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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Radnet, Inc.
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Application Serial No. 90492198
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Mark S. Bicks of Wenderoth, Lind & Ponack, L.L.P.,
for Radnet, Inc.

Amy Kertgate, Trademark Examining Attorney, Law Office 113,
Myriah Habeeb, Managing Attorney.

—
Before Cataldo, Bergsman, and Hudis,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Radnet, Inc. (“Applicant”) seeks registration on the Principal Register of the mark YOUR BODY (in standard characters) for “downloadable podcasts in the field of medical health by medical doctors and others experienced in the relevant medical topics discussed,” in International Class 9.¹

¹ Application Serial No. 90492198 was filed on January 27, 2021, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1052(a), based upon Applicant’s claim of first use anywhere and use in commerce since at least as early as November 18, 2020.

The Examining Attorney refused to register Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles the registered mark YOURBODY.COM, in typed drawing form, for "providing information and advice on aerobics and general health issues through electronic media," in International Class 41, as to be likely to cause confusion.² In addition, the Examining Attorney refused to register Applicant's mark based on the final requirement that Applicant disclaim the exclusive right to use the word "Body" apart from the mark as shown. Section 6(a) of the Trademark Act, 15 U.S.C. § 1056(a).

Citations to the prosecution history refer to the USPTO Trademark Status and Document Retrieval (TSDR) system in the downloadable .pdf format. Citations to the briefs refer to TTABVUE, the Board's online docket system. Before the TTABVUE designation is the docket entry number; and after this designation are the page references, if applicable.

I. Likelihood of Confusion

Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), prohibits the registration of a mark that:

[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

² Registration No. 2791680 registered December 9, 2003; renewed.

A typed mark is the legal equivalent of a standard character mark. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012) ("until 203, 'standard character' marks formerly were known as 'typed' marks.").

We base our determination under Section 2(d) on an analysis of all of the probative 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, 567 (CCPA 1973) (setting forth factors to be considered, referred to as “*DuPont* factors”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). “Whether a likelihood of confusion exists between an applicant’s mark and a previously registered mark is determined on a case-by-case basis, aided by application of the thirteen *DuPont* factors.” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1689 (Fed. Cir. 2018). “In discharging this duty, the thirteen *DuPont* factors ‘must be considered’ ‘when [they] are of record.’” *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997) and *DuPont*, 177 USPQ at 567). “Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances. Any single factor may control a particular case.” *Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, at *3 (Fed. Cir. 2020) (citing *Dixie Rests.*, 41 USPQ2d at 1533).

“Each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973). “Two key factors in every Section 2(d) case are the first two factors regarding the similarity or dissimilarity of the marks and the goods or services, because 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.” *In re Embiid*, 2021 USPQ2d 577, at *10 (TTAB 2021) (quoting *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)). *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 *DuPont* 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)); *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004).

A. Strength of the registered mark.

When we analyze likelihood of confusion in an *ex parte* appeal, in order to determine the conceptual or inherent strength of the cited mark, we evaluate its intrinsic nature, that is, where it lies along the generic-descriptive-suggestive-arbitrary-fanciful continuum of words. Word marks that are arbitrary, fanciful, or suggestive are “held to be inherently distinctive.” *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1068 (2000). *See also, In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1684 (Fed. Cir. 2010) (“In general, trademarks are assessed according to a scale formulated by Judge Friendly in *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759 (2d Cir. 1976), which evaluates whether word marks are ‘arbitrary’ or ‘fanciful,’ ‘suggestive,’ ‘descriptive,’ or ‘generic.’”). We also look to evidence pertaining to the number and

nature of similar marks in use on similar goods or services, under the sixth *DuPont* factor.

When Registrant uses the mark YOURBODY.COM in connection with “providing information and advice on aerobics and general health issues through electronic media,” YOURBODY.COM is suggestive because it brings to mind the subject matter of the information or advice (i.e., the listener’s body).

