

ESTTA Tracking number: **ESTTA1105174**

Filing date: **12/30/2020**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91250143
Party	Plaintiff Theragun, LLC
Correspondence Address	ROD S BERMAN JEFFER MANGELS BUTLER & MITCHELL LLP 1900 AVENUE OF THE STARS 7TH FLOOR LOS ANGELES, CA 90067 UNITED STATES Primary Email: trademarkdocket@jmbm.com 310-203-8080
Submission	Brief on Merits for Plaintiff
Filer's Name	Jessica Bromall Sparkman
Filer's email	jzb@jmbm.com, kp2@jmbm.com
Signature	/s/ Jessica Bromall Sparkman
Date	12/30/2020
Attachments	Trial Brief_ Theragun v. Theragen (Redacted).pdf(726974 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

THERAGUN, LLC,
Opposer,
v.
THERAGEN, INC.,
Applicant.

Opposition No. 91/250,143
Appl. Serial Nos.: 88/369,252; 88/369,266
Mark: THERAGEN
Published for Opposition: July 3, 2019
Atty. Ref. No.: 76840-9019

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

[REDACTED] CONFIDENTIAL TRIAL BRIEF OF OPPOSER THERAGUN, INC.

Opposer Theragun, Inc. (“Opposer” or “Theragun”),¹ through its undersigned counsel, hereby submits its Trial Brief in support of its Opposition to applicant Theragen, Inc.’s (“Theragen” or “Applicant”) applications to register THERAGEN and THERAGEN & Design.

¹ Opposer was converted from the limited liability company Theragun, LLC to the corporation Theragun, Inc. on October 2, 2019. The conversion was recorded with the United States Patent and Trademark Office. Declaration of Dr. Jason Wersland (“Wersland Decl.”), ¶ 2 & Exh. A (14 TTAB 2, 6-10).

TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION	1
II. DESCRIPTION OF THE RECORD	1
III. STATEMENT OF THE ISSUES.....	2
IV. OPPOSER HAS STANDING	3
V. OPPOSER OWNS VALID PRIOR RIGHTS IN THE THERAGUN MARKS	5
VI. THERAGUN AND THERAGEN ARE CONFUSINGLY SIMILAR.....	5
A. THERAGUN and THERAGEN Are Nearly Identical	6
1. THERAGUN and THERAGEN Are Nearly Identical in Appearance	6
2. THERAGUN and THERAGEN Are Similar in Sound	7
3. THERAGUN and THERAGEN Have Similar Connotations.....	7
4. The Design Element Does Not Distinguish Applicant’s Mark.....	7
B. The Parties’ Goods Are Closely Related	8
C. The Parties’ Trade Channels and Consumers Are Closely Related, If Not Identical.....	10
D. THERAGUN Is A Strong Mark	11
E. THERAGUN is Registered for a Variety of Goods.....	13
F. The Extent of Potential Confusion Is Substantial	13
G. Actual Confusion and Concurrent Use Factors Are Not Applicable	13
VII. CONCLUSION.....	14

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>In re Albert Trostel & Sons Co.</i> , 29 U.S.P.Q.2d 1783 (T.T.A.B. 1993)	8
<i>Alzheimer's Found. of Am., Inc. v. Alzheimer's Disease & Related Disorders Ass'n, Inc.</i> , 796 F. Supp. 2d 458 (S.D.N.Y. 2011).....	7
<i>CBS Inc. v. Morrow</i> , 708 F.2d 1579 (Fed. Cir. 1983).....	7
<i>Cunningham v. Laser Golf Corp.</i> , 222 F.3d 943 (Fed. Cir. 2000).....	1
<i>In re Dakin's Miniatures Inc.</i> , 59 U.S.P.Q. 2d 1593 (T.T.A.B. 1999)	6, 7
<i>In re Dixie Restaurants, Inc.</i> , 105 F.3d 1405, 41 U.S.P.Q. 2d 1531 (Fed. Cir. 1997)	6
<i>In re DuPont DeNemours & Co.</i> , 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973)	3, 6
<i>Helene Curtis Industries Inc. v. Suave Shoe Corp.</i> , 13 U.S.P.Q.2d 1618 (T.T.A.B. 1989)	8
<i>Hewlett-Packard Co. v. Packard Press, Inc.</i> , 281 F.3d 1261, 62 U.S.P.Q.2d 1001 (Fed. Cir. 2002)	10
<i>L'Oreal S.A. v. Marcon</i> , 102 U.S.P.Q.2d 1434 (T.T.A.B. 2012)	7
<i>L.C. Licensing Inc. v. Berman</i> , 86 U.S.P.Q.2d 1883 (T.T.A.B. 2008)	3, 7
<i>In re National Data Corp.</i> , 753 F.2d 1056, 224 U.S.P.Q. 749 (Fed. Cir. 1985)	7
<i>Otter Products LLC v. BaseOneLabs LLC</i> , 105 U.S.P.Q.2d 1252 (T.T.A.B. 2012)	3
<i>Rocket Trademarks Pty. Ltd. v. Phard S.p.A.</i> , 98 U.S.P.Q.2d 1066 (T.T.A.B. 2011)	3

Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang,
84 U.S.P.Q.2d 1323 (T.T.A.B. 2007)3

In re Viterra Inc.,
671 F.3d 1358, 101 U.S.P.Q.2d 1905 (Fed. Cir. 2012)7, 10, 11

Statutes

15 U.S.C.
§ 1057(b)5
§ 1063(a)3
§ 1115(a)5

Rules

TMBP §§ 3033
TMBP §§ 309.03(b)3
TMEP §§1207.01 *et seq.*7

I. INTRODUCTION

Opposer owns the trademark THERAGUN, as well as various composite trademarks that incorporate THERAGUN (the “THERAGUN Marks”). Opposer uses the THERAGUN Marks for, *inter alia*, massage devices and related apparatus for stimulating muscles to increase strength and physical performance for medical purposes. Many of the THERAGUN Marks are the subject of federal trademark registrations.

