

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

Mailed: September 30, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

In re Kendall S. Oliver
—

Serial No. 88453982
—

Emily M. Haas and Anthony J. Biller of Michael Best & Friedrich LLP,
for Kendall S. Oliver.

Benjamin Rosen, Trademark Examining Attorney, Law Office 120,
David Miller, Managing Attorney.

—
Before Zervas, Wellington and Greenbaum,
Administrative Trademark Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

Kendall S. Oliver (“Applicant”) seeks registration on the Principal Register of the
mark CAMBRIDGE FITNESS (in standard characters, FITNESS disclaimed) for

Health club services, namely, providing instruction and
equipment in the field of physical exercise, in International
Class 41.¹

¹ Application Serial No. 88453982 was filed on May 31, 2019, based upon Applicant’s
allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the
Trademark Act, 15 U.S.C. § 1051(b) of the Trademark Act.

The Trademark Examining Attorney has refused registration of Applicant's mark 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 the identified services, so resembles the registered marks CAMBRIDGE (in typed form) for "counseling services, namely, counseling others in the field of weight reduction and control and nutrition" in International Class 42 ("703 Registration"), and CAMBRIDGE (in standard characters) for "Sporting and cultural activities, namely, organizing competitive sporting events and community cultural events; providing sports coaching; sports instruction services" in International Class 41 ("372 Registration"), owned by two different Registrants, as to be likely to cause confusion, mistake or deception.²

After the refusal was made final, Applicant twice requested reconsideration and appealed to this Board. Reconsideration was denied in each instance, proceedings resumed, and the appeal is fully briefed. We affirm the refusal to register.

I. Likelihood of Confusion

Our determination under Section 2(d) involves an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, hereinafter referred to as "*DuPont* factors"); *see also In re Majestic*

² The first registration, Reg. No. 1402783, issued on July 29, 1986, and has been renewed twice. Prior to November 2, 2003, "standard character" drawings were known as "typed" drawings, and they are legal equivalents. TRADEMARK MANUAL OF EXAMINING PROCEDURE § 807.03(i) (October 2018) ("TMEP"). The second registration, Reg. No. 5658372, issued on January 22, 2019 with a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), and identifies numerous other goods and services in Classes 9, 16 and 41 which are not at issue here.

Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). However, in any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”); *see also In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all [du Pont] factors for which there is record evidence but ‘may focus . . . on dispositive factors, such as similarity of the marks and relatedness of the goods.’”) (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

A. Similarity or Dissimilarity of the Services

We assess the *DuPont* factor of the similarity or dissimilarity of the services based on the services as they are identified in the application and cited registrations. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); *see also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014). The test is not whether consumers would be likely to confuse the services, but rather whether they would be likely to be confused as to

their source. *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1439 (TTAB 2012); *In re Rexel Inc.*, 223 USPQ 830, 832 (TTAB 1984). Therefore, to support a finding of likelihood of confusion, it is not necessary that the services be identical or even competitive. *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1368 (TTAB 2009). The respective services need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that goods [or services] emanate from the same source.” *Coach Servs.*, 101 USPQ2d at 1722 (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). See also *In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991).

As stated above, Applicant’s recited services are “Health club services, namely, providing instruction and equipment in the field of physical exercise.” The services recited in the ‘703 Registration are “counseling services, namely, counseling others in the field of weight reduction and control and nutrition,” and the relevant services recited in the ‘372 Registration are “Sporting and cultural activities, namely, organizing competitive sporting events and community cultural events; providing sports coaching; sports instruction services.”

