

This Opinion is Not a
Precedent of the TTAB

Mailed: February 1, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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ICON Health & Fitness, Inc.

v.

Procheer Fitness and Dance

—
Opposition No. 91230219

—
Gregory M. Hess and LaShel Shaw of Parr Brown Gee & Loveless, for ICON Health
& Fitness, Inc.

Elizabeth Pritchett Dixon (pro se),
for Procheer Fitness and Dance.

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Before Zervas, Shaw and Greenbaum,
Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Procheer Fitness and Dance (“Applicant”) seeks to register the combined word and design mark depicted below for “providing fitness instruction services in the field of dance, and physical fitness” in International Class 41 on the Principal Register:¹

¹ Application No. 86903208, filed on February 10, 2016 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming first use on January 1, 2015 and first use in commerce on June 1, 2015.



The mark is described as:

[C]onsist[ing] of the words “THE OFFICIAL” in small letters capitalized above the large word “SEX” which is part of a longer word “SEXIFIT”. The letter “T” is represented by a slim dumbbell. The entire word is capitalized though the “SEX” is in thicker 3 dimensional font and the “Fit” is in thinner font. There is a silhouette of a woman standing next to the “T”.

ICON Health & Fitness, Inc. (“Opposer”) opposed registration of Applicant’s mark claiming likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), with the following typed and standard character marks² for the identified goods and services:³

Mark	Registration No.	Goods/Services	Int’l Class
IFIT.COM	2466474 ⁴	“providing information and consultation services in the field of exercise equipment and personal health, fitness and nutrition by means of a global computer network”	42

² A typed mark is the legal equivalent of a standard character mark. *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017); TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) § 807.03(i) (Oct. 2018).

³ Opposer also pleaded dilution by blurring and by tarnishment under Trademark Act Section 43(c), 15 U.S.C. §1125, but did not discuss these claims in its brief. Opposer has thus waived its Section 43(c) claims. *Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1753 (TTAB 2013) (petitioner found to have waived claims not argued before the Board).

⁴ Registered July 3, 2001. Renewed.

Mark	Registration No.	Goods/Services	Int'l Class
IFIT	2618509 ⁵	“fitness and exercise machines” and “educational services, namely, conducting personal training in the field of health and fitness”	28, 41
iFIT	4450213 ⁶	“Personal fitness training services and consultancy; Physical fitness instruction; Physical fitness training services; Providing an on-line computer database featuring information regarding exercise and fitness; Providing information in the field of exercise training”	41
IFIT	4604633 ⁷	“Web-based, downloadable software for the collection, storage and display of personal performance data from various fitness activities, display of nutritional information and fitness and athletic programs and workouts, software for tracking, monitoring and planning fitness training activities”	9
IFIT	4500591 ⁸	“An application service provider (ASP) featuring software for use with mobile devices, tablet, and computers for tracking, storing, and displaying personal performance data for various fitness activities; ASP featuring application programming interface (API) software for connecting and interacting with software applications on mobile devices, tablets, and computers to track, store, and display personal performance data for various fitness activities”	42
iFIT	5530425 ⁹	“Pedometers; altimeters; scales; multifunctional electronic devices for displaying, measuring, and uploading to the Internet and computer networks information including time, date, heart rate, global positioning, direction, distance, altitude, speed,	9

⁵ Registered September 10, 2002. Renewed.

⁶ Registered December 17, 2013, Section 8 and 15 Declaration received.

⁷ Registered September 16, 2014.

⁸ Registered March 25, 2014.

⁹ Registered July 31, 2018.