Applicant has applied to register the trademark THERAGEN and THERAGEN & design, U.S. App. Ser. Nos. 88369252 and 88369266, respectively (the “THERAGEN Mark” or “Applicant’s Mark”) for closely related goods, including an electrostimulatory device for tissue, bone and/or joint treatment. Opposer opposes registration of the THERAGEN Mark because Applicant’s use and registration of the THERAGEN Mark for the applied-for goods and services is likely to cause confusion with Opposer’s federally registered THERAGUN Marks.

To prevail, Opposer must show that: (1) it has standing; (2) it owns valid prior rights in the THERAGUN Mark; and (3) considering the *DuPont* factors, a likelihood of confusion exists between THERAGUN and THERAGEN. *E.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945-46 (Fed. Cir. 2000). As discussed below, Opposer has made each such showing. THERAGEN differs from THERAGUN by just one letter. Applicant’s applied-for goods are closely related to the goods for which the THERAGUN Marks are registered. And all of the other factors relevant to the likelihood of confusion analysis either weigh in Opposer’s favor or are neutral.

Accordingly, for those reasons, and as more fully set forth herein, Opposer respectfully requests that the Board sustain its Opposition.

II. DESCRIPTION OF THE RECORD

The evidence of record consists of:

1. U.S. Application Ser. No. 88369252 for THERAGEN;
2. U.S. Application Ser. No. 88369266 for THERAGEN & design;

3. Printouts from the Trademark Electronic Search System (“TESS”) showing the status and title of the federal trademarks registrations and applications for the THERAGUN Marks;²

4. Printed publications relating to the nature and relatedness of the parties’ goods;³

5. Printed publications, obtained from the internet, relating to the strength and fame of the THERAGUN Marks;⁴

6. Printed publications submitted by Applicant, which Opposer suspects Applicant will argue show third-party use of trademarks incorporating the term “THERA”;⁵

7. Printed publications submitted by Applicant, which Applicant’s claims are relevant to the likelihood of confusion analysis;⁶

8. The Declaration of Applicant’s Chief Executive Officer J. Chris McAuliffe;⁷

9. The Rebuttal Declaration of Dr. Jason Wersland;⁸ and

10. The Rebuttal Declaration of Kevin Tsao.⁹

III. STATEMENT OF THE ISSUES

The issues to be decided by the Board are:

(1) whether Opposer has standing;

(2) whether Opposer owns valid trademark rights in the THERAGUN Marks; and

² Opposer’s Notice of Reliance filed on July 20, 2020 (“NOR”), Exhs. 1-17 (7 TTABVUE 12-50).

³ NOR, Exhs. 18-59 (7 TTABVUE 51-182).

⁴ NOR, Exhs. 60-77 (7 TTABVUE 183-326).

⁵ Applicant’s Notice of Reliance filed on September 16, 2020 (“ANOR”), Exhs. 1-66 (11 TTABVUE 20-210).

⁶ ANOR, Exhs. 67-80 (11 TTABVUE 211-383).

⁷ Declaration of J. Chris McAuliffe filed on September 16, 2020 (“McAuliffe Decl.”) (12 TTABVUE).

⁸ Rebuttal Declaration of Dr. Jason Wersland filed on November 2, 2020 (“Wersland Decl.”) (14 TTABVUE).

⁹ Confidential Rebuttal Declaration of Kevin Tsao filed on November 2, 2020 (“Tsao Decl.”) (16 TTABVUE).

(3) whether, considering the factors set forth in *In re DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973) (the “*DuPont* Factors”), the THERAGEN Marks create a likelihood of confusion.

IV. OPPOSER HAS STANDING

Any person who believes it is being damaged, or will be damaged, by registration of a mark has standing to oppose an application for registration of a mark on the principal register, provided that it shows a “real interest” in the proceeding and a “reasonable basis” for its belief that it will suffer damage as a result of the registration. 15 U.S.C. § 1063(a); TMBP §§ 303, 309.03(b). The standing requirement may be met by making a federal registration of record, and asserting a claim of likelihood of confusion based on that registered mark that is not “wholly without merit.”¹⁰

Opposer has satisfied this requirement. Opposer owns the trademark THERAGUN, which is the subject of U.S. Reg. No. 5213141, applied for on October 17, 2016 and issued on May 30, 2017, for, *inter alia*, “massage apparatus; massage apparatus for massaging injured muscles; vibrating apparatus used to stimulate muscles and increase strength and physical performance for health and medical purposes; electric massage appliances, namely, electric vibrating massager; electric massage appliances, namely, electric vibrating massager.”¹¹ Opposer also owns the following trademarks and registrations: THERAGUN (U.S. Reg. No. 6206626),¹² THERAGUNZ (U.S. Reg. No. 4760327),¹³ THERAGUN G3 (U.S. Reg. No. 6081408),¹⁴ THERAGUN

¹⁰ *L.C. Licensing Inc. v. Berman*, 86 U.S.P.Q.2d 1883, 1887 (T.T.A.B. 2008) (standing established by properly making pleaded registrations of record); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 U.S.P.Q.2d 1323, 1324 (T.T.A.B. 2007) (standing based on ownership of pleaded registrations); *Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 U.S.P.Q.2d 1066, 1072 (T.T.A.B. 2011) (pleaded registrations of record); *Otter Products LLC v. BaseOneLabs LLC*, 105 U.S.P.Q.2d 1252, 1254 (T.T.A.B. 2012) (opposer’s Supplemental Registration sufficient to establish opposer’s real interest in proceeding).