Rather than submit evidence of actual third-party uses of similar marks for similar goods or services, Applicant submitted copies of third-party registrations to support its argument that YOURBODY.COM is diluted and entitled to only a narrow scope of protection. Third-party registrations may be used to show the sense in which a word is used in ordinary parlance. *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015). Applicant submitted copies of the registrations listed below:³

Mark	Reg. No.	Goods/Services
YOUR BODY WILL THANK YOU FOR IT	5270912	Providing fitness training in the field of Pilates and Bodhi suspension ropes
YOUR BODY ON POINT	4714032	Providing a website featuring information on exercise and fitness
YOUR BODY PILATES	6457455	Providing on-line classes and on-line non-downloadable videos in the field of Pilates
YOUR BODY – YOUR WAY	5247024	Consulting services in the fields of fitness and exercise; personal coaching in the field of physical fitness and exercise
YOUR BODY IS POWER	4767563	Athletic training services; personal trainer services; physical fitness instruction; providing classes, workshops, seminars

³ September 27, 2021 Response to Office Action (TSDR 7-26).

None of the registrations include a disclaimer of the exclusive right to use the word “body” or the term “Your Body.”

Mark	Reg. No.	Goods/Services
		and camps in the fields of fitness and exercise
MIND YOUR BODY	4068584	Entertainment in the nature of an on-going special variety, news, music or comedy show featuring physical and mental health broadcast over television, satellite, audio and video media; providing a website featuring blogs and non-downloadable publications in the nature of articles in the field of physical and mental health
KNOW YOUR BODY	4958515	Continuing programs featuring health news and guidance in the field of maintaining a healthy daily diet, physical fitness and mental health delivered by television, radio, satellite and the Internet
LEARN YOUR BODY	6396038	Conducting live and virtual classes, seminars, conferences, and workshops in the fields of improving personal health, nutrition, and wellness
LIVE BETTER IN YOUR BODY	5712894	Mind/body fitness program, namely, yoga instruction focusing on assessment and improvement of range of motion, strength, flexibility, breath work, relaxation and meditation techniques Providing nonloadable videos featuring the same
FUTUREPROOF YOUR BODY		Conducting courses in physical therapy, myotherapy and anatomy; personal fitness training; training in the field of physical health education and general health and well-being exercise.

The third-party registrations corroborate our finding that the term “Your Body” is suggestive when used in connection with “providing information and advice on aerobics and general health issues through electronic media.” However, we would be remiss if we did not mention that Applicant’s mark YOUR BODY is closer to the registered mark YOURBODY.COM than any of the other marks in the third-party

registrations listed above so that the relevance of the third-party registrations is reduced in our likelihood of confusion analysis.

B. The similarity or dissimilarity of the marks.

We now turn to the *DuPont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019); *accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted).

In comparing the marks, we are mindful that “[t]he 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) (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)).

We keep in mind that “[s]imilarity is not a binary factor but is a matter of degree.” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014)

(quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1062 (Fed. Cir. 2003)).

Applicant is seeking to register the mark YOUR BODY. The mark in the cited registration is YOURBODY.COM. We start our analysis of the similarity or dissimilarities of the marks by noting that although the registered mark is presented without spaces between the words, consumers are likely to view and verbalize it as YOUR BODY [dot] COM, based on normal English pronunciation. Thus, the presence or absence of spaces between the words is an inconsequential difference that even if noticed or remembered by consumers would not serve to distinguish these marks. *In re Iolo Technologies, LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010) (finding ACTIVECARE and ACTIVE CARE confusingly similar); *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1025 (TTAB 2009) (finding that petitioner's mark DESIGNED2SELL is phonetically identical to respondent's mark DESIGNED TO SELL because the "marks are also highly similar visually, with the sole differences being the substitution in respondent's mark of the short preposition 'to' for the number '2' between the two dominant words, and the use of spaces between them" and because "the spaces that respondent places between the words do not create a distinct commercial impression from petitioner's presentation of his mark as one word."); *Seaguard Corp. v. Seaward Int'l, Inc.*, 223 USPQ2d 48, 51 (TTAB 1984) (SEAGUARD and SEAGUARD are "essentially identical"); *In re Best Western Family Steak House, Inc.*, 222 USPQ 827, 827 (TTAB 1984) ("there can be little doubt that the marks [BEEFMASTER for restaurant services and BEEF MASTER for

frankfurters and bologna] are practically identical and indeed applicant has not argued otherwise.”); *Stock Pot, Inc. v. Stockpot Rest., Inc.*, 220 USPQ 52, 54 (TTAB 1983), *aff’d* 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984) (“There is no question that the marks of the parties [STOCKPOT AND STOCK POT] are confusingly similar. The word marks are phonetically identical and visually almost identical.”). In today’s online culture, consumers will recognize YOURBODY.COM as a url or domain name. URLs or domain names do not have spaces between the terms.

