

This Opinion is not a
Precedent of the TTAB

Oral Hearing: December 6, 2022

Mailed: March 31, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Disciplina Excellentiae, LLC

Serial No. 90426395

Serial No. 90426435

Olivia M. Muller of Erik M. Pelton & Associates, PLLC,
for Disciplina Excellentiae, LLC

Valerie Kaplan, Trademark Examining Attorney, Law Office 107,
J. Leslie Bishop, Managing Attorney.

Before Kuhlke, Goodman and Allard,
Administrative Trademark Judges.

Opinion by Goodman, Administrative Trademark Judge:

Disciplina Excellentiae, LLC (“Applicant”) seeks registration on the Principal

Register of the following marks:

HIPE FIT¹ (in standard characters, FIT disclaimed); and


¹ Application Serial No. 90426395 was filed on December 29, 2020, based upon Applicant’s assertion 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).

Page references to the application record refer to the online database of the USPTO’s Trademark Status & Document Retrieval (TSDR) system. References to the briefs on appeal

HIPE FITNESS² (in standard characters, FITNESS disclaimed) both for the following services:³

Health club services, namely, providing instruction and equipment in the field of physical exercise; Providing assistance, personal training and consultation in the field of physical fitness; Providing small group training in the field of physical fitness; Providing private yoga instruction; Providing recreational services in the nature of athletic facilities, gymnasiums, fitness centers, and exercise rooms; Yoga, pilates, cycling, dance, strength training, and fitness instruction; Special event planning, coordination and consultation services for entertainment purposes in International Class 41.

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 marks so resemble the following Principal Register marks displayed below as to cause confusion, to cause mistake, or to deceive:

HIP⁴ and ⁵, both owned by the same entity, for the following services:

Education services, namely, training high school students to provide health education and health information

refer to the Board's TTABVUE docket system. Applicant's brief is at 6 TTABVUE and its reply brief is at 9 TTABVUE. The Examining Attorney's brief is at 8 TTABVUE.

² Application Serial No. 90426435 was filed on December 29, 2020, based upon Applicant's assertion 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).

³ Both applications also identify Class 25 clothing goods which are not subject to the Section 2(d) refusals. October 27, 2021 Office Action at TSDR 1 (Serial No. 90426395) and February 14, 2022 Office Action at TSDR 1 (Serial No. 90426435).

⁴ Registration No. 6181328 issued October 20, 2020.

⁵ Registration No. 6181329 issued October 20, 2020. The description of the mark states: "The mark consists of the stylized word 'HIP.'" Color is not claimed as a feature of the mark.

resources to their peers, and providing curricula and course materials in connection therewith In International Class 41; and

HIP⁶ (in standard characters), owned by a different entity, for the following services:

Arranging and conducting youth sports programs in the field of football; Educational services, namely, providing classes, seminars, and workshops in the fields of sports; Entertainment in the nature of football games in International Class 41.

In application Serial No. 90426395, shortly after the refusal was made final, Applicant requested reconsideration. After the Examining Attorney denied the request for reconsideration, Applicant filed an appeal. In application Serial No. 90426435, when the refusal was made final, Applicant filed an appeal. In both appeals, Applicant requested consolidation, which the Board granted.⁷ An oral hearing was held in the consolidated appeal.

We reverse the refusals to register.

I. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049

⁶ Registration No. 5544500 issued August 21, 2018.

⁷ Serial No. 90426395 and Serial No. 90426435, 4, 5 TTABVUE. Therefore, we decide both appeals in a single opinion. In our discussion, all references to the record refer to the record of Application Serial No. 90426395 unless we note otherwise.

(2015). We must 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).


Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Cap. City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011) (“Not all of the *DuPont* factors are necessarily “relevant or of equal weight in a given case, and any one of the factors may control a particular case.”); *In re Shell Oil Co.*, 992 F.2d 1204, 1209, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“the various evidentiary factors may play more or less weighty roles in any particular determination”). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002); *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 [or services] and differences in the marks.”). These factors, and others, are discussed below.

A. Similarity or Dissimilarity of the Services

Under the second *DuPont* factor, we compare the services as they are identified in the involved applications and cited registrations. *See Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

The Examining Attorney need not prove, and we need not find, similarity as to each service listed in the cited marks and the involved applications. “It is sufficient for finding a likelihood of confusion if relatedness is established for any item encompassed by the identification of [services] within a particular class in the application” or cited registration. *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015); *see also Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

Applicant argues that the “education programs” listed in Applicant’s identification as well as the identifications in both Registrants’ registrations are “very specific and relate solely to the indicated (and different) subject matters, and by nature exclude one another.” 6 TTABVUE 20. Applicant submits that although both Applicant’s and Registrants’ services “involve health and education or instruction of some sort, their purposes and focuses differ greatly” as “Applicant’s services are gym and health club services, along with personal training in those fields.” 6 TTABVUE 20.