Mark	Registration No.	Goods/Services	Int'l Class
		steps taken, calories burned, navigational information, weather information, temperature, wind speed, changes in heart rate, activity level, hours slept, and quality of sleep; computer software for wireless data communication for receiving, processing, transmitting and displaying information relating to fitness, body fat, body mass index, and heart rate; Electronic monitoring devices incorporating microprocessors, digital display, and accelerometers, for detecting, storing, reporting, monitoring, uploading and downloading sport, fitness training, and activity data to the Internet, and communication with personal computers, regarding time, steps taken, calories burned, distance; computer software and computer application software for mobile phones and personal digital devices that provides tips, coaching, and personalized workouts, to improve the user's fitness level”	

Applicant, in its Answer, admitted that “according to USPTO records, Opposer is identified as the owner of” U.S. Registration Nos. 4604633, 4500591, 4450213 and 2466474,¹⁰ and denied the remaining salient allegations of the Notice of Opposition. Applicant raised several affirmative defenses in its answer; these affirmative defenses are waived because Applicant did not file a brief. *See Swiss Watch Int’l Inc. v. Fed’n of the Swiss Watch Indus.*, 101 USPQ2d 1731, 1734 n.4 (TTAB 2012) (affirmative defenses deemed waived where no mention of them in trial brief); *Barbara’s Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1292 (TTAB 2007) (where

¹⁰ 5 TTABVUE 3.

applicant did not argue the affirmative defense of equitable estoppel in her brief, the affirmative defense was given no consideration).

I. The Trial Record

In addition to the pleadings, the trial record automatically includes the involved application file pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b). The trial record also includes:

1. Declaration of David Chase Watterson, IFIT Director of Marketing, including Exhibits 1-8, 14 and 15 TTABVUE;
2. Declaration of Colleen Logan, Opposer's Vice-President of Marketing, including Exhibits 1-73, 16 - 21 TTABVUE;
3. Declaration of David Hays, Produce Manager of Free Motion Fitness, Inc., a wholly-owned subsidiary of Opposer, including Exhibits 1-5, 22 and 23 TTABVUE;
4. Declaration of Doug Stevenson, Opposer's Director of Advertising, including Exhibits 1-7, 24 and 25 TTABVUE;
5. Declaration of Jared Lowe, Opposer's Director of Sales – retail eCommerce, including Exhibits 1-2, 26 TTABVUE;
6. Declaration of Mark Waterson, Vice President of Opposer's IFIT Division, including Exhibits 1-8, 27 - 29 TTABVUE;
7. Declaration of Tracy Cox, Opposer's IT.eCommerce Manager, including Exhibits 1-2, 30 TTABVUE;
8. Declaration of Adam Miller, Opposer's National Sales Manager, including Exhibits 1-7, 31 and 32 TTABVUE;
9. Declaration of Emily Wilson, a legal assistant employed by Opposer, including Exhibits 1-7, 33 and 34 TTABVUE;
10. Declaration of Perry Jensen, Opposer's Vice-President of Sales for the U.S. and Latin America, including Exhibits 1-10, 35 and 36 TTABVUE;

11. Opposer's Notice of Reliance, including Exhibits A-N, 37 TTABVUE;
12. Opposer's Notice of Reliance, including Exhibits A-J, 38 TTABVUE;
13. Opposer's Notice of Reliance, including Exhibits A-C, 39 TTABVUE; and
14. Opposer's Notice of Reliance, including Exhibits A-B, 40 TTABVUE.

Applicant did not participate at trial and did not submit any evidence.

II. Standing

Standing is a threshold issue that must be proven by a plaintiff in every *inter partes* case. To establish standing in an opposition or cancellation proceeding, a plaintiff must show "both a 'real interest' in the proceedings as well as a 'reasonable basis' for its belief of damage." *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014) (quoting *ShutEmDown Sports, Inc., v. Lacy*, 102 USPQ2d 1036, 1041 (TTAB 2012)); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Opposer's standing is established by the printouts of its pleaded registrations from the USPTO's TESS database and Applicant's admission that the USPTO's records demonstrate that Opposer is the owner of these registrations.¹¹ See Trademark Rule 2.122(d), C.F.R. § 2.122(d), *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (party's ownership of pleaded registration

¹¹ Notice of opposition Exh. A-E, 1 TTABVUE 12-26; Wilson Decl. Exh. 1-6, 33 TTABVUE 5-22.

establishes standing); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 704.03(b)(1)(A) (June 2018).

