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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Zencom Global

Serial No. 87399153

Ruth Khalsa of LegalForce RAPC Worldwide, P.C.,
for Zencom Global.

Claudia Garcia, Trademark Examining Attorney, Law Office 111,
Robert L. Lorenzo, Managing Attorney.

Before Kuczma, Heasley and Larkin,
Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

Zencom Global ("Applicant") seeks registration on the Principal Register of the mark MAVA (in standard characters) for:

> Clothing, namely, tops, bottoms, headwear, footwear; Headbands; T-shirts; Shirts; Hoodies; Sweatshirts; Leggings; Tank tops; Long sleeve shirts; Shorts; Pants; Athletic uniforms; Athletic tights; Tights; Athletic footwear; Gym suits in International Class 25.[1]

[1] Application Serial No. 87399153 was filed on April 5, 2017, based upon Applicant's claim of first use anywhere and use in commerce since at least as early as March 1, 2015, and originally contained goods in International Classes 10 and 25. After the refusal was made final, Applicant filed a notice of appeal and a request to divide out from the application the

The Trademark Examining Attorney refused registration of Applicant's mark under § 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), citing Registration No. 5210666 owned by MAVA Athletics, LLC ("Registrant"), for the mark MAVA (standard character mark) for inter alia "personal training services in the field of athletic performance" in International Class 41 as a bar to registration.[2]

After the Examining Attorney made the refusal final, Applicant appealed to this Board. Applicant and the Examining Attorney have submitted briefs. As set forth below, the refusal to register is affirmed.

Likelihood of Confusion

Our determination under § 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion enunciated in *In re E. I. du Pont de Nemours & Co.,* 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S.Ct. 1293, 113 USPQ2d 2045, 2049 (2015); *see also In re Majestic Distilling Co.,* 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities

International Class 10 goods that were not subject to the final refusal. The request was granted and the goods in International Class 10 were transferred to newly created application Serial No. 87976630. Therefore, this appeal involves only goods in International Class 25.

[2] Registration No. 5210666, issued May 23, 2017, includes additional services in Classes 9, 41, 42 and 44 that were not cited by the Examining Attorney as a basis for the refusal and are not involved in this appeal.

between the goods and services. *See Federated Foods, Inc. v. Fort Howard Paper Co.,* 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We have considered all of the evidence as it pertains to the relevant *du Pont* factors, as well as Applicant's arguments (including any evidence and arguments not specifically discussed in this opinion). The other factors we treat as neutral.

A. Similarity of the Marks

It is well settled that marks are compared in their entireties for similarities in appearance, sound, connotation and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F. 3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)). Applicant's mark is identical to Registrant's mark in sound, appearance, meaning and commercial impression, and the identity of the marks strongly favors a finding of likelihood of confusion. *See In re Shell Oil*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) ("The identity of words, connotation, and commercial impression weighs heavily against the applicant.").

B. Similarity of the Goods and Services, Customers and Channels of Trade

We turn next to the *du Pont* factor involving the similarity or dissimilarity of Applicant's clothing goods, particularly, t-shirts, pants, gym suits, athletic uniforms and footwear, including athletic footwear,[3] to the personal athletic training services

[3] In determining the similarity of Applicant's goods and Registrant's services, it is sufficient if likelihood of confusion is established for any item encompassed in the identification of

in the cited Registration. The nature, scope and similarity of the goods and services must be determined based on the identification of goods and services listed in the application and cited registration, not on extrinsic evidence of actual use. *See, e.g.*, *Stone Lion*, 110 USPQ2d at 1162 (citing *Octocom Sys. Inc. v. Hous. Comp. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012).

The goods or services need not be identical or directly competitive to find a likelihood of confusion. As a general matter, they need only to 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 or services come from a common source. *See Coach Servs.,* 101 USPQ2d at 1722; *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991). In cases such as this where Applicant's mark is identical to the cited registered mark, the degree of relatedness between the respective goods and services needed to support a finding that they are related is less than it would be if the marks were not identical; there need be only a viable relationship between the goods and services. *See In re Shell Oil,* 26 USPQ2d at 1689; *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202 (TTAB 2009).

Applicant's goods. *See In re Wacker Neuson SE*, 97 USPQ2d 1408, 1409 (TTAB 2010) (citing *Tuxedo Monopoly, Inc. v. General Mills Fun Group,* 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981)).

The Examining Attorney must provide evidence showing that there is a viable relationship between the goods and services to support a finding of likelihood of confusion. *See, e.g., In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (holding BIGG'S (stylized) for retail grocery and general merchandise store services and BIGGS and design for furniture likely to cause confusion). Evidence of relatedness may include advertisements showing that the relevant goods and services are advertised together or sold by the same manufacturer or dealer. TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1207.01(a)(vi) (Oct. 2017).