¹¹ NOR, Exh. 1 (7 TTABVUE 13).

¹² See Exhibit A attached hereto, which is a true and correct copy of a printout from the TESS database showing the current status and title of U.S. Reg. No. 6206626, which issued on November 24, 2020). Opposer requests that the Board take judicial notice of this registration, which issued after Opposer submitted its Notice of Reliance in this matter.

¹³ NOR, Exh. 2 (7 TTABVUE 15).

¹⁴ NOR, Exh. 3 (7 TTABVUE 17).

NETWORK (U.S. Reg. No. 6060204),¹⁵ THERAGUN LIV (U.S. Reg. No. 6043917),¹⁶ THERAGUN G3PRO (U.S. Reg. No. 6043891),¹⁷ THERAGUN RESET (U.S. Reg. No. 6030995),¹⁸ THERAGUN MINI (U.S. Reg. No. 6126360),¹⁹ THERAGUN PRO (U.S. Reg. No. 6126362),²⁰ THERAGUN ELITE (U.S. Reg. No. 6126363),²¹ and THERAGUN PRIME (U.S. Reg. No. 6218258).²² Opposer’s registrations have properly been made of record.

On April 23, 2019, Applicant filed U.S. Trademark Application Ser. Nos. 88369252 and 88369266, for THERAGEN and THERAGEN & design, respectively, both for “medical devices, namely, electrostimulatory devices for tissue, bone and/or joint treatment, medical treatment apparel, and a kit comprising an electrostimulatory device and medical treatment” (the “Applications”). Opposer opposes the Applications on the basis of likelihood of confusion and, as shown in Section VI, *infra*, Opposer’s allegation that a likelihood of confusion exists is not “wholly without merit.” Thus, Opposer has standing.

¹⁵ NOR, Exh. 4 (7 TTABVUE 19).

¹⁶ NOR, Exh. 5 (7 TTABVUE 21).

¹⁷ NOR, Exh. 6 (7 TTABVUE 23).

¹⁸ NOR, Exh. 7 (7 TTABVUE 25).

¹⁹ See Exhibit B attached hereto, which is a true and correct copy of a printout from the TESS database showing the current status and title of U.S. Reg. No. 6126360, which issued on August 11, 2020). Opposer requests that the Board take judicial notice of this registration, which issued after Opposer submitted its Notice of Reliance in this matter.

²⁰ See Exhibit C attached hereto, which is a true and correct copy of a printout from the TESS database showing the current status and title of U.S. Reg. No. 6126362, which issued on August 11, 2020). Opposer requests that the Board take judicial notice of this registration, which issued after Opposer submitted its Notice of Reliance in this matter.

²¹ See Exhibit D attached hereto, which is a true and correct copy of a printout from the TESS database showing the current status and title of U.S. Reg. No. 6126363, which issued on August 11, 2020). Opposer requests that the Board take judicial notice of this registration, which issued after Opposer submitted its Notice of Reliance in this matter.

²² See Exhibit E attached hereto, which is a true and correct copy of a printout from the TESS database showing the current status and title of U.S. Reg. No. 6218258, which issued on December 8, 2020). Opposer requests that the Board take judicial notice of this registration, which issued after Opposer submitted its Notice of Reliance in this matter.

V. OPPOSER OWNS VALID PRIOR RIGHTS IN THE THERAGUN MARKS

Opposer owns the THERAGUN Marks for use in connection with, *inter alia*, electric massage devices. The THERAGUN Marks are the subject of numerous federal trademark registrations, which have properly been made of record herein.²³ Opposer's registration for THERAGUN was applied for on October 17, 2016, issued on May 30, 2017, and is valid and in force, and none of Opposer's registrations for the THERAGUN Marks has been challenged by Applicant.²⁴ Opposer's registrations constitute *prima facie* evidence of the validity of the THERAGUN Marks, as well as of Opposer's exclusive right to use the THERAGUN Marks on the goods specified in the registrations. 15 U.S.C. §§ 1057(b) & 1115(a).

The Applications are both based on intent to use and there is no evidence that Applicant began using either of Applicant's Marks for the applied-for goods prior to the April 3, 2019 filing date of the Applications. Thus, Opposer has established that it is the owner of valid prior trademark rights in THERAGUN, and that its rights in THERAGUN predate any rights that Applicant may claim in THERAGEN.

VI. THERAGUN AND THERAGEN ARE CONFUSINGLY SIMILAR

In determining whether a likelihood of confusion exists, the Board should consider a number of factors, as follows:

- The similarity of the marks as to appearance, sound, and meaning.
- The similarity of the goods in the registrations.
- The similarity of the trade channels.
- The conditions of sale and nature of the consumers.
- The strength of the mark, including fame of the senior mark and whether similar marks are used for similar goods.
- The nature and extent of any actual confusion.