III. Priority

Because Opposer’s pleaded registrations are of record and there is no pending counterclaim to cancel the registrations, priority is not at issue with respect to the mark and goods and services covered by the registrations. *See Cunningham v. Laser Golf Corp.*, 55 USPQ2d at 1844; *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974); *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998).

IV. Likelihood of confusion

We now consider Opposer’s claim of likelihood of confusion under Section 2(d) of the Trademark Act. Our determination of Opposer’s claim of likelihood of confusion is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*du Pont*”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that “[t]he 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.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). “[W]e need to consider only the factors that are relevant and of record.” *M2 Software Inc. v. M2 Commc’ns Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006).

We focus on Opposer's pleaded Registration No. 4450213 ("the '213 Registration") for the mark iFIT in standard character form for services including "physical fitness instruction."¹² If we find confusion likely between this mark and Applicant's mark for "providing fitness instruction services in the field of dance, and physical fitness," we need not consider the likelihood of confusion between Applicant's mark and Opposer's other pleaded marks for their respective goods and services. On the other hand, if we find no likelihood of confusion between Applicant's mark and the mark of the '213 Registration for their services, we would not find confusion likely between Applicant's mark and Opposer's other pleaded marks for their respective goods and services, which are less similar to Applicant's mark for its identified services. *In re Max Capital Grp.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. Similarity of Services, Channels of Trade, Classes of Purchasers

Applicant specifies that its fitness instruction services are in the field of dance, and physical fitness. Because Opposer's recitation of services does not limit its physical fitness instruction services, Applicant's services are therefore encompassed within Opposer's recitation of services and we find the services are overlapping.

Because the services overlap, we presume that the channels of trade and classes of purchasers for those services also overlap. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely

¹² Registered December 17, 2013. Section 8 and 15 declarations received on January 15, 2019 (not yet examined).

on this legal presumption in determining likelihood of confusion); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) (“Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers.”).

The ultimate purchaser of Opposer’s and Applicant’s overlapping services is a member of the general population.

B. Purchasing Conditions.

When services are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion increases because purchasers of such services are held to a lesser standard of purchasing care. *See Palm Bay Import, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1695 (Fed. Cir. 2005); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000). Opposer argues that customers and potential customers of Applicant’s fitness instruction services are not likely to exercise a high degree of care in perusing and/or selecting Applicant’s services, because the price points of these types of services typically range from free (introductory classes) to relatively modest charges.¹³ Indeed, a drop-in belly dancing class costs just \$10.¹⁴ Thus, Opposer’s and Applicant’s services are not only overlapping; they are sold through overlapping trade channels to overlapping classes of consumers, who are likely to exercise a relatively low degree of

¹³ Opposer’s brief at 24, 41 TTABVUE 29, citing 37 TTABVUE 7-8, 15, 20, 25, 153-155, 171-173.

¹⁴ 37 TTABVUE 15.

care when making purchasing decisions, all of which increases the likelihood of confusion. The *du Pont* factor regarding purchasing conditions weighs in favor of finding a likelihood of confusion.

C. Fame.

We now address Opposer's contention that its mark is "has achieved a significant degree of fame."¹⁵ Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 54 USPQ2d at 1897; *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). For purposes of analysis of likelihood of confusion, fame is not an "all-or-nothing factor"; rather, it "varies along a spectrum from very strong to very weak." *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (internal quotations omitted). Fame is "determined from the viewpoint of consumers of like products," and not from the viewpoint of the general public. *Id.* at 1735. "Relevant factors include sales, advertising, length of use of the mark, market share, brand awareness, licensing activities, and variety of goods bearing the mark." *Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012).

¹⁵ 41 TTABVUE 31.