MERRIAM-WEBSTER DICTIONARY (merriam-webster.com) (accessed July 21, 2022) defines “domain name” as “a sequence of usually alphanumeric characters (such as Merriam-Webster.com) that specifies a group of online resources (as of a particular company or person) and that forms part of the corresponding Internet addresses.”⁴ Similarly, it defines “url” as “the address of a resource (such as a document or website) on the Internet that consists of a communications protocol followed by the name or address of a computer on the network and that often includes additional locating information (such as directory and file names). Our site’s URL is <http://www.Merriam-Webster.com>.”

Consumers perceive YOURBODY.COM as a commercial website. The “.COM” portion of Registrant’s mark YOURBODY.COM is part of an Internet address, not a source identifying part of the mark. *See In re 1800Mattress.com IP LLC*, 586 F.3d

⁴ The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *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 S. Malhotra & Co. AG*, 128 USPQ2d 1100, 1104 n.9 (TTAB 2018); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

1359, 92 USPQ2d 1682 (Fed. Cir. 2009) (MATTRESS.COM generic for “online retail store services in the field of mattresses, beds, and bedding”); *In re Hotels.com, L.P.*, 573 F.3d 1300, 91 USPQ2d 1532 (Fed. Cir. 2009) (HOTELS.COM generic for “providing information for others about temporary lodging; travel agency services, namely, making reservations and bookings for temporary lodging for others by means of telephone and the global computer network”); *In re Reed Elsevier Props. Inc.*, 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007) (LAWYERS.COM generic for “providing access to an online interactive database featuring information exchange in the fields of law, lawyers, legal news, and legal services”); *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004) (PATENTS.COM merely descriptive of “computer software for managing a database of records and for tracking the status of the records by means of the Internet”).

Nevertheless, the Court of Appeals for the Federal Circuit has cautioned that in rare, exceptional circumstances, a term that is not distinctive by itself may acquire some additional meaning from the addition of a top level domain name such as “.com” or “.net.” *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005) (STEELBUILDING.COM highly descriptive, but not generic, for "computerized on-line retail services in the field of pre-engineered metal buildings and roofing systems," noting that “the addition of the TLD can show Internet-related distinctiveness, intimating some ‘Internet feature’ of the item.”) (citing *Oppedahl & Larson*, 373 F.3d at 1175-1176, 71 USPQ2d at 1373). That situation does not exist in the record before us. Applicant offers no evidence as to how the addition of the top

level domain “.COM” differentiates the marks and Applicant offers little in the way of argument except the boilerplate that the marks must be considered in their entirety and Registrant’s mark does not have any spaces between terms.

Indeed, we are mindful that, because the similarity or dissimilarity of the marks is determined based on the marks in their entirety, our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Considering the marks in their entirety, including the spaces between “Your” and “Body” in Applicant’s mark and the addition of “.COM” in Registrant’s mark, we find Applicant’s mark YOUR BODY is essentially identical to Registrant’s mark YOURBODY.COM.

Applicant argues, to the contrary, that the Supreme Court in *USPTO v. Booking.com*, 591 US ___, 140 S. Ct. 2298, 2020 USPQ2d 10729, at *6 (2020), held that a designation including “.com” may “convey to consumers a source-identifying characteristic: an association with a particular website.” All this means is that “Generic.com,” when considered in its entirety, may not be a generic term. Specifically, the Court explained,

Thus, if “Booking.com” were generic, we might expect consumers to understand Travelocity—another such service—to be a “Booking.com.” We might similarly expect that a consumer, searching for a trusted source of online hotel-reservation services, could ask a frequent traveler to name her favorite “Booking.com” provider.

Id. at *5.

Applicant submits no evidence and advances no argument as to how the peripheral differences between YOUR BODY and YOURBODY.COM differentiate the marks. *In re Denisi*, 225 USPQ 624, 624 (TTAB 1985) (“[I]f the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral differences.”).

We find the marks are very similar and that this *DuPont* factor favors a finding there is a likelihood of confusion.

