To:	DAVID W. SAR(dsar@brookspierce.com)
Subject:	U.S. Trademark Application Serial No. 90599769 - NOBSACTIVE - Examiner Brief
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Attachments

United States Patent and Trademark Office (USPTO)

U.S. Application Serial No. 90599769

Mark: NOBSACTIVE

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Reference/Docket No. N/A

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EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the trademark Examining Attorney's final refusal to register the trademark "NOBSACTIVE" because of a likelihood of confusion with U.S. Registrations Nos. 6494828, 6300305, 6151637, 5300371. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 et seq.

6494828 V® NO BS WOMEN

6300305 V® NO BS WEIGHTLOSS PROGRAM

6151637 V® NOBS WELLNESS PODCAST

5300371 t® NO B.S., JUST YOGA

The examining attorney after thoughtful reflection and careful consideration of the record and applicant's responses, has determined that U.S. Registrations Nos. 6151637 and 5300371 are no longer a bar to registration under Section 2(d), and the citation of those registrations is herein withdrawn. Thus, the appeal brief will only address the Section 2(d) Refusal as to U.S. Registrations Nos. 6494828 NO BS WOMEN and 6300305 NO BS WEIGHTLOSS PROGRAM, both owned by Phit-N-Phat Personal Training, LLC with respect to applicant's Class 041 services.

FACTS

Applicant filed a trademark application on March 24, 2021 for the mark NOBSACTIVE in classes 021, 025, 027, 028, and 041. An Office Action issued November 8, 2021 refusing registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because of a likelihood of confusion with U.S. Registrations No. 6494828, 6300305, 6151637, 5300371, along with an advisory for pending U.S. Application Serial No. 88576311.

Applicant responded to the Office Action on May 4, 2022, arguing against the similarity of the marks and the relatedness of the goods/services in the Section 2(d) Refusals, and amending the Class 041 services to exclude yoga instruction.

A Final Office Action was issued on June 8, 2022 accepting the amended identification of Class 041, advising that prior pending U.S. Application Serial No. 88576311 had abandoned, and maintaining the Section 2(d) Refusals but limiting the refusals to classes 027 and 041 in the application.

On June 29, 2022, applicant filed a Request to Divide, requesting division of the application such that one portion (the parent) would include all identified goods and services in classes 27 and 41, and then the other portion (the child) would include all identified goods in classes 21, 25 and 28. The Request to Divide was processed and completed August 15, 2022.

Applicant submitted a Request for Reconsideration on November 23, 2022, again arguing against

the similarity of the marks and the relatedness of the goods/services in the Section 2(d) Refusals, and noting certain prior registrations owned by applicant.

On January 30, 2023, this august Examining Attorney denied the Request for Reconsideration, and the Section 2(d) Refusal was maintained and continued to be final. Applicant timely appealed and its brief was forwarded to the Examining Attorney on March 31, 2023.

ISSUE

THE SOLE ISSUE ON APPEAL IS WHETHER THE APPLICANT'S MARK "NOBSACTIVE" IS LIKELY TO BE CONFUSED WITH THE REGISTRANT'S "NO BS WOMEN" and "NO BS WEIGHTLOSS PROGRAM" MARKS

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties. See 15 U.S.C. §1052(d). Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the "du Pont factors"). Only those factors that are "relevant and of record" need be considered. *M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 1382, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006).

In ex parte examination, the issue of likelihood of confusion typically revolves around the similarity or dissimilarity of the marks and the relatedness of the goods or services. The other factors listed in du Pont may be considered only if relevant evidence is contained in the record. TMEP §§1207.01; See *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003). In this case, the following factors are the most relevant based on the relevant evidence contained in the record: similarity of the marks, similarity of the goods, and similarity of trade channels of the goods. See *In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); TMEP §§1207.01 et seq. Any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); see *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002).

