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

Proceeding	87509598
Applicant	Donovan S. McGrath
Applied for Mark	AMPLIFIED YOGA
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**TRADEMARK TRIAL AND APPEAL BOARD**

**VIA ELECTRONIC APPLICATION SYSTEM**

Applicant: Donovan S. McGrath

Serial Number: 87/509598

Mark: AMPLIFIED YOGA

Filing Date: June 28, 2017

Supplement Appeal: August 13, 2019

Examining Attorney: Katie Foss

Law Office: 125

Law Office Number: 571-272-4067

## **APPLICANT SUPPLEMENTAL BRIEF RE: EXAMINER APPEAL BRIEF**

Applicant is requesting an Oral Argument before the TTAB.

### **Likelihood of Confusion**

The Applicant would like to thank the Examiner for her professionalism and responsiveness throughout this process. As a busy small business owner myself, it is appreciated that time is precious and the Applicant acknowledges the Examining Attorney's generosity to this case. The Applicant believes there are many issues still open for consideration, but one in particular that may best be decided on Appeal. The Applicant finally asserts that there would be no likelihood of confusion between the marks as herein explained and argued below.

### **Examining Attorney Argument**

In the Appeal Brief of the Examining Attorney (July 27, 2019) it is argued that because the applied for mark and cited Registration "share an identical dominant first term," which leaves a "similar impression" on a consumer for "highly related services" there would likely be consumer confusion therefore. Also, regarding dilution, it is argued that there is only a "small number" of related marks using the dominant term AMPLIFIED, which is "insufficient to establish that the wording is weak" with respect to the cited registration.

### **Applicant Response**

Regarding dilution and strength of the cited registration, the Applicant refers to previous arguments shown below submitted on May 27, 2019. The Applicant believes that even a "small number" or plurality of related service marks are enough to diminish the strength of an asserted mark, and contends that it is certainly more than de minimis in weakening the strength of the cited registration.

The Applicant requests acknowledgement and explanation of why the Office has allowed similarly situated marks to co-exist but continues to reject the present Application. As

previously argued below, discussed in multiple emails and teleconferences with both the Examining Attorney and Managing Attorney, and submitted via Supplemental Appeal on July 7, 2019; there are many instances where the Office has Registered similar marks and allowed co-existence. Specifically regarding marks with “identical dominant first terms” in “highly related services,” as argued by the Examining Attorney, the Office has allowed co-existence for E-YOGA & E-PILATES, PURE YOGA & PURE PILATES, METHOD YOGA & METHOD PILATES, PRIMAL YOGA & PRIMAL PILATES, INFERNO YOGA & INFERNO HOT PILATES and SANTUARY PILATES & SANCTUARY (yoga); also, regarding marks with the same words in different order in “highly related services,” the Office has allowed co-existence for STICK YOGA & PILATES STICK and THERAPEUTIC YOGA & PILATES THERAPEUTICS (see Supp-Exhibits 1-14 and Exhibits 14-15 respectively). Finally, regarding marks with the “same dominant” second term in “highly related services,” the Office has allowed co-existence for YOGA HAVEN & PILATES HAVEN (see Exhibits 12 & 13). It should also be noted that FITNESS AMPLIFIED was recently allowed, although not yet Registered – SN88251197. How is this possible in light of the present rejection?

### **IN SUM**

The Applicant humbly requests consideration of the arguments and exhibits of record, as well as, a determination as to why the Office has previously allowed co-existence for so many independently owned and similarly situated marks, but refuses to do so for the present Application. The Applicant merely wishes to be treated the same as applicants that came before the present case. The arguments above, asserted against the present Applicant by the Examining Attorney could have fairly been asserted in the referenced cases and were not. The Applicant asks to be treated in similar fashion and in accord with Office practice heretofore.

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(Filed May 27, 2019)

### **I. INTRODUCTION**

Donovan S. McGrath (“Applicant”) has carefully examined the Final Office Action from

Trademark Examining Attorney Katie Foss, Law Office 125. The Applicant appreciates the consideration given to the application during the examination and reconsideration process by the Examining Attorney. This response addresses the likelihood of confusion – section 2(d) final refusal raised in the Office Action dated November 29, 2018. The Office Action required a strict deadline to respond by May 27, 2019, with respect to, the Mark: AMPLIFIED YOGA (the “Present Application”), Serial Number – 87/509598, filed June 28, 2017.

