

THIS OPINION
IS NOT A PRECEDENT
OF THE TTAB

Date: July 31, 2007

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Innovative Fitness Consultants Inc.

v.

Michael A. Rickett

Opposition No. 91157339
to application Serial No. 76202180
filed on January 31, 2001

Douglas T. Johnson of Miller & Martin PLLC for Innovative
Fitness Consultants Inc.

Erik M. Pelton for Michael A. Rickett.

Before Hohein, Walsh and Taylor,
Administrative Trademark Judges.

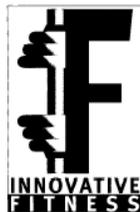
Opinion by Taylor, Administrative Trademark Judge:

Applicant has filed an application to register the mark
INNOVATIVE FITNESS and design, shown below,



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for "physical fitness and food nutrition instruction; physical education services; teaching in the fields of physical fitness and nutrition; training in the use of weightlifting, physical fitness and sports training equipment" in Class 41.¹ Registration has been opposed by Innovative Fitness Consultants Inc. on the ground of priority of use and likelihood of confusion with its previously used mark, shown below as it appears in the record.



Opposer specifically alleges that it provides fitness related services in the United States and Canada, including personal fitness training and lifestyle management services in the nature of physical fitness consultations, and that long prior to the filing date of the opposed application, and since at least 2000, Opposer and its predecessors in title have continuously and extensively advertised, promoted and offered fitness related services in interstate and foreign commerce in connection with opposer's distinctive IF INNOVATIVE FITNESS mark ("IF mark"). Opposer further

¹ Serial No. 76202180, filed on January 31, 2001, and claiming January 1, 1992 as the date of first use of the mark anywhere and

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alleges that it is the owner of the IF mark in at least those territories where it has used the mark and may reasonably expand its use by virtue of its undisputed use of the mark in connection with fitness related services since as early as 1995; that while Applicant claims use of its INNOVATIVE FITNESS and design mark since 1992, any such use was geographically remote from and unknown to opposer either actually or constructively prior to the January 31, 2001 filing date of application Serial No. 76202180; and that Applicant's use of its INNOVATIVE FITNESS and design mark is substantially limited to the state of Colorado.

Applicant, in its answer, admits that "Applicant's mark and Opposer's mark are likely to create confusion, mistake or to deceive the public which [sic] used in connection with the relevant services,"² but otherwise denies the salient allegations of the notice of opposition.

THE RECORD

The record consists of the pleadings; the file of application Serial No. 76202180; the testimony deposition, with Exhibits 1-30, of Jeff Sharpe, Opposer's president and CEO; Opposer's notice of reliance on Applicant's first supplemental response to Opposer's interrogatories, nos. 7, 41, and 42 together with Applicant's first supplemental

in commerce. The word "FITNESS" has been disclaimed.

² Answer at paragraph 9.

response to Opposer's first request for production of documents, No. 15³; and the testimony deposition, with Exhibits A-D, F, and Y-Z, of Applicant, Michael A. Rickett.

FINDINGS OF FACT

Opposer

Opposer, Innovative Fitness Consultants Inc. ("ICF"), is one of the largest personal training companies in North America. Opposer commenced use of its IF INNOVATIVE FITNESS mark in connection with providing personal fitness and lifestyle management services in Vancouver, British Columbia Canada in 1995. (Sharpe test., pp. 7 and 9). Opposer opened its first facility in 1997 in Vancouver. (Sharpe test., pp. 7-8). Opposer expanded its fitness training services in 2000 to Bellevue, Washington and later to San Rafael, California. The opening of the facility in Bellevue, Washington was on August 1, 2000. (Sharpe test., p. 13). All of Opposer's fitness facilities include the "INNOVATIVE FITNESS name" in the exterior signage, and the interior signage displays the "INNOVATIVE FITNESS name and

³ While these documents (i.e., copies of Applicant's Federal Income Tax returns for the years 1999-2002) are not proper subject matter for introduction by notice of reliance, inasmuch as applicant did not object to their submission, we will treat the material as being stipulated into the record for whatever probative value it may have. See *Jeanne-Marc, Inc. v. Cluett, Peabody & Co.*, 221 USPQ 58, 59 n. 4 (TTAB 1984).