²³ *Id.*

²⁴ *Id.*

- The length of concurrent use without evidence of actual confusion.
- The variety of goods on which a mark is or is not used.
- The market interface between the parties.
- The junior user's right to exclude others from use of its mark on its goods.
- The extent of potential confusion.

DuPont, 177 U.S.P.Q. at 567. Any one of the factors listed may be dominant in any given case, depending upon the evidence of record. *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 U.S.P.Q. 2d 1531, 1533 (Fed. Cir. 1997). In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods, similarity of the trade channels of the goods, and potential confusion. *See In re Dakin's Miniatures Inc.*, 59 U.S.P.Q. 2d 1593 (T.T.A.B. 1999); TMEP §§1207.01 *et seq.* While these factors are most relevant here, *all* of the factors either weigh in favor of a finding of likelihood of confusion or are neutral.

A. THERAGUN and THERAGEN Are Nearly Identical

In determining similarity, the marks at issue must be compared in their entireties, including with respect to appearance, sound, and meaning or connotation. *See DuPont*, 177 U.S.P.Q. at 567. Similarity as to one element (*i.e.*, appearance, sound, or connotation) may be sufficient to deem the marks similar. Here, the marks are similar with respect to all three elements and nearly identical with respect to appearance.

1. THERAGUN and THERAGEN Are Nearly Identical in Appearance

Opposer's mark is THERAGUN. Applicant's mark is THERAGEN.

THERAGUN. THERAGEN.

There is no question that the parties' marks are similar in appearance. Indeed, the marks are identical except that the second to last letter in the THERAGUN Mark is "u" and the second to last letter in the THERAGEN Mark is "e." A consumer confronting the parties' marks in the market place could easily mistake THERAGEN for THERAGUN, or vice versa.

2. THERAGUN and THERAGEN Are Similar in Sound

Both parties' marks are three syllables. The first two syllables of the parties' marks are identical. The third, and final, syllables of parties' marks both end in "n." Thus, a consumer *hearing* THERAGEN spoken aloud, could easily mistake the mark for THERAGUN.

3. THERAGUN and THERAGEN Have Similar Connotations

The first two syllables of the parties' marks are identical – in appearance, as well as in meaning. Although the final syllables are not identical, the parties' marks nonetheless similar in connotation. Indeed, any small distinctions in meaning fade in light of the fact that the marks are nearly identical in both appearance and sound.

4. The Design Element Does Not Distinguish Applicant's Mark

Though marks should be compared in their entirety, the Board may properly give more weight in its comparison to the dominant feature of a mark – in other words, the feature of a mark that the average consumer is most likely to recall. *See In re National Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985); *L'Oreal S.A. v. Marcon*, 102 U.S.P.Q.2d 1434, 1438 (T.T.A.B. 2012); *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 U.S.P.Q.2d 1905, 1908 (Fed. Cir. 2012). If a mark comprises both wording and a design, greater weight is often given to the wording, because the literal component of brand names likely will appear alone when used in text and will be spoken when requested by consumers." *See, e.g., Viterra*, 101 U.S.P.Q.2d at 1911.²⁵

²⁵ *See also CBS Inc. v. Morrow*, 708 F.2d 1579, 1581-83 (Fed. Cir. 1983) (stating "the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed"); *L.C. Licensing, Inc. v. Cary Berman*, 86 U.S.P.Q.2d 1883, 1887, 2008 WL 835278, at *3 (T.T.A.B. 2008) ("[I]t is well settled that if a mark comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods."); *In re Dakin's Miniatures, Inc.*, 59 U.S.P.Q.2d 1593 (T.T.A.B. 1999) ("In the case of marks which consist of words and a design, the words are normally accorded greater weight because they would be used by purchasers to request the goods."); *Alzheimer's Found. of Am., Inc. v. Alzheimer's Disease & Related Disorders Ass'n, Inc.*, 796 F. Supp. 2d 458, 465 (S.D.N.Y. 2011) ("While a composite mark (consisting of both a word element and a design element) must be considered in its entirety, trademark law recognizes that the word portion is often more likely to be impressed upon a purchaser's memory because it is the word that purchasers use to request the goods and/or services.").

Here, the dominant element of Applicant's design mark is the wording THERAGEN. And, as discussed in the preceding sections, THERAGEN and THERAGUN are nearly identical. The addition of a design element to Applicant's Mark is insufficient to avoid a finding that confusion is likely.

Accordingly, this factor weighs heavily in favor of a finding of likelihood of confusion.

B. The Parties' Goods Are Closely Related

In determining whether goods are related, the issue is not whether purchasers are likely to substitute one type of goods for the other; "goods need not be similar or even competitive in nature to support a finding of likelihood of confusion." See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 U.S.P.Q.2d 1618 (T.T.A.B. 1989). Instead, the goods are related if consumers may reasonably believe the goods emanate from the same source. See *In re Albert Trostel & Sons Co.*, 29 U.S.P.Q.2d 1783 (T.T.A.B. 1993).

Here, Opposer's goods include "massage apparatus; massage apparatus for massaging injured muscles; vibrating apparatus used to stimulate muscles and increase strength and physical performance for health and medical purposes; electric massage appliances, namely, electric vibrating massager; electric massage appliances, namely, electric vibrating massager." Applicant's goods are "medical devices, namely, electrostimulatory devices for tissue, bone and/or joint treatment, medical treatment apparel, and a kit comprising an electrostimulatory device and medical treatment."