As to the cited registrations, HIP and  marks (Registration Nos. 6818328 and 6181329), the Examining Attorney argues that Registrant’s services of training high school students to provide health education and health information under the marks is related to Applicant’s “health club instruction” services which are “broad enough to encompass all types of instruction” and that “health education includes Applicant’s narrower subject basis of physical exercise.” 8 TTABVUE 12.

We take judicial notice that “health” is defined as “the condition of the body and the degree to which it is free from illness, or the state of being well” and “fitness” is defined as “the condition of being physically strong and healthy.”⁸ We find that Applicant’s “small group training” is broad enough to encompass “training of high school students” and the field of “physical fitness” is under the broader field of health identified by the Registrant’s services.⁹ See *Southwestern Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015), *aff’d*, 652 Fed. Appx. 971 (Fed. Cir. 2016) (given the broad identification of services, “we must presume that the services encompass all services of the type identified”). Therefore, we find these services are related in part.

As to the cited HIP mark (Reg. No. 5544500) for sports educational services, the Examining Attorney argues that the internet evidence supports a finding of relatedness to Applicant’s services. 8 TTABVUE 12.

The evidence in the record shows, for example, that Arena Club, a comprehensive fitness and sports center, offers gym and pool facilities, wellness and recreation activities, fitness and cardio equipment, and group fitness classes.¹⁰ It offers athletic

⁸ The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (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); CAMBRIDGE DICTIONARY, dictionary.cambridge.org, (accessed March 28, 2023).

⁹ Applicant states that “though Applicant’s and Registrants’ services fall generally under the umbrella of ‘health related services,’ each is offered to a distinct niche. Applicant’s services are health club and gym services, whereas Registrant Health Information Project provides an educational health program for high schoolers and Registrant HIP football organizes safer games of football.” 6 TTABVUE 18, note 2.

¹⁰ January 11, 2022 Denial of Reconsideration at TSDR 2-3.

programs and clinics for “emerging athletes to realize their full potential,” clinics relating to football or baseball, and a “sports performance program to provide young athletes with a complete well-rounded training experience that helps improve performance to become successful in any chosen sport.”¹¹ Sports Academy offers youth “academy sports” for training and playing in competitions; youth memberships for focusing on sports skill development training; and membership classes that focus on “Speed and Agility, Explosive Power and Strength Building.”¹² IMG Academy offers football training, sports specific training, and personalized training sessions.¹³

We find the internet evidence supports the relatedness of Registrant’s (Registration No. 5544500) “educational services, namely, providing classes, seminars, and workshops in the fields of sports services,” with Applicant’s “Health club services, namely, providing instruction and equipment in the field of physical exercise; Providing small group training in the field of physical fitness; Yoga, pilates, cycling, dance, strength training, and fitness instruction.”

The Examining Attorney also argues that the trade channels overlap. We find the internet evidence supports an overlap in the trade channels at least as to the cited Registration No. 5544500.

¹¹ January 11, 2022 Denial of Reconsideration at TSDR 5, 13.

¹² January 11, 2022 Denial of Reconsideration at TSDR 68, 70-71.

¹³ January 11, 2022 Denial of Reconsideration at TSDR 33-34.

B. Strength of the Marks and Similarity and Dissimilarity of the Marks

Before comparing Applicant's mark to the registered marks, we address Applicant's arguments related to the strength of the registered marks which may affect the scope of protection to which they are entitled.¹⁴ See *In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1745 (TTAB 2016) ("the strength of the cited mark is — as always — relevant to assessing the likelihood of confusion under the *DuPont* framework"); see also *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1517-18 (TTAB 2016) (we may consider whether an inherently distinctive mark is "weak as a source indicator" in the course of a *DuPont* analysis).

1. Conceptual Strength

To determine the conceptual strength of the cited marks, we evaluate their intrinsic nature, that is, where they lie "along the generic-descriptive-suggestive-arbitrary (or fanciful) continuum of words." *In re Davia*, 110 USPQ2d 1810, 1814 (TTAB 2014). In connection with conceptual strength, we may consider dictionary definitions "to determine the ordinary significance and meanings of words." *Hancock v. Am. Steel & Wire Co. of N. J.*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953). Thus, dictionary definitions may be used as evidence of the descriptiveness or suggestiveness or of a term. See *In re Azteca Restaurant Enters. Inc.*, 50 USPQ2d

¹⁴Although, in determining the strength of a cited mark, we may consider both its inherent strength, based on the nature of the mark itself, and commercial strength or weakness based on the marketplace, in this case there is no evidence of third-party use in the record to analyze commercial strength or weakness of HIP. See *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 ... and its marketplace strength").