The Trademark Examining Attorney has refused registration under Section 2(d) of the Lanham Act, based upon the Trademark Examining Attorney’s contention that Applicant’s use and application for AMPLIFIED YOGA in IC Class 041 (yoga instruction services), is likely to cause confusion with U.S. Registration No. 5404498 for AMPLIFIED PILATES CENTER (the “Cited Registration”). As discussed below, AMPLIFIED (and related formatives) is registered by multiple parties for goods and services in related or the same fields (see IC Class 041). Applicant’s proposed use of AMPLIFIED YOGA is not likely to cause confusion with the Cited Registration, due to the fact the field is diluted, the cited mark is weak, the services are markedly different, the marks have a different commercial impression, and the Office has allowed similar yoga and Pilates marks to co-exist.

## **II. Likelihood of Confusion Analysis**

Under TMEP § 1207.01, “there is no mechanical test for determining likelihood of confusion and each case must be decided on its own facts.” In some cases, “a determination that there is no likelihood of confusion may be appropriate, even where the marks are similar and the goods/services are related, because these factors are outweighed by other factors, such as differences in the relevant trade channels of the goods/services, the presence in the marketplace of a significant number of similar marks in use on similar goods/services or another established fact probative of the effect of use.” (citations omitted).

The Examining Attorney based the refusal to register Applicant’s mark on three factors: similarity of the marks; the similar nature of the services; and the similarity of trade channels. However, there are many factors to consider in a likelihood of confusion analysis. The

following are common factors analyzed in determining whether a likelihood of confusion exists: (i) similarity between the marks in appearance and suggestion; (ii) similarity of the services; (iii) area and manner of concurrent use; (iv) degree of care likely to be exercised by consumers; (v) strength of the marks; and (vi) actual confusion. Autozone, Inc. v. Strick, 543 F.3<sup>rd</sup> 923 (7<sup>th</sup> Cir. 2008); International Kennel Club of Chicago, Inc. v. Mighty Star, Inc. 846 F.2d 1079 (7<sup>th</sup> Cir. 1988); see also Polaroid Corp. V. Polarad Electronics Corp. 287 F.2d 492, 495 (2d Cir. 1961). No single factor is most important, and courts may assign different weights to any of the factors depending on the case. Packman v. Chicago Tribune Co., 267 F.3<sup>rd</sup> 628 (7<sup>th</sup> Cir. 2001). Analyzing all of the factors together shows that confusion between the marks is not likely.

**i. Similarity of the Marks**

The Examining Attorney asserts that the marks are sufficiently similar to find a likelihood of confusion. However, a determination of similarity between marks is proven while viewing the marks in their entirety, and not just side-by-side. Autozone, 543 F.3<sup>rd</sup> 923. Here, an analysis of the marks in their entirety evidences substantial dissimilarity, and this factor weighs in favor of allowing the Present Application to register and co-exist with the Cited Registration.

The use of the word “amplified” is different. The word Amplified, as used by the Cited Registration, is a noun describing a source of generic Pilates classes, as are known in the field. The word Amplified, as used by the Applicant, is a verb referring to the action of practicing yoga to a rhythm from a musical beat, thereby manipulating and energizing “amplifying” chakras or energy centers of the body. The Applicant teaches a very specific form of enhanced yoga, as opposed to the generic form of Pilates offered by the Owner of the Cited Registration.

Further, the Cited Registration is a Standard Character type mark. Where numerous third-party uses of identical or similar marks indicate that a typed drawing is not distinctive and thus weakens the name. Bliss Salon Day Spa v. Interland Inc., 268 F.3<sup>rd</sup> 494, 496 (7<sup>th</sup> Cir.

2001) (extensive use of “Bliss” marks for similar services made it unlikely consumers would associate the parties’ marks); Halo Management, LLC v. Interland, Inc., 308 F.Supp.2d 1019, 1034 (N.D.Cal. 2003) (noting that when there is a crowded field of similar marks for similar products, “the ability of any member of this field to prevent use by others is relatively weak”).

As to the Cited Registration, the field is crowded with over 60 active registrations that co-exist and have AMPLIFIED as part of their Mark, as well as, 11 Registrations (Exhibits 1-11) within the same field IC Class IC 041 (services), please see below and Exhibits made of record by Applicant. If these marks were not found to be similar enough to cause confusion, then AMPLIFIED YOGA should not be presumed to result in a likelihood of confusion with the Cited Registration. The use of AMPLIFIED by third parties in commercial parlance with a variety of goods and services illustrates the limited strength of the word as an indicator of a single source. Accordingly, the consumers ability to differentiate between and amongst AMPLIFIED marks based upon differences in goods and services in the marketplace is clearly diminished. It is reasonable to infer from such coexistence of AMPLIFIED related marks on the Register that consumers are conditioned so as not to associate these various marks with one single source.