Although the goods are not identical, it is apparent from the descriptions of the parties' respective goods that both parties' goods are for use in the treatment or management of or therapy for muscle pain or injury. As such, the parties' goods are clearly complementary. Further, the evidence of record includes more than 30, live, use-based federal trademark registrations that include both massage devices and electrostimulatory devices.²⁶ The evidence of record also shows

²⁶ NOR, Exhs. 18-52 (7 TTABVUE 51-120).

that numerous companies sell both massage devices and electrostimulatory devices,²⁷ and that massage devices and electrostimulatory devices are available for sale through a number of the same websites and channels.²⁸

Notwithstanding the foregoing, based on the evidence and testimony that Applicant has submitted, Opposer understands that Applicant intends to argue that the parties' goods are not related. In testimony provided by its Chief Executive Officer, Applicant claims that its use of THERAGEN is somehow limited by representations made by it to the FDA. Opposer is unaware of any authority for the proposition that representations made to the FDA could restrict a company's ability to use a trademark. Even if such limitations did exist, however, they are not reflected in the in the Applications and for that reason, for purposes of this proceeding, they are irrelevant.

Applicant has also put into evidence certain claims about the nature of its goods, *e.g.*, that they will not be "handheld," that they will only be available via prescription, or that they remain in one location on the body while delivering therapy. Again, however, such restrictions do not appear in the identification of goods in the Applications, which instead, broadly claims, *inter alia*, "electrostimulatory devices for tissue, bone and/or joint treatment." Such a broad description certainly includes handheld goods, goods available over the counter, and goods that can be moved to different areas to deliver therapy.

Lest there be any doubt that the parties' goods are related, in rebuttal to Applicant's testimony, Opposer's founder has provided testimony explaining the close relationship between the parties' goods. While both parties' goods can be used alone, each is often used as part of fitness, health, wellness, recovery, or therapy plan that also includes both massage and electrostimulatory devices.²⁹ Opposer's THERAGUN branded products are used to soothe and loosen muscles that are painful, tight, or sore from exertion or injury, as well as to promotion

²⁷ NOR, Exhs. 57-58 (7 TTABVUE 139-165).

²⁸ NOR, Exhs. 53-56, 59 (7 TTABVUE 121-138, 166-182).

²⁹ Wersland Decl., ¶ 6-7 (14 TTABVUE 11).

healing and recovery after exertion or injury, including by targeting specific areas or muscle groups.³⁰ Electrostimulatory devices, such as those included in Applicant's goods, are commonly used to stimulate muscles and increase strength and improve physical performance, to soothe and loosen muscles that are painful, tight, or sore from physical exertion or injury, to promote healing after exertion or injury, and to target a specific area or muscle group.³¹

Opposer's THERAGUN massage devices are used by individuals, therapists, and trainers, as part of fitness, health, wellness, recovery, and therapy plans administered to their patients or clients, as well as by numerous professional sports teams.³² Electrostimulatory devices, such as those included in Applicant's goods, are also commonly used by individuals, therapists, and trainers, as part of fitness, health, wellness, recovery, and therapy plans administered to their patients or clients, as well as by numerous professional sports teams.³³

Accordingly, the evidence of record shows that the parties' goods are closely related and, therefore, this factor weighs heavily in favor of a finding of likelihood of confusion.

C. The Parties' Trade Channels and Consumers Are Closely Related, If Not Identical

Neither Theragun's registrations nor the Applications contain any limitations with respect to the consumers and trade channels for the goods contained therein. Thus, it is presumed that the parties' goods move in all normal trade channels for goods of their type. *See Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 U.S.P.Q.2d 1001 (Fed. Cir. 2002) (“[A]bsent restrictions in the application and registration, goods and services are presumed to travel in the same channels of trade to the same class of purchasers.”); *Viterra*, 671 F.3d at 1362 (Fed. Cir. 2012) (same).

³⁰ *Id.* at ¶ 5 (14 TTABVUE 11).

³¹ *Id.* at ¶ 6-7 (14 TTABVUE 11).

³² *Id.* at ¶ 6-7 (14 TTABVUE 11).

³³ *Id.* at ¶ 6-7 (14 TTABVUE 11).

As described above, the parties' goods are closely related. Because the parties' goods are closely related, both the trade channels and the purchasers of the parties' goods are presumed to be closely related as well. *Id.* Indeed, Applicant admits its goods – like Opposer's goods – are intended to be used by doctors, physical therapists, and other medical professionals, and their patients, as well as at clinics where therapy may be provided on-site.³⁴

Accordingly, these two factors weigh heavily in favor of a finding of likelihood of confusion.

