

THIS DISPOSITION IS NOT
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

World Gym International, Inc.
v.
Eunice U.S.A., Inc.

Opposition No. 91124916
to application Serial No. 75898131
filed on January 19, 2000

Joseph D. Lewis of Barnes & Thornburg for World Gym
International, Inc.

Michael R. Doram of Creskoff & Doram for Eunice U.S.A., Inc.

Before Seeherman, Hairston and Kuhlke, Administrative
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Eunice U.S.A., Inc., seeks registration of
the mark shown below



The World Is Our Gym

for goods identified in the application as "clothing,
namely, shirts, pants, shorts, jackets, T-shirts, tops and

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suits for men, women, boys and girls" in International Class 25. The application was filed on January 19, 2000, based on an assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. §1051(b). The wording "The World Is Our Gym" is disclaimed.

Opposer, World Gym International, Inc., opposed registration of applicant's mark on the following grounds: (1) that, as applied to applicant's goods, the mark so resembles opposer's previously used and registered WORLD GYM and WORLD GYM formative marks for a wide variety of goods and services, including fitness and gymnasium services, shirts, pants, sweat suits, jackets, hats, and gloves, as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d), 15 U.S.C. §1052(d); and (2) that applicant's mark "will cause dilution of the distinctive quality of opposer's marks" under Trademark Act Section 43(c), 15 U.S.C. §1125(c).¹

Applicant filed an answer by which applicant admitted that the registrations pleaded by opposer are owned by opposer and are valid and subsisting; that applicant adopted its mark long after opposer's adoption and use of opposer's

¹ Opposer also attempted to assert the ground that applicant's mark falsely suggests a connection with opposer's marks under Trademark Act Section 2(a), 15 U.S.C. §1052(a). Aside from the fact that this claim was not sufficiently pleaded, opposer did not pursue this claim in its brief. In view thereof, the Board considers the false suggestion claim to have been waived.

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marks; that opposer's marks are widely used by opposer and its licensees throughout the United States; and that applicant did not use its mark before July 1, 2000.

Applicant denied the remaining salient allegations of the notice of opposition. Applicant's answer also included three "affirmative defenses," the first and third of which the Board found, by order dated June 11, 2003, to be merely amplifications of its denial of opposer's claim of likelihood of confusion and the second of which was stricken from the pleading. The parties have fully briefed this proceeding. The parties did not request an oral hearing.

Pursuant to Trademark Rule 2.123(b), the parties have submitted, by stipulation, testimony in the form of three declarations. Trademark Rule 2.123(b). However, opposer, in its main brief, objected to the declaration of Michael R. Doram, applicant's attorney, and accompanying exhibits 1-4. Opposer argues that the "proffered testimony does not comprise merely formal matters, but is directed to substantive issues such as the goods of the parties, and their respective channels of trade" and that "Testimony by an attorney should not be made by an attorney who is continuing to act as counsel in the case." Br. p. 1. Opposer requests that "At the very least, this Declaration should be accorded 'no probative value whatsoever' because it is 'subject to an incredible amount of bias.'" Br. p. 1,

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citing *In re Gray Inc.*, 3 USPQ2d 1558, 1560. Applicant did not respond to opposer's objection, nor did applicant refer to this declaration or accompanying exhibits in its brief on the case. An attorney generally may not appear as a witness on behalf of a party he is representing and if an attorney becomes a witness on behalf of a party withdrawal from representation may be necessary. Patent and Trademark Rule 10.63. As stated in *In re Gray*, supra:

Finally, to avoid the predicament of a lawyer's having to testify and then having to argue the credibility and effect of his own testimony, both the Code of Professional Responsibility (Rule 5-102) and our own rules, 37 CFR §10.63 (1986), require an attorney to withdraw as counsel in a case if he learns that he ought to be called as a witness or sign an affidavit to be filed in the case. As counsel here has not withdrawn, it would be improper for us to give any weight to his affidavit on the ultimate issue.

In view thereof, opposer's objection is sustained to the extent that the declaration of Michael R. Doram and accompanying exhibits 1-4 have been given no weight.²

The evidence of record, therefore, includes the pleadings herein, the file of the opposed application, and the declarations of opposer's president, Michael Uretz, and

² We further note, that this evidence is of little probative value inasmuch as it consists of printouts from the Internet pertaining to opposer's goods and marketing channels. Such evidence is irrelevant for our purposes, as we are obliged to consider opposer's goods and trade channels as they are identified in the registrations.