Therefore, the Cited Registration is not a strong mark entitled to broad protection because there are multiple similarly registered marks in use on the same or related goods and services. The Cited Registration, already coexists with numerous other federal registrations for marks that are identical or highly similar in sight and sound within the same and/or related fields, especially within IC Class 041, and the USPTO should limit the protection accorded the Cited Registration to the specific uses of the Good or Service to which the Owner puts its Mark, i.e., Pilates. The same was done in the case, *Amstar Corp. v. Domino’s Pizza, Inc.*, (5<sup>th</sup> Cir. 1980), where the court noted that the greater the number of identical, or more or less similar, trademarks already in use on different kinds of goods, the less there is a likelihood of confusion. Accordingly, the court determined that third-party uses and registrations limit the protection to be accorded the plaintiff’s mark outside the uses of the good “sugar” in that instance. The same

is true in the current analysis, and therefore the Cited Registration should be limited to Pilates.

**ii. Similarity of the Services**

The Examining Attorney argues that the services are similar. However, it is necessary to consider the overall concept and feel of the products in order to determine if a likelihood of confusion exists. Nike, Inc. v. "Just Did It" Enters, 6 F.3<sup>rd</sup> 1225 (7<sup>th</sup> Cir. 1993). Here, the services or yoga classes that Applicant sells are completely different from the services or Pilates classes sold under the Cited Registration.

Looking to the overall concept of the classes offered by the Parties, the services themselves differ tremendously. Applicant's mark is for an enhanced or "amplified" form of yoga. The Cited Registration is for generic Pilates. Pilates is known to be a form of physical exercise, namely strength conditioning, utilizing a complex apparatus known as a "Reformer." Whereas yoga, on the other hand, is a philosophy or spiritual discipline that utilizes breath, meditation, study, spirituality and flexibility conditioning to facilitate the philosophical goal of detachment from the ego. Amplified Yoga, created by Applicant, is yoga enhanced with rhythm from a musical beat, thereby manipulating and energizing "amplifying" chakras or energy centers of the body. In other words, Amplified Yoga is distinct from Pilates as being about mental, spiritual and emotional fitness using a mat and movement/stretching exercises set to music, as opposed to only generic physical fitness using a complex machine or "Reformer." In no circumstances would Amplified Yoga incorporate a machine into the practice.

**iii. Area and Manner of Concurrent Use**

The Owners of the Cited Registration operate out of Illinois, while the Applicant operates out of California. Even if all Parties operated out of the same state, there are multiple instances where Pilates and yoga have been allowed to co-exist by the USPTO for similarly related goods and services (see list below and previous Exhibits). Accordingly, it would be inconsistent and unfair to refuse to allow the Present Application to co-exist with the Cited Registration.



Specifically, the Office has allowed PILATES HAVEN (RN – 5198178) to coexist with YOGA HAVEN (RN – 4972354), which are related services, both registered in class IC 041. The Office has also allowed SANCTUARY PILATES (RN – 4197086), IC 041, to coexist with SANCTUARY (RN – 3423994) with respect to the related good of yoga mats in class IC 028. Finally, the Office has allowed the Cited Registration to coexist with AMPLIFIED YOGA with respect to related goods for yoga under 8 distinct G & S Classes referenced below and Owned by the Applicant. Considering that the Office has allowed the above related goods and services for Pilates and yoga to co-exist, the Office should consistently do the same for the Present Application.

Finally, Applicant's classes are tailored to individuals that are specifically interested in integrating music beats, energy center work and yoga. Pilates is a mass produced method and system of stretching and strengthening using a specialized machine. These differences are further evidence that there would be no confusion between Pilates and yoga classes.

**iv. Degree of Care Likely to be Exercised by Consumers**

It is extremely unlikely that consumers would be confused between the marks when searching for their respective product. The Parties' potential consumers must be considered when determining degree of care. CAE, Inc. v. Clean Air Eng's, Inc. 267 F.3d 660 (7<sup>th</sup> Cir. Ill, 2001). When products are such that a consumer would exercise a great deal of care before purchasing, confusion as to source is less likely. Checkpoint Systems, Inc. v. Check Point Software Technologies, Inc. 269 F.3<sup>rd</sup> 270 (3d Cir. 2001); Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc., 718 F.2d 1201, 1206-1207 (1<sup>st</sup> Cir. 1983).