D. THERAGUN Is A Strong Mark

With the introduction of its THERAGUN massage device, Opposer jump started a wave of massage guns into the market and Opposer remains the market leader.³⁵ Opposer's THERAGUN branded massage devices have received glowing write-ups and reviews in *Vogue*, *TeenVogue*, *US Weekly*, *Shape*, *SELF*, *GQ*, and *Men's Health*, among others, including in articles titled "7 Gadgets Star Athletes Can't Live Without," "All About the TheraGun, the Self-Massage Device That's Taking Over Instagram," "Meet the Theragun, the NBA's Secret Sideline Weapon," "Why Celebrities and Athletes are Going Gaga for this Massage Gadget," and "The Celeb- Favorite Massage Too Taking Over the Fitness World," "Why Celebs Are Obsessed With Theragun – and Why You Will Be Too."³⁶ Opposer's THERAGUN branded devices are used by numerous pro athletes, including by Atlanta Falcons player Julio Jones during Super Bowl LI and by NBA player Kyrie Irving during the 2017 NBA Finals.³⁷ Other athletes and celebrities that are reportedly fans of THERAGUN include Detroit Lions wide receiver Marvin Jones, who says "I can't live without it anymore",³⁸ as well as Ashley Graham and Kevin Hart,³⁹ Los Angeles Rams defensive back

³⁴ McAuliffe Decl., ¶ 16-17 (12 TTABVUE 4-5).

³⁵ NOR, Exh, 67 (7 TTABVUE 249).

³⁶ NOR, Exhs. 60-77 (7 TTABVUE 183-325).

³⁷ NOR, Exhs. 61, 64, 65, 66, 67, 69, 74 (7 TTABVUE 194-96, 218, 222-23, 231, 249, 261, 297).

³⁸ NOR Exh. 61 (7 TTABVUE 194-96).

³⁹ NOR, Exh, 62 (7 TTABVUE 201).

Marcus Peters,⁴⁰ Shakira and three-time Olympian Kerri Walsh-Jennings,⁴¹ Chelsea Handler, Diddy, Adam Levine and Maroon 5, and DJ Khaled,⁴² Gal Godot, Jamie Lynn Sigler, Chris Hemsworth, Cristiano Ronaldo, and Rob Gronkowski.⁴³

Despite the popularity and acclaim enjoyed by Opposer's THERAGUN branded products, based on the evidence submitted by Applicant, Opposer anticipates that the Opposer may argue that THERAGUN is mark weak and entitled only to a narrow scope of protection. Contrary to Applicant's suggestion, however, the evidence of record demonstrates, Opposer's mark is quite strong and deserving of a wide scope of protection. Opposer has extensively advertised and promoted its THERAGUN mark, including to its nearly 80,000 Facebook followers and more than 343,000 Instagram followers.⁴⁴ Opposer purchases advertising, all of which features the THERAGUN Mark, on various platforms, including Facebook, Google, Amazon, LinkedIn, and Twitter. Since 2018 alone, Opposer has devoted nearly [REDACTED] to advertising and promoting the THERAGUN Mark and THERAGUN branded in the U.S.⁴⁵ Over that time, Opposer ads have received [REDACTED] of user impressions and [REDACTED] to Opposer's website.⁴⁶ In addition, Opposer was named to *Fast Company's* listed of the most innovative wellness companies of 2020 and Opposer's THERAGUN products were named to *Golf Digest's* list of "Best Fitness Equipment for Golfers," identified by the *Robb Report* as one of the best massage guns on Amazon, and have multiple product design awards.⁴⁷

Thus, this factor weighs in favor of a finding of likelihood of confusion.

⁴⁰ NOR, Exh, 66, 69 (7 TTABVUE 231, 261).

⁴¹ NOR, Exh, 72 (7 TTABVUE 278).

⁴² NOR, Exh, 74 (7 TTABVUE 296-97).

⁴³ NOR, Exh, 77 (7 TTABVUE 316).

⁴⁴ Tsao Decl., ¶ 2, Exhs. A-B (16 TTABVUE 2, 8, 20).

⁴⁵ *Id.* at ¶ 3 (16 TTABVUE 2-3).

⁴⁶ *Id.* at ¶ 7 (16 TTABVUE 3).

⁴⁷ *Id.* at ¶ 8-14, Exhs. C-J (16 TTABVUE 4-5, 23-126).

E. THERAGUN is Registered for a Variety of Goods

In addition to the massage devices discussed at length herein, Opposer also owns registrations for THERAGUN, or marks incorporating THERAGUN, for athletic apparel, t-shirts, hats, caps, affiliate marketing and promoting the goods and services of others, percussive therapy services, massage therapy services, massage oils, massage creams, sports cream, dietary supplements, and nutritional supplements.⁴⁸

Applicant's goods are also closely related to many, if not all, of the foregoing goods, many of which are either related to or involve the provision of therapy. Further, the variety of goods for which THERAGUN is registered and use only increases the chance that consumers will mistakenly believe that THERAGEN branded electrostimulatory products are being put out by Opposer.

F. The Extent of Potential Confusion Is Substantial

The potential for confusion between THERAGUN and THERAGEN is substantial. Both parties offer similar goods in the same or similar trade channels to the same consumers. Additionally, the parties' marks look and sound nearly identical. Thus, this factor weighs in favor of a finding of likelihood of confusion.

G. Actual Confusion and Concurrent Use Factors Are Not Applicable

Applicant's Mark is not yet in use for the applied-for goods. Accordingly, the parties' marks have never been used concurrently and there has been no opportunity for consumers to be actually confused. Thus, the *DuPont* factors of actual confusion and length of concurrent use without actual confusion are both neutral, and weigh neither for nor against a finding of likelihood of confusion.

///

///

///

///

⁴⁸ NOR, Exhs. 1-18 (7 TTABVUE 12-52); Exhs. A-E, hereto.