Here, Applicant's clothing, particularly, t-shirts, pants, gym suits, athletic uniforms and footwear, and Registrant's services, personal athletic training services, both relate to athletic performance. The evidence introduced by the Examining Attorney shows that individuals and businesses that provide personal training services[4] also provide their own branded clothing, demonstrating the relatedness of

[4] As shown by their definitions, "personal training" (performed by a personal trainer) and "athletics" are highly related as they both involve exercise, fitness and physical activity:

> "Personal trainer" 1. A person who works one-on-one with a client to plan or implement an exercise or fitness regimen. Dictionary.com Unabridged based on the Random House Unabridged Dictionary, © Random House, Inc. 2018, <http:// www.dictionary.com/browse/personal-trainer >.
>
> "Athletics" (in American): sports, games, exercises, etc. requiring physical strength, skill, stamina, speed, etc. Webster's New World College Dictionary 4th ed. Copyright © 2010 by Houghton Mifflin Harcourt at <https://www.collinsdictionary .com/dictionary/english/athletics>; Athletics: 2. (American) sports and other physical activities. Macmillan Dictionary (© Macmillan Publishers Limited 2009-2018 <https://www.macmill andictionary.com/dictionary/american/athletics>.

these goods and services as set forth in the following website screen shots cited below[5]:

June 27, 2017 Office Action:

> Code Red at <http://www.coderedtraining.com/services.html> at 22-24 and <http://www.coderedtraining.com/shop/> offering t-shirts and tank tops at 28-29.[6]
>
> Ralph Roberts Personal Trainer at <http://www.ralphroberts personal trainer .com/store/c1/Featured_Products.html> offering t-shirts at 30-31 and <http://www.ralphrobertspersonaltrainer.com/customworkouts.html> offering personal training at 32-33.

September 6, 2017 Final Action:

> LA Fitness-offering Personal Training <https://www.lafitness.com/pages/PersonalTrainingGeneral.aspx> at 8-9 and t-shirts and tank tops at 10.[7]
>
> VIDA Fitness- Personal Training <http://vidafitness.com/personal-training /overview-rates/>, <http://vidafitness.com/locations/verizon-center/club-overview/> at 11-16 and online shop advertised as "Gear Shop featuring licensed VIDA apparel" at 16.
>
> Equinox- Personal Training <https://www.equinox.com/personaltraining> at 18-24 and online shop offering apparel at 26.

Thus, the "personal training" services identified in the evidence introduced by the Examining Attorney are the same as or equivalent to the "personal athletic training services" identified in the cited registration.

The Board may take judicial notice of dictionary definitions, including online dictionaries which exist in printed format. *See In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff'd,* 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002); *see also Univ. of Notre Dame du Lac v. J. C. Gourmet Food Imps. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd,* 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

[5] Examining Attorney's Appeal Brief at 7 TTABVUE 5-6. References to the briefs in this opinion refer to the TTABVUE docket system.

[6] Page references to the application record refer to the .pdf version of the USPTO's Trademark Status & Document Retrieval (TSDR) system.

[7] While the page showing the LA Fitness t-shirts and tank tops offered for sale was not labeled with the name of the site and the date printed, Applicant raised no objection and it has been considered.

Julie Lohre- FITBODY Online Personal training <http://julielohre.com/online-personal-training/> at 27-29, and online shop offering tank tops and hoodies <http://julielohre.com/portfolio/live-fitbody-clothing-tanks-hoodies/> at 34-35.

Bombshell Fitness- Personal training <http://bombshellfitness.com/homebody/> at 36-40 and online shop offering tank tops, hoodies, t-shirts <http://b-couture.boutique/product-category/tops/> at 41, 48-53, 56.

Mike Davies Fitness - Personal training <http://www.mikedaviesfitness .com/service/personal-training-and-monthly-workouts/> at 59-68 and online shop offering tank tops and headwear <http://www.mikedaviesfitness.com/product-category/apparel/> at 57-58.

AnaBells Fitness- Personal Training <http://anabellsfitness.com /services/private-personal-training/> at 73-74 and online shop offering tank tops and t-shirts <http://anabellsfitness.com/shop/t-shirts/kettlebell-chicks-womens-tank-top/> at 75-77.

November 21, 2017 Denial of Request for Reconsideration:

Anytime Fitness- Personal training <https://www.anytimefitness.com/training/personal-training/> at 21-24 and Online Shop offering t-shirts, tanks, jackets, sweatshirts and pants <Anytimegear.com/cgi-bin/commerce.exe?search=action&category=1LAD> at 6-20.

Atlas Fitness- Personal training <www.atlasfitnessdc.com/training/> at 25-28 and online shop offering t-shirts <www.atlanfitness.com/shop/> at 29-30.