The webpage evidence of record demonstrates that health clubs often offer one or more of the services identified in the cited registrations, namely, nutritional counseling services, sports coaching, sports instruction, or organization of competitive

sporting events, under the same mark. August 27, 2019 Office Action, TSDR 22-41.³

Specifically:

- City Gym offers fitness equipment, personal training, group fitness, and nutritional counseling with an onsite dietician;
- Vida Fitness offers personal training, small group training and nutritional counseling;
- Gold’s Gym claims that “coaching is in our DNA,” and offers “World-class certified personal trainers, energetic class instructors, and innovative fitness programs – we have the coaching programs and experience you need to help you achieve your fitness goals,” as well as personal nutrition counseling and “group nutrition classes at your gym”;
- Sport & Health offers personal training, group fitness classes, organized basketball games “in one of our competitive leagues,” and “tennis lessons, programs, clinics, ladder and match play for all ages”;
- Health Genesis Clubs offers group fitness classes, personal training, and the “Elevate Basketball Academy,” a “professional program to enhance your player’s overall basketball knowledge and skill level” with “detailed development plans for each player that focuses on developing skills and fundamentals that will improve game day performance. Workouts are designed

³ Citations are to TTABVUE and the Trademark Status and Document Retrieval (TSDR) record downloaded in .pdf format.

to breakdown and fine tune instruction then apply in game speed, same situation drills to produce results on game day”; and

- The St. James offers “state-of-the-art sports venues” with “expansive turf fields, two ice rinks, an Olympic-size swimming pool... under one roof,” as well as a health club with personal trainers and fitness classes, and a “Court House” with “four regulation-size basketball courts and nine volleyball courts” that “hosts special events like clinics, combines, and showcases.”

This evidence is probative of the relatedness of the identified services because it shows consumers, who are members of the general public who exercise, are exposed to Applicant’s and Registrants’ types of services offered under the same mark. *See, e.g., In re C.H. Hanson Co.*, 115 USPQ2d 1351, 1355-56 (TTAB 2015); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009).

We find Applicant’s and Registrants’ services to be related. This *DuPont* factor therefore weighs in favor of a finding of a likelihood of confusion.

B. Strength of the Cited Marks

Applicant contends that “Cambridge” is a weak term entitled to a narrow scope of protection or exclusivity of use because of an asserted plethora of third-party uses and registrations of CAMBRIDGE-formative marks for services that include fitness programs and equipment, and other purportedly related goods and services. According to Applicant, if the cited registrations for CAMBRIDGE can coexist with other CAMBRIDGE-formative marks, and with each other, then its mark also should be permitted to register. In support of this contention, Applicant points to 38

registrations for services in either Class 41 or Class 42, and screenshots from approximately 15 third-party websites, which we address in turn.⁴

Third-party registrations are not evidence of use or what happens in the marketplace. *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973). However, they may be relevant to show the sense in which a mark is used in ordinary parlance; that is, an element common to the parties' marks may have a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that the segment is inherently weak. *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); *see also In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1745 (TTAB 2016) (“[T]hird-party registrations are relevant evidence of the inherent or conceptual strength of a mark or term because they are probative of how terms are used in connection with the goods or services identified in the registrations.”).

Initially, we observe that of the 38 registrations, Applicant only addressed two, and collectively referred to the other 36 simply as registrations that contain services in Classes 41 or 42. The two registrations referenced by Applicant are (1) cancelled Reg. No. 1943337 for the mark CAMBRIDGE EDUCATIONAL for goods in Classes 9 and 16, which does not support Applicant's position;⁵ and (2) Reg. No. 5211233 for the

⁴ Applicant submitted this evidence as Exhibits A and B to the March 16 Request for Reconsideration. Applicant previously submitted the marketplace evidence as Exhibit A to the September 23, 2019 Response to Office Action.

⁵ This registration identified software and printed matter for the educational market featuring, inter alia, physical education and health. A cancelled or expired registration is “only evidence that the registration issued and does not afford [an applicant] any legal

mark CAMBRIDGE CORE for “computer software, educational documents, and assessment criteria for nutrition education,” which is not owned by a third party, but by the same Registrant who owns the cited ‘372 Registration.⁶ The other third-party registrations are not probative because they do not identify nutritional counseling services, sports coaching services, sports instruction services, or organizing competitive sporting events for others (or health club services), or arguably similar goods or services.⁷ See *i.am.symbolic*, 123 USPQ2d at 1751 (disregarding third-party registrations for goods or services where the proffering party had neither proven nor explained that they were related to the goods or services in the cited registration). Therefore, although the third-party registrations show that CAMBRIDGE is a somewhat commonly registered term for unrelated goods or services, they do not support Applicant’s claim that it is weak for Registrants’ services.