VII. CONCLUSION

Opposer owns valid trademark rights in THERAGUN, and all of the *DuPont* factors either weigh in favor of a finding of likelihood of confusion or are neutral. The Board should find that a likelihood of confusion exists, sustain Opposer's opposition, and refuse registration of Applicant's Mark.

Respectfully submitted,

Dated: December 30, 2020

/s/ Jessica Bromall Sparkman
Rod S. Berman, Esq.
Jessica Bromall Sparkman, Esq.
Attorney for Opposer Theragun, Inc.
Jeffer Mangels Butler & Mitchell LLP
1900 Avenue of the Stars, Seventh Floor
Los Angeles, CA 90067-5010
Telephone: (310) 203-8080
Fax: (310) 203-0567
E-mail: trademarkdocket@jmbm.com

EXHIBIT A



United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [FAQ](#) | [Glossary](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#)**Trademarks > Trademark Electronic Search System (TESS)**

TESS was last updated on Wed Dec 30 04:07:22 EST 2020

[TESS HOME](#) | [NEW USER](#) | [STRUCTURED](#) | [FREE FORM](#) | [BROWSE DICT](#) | [SEARCH OG](#) | [BOTTOM](#) | [HELP](#)

Please logout when you are done to release system resources allocated for you.

Record 1 out of 1[TSDR](#)[ASSIGN Status](#)[TTAB Status](#)*(Use the "Back" button of the Internet Browser to return to TESS)*

THERAGUN

Word Mark

THERAGUN

Goods and Services

IC 003. US 001 004 006 050 051 052. G & S: Non-medicated skin creams. FIRST USE: 20200700. FIRST USE IN COMMERCE: 20200700

IC 005. US 006 018 044 046 051 052. G & S: Sports cream for relief of pain. FIRST USE: 20200700. FIRST USE IN COMMERCE: 20200700

Standard Characters Claimed**Mark Drawing Code**

(4) STANDARD CHARACTER MARK

Serial Number

88422970

Filing Date

May 9, 2019

Current Basis

1A

Original Filing Basis

1B

Published for Opposition

August 13, 2019

Registration Number**6206626****International****Registration Number**

1503264

Registration Date

November 24, 2020

Owner

(REGISTRANT) THERAGUN, INC. CORPORATION DELAWARE 9420 WILSHIRE BLVD., FOURTH FLOOR BEVERLY HILLS CALIFORNIA 90212

Assignment Recorded

ASSIGNMENT RECORDED

Attorney of Record

Rod S. Berman

Prior Registrations

4760327;5213141

Type of Mark

TRADEMARK

Register

PRINCIPAL

Live/Dead Indicator

LIVE

[TESS HOME](#) | [NEW USER](#) | [STRUCTURED](#) | [FREE FORM](#) | [BROWSE DICT](#) | [SEARCH OG](#) | [TOP](#) | [HELP](#)

EXHIBIT B



United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [FAQ](#) | [Glossary](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#)**Trademarks > Trademark Electronic Search System (TESS)**

TESS was last updated on Wed Dec 30 04:07:22 EST 2020

[TESS HOME](#) | [NEW USER](#) | [STRUCTURED](#) | [FREE FORM](#) | [BROWSE DICT](#) | [SEARCH OG](#) | [BOTTOM](#) | [HELP](#) Please logout when you are done to release system resources allocated for you.**Record 1 out of 1**[TSDR](#)[ASSIGN Status](#)[TTAB Status](#)*(Use the "Back" button of the Internet Browser to return to TESS)*

THERAGUN MINI

Word Mark THERAGUN MINI

Goods and Services IC 010. US 026 039 044. G & S: Massage apparatus; Massage apparatus and instruments; Massage apparatus for massaging injured muscles; Massaging apparatus for personal use; Vibrating apparatus used to stimulate muscles and increase strength and physical performance for health and medical purposes; Electric massage appliances, namely, electric vibrating massager; Foot massage apparatus. FIRST USE: 20200500. FIRST USE IN COMMERCE: 20200500

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 88682583

Filing Date November 6, 2019

Current Basis 1A

Original Filing Basis 1B

Published for Opposition March 24, 2020

Registration Number **6126360**

Registration Date August 11, 2020

Owner (REGISTRANT) THERAGUN, INC. CORPORATION DELAWARE 9420 WILSHIRE BLVD., FOURTH FLOOR BEVERLY HILLS CALIFORNIA 90212

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record Rod S. Berman

Prior Registrations 4760327;5213141

Disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "MINI" APART FROM THE MARK AS SHOWN

Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead Indicator LIVE

[TESS HOME](#) | [NEW USER](#) | [STRUCTURED](#) | [FREE FORM](#) | [BROWSE DICT](#) | [SEARCH OG](#) | [TOP](#) | [HELP](#)

EXHIBIT C



United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [FAQ](#) | [Glossary](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#)**Trademarks > Trademark Electronic Search System (TESS)**

TESS was last updated on Wed Dec 30 04:07:22 EST 2020

[TESS HOME](#) | [NEW USER](#) | [STRUCTURED](#) | [FREE FORM](#) | [BROWSE DICT](#) | [SEARCH OG](#) | [BOTTOM](#) | [HELP](#) Please logout when you are done to release system resources allocated for you.**Record 1 out of 1**[TSDR](#)[ASSIGN Status](#)[TTAB Status](#)*(Use the "Back" button of the Internet Browser to return to TESS)*