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accompanying exhibits, and applicant's vice president of marketing and sales, Robert Hsu, and accompanying exhibits.

As noted above, opposer pleaded ownership of several registrations. The registrations, all of which are in full force and effect and owned by opposer, as testified to by way of declaration, are summarized as follows:³

Registration No. 1783000, for the mark shown below



for "gymnasium services: conducting bodybuilding exhibitions" in International Class 41, with GYM disclaimed, filed October 8, 1992, issued on July 20, 1993;

Registration No. 1354193, for the mark shown below

³ Three of the original four pleaded registrations have been made of record. In addition, opposer has made of record three other registrations. Applicant has raised no objection to opposer's submission of and reliance upon these unpleaded registrations and has addressed them on the merits in its brief. In view thereof, we deem the pleadings to be amended to include opposer's claim of ownership of those three additional registrations. Fed. R. Civ. P. 15(b); See Time Warner Entertainment Co. v. Jones, 65 USPQ2d 1650, 1653 n.2 (TTAB 2002); Hewlett-Packard Co. v. HumanPerformance Measurement Inc., 23 USPQ2d 1390, n. 7 (TTAB 1991).



for "gym clothing" in International Class 25, with GYM disclaimed, filed on December 12, 1983, issued on August 13, 1985; and

Registration No. 2268311, for the mark shown below



for "shirts, shorts, pants, sweat suits, jackets, hats, gloves" in International Class 25, with GYM disclaimed, filed October 17, 1997, issued on August 10, 1999.

Registration No. 1911887, for the mark WORLD (in standard character form) for "fitness center services, conducting seminars on fitness and providing personal instructions on exercise and physical fitness by manner of individualized courses, gymnasium services, conducting bodybuilding exhibitions and contests" in International Class 41, filed June 15, 1994, issued on August 15, 1995;

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Registration No. 1791584, for the mark WORLD GYM (in standard character form) for "printed publications; namely, magazines and informational brochures pertaining to bodybuilding, health and nutrition and gymnasium products and services; posters; decorative adhesive stickers" in International Class 16, "gymnasium services; conducting bodybuilding exhibitions and contests" in International Class 41, with GYM disclaimed, filed October 8, 1992, issued on September 7, 1993; and

Registration No. 1856427, for the mark shown below



for "fitness center services, conducting exercise classes, conducting seminars on nutrition and fitness and providing personal instructions on nutrition, exercise and physical fitness" in International Class 41, with GYM FITNESS CENTERS disclaimed, filed December 24, 1992, issued on September 27, 1994.

Because opposer has made its pleaded registrations of record, and because its likelihood of confusion claim is not frivolous, we find that opposer has established its standing to oppose registration of applicant's mark. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

We turn first to opposer's claim of likelihood of confusion under Section 2(d) of the Trademark Act. In order

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to succeed on this claim, opposer must establish that it is the prior user and that contemporaneous use of the parties' respective marks on their respective goods and/or services would be likely to cause confusion, mistake or to deceive consumers. 15 U.S.C. §1052(d). In view of opposer's pleaded registrations which were made of record, priority is not an issue in this proceeding. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Moreover, applicant, in its answer, has admitted opposer's prior use.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

We first address opposer's argument and supporting evidence that its "WORLD GYM" marks are famous. "[T]he fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident." *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002). Opposer's testimony and evidence show that opposer started offering its gymnasium

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services in 1977 (Uretz Decl. ¶5); opposer began its licensing program in 1981 for use of the mark WORLD GYM in connection with gymnasiums which has expanded to more than 220 affiliated gyms and fitness centers today and hundreds of thousands of members throughout the United States (id. ¶¶ 7, 9); opposer licenses various forms of the mark WORLD GYM for use on a wide variety of goods, including sweat pants, shorts, jackets, t-shirts, hats, sneakers, baby clothes, bags, key chains, and water bottles (id. Ex Nos. 16-37); sales of the WORLD GYM clothing items "have been extensive, totaling many millions of dollars" (id. ¶ 19); the clothing items have been sold in K-Mart and advertised nationally by K-Mart in major newspapers (id. ¶ 20, Ex. No. 18); opposer distributes publications such as WORLD GYM MAGAZINE and WORLD GYM INSIDER targeted at gym owners, gym members and the general public which include advertisements for opposer's products, including clothing, for which opposer licenses its WORLD GYM marks (id. ¶ 26); opposer maintains the quality of its products and services by conducting in-person inspections, business seminars and training workshops for the operators of its facilities (id. ¶¶ 29, 30); promotional uses of the WORLD GYM marks include "Lead Boxes" displayed in various retail outlets, publicity placements in national magazines, radio and television advertising, advertisements in local newspapers and flyers, celebrity

