

**This Opinion is Not a
Precedent of the TTAB**

Mailed: May 11, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Urban Yoga LLC

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Serial No. 86392231

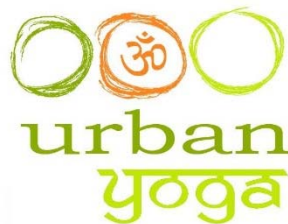
Gene Bolmarcich, Esq.
for Urban Yoga LLC.

Lauren E. Burke, Trademark Examining Attorney, Law Office 106,
Mary I. Sparrow, Managing Attorney.

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Before Quinn, Ritchie and Heasley,
Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Urban Yoga LLC (“Applicant”) seeks registration on the Principal Register of the
mark shown below



Application Serial No. 86392231

for “yoga instruction” in International Class 41.¹ The word “Yoga” and the “Om symbol” are disclaimed. The application includes the following statements: “The mark consists of a horizontal line of three circles, the first circle is green, the second circle is orange with an orange Sanskrit OM symbol inside, and the third circle is light green; beneath the circles is the word URBAN in green; and beneath the word URBAN is the word YOGA in light green. The color(s) green, light green and orange is/are claimed as a feature of the mark. The non-Latin characters in the mark transliterate to om and this means om in English.”²

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark, when used in connection with Applicant’s services, so resembles the previously registered mark shown below



¹ Application Serial No. 86392231, filed September 11, 2014 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging first use anywhere and first use in commerce on November 30, 2010.

² The word “om” is defined as “a mantra consisting of the sound \ōm\ and used in contemplation of ultimate reality.” (www.merriam-webster.com). The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

for “hats, shirts and sweatshirts” in International Class 25; “yoga mats, bags specially adapted to carry yoga equipment, yoga boards, yoga blocks, and yoga straps” in International Class 28; and “yoga instruction” in International Class 41³ as to likely to cause confusion. The words “Yoga Florida” are disclaimed. The registration includes the following statement: “The mark consists of the conjoined letters ‘U’ and ‘Y,’ which suggest the form of a stylized human figure, above the words ‘URBAN YOGA FLORIDA.’”


When the refusal was made final, Applicant appealed. Applicant and the Examining Attorney filed briefs.

Applicant argues that the marks are not similar and that the cited mark is “diluted”: “‘URBAN YOGA’ by itself has become ubiquitous in the field of yoga related instruction and services, including as the name of a major foundation that focuses on ‘urban yoga’ (i.e. yoga that is taught in an urban setting). This is evidence that consumers are able to distinguish marks containing ‘urban yoga’ by the differences in their appearance and other logo design elements.” (4 TTABVUE 4). Applicant further asserts that “a term can be a weak source identifier either because it is commonly used as a trademark, or a part of a trademark, in a particular market OR because it is inherently weak. In the present case, the evidence clearly shows the former but it can also be inferred that it must have a descriptive meaning by virtue of this widespread use.” (emphasis in original) (7 TTABVUE 3). In this connection,

³ Registration No. 4720429, issued April 14, 2015.

Applicant submitted excerpts from third-party websites showing uses of “urban yoga” and “urban yogi.” (Response, Exhibit A, 4/17/15).

The Examining Attorney maintains that Applicant’s services are identical to Registrant’s services, and closely related to Registrant’s goods. In this connection, the Examining Attorney submitted third-party registrations indicating that such goods and services may emanate from the same source. Further, the Examining Attorney contends that the marks in their entirety are similar. In response to Applicant’s principal argument that the cited mark is weak, the Examining Attorney asserts that even weak marks are still entitled to protection against subsequent users of similar marks for identical services and closely related goods. As for Applicant’s evidence, the Examining Attorney states: “The third-party website evidence has no probative value in this discussion and applicant has not shown any proof of third[-]party registrations for marks similar to those at issue, used in association with similar goods and services Even though the evidence shows that other entities use the term ‘URBAN YOGA’ for yoga related services, there is no descriptive or common meaning for this term. Therefore, consumers are still likely to view the collective term ‘URBAN YOGA’ as a source-identifier, and registration of applicant’s mark would result in a likelihood of confusion with registrant’s mark, both which contain this identical wording.” (6 TTABVUE 9-10).⁴

⁴ We note that the Examining Attorney also refused, then withdrew, a Section 2(d) refusal based on Registration No. 3834784 for the mark  for “capri pants; long-sleeved shirts; pants; shirts; short-sleeved shirts; shorts.”