THERAGUN PRO

Word Mark THERAGUN PRO

Goods and Services IC 010. US 026 039 044. G & S: Massage apparatus; Massage apparatus and instruments; Massage apparatus for massaging injured muscles; Massaging apparatus for personal use; Vibrating apparatus used to stimulate muscles and increase strength and physical performance for health and medical purposes; Electric massage appliances, namely, electric vibrating massager; Foot massage apparatus. FIRST USE: 20200100. FIRST USE IN COMMERCE: 20200100

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 88682598

Filing Date November 6, 2019

Current Basis 1A

Original Filing Basis 1B

Published for Opposition March 17, 2020

Registration Number **6126362**

Registration Date August 11, 2020

Owner (REGISTRANT) THERAGUN, INC. CORPORATION DELAWARE 9420 WILSHIRE BLVD., FOURTH FLOOR BEVERLY HILLS CALIFORNIA 90212

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record Rod S. Berman

Prior Registrations 4760327;5213141

Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead Indicator LIVE

[TESS HOME](#) | [NEW USER](#) | [STRUCTURED](#) | [FREE FORM](#) | [BROWSE DICT](#) | [SEARCH OG](#) | [TOP](#) | [HELP](#)

EXHIBIT D



United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [FAQ](#) | [Glossary](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#)**Trademarks > Trademark Electronic Search System (TESS)**

TESS was last updated on Wed Dec 30 04:07:22 EST 2020

[TESS HOME](#) | [NEW USER](#) | [STRUCTURED](#) | [FREE FORM](#) | [BROWSE DICT](#) | [SEARCH OG](#) | [BOTTOM](#) | [HELP](#) Please logout when you are done to release system resources allocated for you.**Record 1 out of 1**[TSDR](#)[ASSIGN Status](#)[TTAB Status](#)*(Use the "Back" button of the Internet Browser to return to TESS)*

THERAGUN ELITE

Word Mark THERAGUN ELITE

Goods and Services IC 010. US 026 039 044. G & S: Massage apparatus; Massage apparatus and instruments; Massage apparatus for massaging injured muscles; Massaging apparatus for personal use; Vibrating apparatus used to stimulate muscles and increase strength and physical performance for health and medical purposes; Electric massage appliances, namely, electric vibrating massager; Foot massage apparatus. FIRST USE: 20200100. FIRST USE IN COMMERCE: 20200100

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 88682612

Filing Date November 6, 2019

Current Basis 1A

Original Filing Basis 1B

Published for Opposition March 17, 2020

Registration Number **6126363**

Registration Date August 11, 2020

Owner (REGISTRANT) THERAGUN, INC. CORPORATION DELAWARE 9420 WILSHIRE BLVD., FOURTH FLOOR BEVERLY HILLS CALIFORNIA 90212

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record Rod S. Berman

Prior Registrations 4760327;5213141

Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead Indicator LIVE

[TESS HOME](#) | [NEW USER](#) | [STRUCTURED](#) | [FREE FORM](#) | [BROWSE DICT](#) | [SEARCH OG](#) | [TOP](#) | [HELP](#)

EXHIBIT E



United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [FAQ](#) | [Glossary](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#)**Trademarks > Trademark Electronic Search System (TESS)**

TESS was last updated on Wed Dec 30 04:07:22 EST 2020

[TESS HOME](#) | [NEW USER](#) | [STRUCTURED](#) | [FREE FORM](#) | [BROWSE DICT](#) | [SEARCH OG](#) | [BOTTOM](#) | [HELP](#) Please logout when you are done to release system resources allocated for you.**Record 1 out of 1**[TSDR](#)[ASSIGN Status](#)[TTAB Status](#)*(Use the "Back" button of the Internet Browser to return to TESS)*

THERAGUN PRIME

Word Mark THERAGUN PRIME

Goods and Services IC 010. US 026 039 044. G & S: Massage apparatus; Massage apparatus and instruments; Massage apparatus for massaging injured muscles; Massaging apparatus for personal use; Vibrating apparatus used to stimulate muscles and increase strength and physical performance for health and medical purposes; Electric massage appliances, namely, electric vibrating massager; Foot massage apparatus. FIRST USE: 20200101. FIRST USE IN COMMERCE: 20200101

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 88721223

Filing Date December 10, 2019

Current Basis 1A

Original Filing Basis 1B

Published for Opposition March 17, 2020

Registration Number **6218258**

Registration Date December 8, 2020

Owner (REGISTRANT) THERAGUN, INC. CORPORATION DELAWARE 9420 WILSHIRE BLVD., FOURTH FLOOR BEVERLY HILLS CALIFORNIA 90212

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record Rod S. Berman

Prior Registrations 4760327;5213141

Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead Indicator LIVE

[TESS HOME](#) | [NEW USER](#) | [STRUCTURED](#) | [FREE FORM](#) | [BROWSE DICT](#) | [SEARCH OG](#) | [TOP](#) | [HELP](#)

CERTIFICATE OF SERVICE

It is hereby certified that on **December 30, 2020**, a copy of the foregoing [REDACTED] CONFIDENTIAL TRIAL BRIEF OF THERAGUN, INC. has been sent via email to Applicant's counsel of record as follows:

Lynn E. Rzonca
BALLARD SPAHR LLP
1735 Market Street 51st Floor
Philadelphia, PA 19103-7599
Email: tmdocketing@ballardspahr.com; rzoncal@ballardspahr.com

/s/ Kerene Palmer
Kerene Palmer