C. The similarity or dissimilarity and nature of the goods and services.

Applicant is seeking to register its mark YOUR BODY for “downloadable podcasts in the field of medical health by medical doctors and others experienced in the relevant medical topics discussed.” The mark in the cited registration YOURBODY.COM is for “providing information and advice on aerobics and general health issues through electronic media.” The goods and services are legally identical in part inasmuch as both Applicant and Registrant are providing health care information to others. Applicant is providing medical health information via podcasts and Registrant is providing information on general health through electronic media.⁵

MERRIAM-WEBSTER DICTIONARY (merriam-webster.com) (accessed July 21, 2022) defines “Podcast” as “a program (as of music or talk) made available in digital format

⁵ Under this *DuPont* factor, the Examining Attorney need not prove, and we need not find, similarity as to each product or activity listed in the descriptions of goods and services. It is sufficient for a refusal based on likelihood of confusion that we find any item encompassed by the identification of goods or services in a particular class in the application and registration related. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1409 (TTAB 2015), *aff’d* 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017).

for automatic download over the Internet.” A podcast downloaded over the Internet is a form of electronic media. Thus, Applicant and Registrant are providing their information in the field of health through the same media.

The fact that Applicant’s downloadable podcasts are placed in International Class 9 and Registrant’s information through electronic media is placed in International Class 41 is a quirk of the classification system. For example, Applicant’s downloadable podcasts are in International Class 9 because “[c]omputer programs and computer software are goods classified in International Class 9 if they are recorded on media or are downloadable and thus can be transferred or copied from a remote computer system for use on a long-term basis.” TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1402.03(d) (2022). On the other hand, Registrant’s “providing information and advice on aerobics and general health issues through electronic media” services are in International Class 41 because services providing information or consultation are classified in the same classes that correspond to the subject matter of the advice or information. TMEP § 1402.11(b). Classification does not extend or limit an applicant’s or registrant’s rights. Section 30 of the Trademark Act, 15 U.S.C. § 1112 (“The Director may establish a classification of goods and services, for convenience of Patent and Trademark Office administration, but not to limit or extend the applicant’s or registrant’s rights.”).

In sum, the goods and services at issue are legally identical in part; they differ only in manner in which Applicant and Registrant have identified them.

Applicant contends the goods and services are different and unrelated because Applicant limited its podcasts to medical doctors and others experienced in the relevant medical topics; that is, there is a distinction between the medical information provided by medical professionals compared to general health services.⁶ We disagree.

First, has been often said, we must consider the goods [and services] as they are described in the application and registration. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys, Inc. v. Houston Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.”); *Paula Payne Prods. v. Johnson Publ’g Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) (“Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods”). As discussed above, Applicant’s goods and Registrant’s services both involve disseminating health information.

Second, Registrant’s “providing information and advice ... general health issues” through electronic media is broad enough to encompass Applicant’s “downloadable podcasts in the field of medical health by medical doctors.” Where goods and services

⁶ Applicant’s Brief, pp. 5-6 (4 TTABVUE 9-10).

are broadly identified in an application or registration, “we must presume that the services encompass all services of the type identified.” *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015) (where the services in an application or registration are broadly described, they are deemed to encompass all the activities of the nature and type described therein), *quoted in In re Country Oven, Inc.*, 2019 USPQ2d 443903, * 4 (TTAB 2019) and *cited in In re AC Webconnecting Holding B.V.*, 2020 USPQ2d 11048, *11-12 (TTAB 2020).

We find Applicant’s goods are legally identical in part to Registrant’s services.

D. Established, likely-to-continue channels of trade and classes of consumers.

Because the goods and services described in the application and the cited registration are in part legally identical, we presume that the channels of trade and classes of purchasers are the same. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (identical goods are presumed to travel in same channels of trade to same class of purchasers) (cited in *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (“With respect to similarity of the established trade channels through which the goods reach customers, the TTAB properly followed our case law and ‘presume[d] that the identical goods move in the same channels of trade and are available to the same classes of customers for such goods....”); *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); *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1745 (TTAB 2018), *aff’d mem.* (No. 18-2236) (Fed. Cir. September 13, 2019)

“Because the services described in the application and the cited registration are identical, we presume that the channels of trade and classes of purchasers are the same.”).

E. Conclusion

Because the marks are very similar, the goods and services are in part legally identical, and we presume the goods and services are offered in the same channels of trade to the same classes of consumers, we find that Applicant’s mark YOUR BODY for “downloadable podcasts in the field of medical health by medical doctors and others experienced in the relevant medical topics discussed” is likely to cause confusion with the registered mark YOURBODY.COM for “providing information and advice on aerobics and general health issues through electronic media.”