We turn next to the Internet evidence. Evidence of third-party use bears on the strength or weakness of a registrant’s mark. *i.am.symbolic*, 123 USPQ2d at 1751. If the evidence establishes that the consuming public is exposed to third-party uses of

presumptions under Trademark Act Section 7(b),” 15 U.S.C. § 1057(b), including the presumption that the registration is valid, owned by the registrant, or that the registrant has the exclusive right to use the mark in commerce in connection with the goods and/or services identified in the registration certificate. *Bond v. Taylor*, 119 USPQ2d 1049, 1054-55 (TTAB 2016).

⁶ March 16, 2020 Request for Reconsideration, TSDR at 147-152. The same is true for 5 other of the 38 registrations. *Id.*, TSDR at 130-146, 153-156, 160-164.

⁷ The Class 41 and Class 42 services covered by the third-party registrations attached to the March 16, 2020 Request for Reconsideration include disparate services such as management consulting services (TSDR at 57-59), research in the field of world energy trends (TSDR at 64-67), day care services (TSDR at 68-76), hotel services (TSDR at 85-87), seminars on financial topics (TSDR at 88-91) and medical research services (TSDR at 102-104), to name but a few.

similar marks for similar goods or services, it “is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005). In determining a mark’s strength, we consider both inherent or conceptual strength, based on the nature of the mark itself, and commercial strength or recognition. *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1476 (TTAB 2014); *see also In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”).

Of the approximately 15 listed websites involving businesses with CAMBRIDGE-formative names, nearly all of them are for fitness-related services located in or near Cambridge, Massachusetts, and two of them are for fitness-related services located in or near Cambridge, Maryland. Although “extensive evidence of third-party use and registrations is ‘powerful on its face,’ even where the specific extent and impact of the usage has not been established,” *Jack Wolfskin*, 116 USPQ2d at 1136 (citing *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)), Applicant’s evidence consists of marketplace evidence of 15 different entities using CAMBRIDGE-formative marks and no third-party registrations covering similar services. While this evidence is similar in volume to that in *Jack Wolfskin*, where there were at least 14 relevant third-party uses or registrations of record, it is far short of the at least 26 relevant third-party uses or registrations of record found

convincing in *Juice Generation*. See also *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030 (TTAB 2016) (weakness found based on at least 85 actual uses of ROSE-formative marks for similar services, eight similar third-party registrations, expert testimony and other evidence regarding the common nature of ROSE-formative marks in the industry, and testimony by opposer that it did not vigorously enforce its mark).

Nor does the record approach that in *In re Broadway Chicken, Inc.*, 38 USPQ2d 1559, 1565 (TTAB 1986), where the Board found no likelihood of confusion between BROADWAY CHICKEN and BROADWAY PIZZA for identical services largely because the record contained hundreds of examples of third-party use of the term “Broadway.”⁸ The evidence in this case essentially consists of a few examples of health clubs and fitness-related service providers clustered in or near locations named Cambridge, and supports a finding that the term CAMBRIDGE sometimes has a geographic connotation. But it does not establish commercial weakness or that customers are accustomed to relying on small differences to distinguish among many CAMBRIDGE-formative marks.

Finally, because we are not privy to the reasons that the two cited CAMBRIDGE registrations coexist, we follow the often repeated principle from the Federal Circuit, our primary reviewing court, that every application is examined on its own record. See *In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016) (“[The Federal Circuit], like the Board must evaluate the evidence in the present

⁸ We also note that the services at issue are not identical, as they were in *Broadway Chicken*.

record to determine whether there is sufficient evidence”); *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 91 USPQ2d 1218, 1221 (Fed. Cir. 2009) (“Applicant’s allegations regarding similar marks are irrelevant because each application must be considered on its own merits.”); *see also In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“Even if some prior registrations had some characteristics similar to Nett Designs’ application, the PTO’s allowance of such prior registrations does not bind the [Trademark Trial and Appeal] Board or this court.”).