logo."⁴ (Sharpe test., pp. 31-32 and Exh. 13). Promotional efforts include, *inter alia*, brochures distributed through IFC facilities and to IFC customer families, friends, associates, and local businesses and corporate offices (Sharpe test., pp. 14-15); and complimentary training cards, water bottles, T-shirts, fitness related activities and newsletters distributed to clients, coffee shops and local recreation and community centers. (Sharpe test., pp. 19-20, 22, 23, 28 and 37). Opposer also sponsors charitable fundraising activities, which commenced in Washington State in late-2000. (Sharpe test., pp. 20-21). Opposer also established a web site in 1999, which is the source of many of Opposer's promotions and its newsletter. (Sharpe test., p. 24-25, 27). Opposer is also the recipient of third-party publicity, both early in its operation and with the later affiliation of Jeff Garcia (the former San Francisco 49ers quarterback)⁵ with the company in connection with the 2003 opening of the San Rafael, California facility. (Sharpe test., pp. 29, 30, 40-42 and Exh. 10, 11 and 28).

⁴ It is evident from Exhibit No. 13 that Mr. Sharpe is referring to the pleaded IF INNOVATIVE FITNESS mark with regard to both the exterior and interior signage.

⁵ At the time the Sharpe deposition was taken, Mr. Garcia apparently was the 49ers quarterback.

Applicant

Applicant is a fitness service provider whose business consists of personal training, providing continuing education for certified professionals and certifying new prospective personal trainers, aerobic instructors and fitness professionals. (Rickett test., p. 6). Applicant first used the name "Innovative Fitness" and INNOVATIVE FITNESS word mark in connection with his fitness business in January of 1992 when he started working with Healthworks Fitness Club in Fort Collins, Colorado. (Rickett test., p. 6). Applicant promotes his business using the "brand name" Innovative Fitness with business cards⁶, brochures and through a network of personal referrals. (*Id.*). The mark appearing on the brochures is as follows:



(Rickett test, Exhs., A and B). Applicant's business grew steadily from 1993 to 1997 and in 1997, he began traveling to other states as a result of the Innovative Fitness

⁶ Although applicant did not make a copy of his business cards of record, he describes the information on the business cards as "just the logo of the fitness figure that has got the I and the F, and it says Innovative Fitness." (Rickett test., p. 23). Applicant, after viewing exhibit A, stated "[t]hat's what it looks like." (*Id.*)

business. (Rickett test., p. 7). The purpose of the out-of-state travel was to participate in the American Aerobic Association International ("AAAI") and International Sports Medicine Association ("ISMA") conferences - also referred to as World One conferences and other fitness conferences as an instructor or promoter or evaluator. Since 1997, Applicant has participated in 25 to 30 of these fitness conferences a year and "go[es] or promote[s] probably another 5 to 10 each year." (Rickett test., p. 10). Applicant is, and has been since 1997, identified in conference brochures as president of Innovative Fitness. (Rickett test., p. 9 and Exhs. D and Z). Applicant has submitted a sample invoice to AAAI for payment for participation in the AAAI's fitness conferences. Applicant's INNOVATIVE FITNESS and design mark shown on the invoice of record is as follows:



INVOICE

(Rickett test., Exh. Y). Applicant also uses the INNOVATIVE FITNESS and design mark on a web site. When asked when he first created his web site, applicant responded:

That was -- let me find the exact date here. It was in 1999, I'm thinking. The exact date was -- the actual launching was in 2000, but the actual put together and the trial of this was probably October 1999. The actual on-line was 2000.

(Rickett test., p. 12). Applicant's INNOVATIVE FITNESS and design mark, as it appeared on the front page of the web site on March 18th, 2002 is as follows:⁷



(Rickett test., p. 12 and Exh. C).

PRELIMINARY MATTER

During the testimony deposition of Michael Rickett, Opposer objected to the introduction of Exhibit Z, consisting of a letter from the President of AAAI (American Aerobics Association), on hearsay grounds. Inasmuch as Opposer did not maintain its objection in its brief, it is considered waived and we have considered Exhibit Z in this decision. See *Hard Rock Café International (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1507 n. 5 (TTAB 2000); and *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1126 n. 4 (TTAB 1990).

⁷ Applicant indicates that this is the "general presentation" that the web site has maintained since its creation in 1999. (Rickett test., pp. 13-14).