ARGUMENTS

I. APPLICANT'S MARK "NOBSACTIVE" IS LIKELY TO CAUSE CONFUSION WITH REGISTRANT'S MARKS "NO BS" FORMATIVE MARKS BECAUSE THE MARKS IMPART A HIGHLY SIMILAR OVERALL COMMERCIAL IMPRESSION

When comparing marks, "[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 [consumers] who encounter the marks would be likely to assume a connection between the parties." *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1373, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018); TMEP §1207.01(b). Marks may be confusingly similar in appearance where similar terms or phrases or similar parts of terms or phrases appear in the compared marks and create a similar overall commercial impression. *See Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1495, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987); TMEP §1207.01(b)(ii)-(iii).

Consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). Where the goods and/or services of an applicant and registrant are "similar in kind and/or closely related," as they are here, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse goods and/or services. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); TMEP §1207.01(b).

Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018); TMEP §1207.01(b)(viii), (c)(ii). Matter that is descriptive

of or generic for a party's goods and/or services is typically less significant or less dominant in relation to other wording in a mark. See *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd*., 115 USPQ2d 1816, 1824-25 (TTAB 2015).

Here, the marks begin with the essentially identical wording "NOBS" and "NO BS". The additional wording in the registered marks is descriptive/generic and appropriately disclaimed in their registrations, and is accordingly less significant in the marks. The additional wording "active" (requiring vigorous action or exertion) in applicant's mark is also descriptive in relation to the services because it describes that vigorous action or exertion is involved in physical fitness and weight loss, and thus also is less significant. See the previously attached definitions in the November 9, 2021 Office Action, TSDR p. 16.

Applicant argues that other registered marks show that "'NOBS' / 'NO BS' is not the dominant element in the marks". This argument is not persuasive. All of the "NO BS" marks referenced by applicant are consistent in treating "NO BS" as the dominant and distinctive source indicating portion of the mark. If applicant's argument is charitably viewed as an attempt to argue "weakness" of the term, applicant would also be incorrect. The marks referenced by applicant are used in connection with cookies, food bars, business services, sales promotion, yoga instruction, wellness podcasts, and marketing newsletters. The only marks that exist in the area of education services in the field of nutrition and health are the marks at issue here.

Although applicant argues that the NOBS in their mark stands for No Body Shame, there is nothing in the mark itself making that distinction self evident. The marks are compared as they appear in the drawing of the application and in the registration; the USPTO does not consider how an applicant and registrant actually use their marks in the marketplace. *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1186 (TTAB 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1324, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)).

In this case, neither applicant's nor registrant's marks contain additional wording explaining any meaning behind their respective NO BS formative marks. Thus, the consumer is left to compare marks

that begin with an essentially identical phrase, and there is no other distinctive wording to differentiate the marks.

Finally, because the dominant word portions of the marks are essentially identical in appearance, sound, connotation, and commercial impression, the addition of a design element in U.S. registration 6300305 does not obviate the similarity of the marks in this case. *See In re Shell Oil Co.*, 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993); TMEP §1207.01(c)(ii).

In summary, the marks have a highly similar commercial impression because the essentially identical wording "NOBS" and "NO BS" appears first in the marks, where consumers are inclined to focus on the similarity. The additional wording in the registered marks is less significant because it is descriptive or generic and appropriately disclaimed in the registrations. The additional wording in Applicant's mark is also descriptive in relation to the goods/services, and would have required a disclaimer if the words had been separated, and thus is also less significant in the comparison of marks. And because the marks are compared as they appear in the drawing of the application and in the registrations, any differences in how the marks may actually be used in the marketplace are not considered. Thus, the consumer is likely to confuse essentially identical marks beginning with "NOBS" and "NO BS" and there is no other wording that significantly differentiates the marks.

II. APPLICANT'S AND REGISTRANT'S GOODS AND SERVICES ARE CLOSELY RELATED BECAUSE THEY ARE SIMILAR IN KIND AND ARE ENCOUNTERED IN THE SAME COMMERCIAL TRADE CHANNELS

The compared goods and/or services need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000). They need only be "related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

Determining likelihood of confusion is based on the description of the goods and/or services stated in the application and registration at issue, not on evidence of actual use. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

Applicant's services include:

> 041: Educational services, namely, providing on-line and streamed classes and videos in the field of physical fitness, nutrition and health, not including yoga instruction; Educational services, namely, providing online instruction in the field of physical fitness, nutrition and health via an online website, not including yoga instruction

Registrant's goods and/or services include:

> 009: Downloadable educational course materials in the field of weight loss, weight control, nutrition, health and lifestyle wellness.
>
> 041: Education services, namely, providing live and on-line seminars, retreats, interactive courses and classes, ecourses, coaching, conferences, workshops, and webinars in the field of weight loss, weight control, nutrition, health and lifestyle wellness; Entertainment services, namely, providing podcasts in the field of weight loss, weight control, nutrition, health and lifestyle wellness; Providing online newsletters in the field of weight loss, weight control, nutrition, health and lifestyle wellness via e-mail; Providing a website featuring blogs and non-downloadable publications in the nature of articles and advice columns in the field(s) of weight loss, weight control, nutrition, health and lifestyle wellness

The respective services are highly related because both parties offer education in the form of content and classes in the field of nutrition and health specifically, and registrant's health and lifestyle wellness is broad enough to include applicant's physical fitness. Further, registrant's weight loss and weight control would logically seem to be related to applicant's physical fitness, nutrition and health.

Applicant argues "there have been no instances of actual confusion between the Cited Marks on one hand, and Applicant's prior registrations or the Applied-For Mark on the other hand." However, "'[A] showing of actual confusion is not necessary to establish a likelihood of confusion.'" *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); TMEP §1207.01(d)(ii). "[T]he relevant test is likelihood of confusion, not actual confusion." *In re Detroit Athletic Co.*, 903 F.3d 1297, 1309, 128 USPQ2d 1047, 1053 (Fed. Cir. 2018) (emphasis in original). "Uncorroborated statements of no known instances of actual confusion . . . are of little evidentiary value," especially in ex parte examination. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1317, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003).

Applicant argues that their prior registrations have peacefully co-existed with the cited marks. However, any peaceful coexistence of the marks is likely due to differences in the services in applicant's prior registrations and the cited registrations, which are apparently not related enough to sow consumer confusion. Applicant's prior relevant registrations are for "Promoting public interest and awareness of the importance of respecting people of all body types and of self-affirmation regarding one's own body" and "motivational speaking services" in the narrow fields of "positive self-esteem regarding one's body and respecting others regardless of their appearances" and "positive self-esteem despite one's obesity and respecting people who are obese". These services in applicant's prior registrations are significantly different from the services in the cited registrations, and have a much narrower focus with respect to the content and field. In contrast, the current application is for education services in the much broader fields of "physical fitness, nutrition and health", which are highly related to the fields and content of registrant's education goods and services.

The compared goods and services need only be related in some manner and need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000) and *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012). Accordingly, the Examining Attorney properly found the goods and services to be related because they are of a similar kind and

provided in the same field, with both applicant and registrant offering education in the form of content and classes in the field of nutrition and health. The content of the goods and services also overlap, with registrant's health and lifestyle wellness being broad enough to include applicant's physical fitness, and applicant's nutrition and health being broad enough to include registrant's weight loss and weight control. Because of this relatedness, the goods and services would have similar audiences, and would be encountered by the same purchasers in the same trade channels under circumstances that would give rise to the mistaken belief that the goods and services come from a common source.

III. CONCLUSION

Given the similarity between the respective marks, the relatedness of the goods and services, and the similarity between the channels of trade for these goods and services, it is likely that consumers will be confused as to the ultimate source of these goods and services and associate the registered mark with the applicant's proposed mark. Accordingly, the refusal to register under Trademark Act Section 2(d) is proper and should be affirmed.

Respectfully submitted,

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USPTO OFFICIAL NOTICE

Examining attorney's appeal brief has issued
on August 10, 2023 for
U.S. Trademark Application Serial No. 90599769

A USPTO examining attorney has issued an appeal brief. Follow the steps below.

(1) Read the appeal brief. This email is NOT the appeal brief.

(2) Submit reply brief within 20 days of August 10, 2023 , if you wish to do so. If submitted, a reply brief must be submitted using the Electronic System for Trademark Trials and Appeals (ESTTA) and received by the USPTO on or before 11:59 p.m. **Eastern Time** of the last day of the reply period.

(3) Direct questions about the appeal proceeding to the Trademark Trial and Appeal Board at 571-272-8500 or TTABInfo@uspto.gov.