Despite some evidentiary infirmities, the record supports a finding that the term “Cambridge” is not entirely unique when used in connection with health and fitness services, and may be referring to the geographic location where those services are rendered, and that purchasers would be aware of this geographic connotation. We find, therefore, that the mark in the cited registrations, CAMBRIDGE, has some conceptual weakness, and accordingly, it is entitled to a slightly narrowed scope of protection than would be accorded an arbitrary mark.

C. Similarity or Dissimilarity of the Marks

We next compare Applicant’s mark CAMBRIDGE FITNESS and the cited registered marks CAMBRIDGE, all in standard characters, “in their entirety as to appearance, sound, connotation and commercial impression.” *Detroit Athletic Co.*, 128 USPQ2d at 1048 (quoting *DuPont*, 177 USPQ at 567); *see also Palm Bay Imps.*, 73 USPQ2d at 1691. “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.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018).

Because similarity is determined based on the marks in their entirety, our analysis is not predicated on dissecting the marks into their various components. *Stone Lion*, 110 USPQ2d at 1161; *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). On the other hand, “there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety.” *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Further, the marks “must be considered ... in light of the fallibility of memory ...” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quotation omitted). We focus on the recollection of the average consumer – here, an ordinary consumer of health, fitness and nutrition services – who normally retains a general rather than a specific impression of trademarks. *See id.* at 1085; *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971).

The marks look and sound similar because of the common wording CAMBRIDGE, important considerations in the analysis for consumers “calling for” the services. *See In re Viterra, Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1911 (Fed. Cir. 2012). As the first part of Applicant’s mark, CAMBRIDGE “is most likely to be impressed upon the

mind of a purchaser and remembered,” *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) and *Palm Bay Imps.*, 73 USPQ2d at 1692. Also, the remaining part of Applicant’s mark, FITNESS, consists of descriptive wording that Applicant disclaimed, thereby diminishing its significance in the comparison of marks. *See Dixie Rests.*, 41 USPQ2d at 1533-34; *Nat’l Data*, 224 USPQ at 752.

In addition, while there is no rule that a likelihood of confusion is present where one mark encompasses another, in this case, as in many others, the fact that Applicant’s mark includes the entirety of Registrants’ mark increases the similarity between them. *See, e.g., Wella Corp. v. Cal. Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (finding CALIFORNIA CONCEPT marks substantially similar to prior mark CONCEPT); *Coca-Cola Bottling Co. of Memphis, Tenn., Inc. v. Joseph E. Seagram and Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (CCPA 1975) (applicant’s mark BENGAL LANCER for club soda, quinine water and ginger ale is likely to cause confusion with BENGAL for gin). Moreover, consumers often shorten full names and likely will shorten CAMBRIDGE FITNESS to CAMBRIDGE. *See Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983) (“Although the record does not indicate that applicant’s business is commonly referred to as ‘Giant,’ it does indicate that people have called it by that name, omitting the word ‘Hamburgers.’ Thus, in a conversation between two consumers in opposer’s area about a place of business called ‘Giant,’ there likely would be confusion about which ‘Giant’ they were talking about.”). We find that likely here, where the registered services can be provided within a health club.

We find that when viewed in their entirety, the marks are very similar in all respects. The first *DuPont* factor thus weighs in favor of a finding that confusion is likely.

II. Conclusion

We have found that term CAMBRIDGE has some conceptual weakness in the registered marks. Such conceptual weakness is outweighed by the lack of any demonstrated commercial weakness of the very similar marks used on or in connection with related services. Confusion, therefore, is likely between Registrants' standard character mark CAMBRIDGE and Applicant's standard character mark CAMBRIDGE FITNESS.

Decision: The refusal to register Applicant's mark CAMBRIDGE FITNESS is affirmed.