Applicant's classes are tailored to individuals that are specifically interested in integrating music beats, energy center work and yoga. The Pilates of the Cited Registration is a mass produced method and system of stretching and strengthening using a specialized machine. Each of these are targeted toward a specific customer with distinct needs and objectives who would exercise a high degree of care due to the distinct nature of the classes and outcome

**III. Extent to which the Cited registration may Exclude Others**

Due to the diluted field and weakness of Marks by third party uses and registrations previously discussed, the Cited Registration would have no blanket right to exclude others from using the Marks, except for within a narrow ambit of protection. Furthermore, no effort to exclude was made by the Cited Registration or asserted in Opposition proceedings against any of the Applicant's trademark applications for AMPLIFIED YOGA that have since registered, please see below and Exhibits of record. These facts favor Applicant.

**IV. Extent of Potential Confusion**

In view of third party uses, registrations and the failure to exclude or "Oppose" any of Applicant's applications, the extent of potential confusion is de-minimis and assertion of third party rights to date is entirely absent. This factor also favors Applicant.

**V. Conclusion**

The foregoing arguments and following exhibits submitted herewith, weigh against the likelihood of confusion between the Present Application and the Cited Registration. The Applicant respectfully requests that the TTAB withdraw the refusal of record and allow the Present Application to move to the next stage in the examination process.

**List of Active Registration Numbers**

<u>Mark</u>	<u>Date</u>	<u>Serial No.</u>	<u>Relevant Goods/Services</u>	<u>Owner</u>	<u>Exh. No.</u>
AMPLIFIED	11/5/13	85893288	IC Class 041 – entertainment, car audio	Soundman, Inc	1
LIVE & AMPLIFIED	7/30/13	85806107	IC Class 041 – entertainment, music	Welch, Jason	2
AMPLIFY ENTERTAINMENT	6/15/10	77704196	IC Class 041 – audio recording and production	Riley, Susan	3
WINE AMPLIFIED	3/25/08	77171000	IC Class 041 – entertainment, wine	Rock Wine, LLC	4
AMPLIFY SOCIAL	9/11/12	85430164	IC Class 041 – online athletic news	Amp Social, Inc	5
AMPLIFIER AWARDS	6/26/12	85380950	IC Class 041 – entertainment, gay issues	GLAAD, Inc	6
GRAMMY AMPLIFIER	11/12/13	85912206	IC Class 041 – internet music	NARAS, Inc	7
AMPLIFIED SOUL	11/21/17	87418460	IC Class 041 – consulting, self improvement	Fremon, Ruby	8
INTELLIGENCE AMPLIFIED	10/31/17	87975765	IC Class 041 – services, education asset management	Asset Intel, llc	9
AMPLIFIED DYNAMICS	6/13/17	87080918	IC Class 041 – education, healthcare	Montgomery, M	10
LIVING AMPLIFIED	10/18/16	86495501	IC Class 041 - life coaching	Living Amp, llc	11
PILATES HAVEN	5/9/17	86942718	IC Class 041 – services, pilates instruction	PilatesHaven llc	12
YOGA HAVEN	6/7/16	86764829	IC Class 041 – servies, yoga instruction	YogaSource inc.	13
SANCTUARY PILATES	8/28/12	85384810	IC Class 041 – pilates services	Artibee, Kathy	14
SANCTUARY	5/6/08	78213045	IC Class 028 – yoga mats	Wai Lan Trust	15
PILATES AND DANCE AMPLIFIED	8/10/10	77909338	IC Class 041 - pilates services	Xtend, LLC	16
AMPLIFIED YOGA	5/29/18	87509620	IC Class 028 – yoga equipment	McGrath, D.	17
AMPLIFIED YOGA	Pending	87717807	IC Class 025 – clothing	Mcgrath, D.	18
AMPLIFIED YOGA	pending	87717890	IC Class 027 – yoga bags	McGrath, D.	19
AMPLIFIED YOGA	Pending	87719837	IC Class 009 – digital media	McGrath, D.	20
AMPLIFIED YOGA	pending	87719899	IC Class 016 - books	McGrath, D.	21
AMPLIFIED YOGA	Pending	87725241	IC Class 035 – retail services	McGrath, D.	22
AMPLIFIED YOGA	pending	87725340	IC Class 021 - bottles	McGrath, D.	23
AMPLIFIED YOGA	pending	87725109	IC Class 038 –A/V streaming services	McGrath, D.	24

**Applicant Signature:**

/Donovan S. McGrath/

Date: 08/14/2019

**Applicant Information:**

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