1209, 1212 (TTAB 1999) (suggestiveness of Azteca established by dictionary definition and further confirmed by third-party registrations); *In re Interco Inc.*, 29 USPQ2d 2037, 2039 (TTAB 1993) (dictionary definition and newspaper excerpts established descriptiveness of “lightweight”).

To support its conceptual weakness argument, Applicant submitted dictionary definitions for “hip,” which include the following definitions: “a: having or showing awareness of or involvement in the newest developments or styles” and “b: very fashionable : TRENDY.”¹⁵

Relying on the dictionary definition, Applicant argues that “[t]he cited Registrants’ HIP marks each have diminished source identifying significance because they are highly suggestive” and that as viewed in connection with the services, “Registrants’ HIP marks imply that the services are cool and new.” 6 TTABVUE 19; 9 TTABVUE 9.

Applicant submits that

HIP is suggestive of the modern peer-to-peer method Registrant Health Information Project uses to teach the subject or the way in which it seeks to make its content cool or relevant to students. In turn, in connection with a new version of football meant to reduce head injuries, Registrant HIP Football’s mark suggests that it is a new, up-to-date game that is more with our times.

6 TTABVUE 19.

¹⁵ MERRIAM-WEBSTER DICTIONARY, November 30, 2021 Request for Reconsideration at TSDR 16 (Serial No. 90426395); January 9, 2022 Response to Office Action at TSDR 17 (Serial No. 90426435).

In response, the Examining Attorney argues that “Applicant failed to provide any evidence that show HIP and HIPE are diluted or commonly used with the services set forth in the application or registrations to make the marks ‘conceptually weak.” 8 TTABVUE 10.


We note that the cited HIP marks are inherently distinctive because they registered on the Principal Register without a claim of acquired distinctiveness. *Tea Bd. of India v. Republic of Tea, Inc.*, 80 USPQ2d 1881, 1889 (TTAB 2006) (a “mark that is registered on the Principal Register is entitled to all Section 7(b) presumptions including the presumption that the mark is distinctive and moreover, in the absence of a Section 2(f) claim in the registration, that the mark is inherently distinctive for the [services]”). We find that although the dictionary definitions do support a finding that HIP is suggestive of up-to-date training and educational services, Applicant has not shown the existence of other third-party registrations for the term, apart from the cited registrations, that could demonstrate that HIP conveys a high degree of suggestiveness. *In re Davia*, 110 USPQ2d at 1815.

2. Similarity or Dissimilarity of the Marks

We now turn to the first *DuPont* factor, the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (citing *DuPont*, 177 USPQ at 567).

Applicant’s marks HIPE FIT and HIPE FITNESS are in standard characters as are two of the cited HIP registrations, which means that the marks can be depicted in any font style, size, or color. Trademark Rule 2.52(a), 37 CFR 2.52(a). For that

reason, we must assume that the marks could be displayed in a stylization identical or similar to each other. *See Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983) (“[T]he argument concerning a difference in type style is not viable where one party asserts rights in no particular display. By presenting its mark merely in a typed drawing, a difference cannot legally be asserted by that party.”); *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1186 (TTAB 2018) (“[T]he rights associated with a standard character mark reside in the wording per se and not in any particular font style, size, or color.”) (citation omitted). Additionally, in view of

the foregoing, as to the cited stylized mark, , we must assume that Applicant's mark could be displayed in the same stylization as Registrant.

Applicant submits that its marks and the cited marks are different in appearance, sound, meaning and commercial impression, but focuses its arguments on the sound, meaning and commercial impression of its marks and the cited marks. 6 TTABVUE 14-18; 9 TTABVUE 6-8.

Applicant argues that “all [the terms in the] marks are recognized words and that there are correct pronunciations that make them aurally different in addition to visually different” as well as different in meaning and commercial impression. 6 TTABVUE 14, 15. Referencing the dictionary definitions it submitted during prosecution, Applicant submits that “HIPE is the phonetic equivalent of ‘hype,’” which is defined as “: Stimulate, Enliven” “and pronounced with a “long ‘I’ sound” (‘hīp) and that the word in the cited registrations, HIP, is a separate word that is pronounced with a “short ‘I’” sound (‘hip) which, as already indicated, is defined as

“having or showing awareness of or involvement in the newest developments.”¹⁶ 6 TTABVUE 15. Applicant argues that because HIP and HIPE (the phonetic equivalent of “hype”) “are both real words with separate dictionary definitions,” it is “likely that consumers would pronounce them differently and recognize their different meanings and commercial impressions.” 6 TTABVUE 15.