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endorsements, display on the gymnasiums, fitness centers and clothing, on its website, and in a feature film (id. ¶¶ 42-52); and opposer owns registrations for various WORLD GYM marks in connection with fitness center services, clothing, magazines, posters and informational brochures (id. ¶¶ 33-39).

While the record shows the increasing popularity of the gym in terms of the expansion of the franchise, opposer has not provided actual sales figures, advertising expenditures, or evidence of the extent of the advertising (e.g., which markets, how frequently the advertisements appear, over what time period). While Mr. Uretz states that "World Gym is and has for some time been the third largest group of gyms and fitness centers in the United States," his only support for this statement is an excerpt from the April 1999 issue of CBI (apparently a magazine published by the International Health, Racquet & Sportsclub Association) which includes a ranking of the number of clubs owned by a particular company as of 1998. (Id. ¶ 53, Ex. No. 46). This ranking has very limited probative value inasmuch as it provides information as to ranking for only one year and it is also an incomplete list as indicated by the footnote attached to the ranking that clarifies that a number of chains did not provide data. With respect to its advertising efforts, Mr. Uretz states that an example of marketing the services "include[s] use of

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a "Lead Box" which is intended to be placed at a variety of busy retail outlets as a form of advertising." Uretz Decl. ¶ 44. Opposer has not shown in how many stores, where in those stores or for how long these lead boxes have been placed; thus, we cannot determine the extent to which consumers have been exposed to the mark in this manner. Similarly, although opposer states it has advertised on radio and television, opposer has provided only a listing of television and radio "publicity placements" in New York for January -August of 1994. There is not enough in the record to establish a sustained and continuing advertising program. With regard to advertising expenditures, opposer merely states that "Many of the local facilities place ads in newspapers or distribute flyers, and this has been done in local publications throughout the country. Because much of the advertising is placed on the local level, total advertising expenditures are unknown to me, but are very substantial." Uretz Decl. ¶ 48. This vague statement by Mr. Uretz that he does not know the numbers but they are substantial, is inherently inconsistent and of very little probative value. With regard to mentions in the press, Mr. Uretz gave only two examples and then stated without documentary support, "The recent passing of World Gym's founder, Joe Gold, resulted in substantial nation-wide mentions in the press of World Gym." Uretz Decl. ¶ 46.

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With regard to the merchandising associated with the gyms, and, in particular, clothing items, opposer's president, Mr. Uretz, states that its apparel is "sold not only at WORLD GYM facilities but also at other retail outlets throughout the United States" and "sales of these types of products have been extensive, totaling many millions of dollars" including "general merchandise stores throughout the United States, such as K-Mart." Uretz Decl. ¶¶ 19, 20. There is nothing else in the record to establish the actual volume of sales of the clothing, over what time period these sales were made, or if the sales are increasing or decreasing.

As stated by the Board in *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d 1811, 1819 (TTAB 2005), "In view of the extreme deference that is accorded to a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, we think that it is the duty of a plaintiff asserting that its mark is famous to clearly prove it." On this record, we cannot say that opposer has provided sufficient evidence about the extent of its use of the mark, or its sales under the mark such that we can conclude that any of opposer's WORLD GYM marks can be considered a famous mark. See *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

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However, although we have found that the record is insufficient to support a finding of fame, in view of the evidence we do have of public exposure to the WORLD GYM marks in connection with the gym and fitness centers and the clothing, coupled with the lack of evidence of third-party use of the terms WORLD or WORLD GYM, we find that WORLD GYM is a strong mark with some renown.

We turn now to the two key considerations in any likelihood of confusion analysis; the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

As noted above, opposer is relying on several registrations. However, we will concentrate our analysis on Reg. No. 2268311 because the goods in that registration are most similar to applicant's.