ANALYSIS

Standing

An opposer must have "a 'real interest' in the outcome of a proceeding in order to have standing." *Richie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). The evidence of record shows that Opposer is the source of fitness related services with which it uses its IF INNOVATIVE FITNESS and design mark. We find this fact, together with the fact that Opposer's likelihood of confusion claim is not frivolous satisfies the requirements for standing in this case. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Likelihood of Confusion

Likelihood of confusion has been admitted by Applicant in his answer at paragraph 9. Additionally, the parties, in their briefs, agree that their disputed marks are confusingly similar when used in connection with the parties' respective physical fitness services.

Priority

To establish priority on a likelihood of confusion claim brought under Trademark Act § 2(d), a party must prove that, vis-à-vis the other party, it owns "a mark or trade name previously used in the United States ... and not abandoned...." Trademark Act Section 2, 15 U.S.C. § 1052. A party may establish its own prior proprietary rights in a

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mark through ownership of a prior registration, actual use or through use analogous to trademark use, such as use in advertising brochures, trade publications, catalogues, newspaper advertisements and Internet websites which create a public awareness of the designation as a trademark identifying the party as a source. See Trademark Act §§ 2(d) and 45, 15 U.S.C. Section 1052(d) and 1127; *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996), *vacating Pactel Teletrac v. T.A.B. Systems*, 32 USPQ2d 1668 (TTAB 1994). Priority is an issue in this case because Opposer does not own an existing registration upon which it can rely under § 2(d). See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

The record is clear that opposer first used its IF INNOVATIVE FITNESS and design mark in the United States upon the opening of its Bellevue, Washington location on August 1, 2000. Applicant contends that he first used the INNOVATIVE FITNESS and design mark, which is the subject of the application, in 1992 and first used the mark in interstate commerce in 1997. Opposer, on the other hand, argues that Applicant did not use the INNOVATIVE FITNESS and design mark in the style that is the subject of the present application until sometime in the year 2000, and essentially that, on this record, Applicant can only claim January 31,

2001, the filing date of his application, as his date of first use. Consequently, opposer asserts that it has priority.

Although, as noted above, Applicant asserts first use of his applied-for mark in 1992 (and first use of his mark in interstate commerce in 1997), there is no proof of any use of that mark in the record. Accordingly, the earliest date upon which Applicant can rely for purposes of priority, absent tacking, is the filing date of his application, i.e., January 31, 2001, a date that is subsequent to Opposer's August 1, 2000 first use date.⁸ Section 7(c) of the Trademark Act, 15 U.S.C. § 1057(c). See *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1428-29, n. 13 (TTAB 1993); and *Brewski Beer Co. v. Brewski Brothers Inc.*, 47 USPQ2d 1281, 1284 (TTAB 1998). We therefore presume that Applicant's claim of priority is based on his earlier use of the word mark and business name INNOVATIVE FITNESS and/or his previous INNOVATIVE FITNESS and design marks, and that Applicant attempts to defeat

⁸ We feel compelled to note that the specimen of record was taken from Applicant's web site, but obviously is a different page than that submitted as Exhibit C to Applicant's testimony deposition. Even if we were to consider the specimen in use as early as "2000," the date attested to by Applicant as the launching date of his web site, given the indefiniteness of 2000, applicant's first use date of the specimen for purposes of priority would have been December 31, 2000, also a date subsequent to opposer's first use date. See generally, TBMP § 903.07.

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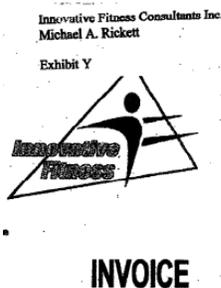
Opposer's claim of priority by "tacking" on such earlier use. We find, however, that Applicant is not entitled to tacking in this case.

"Tacking" (for priority purposes) of a party's use of an earlier mark or name onto its use of a later mark or name is permitted only in rare circumstances, and only where the applied-for mark is "the same mark" as the ones previously used. That is, whether the applied-for mark and the previous marks/names are "legal equivalents," i.e., whether they create the same, continuing commercial impression such that the consumer would consider all of the marks as the same mark. See *Van Dyne-Crotty Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 USPQ2d 1866 (Fed. Cir. 1991); *Ilco v. Ideal Security Hardware Corp.*, 527 F.2d 1221, 188 USPQ 485 (CCPA 1976); and *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048 (TTAB 1992).