Applicant also argues that the Examining Attorney’s statement that there is no correct pronunciation of a mark “leaves out half of the relevant law” which is that “[t]here is no correct pronunciation of a trademark that is not a recognized word,” citing *StonCor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 111 USPQ2d 1649, 1651 (Fed. Cir. 2014). 9 TTABVUE 6. Applicant points out that while consumers may pronounce marks differently than intended by the trademark owner, “the Board has acknowledged that ... ‘it does not follow that any and all suggested pronunciations of a trademark must be deemed to be ‘correct’ or viable, even those which are inherently implausible and inconsistent with common phonetic usage and practice,” quoting *In re Who? Vision Sys. Inc.*, 57 USPQ2d 1211, 1218 (TTAB 2000). 9 TTABVUE 6. Applicant submits that “[i]t is extremely unlikely that the registered ‘HIP’ marks would be pronounced as ‘haip’ [a long ‘I’ sound] or that ‘HIPE’ in Applicant’s mark would be pronounced ‘HIP’ with a short ‘I’ sound.” 9 TTABVUE 6. Applicant argues:

Hip is pronounced with a short ‘I’ sound and there is no evidence that anyone would pronounce ‘HIP’ with a long ‘I’

¹⁶ November 30, 2021 Request for Reconsideration at TSDR 11, 16 (Serial No. 90426435); and January 9, 2022 Response to Office Action at TSDR 12, 17 (Serial No. 90426395).

sound. Applicant's HIPE FIT and HIPE FITNESS mark[s] use a spelling of 'hype' that makes it even more obvious that the vowel sound is a long 'I.' This is an English spelling convention—the 'E' featured directly behind a single consonant makes the 'I' a long 'I' sound. Ignoring this basic rule for the purposes of trademark comparison is illogical and mistakenly assumes the average consumer does not have basic reading skills. In addition, there is no actual evidence of record that anyone would pronounce the word 'HIP' as 'haip.' The Examining Attorney has made this conclusory statement without any support from any linguistic or pronunciation resource.

Reply, 9 TTABVUE 7.

We acknowledge that there is no way to gauge how consumers will pronounce a mark that is not a recognized word. *StonCor Grp., Inc.*, 111 USPQ2d at 1651. "Where a trademark is not a recognized word and the weight of the evidence suggests that potential consumers would pronounce the mark in a particular way, it is error for the Board to ignore this evidence entirely and supply its own pronunciation." *Id.* Therefore, absent evidence to the contrary, we must consider all reasonable possibilities based on normal English pronunciation.

The Examining Attorney argues that because the "e" is silent in "hipe," the terms "hip" and "hipe" will be pronounced similarly, they are phonetic equivalents, and they would be assigned the same meaning by consumers. 8 TTABVUE 7, 8.

However, we cannot agree with the Examining Attorney that "hipe" and "hip" are phonetic equivalents, and find these assertions unsupported in the record. In standard English pronunciation, when a vowel and single consonant are followed by an "e" in a single syllable word, the "e" is almost always silent, and the preceding vowel is long (e.g., bike). Although as stated, there is no correct pronunciation for a

term that is not a recognized word, in view of the ending silent “e,” in “hipe,” we find that it is more probable that the average consumer in the United States will pronounce “hipe” with a long “i,” rather than short “i,” as the Examining Attorney suggests (e.g., kit/kite, rip/ripe, fin/fine, hid/hide, spin/spine, fir/fire). In addition, as reflected by the dictionary definition provided by Applicant for “hype,” most one-syllable words in the English language composed of a consonant plus the letter ‘y’ (e.g., by, my, try, fly) create a word pronounced with the long “i” vowel sound. In the term “hipe” Applicant has substituted the letter “i” for the letter “y.” Therefore, we find that “hipe” in Applicant’s mark is the phonetic equivalent of “hype.”

As shown by the record, HIP and HIPE (“hype”) have different meanings. When Applicant’s HIPE FIT and HIPE FITNESS are considered in their entirety in connection with the services, we find they have different connotations and commercial impressions from the cited HIP marks. In view of the foregoing, we find that the marks of the cited registrations are not similar to Applicant’s marks because the differences in sound, meaning and commercial impressions outweigh any similarities in appearance.

The first *DuPont* factor weighs against a finding of likelihood of confusion.

II. Conclusion

Balancing all of the *DuPont* factors, we conclude that confusion is not likely. Notwithstanding the relatedness of the services and the overlap in trade channels (at least for Registration No. 5544500), we find that the marks are sufficiently dissimilar that confusion is unlikely. In this case, the dissimilarity of the marks under the first

DuPont factor simply outweighs the other *DuPont* factors in this case. See *Truescents LLC v. Ride Skin Care, L.L.C.*, 81 USPQ2d 1334, 1342 (TTAB 2006); *Kellogg Co. v. Pack'Em Enters. Inc.*, 14 USPQ2d 1545, 1550 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

Decision: The refusals to register Applicant's marks HIPE FIT and HIPE FITNESS are reversed.