc.*, 228 USPQ 625, 625 F. Supp. 571 (D.N.J. 1985) found that the use of well-known marks would taint the respondents to find against genericness. In *Eagle*, the survey expert asserted that his survey supported a finding of genericness, but the Court discounted the effectiveness of the survey because the marks it included as examples were too strong, which may have led respondents to think, incorrectly, that a brand name (e.g., TABATA BOOTCAMP) needs to be especially strong. *Id.*, 228 USPQ at 628-29. Thus, if anything the use of particularly strong examples as “brand” names, and the survey participants’

Action; *compare with McCarthy on Trademarks*, § 12:16, at page 12-58-59 (showing the actual questions asked in the *Teflon* survey).

recognition of TABATA BOOTCAMP as a trademark, provides further support for Dr. Stewart's conclusion.

Accordingly, the format and methodology used in the Stewart survey was in the manner that has already been endorsed by the Board and it should be given full weight.

3. The Locations Of The Surveys Were Appropriate

The final new criticism of the Stewart Survey raised in the Response is that it was done at professional fitness trainer conferences where Applicant also appeared and had its advertisements. Response at 24. Of course, as discussed, *supra*, the market for consumers of Applicant's services, professional fitness trainers, is relatively narrow and uniquely available (both for purposes of Applicant's advertising and participation in a survey) at these shows. But, substantial advertising is a factor that weighs in favor of a mark having acquired distinctiveness¹², so this new criticism actually highlights evidence supporting a finding of acquired distinctiveness.

More important, Applicant's effectiveness in marketing towards its narrow audience would make it impracticable, if not impossible, to avoid surveying instructors who have been extensively exposed to Applicant's advertising. Applicant estimates that the total universe of potential customers is limited to just 250,000 professional instructors. Exhibit 2 at ¶ 12, Feb. 19, 2014 Resp. to Office Action. Moreover, Applicant has a booth at most conferences for these trainers, provides a "teaser session" of its instruction at 30 conventions per year and its fitness instructor training program was awarded the 2013 Most Impactful Program Award. Exhibit 1 at ¶¶ 10-14, Feb. 19, 2014 Resp. to Office Action (also noting that between "approximately 500 and 5,000 people at each convention ... have contact with the TABATA BOOTCAMP brand"). In short, Applicant has been extremely effective in advertising and marketing its brand to the narrow group that makes up its potential customers, meaning that it would be virtually impossible to find professional fitness instructors not "tainted" by its advertising. But far from being a detriment to a finding of acquired distinctiveness, this factor supports such a finding.

¹² See generally, *McCarthy on Trademarks*, § 15:50 at pages 15-84 through 15-85 (discussing "Advertising as a means of establishing secondary meaning")


C. Applicant's Specimen Is Adequate

Ignoring's Applicant's showing to the contrary, the Examining Attorney continues to argue that Applicant's specimen is inadequate because it "does not mention or suggest that applicant provides seminars and workshops itself." Response at 26. But this is not the appropriate standard for determining whether a specimen for a service mark is appropriate. Rather, as the TMEP instructs, "[a] service-mark specimen must show the mark used or displayed in connection with a registrable service offered for the benefit of others." TMEP §1301.04(b). Applicant submitted the declaration of Mindy Mylrea who explained that, consistent with the Amendment to allege use, the specimen consists of "examples of materials that were provided in [Applicant's] training showing use of the trademark in classrooms, seminars and workshops." Exhibit 1 at ¶ 5, Feb. 19, 2014 Resp. to Office Action. She also explained that "these are handouts distributed to trainees in our early live classroom trainings and workshops." Thus, the specimen shows the mark as it is used and displayed in rendering Applicant's services. Accordingly, the Board should reverse the Examining Attorney's refusal to register on the basis of an inadequate specimen. TMEP 1301.04(b); *see also In re Metriplex Inc.*, 23 USPQ 2d 1315, 1316 (TTAB 1992) (reversing a refusal to register where "[t]he gravamen of the Examining Attorney's complaint about the specimens is that they do not make reference to the service identified in the application" but the "applicant explained in its declaration, the specimens show the mark as it appears on a computer terminal in the course of applicant's rendering of the service").

III. CONCLUSION

In light of the arguments made, and evidence cited, in Applicant's Appeal Brief and this Reply, Applicant respectfully requests that the refusals be reversed and this application be allowed on the principal register, or the Supplemental Register, should the Board decide that is the better course.

Respectfully submitted,



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