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). These factors, together with the sixth *du Pont* factor involving the number and nature of similar marks in use in connection with similar services, are relevant to the present appeal.

We first turn to the *du Pont* factor involving the similarity of the goods and/or services. We initially note that the cited registration includes both goods and services. We will focus our attention on the services inasmuch as this comparison presents the strongest case for the refusal. That is to say, if confusion is likely with respect to the services, there is no need to consider the likelihood of confusion with the cited mark for the goods, while if there is no likelihood of confusion between the marks for the services, then there would be no likelihood of confusion with respect to Applicant's services and Registrant's goods. *See In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

In the present case, both the application and the cited registration cover "yoga instruction." Likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the recitation of services in the application and the goods and services in the cited registration. *See Tuxedo Monopoly, Inc. v.*

General Mills Fun Group, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1409 (TTAB 2015).

Given the identity of the services, we presume that the services travel through all usual channels of trade and are offered to all normal potential purchasers. *See In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994). *See also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion).

Based on the identical nature of the services as identified in the application and cited registration, and the presumed identity of the trade channels and purchasers, these *du Pont* factors favor a finding of likelihood of confusion.

With respect to the first *du Pont* factor dealing with the similarity of the marks, we must compare the marks shown below in their entirety as to appearance, sound, connotation and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005), quoting *In re E. I. du Pont de Nemours & Co.*, 177 USPQ at 567. “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons

who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014).



In comparing the marks, we are mindful that where, as here, the services are identical in part, the degree of similarity between the marks necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the services. *Coach Servs., Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1721; *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007). We find, however, that Applicant’s mark and Registrant’s mark, when considered in their entireties, are different enough that even when used in connection with identical services, confusion is unlikely. “No mechanical rule

determines likelihood of confusion, and each case requires weighing of the facts and circumstances of the particular mark.” *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010).

The marks are similar to the extent that both share the terminology “URBAN YOGA.”⁵ Although the word portions of marks generally create the dominant impression and are therefore given more weight when comparing marks, in some cases, like the present one, there are significant differences between the accompanying prominent design features that can overcome the similarity between marks and prevent the likelihood of confusion. This is especially true when the word portions of the marks are not particularly strong or are the subject of third-party usage, as the present record indicates.

The record does not include any dictionary entries to establish that the terminology “urban yoga” might be merely descriptive for yoga instruction. Thus, we cannot conclude that the terminology is merely descriptive; however, based on the record and the commonly understood meaning of the words “urban” and “yoga,” we view the terminology as falling within the range of suggestive to highly suggestive. Moreover, as part of a *du Pont* analysis, we must consider “[t]he number and nature of similar marks in use on similar goods [or services].” 177 USPQ at 567. Evidence of third-party use of similar marks in connection with similar services is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection. Applicant contends that the terminology “urban yoga” is commonly understood to

⁵ The dictionary definition of the word “urban,” of which we take judicial notice, reads “of, relating to, characteristic of, or constituting a city.” (www.merriam-webster.com).

mean yoga that is taught in an urban setting; therefore, according to Applicant, the terminology is weak when it appears in a mark, and consumers are able to distinguish among marks containing “urban yoga” by other differences in the marks. Applicant made of record screenshots of seven third-party websites showing uses of the terminology “urban yoga” or “urban yogi” in connection with yoga instruction:



In addition, another third party uses “urban yoga” for a smart phone application:

Urban Yoga Ninja

You poor yogis ... always on the lookout for a yoga studio in your hood. Well, here to serve your granola soul and bring you as many Warrior I poses as your legs can bear is Urban Yoga Ninja. This iPhone app enables yogis to search for yoga classes at a convenient location and time and then book the class.

The Federal Circuit has stated that “evidence of third-party use of similar marks on similar goods ‘can show that customers have been educated to distinguish between different marks on the basis of minute distinctions.’” *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015), quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015). Such evidence is “powerful on its face, even where the specific extent and impact of the usage has not been established.” *Jack Wolfskin v. New Millennium Sports*, 116 USPQ2d at 1136 (internal quotes omitted). “The weaker an opposer's mark, the closer an applicant's mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.” *Juice Generation v. GS Enters.*, 115 USPQ2d at 1674.