The shirts, pants, shorts and jackets identified in the application and registration are legally identical. In addition, several of the remaining goods are related, e.g., t-shirts and sweat suits. As to the parties' channels of trade, inasmuch as there are no limitations in the identification of goods in the application and registration, we presume an overlap in trade channels and that the goods

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would be offered to all normal classes of purchasers. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992). In addition, the parties' goods are relatively inexpensive and would be purchased without a great deal of care by ordinary consumers from the general public.

Applicant's argument that it "has never marketed or sold athletic, exercise, or fitness apparel," and "has never marketed or sold its apparel to sporting goods stores, gyms, fitness centers, or other physical exercise oriented customers or markets" (br. p. 6), is not persuasive. We must consider the goods as they are described in the application and registration and we cannot read limitations into those goods. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987). Further, as noted above, we must deem the goods to be sold in all channels of trade that are appropriate for the goods as they are identified in the application.

In view of the above, the du Pont factors of the similarity of the goods, the channels of trade, and conditions under which consumers purchase these goods favor a finding of likelihood of confusion as to Reg. No. 2268311.

We now turn to the first du Pont factor, i.e., whether applicant's mark and opposer's mark are similar or

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dissimilar when compared in their entireties in terms of appearance, sound, connotation and commercial impression. We make this determination in accordance with the following principles. The test, under the first du Pont factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Finally, "[w]hen marks would appear on virtually identical goods or services, the degree of similarity [between the marks] necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), cert denied, 506 U.S. 1034 (1992).

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We recognize that there are certain differences in the appearance of the parties' marks in view of the design portion of applicant's mark which includes the wording EUNICE U.S.A., and the gorilla and globe design in opposer's mark. However, the slogan THE WORLD IS OUR GYM is visually much more prominent than the portion of applicant's mark in which the words EUNICE U.S.A. blend into the design, and appear to be more in the nature of a house mark, with the more prominent slogan operating as a secondary mark. Because of the prominent visual appearance of THE WORLD IS OUR GYM, it is likely that consumers will use this phrase, rather than the visually smaller EUNICE U.S.A., to call for or refer to applicant's goods. Similarly, we find that the words WORLD GYM, rather than the design elements, are the dominant part of opposer's mark inasmuch as it is by the words that consumers will call for the goods. In re Appetito Provisions Co. Inc., 3 USPQ2d 1553, 1554 (TTAB 1987). Therefore, the dominant elements of each mark, WORLD GYM and THE WORLD IS OUR GYM, are entitled to the most weight in our analysis under the first du Pont factor. See In re National Data Corp., supra. These elements are visually and phonetically similar, and are similar in connotation and commercial impression as well, with WORLD GYM and THE WORLD IS OUR GYM both conveying the idea of a global gym. Further, because of this similarity of

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connotation, consumers are likely to view THE WORLD IS OUR GYM as a variation on opposer's WORLD GYM mark, and to believe that both these marks, when used on identical and closely related clothing items, indicate goods emanating from a single source.

We are not persuaded by applicant's argument that the words WORLD and GYM are weak terms and "not likely to be perceived by purchasers as distinguishing as to source." Br. p. 13. Although we recognize that the word GYM has a descriptive significance for clothing used for exercise and, indeed, opposer's registration contains a disclaimer of this word, the record establishes the strength of opposer's WORLD GYM mark. As noted previously, there is no evidence of third-party use of the term WORLD for clothing.

In view of the above, we find, that the parties' marks are similar, and that this du Pont factor favors opposer.

We conclude that the evidence of record as it pertains to the relevant du Pont factors supports a finding of likelihood of confusion as to the mark in opposer's Reg. No. 2268311.

Finally, to the extent there is any doubt on the issue of likelihood of confusion, such doubt must be resolved in favor of the prior registrant and against the newcomer. *Hewlet-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1003 (Fed. Cir., 2002) ("This court resolves

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doubts about the likelihood of confusion against the newcomer because the newcomer has the opportunity and obligation to avoid confusion with existing marks"). The equities clearly require us to follow that presumption in this case, where applicant has only an intention to use its mark, and opposer has been using its mark for many years prior to applicant's filing date.

In view of our determination that applicant's mark is likely to cause confusion with opposer's Registration No. 2268311, we need not consider the likelihood of confusion claim with respect to opposer's other registrations. Further, in view of our decision with regard to the likelihood of confusion claim, we need not reach the claim of dilution under Trademark Act §43(c).

Decision: The opposition is sustained on the basis of likelihood of confusion under Section 2(d) of the Trademark Act.