Because we accord a famous mark a wide latitude of legal protection, and fame has a dominant role in the likelihood of confusion analysis, “[i]t is the duty of the party asserting that its mark is famous to clearly prove it.” *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

To demonstrate the fame of its mark, Opposer relies on (i) income and sales of IFIT branded exercise and fitness machines and other products, (ii) the number of apps that have been downloaded, (iii) the number and frequency of visits to Opposer’s website and blog, (iv) its advertising including online, social media, co-op programs, email, television on major networks during popular programs and newspaper throughout the United States, (v) the availability of its products at major retailers such as Walmart and Amazon.com, (vi) its participation in trade shows such as the Consumer Electronic Show (CES), (vii) positive press and publicity it has received in national magazines including product reviews, (viii) various awards it has received, and (ix) use of the IFIT mark since the 1990s. Opposer submitted some of its critical evidence under seal and therefore we do not specifically describe its evidence in this opinion. While Opposer’s evidence is impressive, much of it concerns the goods it sells and does not concern fitness instruction. Suffice it to say, however, that Opposer has established that its mark is very strong in the field of fitness instruction due to its impressive showing concerning its many fitness-related products. *G.H. Mumm & Cie v. Desnoes & Geddes Ltd.*, 917 F.2d 1292, 16 USPQ2d 1635, 1639 (Fed. Cir. 1990).

D. The Similarity or Dissimilarity of the Marks.

Turning now to the *du Pont* factor concerning the similarities or dissimilarities of the marks, we compare the marks for similarities and dissimilarities in appearance, sound, connotation and commercial impression. *Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d at 1692. While marks must be compared in their entireties and the analysis cannot be predicated on dissecting the marks into their various components, different features may be analyzed to determine whether the marks are similar. *See In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *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.”); *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1430 (TTAB 2013) (citing *Price Candy Co. v. Gold Medal Candy Corp.*, 220 F.2d 759, 105 USPQ 266, 268 (CCPA 1955)). Similarity in any one of the elements of sound, appearance, meaning, or commercial impression is sufficient to support a determination of likelihood of confusion. *See, e.g., Krim-Ko Corp. v. Coca-Cola Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016); *Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1519 (TTAB 2009). In addition, where, as here, the services at issue are overlapping, “the degree of similarity necessary to support a conclusion of likely confusion declines.” *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Opposer's IFIT mark is a standard character mark not limited to any particular presentation and may be presented any particular font, style, color, or size of display. *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.2d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011). Applicant's mark is composed of a number of word and design components, with the large wording SEXIFIT being the dominant part of the mark. First, wording typically dominates in terms of identification of source over designs because it is the wording by which potential consumers will call for the services. *In re Viterra Inc.*, 101 USPQ2d at 1911; *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553 (TTAB 1987). Second, this wording is substantially larger in size than other wording in the mark. Of course, the first letter "T" is in the shape of a slim barbell; consumers would likely view this as part of the term SEXIFIT and not as an independent design element separating the wording SEX and FIT. The marks are similar in commercial impression due to Applicant's inclusion of the entirety of Opposer's mark in its mark. Likelihood of confusion has been found where the entirety of one mark is encompassed by another. *See, e.g., The Wella Corp, v. Calif. Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design for men's cologne, hair spray, conditioner and shampoo likely to cause confusion with the mark CONCEPT for cold permanent wave lotion and neutralizer); *In re Riddle*, 225 USPQ 630, 632 (TTAB 1985) ("Richard Petty's Accu Tune" for automotive service centers specializing in engine tune-ups and oil changes likely to cause confusion with "Accutune" automotive testing equipment.").

In view of the forgoing, and mindful of the obvious differences between the marks, we find that the *du Pont* factor regarding the similarity or dissimilarity of the marks weighs in favor of finding a likelihood of confusion.

E. Conclusion.

We have considered all of the evidence of record pertaining to the likelihood of confusion, as well as all of the arguments related thereto, including any evidence or arguments not specifically discussed in this opinion. The services, trade channels and classes of consumers overlap. Opposer's mark is a very strong mark and there is no evidence of third-parties using similar marks. Opposer's and Applicant's marks are similar, and consumers are likely to exercise a relatively low degree of care when making purchasing decisions for the involved fitness instruction services. We therefore find that Applicant's mark for "providing fitness instruction services in the field of dance, and physical fitness," is likely to be confused with Opposer's mark for services including "physical fitness instruction."

Decision: The opposition is sustained and registration to Applicant is refused.