We find the evidence of third-party use in this case is sufficient to show that the term “urban yoga” is weak as a source indicator for goods and services such as those of Registrant. Accordingly, we agree with Applicant that, to the extent that Applicant's mark resembles the cited mark because it includes the terminology “URBAN YOGA,” Registrant’s mark is entitled to a “comparatively narrower range of protection.”

More significantly, the marks otherwise are quite different. Applicant’s mark includes prominent design features, and the Sanskrit symbol for “om.” Registrant’s mark also includes prominent design features, including the highly stylized letters “U” and “Y,” which serve as a distinction both in terms of appearance and sound. That

is to say, these highly stylized letters “partake of both visual and oral indicia” adding to the differences between the marks. *In re Electrolyte Labs. Inc.*, 929 F.2d 645, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990). As the Federal Circuit explained in reversing the Board’s decision finding a likelihood of confusion in the case of *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1062 (Fed. Cir. 2003):

Both marks contain the words “Blue Moon” in all capital letters, and those words are prominent in each mark ... Although both marks prominently display a full moon in conjunction with the words “Blue Moon,” the two moon figures are quite different ... Although we uphold the Board’s finding that the two marks are generally similar, principally because they both use the term “Blue Moon,” we note that similarity is not a binary factor but is a matter of degree. Because there are significant differences in the design of the two marks, the finding of similarity is a less important factor in establishing a likelihood of confusion than it would be if the two marks had been identical in design or nearly indistinguishable to a casual observer.

See Massey Junior Coll., Inc. v. Fashion Inst. of Tech., 492 F.2d 1399, 181 USPQ 272, 276 (CCPA 1974) (finding that the design portion of the challenged mark, which included a blue ribbon, created a different commercial impression from the prior mark and that the design portion could not be ignored since the marks must be considered in their entireties); *Columbian Steel Tank Co. v. Union Tank and Supply Co.*, 277 F.2d 192, 125 USPQ 406, 409 (CCPA 1960); *see also First Sav. Bank, F.S.B. v. First Bank System, Inc.*, 101 F.3d 645, 40 USPQ2d 1865, 1871-73 (10th Cir. 1996) (Because FIRST BANK was held to be relatively weak, defendant’s display of the word in a different visual format was found not to be likely to cause confusion. “When the primary term is weakly protected to begin with, minor alterations may effectively

negate any confusing similarity between the two marks.”); *In re Covalinski*, 113 USPQ2d 1166 (TTAB 2014).

In sum, we find that the differences between the marks outweigh the identity in the highly suggestive terminology URBAN YOGA, and that the marks, when considered in their entireties with prominent design features, engender sufficiently different overall commercial impressions that consumers are not likely to be confused by the marks. In comparing the marks in their entireties, the sole common element is the highly suggestive terminology “URBAN YOGA”; we find that the presence of the additional letters “U” and “Y” in the cited registration (which affect both appearance and sound), along with differences in the prominent design features of each mark, are cumulatively enough to distinguish the marks. *See, e.g., Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1245, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004); *Safer, Inc. v. OMS Invs., Inc.*, 94 USPQ2d 1031, 1044-45 (TTAB 2010); *Bass Pro Trademarks, L.L.C. v. Sportsman’s Warehouse, Inc.*, 89 USPQ2d 1844, 1857-58 (TTAB 2008).

We have considered all of the arguments and evidence of record, including those not specifically discussed herein, and all relevant *du Pont* factors. The evidence shows that the common element in Applicant’s mark and the cited registered mark, that is, URBAN YOGA, is weak in the field of yoga goods and services. When this highly suggestive terminology is combined with prominent design features that are distinctly different and, thus, the marks are considered in their entireties, Applicant’s

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mark is sufficiently different from the cited mark. Under these circumstances, despite the identity in services and close relationship between the goods and services, customers would not be likely to believe that Applicant's services, offered under Applicant's mark, emanate from the same source as Registrant's goods and services.

Decision: The refusal to register is reversed.