II. The disclaimer requirement

An examining attorney may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. Trademark Act Section 6(a), 15 U.S.C. § 1056(a) (“The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable.”). Merely descriptive terms are unregistrable, under Trademark Act Section 2(e)(1), 15 U.S.C. § 1051(e)(1), and, therefore, are subject to disclaimer if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is grounds for refusal of registration. *See In re Omaha Nat’l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987) (“FirsTier” for banking services is merely descriptive and unregistrable without a disclaimer of the exclusive right to use the term “First Tier”); *In re Richardson Ink Co.*, 511 F.2d 559,

185 USPQ 46, 47 (CCPA 1975) (“[I]t follows that if the words SOLID STATE [in the mark RICO SOLID STATE], which it appears appellant has declined to disclaim, are descriptive of appellant’s goods within the prohibition of *section 2(e)(1)*, then the Commissioner did not err in conditionally refusing registration.”); *In re Ginc UK Ltd.*, 90 USPQ2d 1472 (TTAB 2007) (ZOGGS TOGGS for clothing is unregistrable without a disclaimer of the exclusive right to use the word “Toggs”); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1954 (TTAB 2006).

Here, the Examining Attorney required Applicant to disclaim the exclusive right to use the word “Body” because when used in connection with Applicant’s podcasts in the field of medical health, it describes “a feature of the goods and is therefore an unregistrable component of the mark.”⁷ In support of the requirement for Applicant to disclaim the exclusive right to use the word “Body,” the Examining Attorney cites the COLLINS DICTIONARY (collinsdictionary.com/dictionary/english/body) defining body as “[y]our body is all your physical parts, including your head, arms, and legs.”⁸ The Examining Attorney also refers to Applicant’s website (yourbodyshow.com) which states that “Your Body takes a deep dive inside your body, giving you a complete understanding of your health and wellness through conversations with Subspecialty Radiologists, Researchers and Physicians.”⁹

⁷ Examining Attorney’s Brief (7 TTABVUE 20).

⁸ August 24, 2021 Office Action (TSDR 10). *See also* Lexico.com defining “Body” as “the physical structure of a person or an animal, including the bones, flesh, and organs” attached to the December 6, 2021 Office Action (TSDR 76).

⁹ December 6, 2021 Office Action (TSDR 84).

Rather than a feature of the podcasts, “Your Body” is the subject matter of the podcasts. However, the Examining Attorney did not find the entire mark merely descriptive; the Examining Attorney only claimed the word “Body” is descriptive. Thus, the requirement for a disclaimer.

We find the mark YOUR BODY is a unitary term and, therefore, does not require a disclaimer. *See* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1213.05 (2022) (“If the matter that comprises the mark or relevant portion of the mark is unitary, no disclaimer of an element, whether descriptive, generic or otherwise, is required.”).

As explained by the Federal Circuit in *Dena Corp. v. Belvedere Int’l, Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991), a mark that is unitary

has certain observable characteristics. Specifically, its elements are inseparable. In a unitary mark, these observable characteristics must combine to show that the mark has a distinct meaning of its own independent of the meaning of its constituent elements. In other words, a unitary mark must create a single and distinct commercial impression. This test for unitariness requires the Board to determine “how the average purchaser would encounter the mark under normal marketing of such goods and also...what the reaction of the average purchaser would be to this display of the mark.” [*In re*] *Magic Muffler [Servs., Inc.]*, 184 USPQ [125] at 126 [(TTAB 1974)].

In *Magic Muffler*, 184 USPQ at 126, the Board explained that we use Applicant’s specimen to gauge the reaction of the average purchaser to the display of the mark.

It is apparent that, in order to determine whether what applicant seeks to register constitutes a single composite or unitary mark, one must look to the specimens filed with an application because they show the mark as used on or in connection with the goods and therefore how the average purchaser would encounter the mark under normal

marketing of such goods and also suggest what the reaction of the average purchaser would be to this display of the mark.

Turning to a consideration of how Applicant displays its mark, we reproduce below Applicant's specimen of use filed with its application.



The word "Your" refers to one or oneself as a possessor, in this case a possessor of one's body. Applicant's listeners will perceive YOUR BODY as referring to one's own body; that is, a single and distinct commercial impression separate and apart from its components. The term YOUR BODY is so merged together that the terms are not separable; rather, they are unitary.

We reverse the requirement that Applicant disclaim the exclusive right to use the word "Body" apart from the mark as shown.

Decision: We affirm the Section 2(d) refusal to register Applicant's mark YOUR BODY.

We reverse the requirement that Applicant disclaim the exclusive right to use the word "Body" apart from the mark as shown.