Gold's Gym- Personal training <https://www.goldsgym.com/personal-training/> at 36-39 and online shop offering tank tops, t-shirts, shorts, pants and headwear <www.goldsgear.com/cgiphp/store.php?category=10&subcat=19&so rt_by=user10&search=++Search++> at 31-35.

Jesses Swoyer- Personal training <www.jesseswoyer.com/coachingtraining-services/personal-training/> at 40-42 and online shop offering t-shirts <www.jesseswoyer.com/shop/> at 43-45.

Tapout Fitness- Personal training <nyc106.tapoutfitness.com> at 46-47 and online shop offering t-shirts, tank tops, capris, leggings and shorts <www.tapout.com/new-arrivals/?curr=USD> at 48-57.

> Title Boxing Club-Personal training with boxing workout <https://titleboxing club.com/workout/> at 61-67 and online shop offering tank tops, t-shirts, sweat pants and hats <https://www.titleboxing.com/apparel> at 58-60.
>
> UFC-Personal training <https://ufcgym.com/personal-training> at 68-70 and online shop offering t-shirts, tank tops, sweatshirts, jackets, hats and socks <www.ufcstore.com/UFC_Gym> at 71-77.

In view of this evidence showing that personal training services and clothing items are frequently sold under the same mark, there is at least a viable relationship between these goods and services, and it would be reasonable for prospective customers to assume that Applicant's goods and Registrant's services emanate from the same source when sold under identical marks.

Because there are no restrictions in the description of goods in Applicant's application or in the identification of services in the cited Registration, we must consider the goods and services to move in all the normal and usual channels of trade and methods of distribution to all potential purchasers, and these customers would include the general public. *Octocom,* 16 USPQ2d at 1787; *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987).

Here, the evidence shows that the same entities provide and market the relevant goods and services under the same mark, and that the relevant goods and services are sold or provided through the same trade channels to the same classes of customers; thus, Applicant's goods are related to Registrant's services.

C. The extent to which Applicant has a right to exclude others

Applicant asserts that *du Pont* factor eleven was overlooked during the ex parte examination of the current application because the eleventh factor allows it to exclude others from use of its applied-for mark in its natural zone of expansion based on its ownership of two prior registrations.[8] Specifically, Applicant contends its ownership of Registration Nos. 4897983 for MAVA and 4897984 for 

, both for weight lifting gloves and work-out gloves, means that it owns the senior federal trademark registrations in the product space asserted in this case since the "applied-for mark, the Cited mark, and Applicant's registrations all cover the identical literal elements MAVA."[9]

However, the "zone of natural expansion" doctrine has limited application in ex parte proceedings and is typically applied in inter partes proceedings where an opposer claims that its priority of use of a mark with respect to its goods/services should be extended to include applicant's goods/services because they are in the natural scope of expansion of opposer's goods/services. *See Orange Bang, Inc. v. Olé Mexican Foods, Inc.*, 116 USPQ2d 1102, 1119 (TTAB 2015) (noting that the "natural zone of expansion" doctrine normally applies in inter partes cases in the context of the parties' dueling claims of priority). In ex parte proceedings, the concept is

[8] Brief of the Applicant at p. 6 (4 TTABVUE 7).

[9] Brief of the Applicant at p. 5 (4 TTABVUE 6). It is noted that Applicant's Registration No. 4897984 is for a word and design mark which is not identical to the mark in the pending application. Applicant's Registration Nos. 4897983 and 4897984 were filed and registered prior to the filing and registration dates of the cited mark.

considered through a traditional relatedness of goods and services approach. *In re Kysela Pere et Fils Ltd.*, 98 USPQ2d 1261, 1266 (TTAB 2011); *In re Ginc UK Ltd.*, 90 USPQ2d 1472, 1480 n.9 (TTAB 2007). The coexistence of the cited Registration with Applicant's two prior registrations does not compel a different result.[10] As addressed earlier, the goods in the subject application are related to Registrant's services.

Moreover, our determination of likelihood of confusion must be based on the facts and record before us. We are not bound by a previous examining attorney's determination that the cited mark was entitled to register over Applicant's two prior registrations. Each case must be decided on its own facts, and occasionally an applicant with registrations for the same or very similar marks may be unable to

[10] Applicant notes that it presented evidence under *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1469 (TTAB 1988), of third-party registrations showing that its clothing items are in the natural zone of expansion for its identical registered mark covering weight lifting gloves and work-out gloves (*see* October 31, 2017 Request for Reconsideration at 13-19) and similar evidence of third-party registrations covering both work-out or weight lifting gloves and fitness training/instruction/facility services (*id*. at 19-25). 4 TTABVUE 6. Applicant argues that its prior "registrations are owed the same deference, given valid *Mucky Duck* evidence [it submitted] pertinent to the relationship between Applicant's *registered* goods, and the other goods and services at issue." 4 TTABVUE 7-8. However, Applicant's applied-for mark is for different goods than the goods in its prior registrations. Moreover, "each application for registration of a mark for particular goods must be separately evaluated. Nothing in the statute provides a right *ipso facto* to register a mark for additional goods when items are added to a company's line or substituted for other goods covered by a registration." *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865, 869 (Fed. Cir. 1985) (examining attorney could properly refuse registration on ground that DURANGO for chewing tobacco is primarily geographically deceptively misdescriptive, even though applicant owned incontestable registration of same mark for cigars); *In re Best Software Inc.*, 58 USPQ2d 1314, 1317 (TTAB 2001); *In re Sunmarks Inc.*, 32 USPQ2d 1470, 1472-73 (TTAB 1994) ("Suffice it to say that each case must be decided on its own merits based on the evidence of record . . . in any event the issuance of a registrations(s) by an Examining Attorney cannot control the result of another case."). The Board also recognized at n.7 in *Sunmarks* that although *In re Loew's Theatres* and another case cited in *Sunmarks*, *In re BankAmerica*, 231 USPQ 873 (TTAB 1986), involved refusal under § 2(e), "the propositions expressed therein . . . are just as valid when considering refusals under § 2(d)."

obtain subsequent registrations. *See In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("The Board must decide each case on its own merits. . . . Even if some prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the Board or this court."); *In re Kent-Gamebore Corp.,* 59 USPQ2d 1373, 1377 (TTAB 2001). Even when one registration issues over the other and both exist side-by-side for some period of time (in this case only a little over a year), that is just one element "which is placed in the hopper with other matters which ordinarily are considered in resolving the question of likelihood of confusion, but which is not in the least determinative of said issue." *In re Trelleborgs Gummifabriks Aktiebolag*, 189 USPQ 106, 107 (TTAB 1975); *see also Sunmarks*, 32 USPQ2d at 1472 ("We readily admit that in the present case it is troublesome to refuse registration when applicant already owns registrations for the identical mark for the same and/or similar goods. We find, however, that when this evidence is balanced against the other *du Pont* factors, the scales remain tipped in favor of affirming the refusal here.").

In this case, the factors of the identity of the marks and the relatedness of the goods and services outweigh this point in our consideration of likelihood of confusion as a whole. Inasmuch as there is a likelihood of confusion, it is not appropriate to allow Applicant's mark to be published. If Applicant believes the later-registered cited mark is likely to cause confusion with any of its marks, it may petition to cancel that registration pursuant to § 14 (1), (3) of the Trademark Act, 15 U.S.C. § 1064 (1), (3).[11]

[11] Applicant argues that "[t]o the extent any conflict exists between Applicant's registrations for MAVA and the [later-issued] cited registration for MAVA, Applicant owns senior rights."

D. Conclusion

It is well recognized that confusion in trade is likely to occur from the use of similar or, as in this case, identical, marks for goods on the one hand and for services that deal with or are related to those goods on the other. *In re Hyper Shoppes (Ohio), Inc.*, 6 USPQ2d at 1025 ("retail grocery and general merchandise store services" would include sale of "wooden and upholstered furniture" recited in application); *In re H.J. Seiler Co.,* 289 F.2d 674, 129 USPQ 347 (CCPA 1961) (holding SEILER'S for catering services and SEILER'S for smoked and cured meats likely to cause confusion); *In re United Serv. Distribs., Inc.*, 229 USPQ 237 (TTAB 1986) (holding mark consisting of a design featuring silhouettes of a man and woman used in connection with distributorship services in the field of health and beauty aids and mark consisting of a design featuring silhouettes of a man and woman used in connection with skin cream likely to cause confusion); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (holding 21 CLUB for various items of clothing and THE "21" CLUB (stylized) for restaurant services likely to cause confusion). The evidence establishes that Applicant's clothing goods, particularly, t-shirts, pants, gym suits, athletic uniforms and footwear, and Registrant's personal athletic training services are

However, the dates of use alleged for the Class 41 services in the cited Registration are earlier than the dates of use alleged in Applicant's earlier-issued registrations. The dates of use and the priority of use of the marks are not taken into account in arriving at our ex parte decision, and the issue of whether Applicant owns senior rights in its mark entitling it to registration of the subject mark must be addressed in an adversary proceeding involving the owner of the cited Registration.

sufficiently related such that customers confronted with identical marks therefor would be likely to assume a common source or sponsorship.

Decision: The refusal to register Applicant's mark MAVA under § 2(d) of the Trademark Act is affirmed.