To meet the legal equivalents test, the marks must be indistinguishable from one another or create the same, continuing commercial impression such that the consumer would consider all of the marks as the same mark. See *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001) (reversed on other grounds); and *Compania Insular Tabacalera, S.A. v. Camacho Cigars, Inc.*, 167 USPQ 299 (TTAB 1970). A minor difference in the marks such as mere pluralization or an inconsequential

modification of a later mark will not preclude application of the rule. See *In re Loew's Theatres, Inc.*, 223 USPQ513 (TTAB 1984) aff'd, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985); and *In re Flex-O-Glass, Inc.*, 194 USPQ 203 (TTAB 1977). At the same time, however, it is clear that the "legal equivalents" standard is considerably higher than the standard for "likelihood of confusion." Thus the fact two (or more) marks may be confusingly similar does not necessarily mean that they are legal equivalents. *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, *supra*.

In this case, we find that Applicant's earlier used INNOVATIVE FITNESS word mark and/or name is not the legal equivalent of his applied-for mark because the involved mark contains a distinctive design element. We further find that Applicant's previously used INNOVATIVE FITNESS and design marks, shown below,



are not the "same" as the mark which is the subject of this proceeding, shown below,



because the change in the design results in a material alteration of Applicant's earlier design marks.

A material alteration exists if the old and new formats do not create the same general commercial impression. See J. Thomas McCarthy, 3 McCarthy on Trademarks and Unfair Competition §§19:58:50 and 19:133 (4th ed. 2007). Here, the positioning of the words "Innovative Fitness" on the right side of the stylized fitness figure, as opposed to the left side, and the addition of the visually prominent swoosh, reminiscent of a fitness ribbon and extending from a point between the legs of the stylized fitness figure and continuing past the word component, and on which the word "Fitness" is superimposed, constitutes a material alteration of the designs previously used by Applicant, as the swoosh and word placement are integral components of Applicant's involved INNOVATIVE FITNESS and design mark. See, e.g., *In re CTB Inc.*, 52 USPQ2d 1471 (TTAB 1999) (The applicant sought to change its special form mark from



to standard character form, TURBO, thus deleting the swirling design element, which was determined to be "an essential part of the original mark and hence 'integrated' into the composite"); and *In re Dillard Department Stores*, 33 USPQ2d 1052 (Comm'r 1993) (the registrant sought to change, by post publication amendment, its mark from



to



but the Commissioner determined that the mark, as registered, clearly contained "salient design features apart from the word portion" and that, particularly in view of the goods involved (clothing items), "the syllabication and unique layout could lead someone to view the mark as a play on the terms 'in' and 'vestments'.").⁹ In view of the

⁹ But see, for example, *In re 1175856 Ontario Ltd.*, 81 USPQ2d 1446 (TTAB 2006) (Applicant sought to register the mark

 , but the mark appeared in the specimens of record as . The Board found that the removal of a curved design from the mark was not a mutilation or an incomplete representation of the mark actually used, since the letters "WSI" and the globe design created a separate and distinct commercial impression and not an impermissible mutilation.). The curve design in that case was neither visually dominant nor an integral part of the remaining design.

foregoing, we find that none of Applicant's earlier used INNOVATIVE FITNESS marks (with or without a design element) are legal equivalents of his applied-for mark.¹⁰

In sum, because the earliest date upon which Applicant can rely for purposes of priority is the filing date of his application, and given that Applicant is not entitled to tack on its earlier use of the INNOVATIVE FITNESS word mark and/or other INNOVATIVE FITNESS and design marks, priority rests with Opposer. As previously indicated, applicant admitted in his answer that confusion is likely.

¹⁰ Opposer also argues at length that even if Applicant is found to have priority, Opposer is at least an "immediate junior user" and, therefore, Applicant is not entitled to an unrestricted registration. Opposer also contends that "whether the words 'previously used' in Section 2(d) of the Lanham Act refer to an absolute priority between the parties, or instead refer to previous use with respect to the filing date of the application" is an issue of "first impression" in this case.

In inter partes proceedings before the Board where the plaintiff asserting a Section 2(d) claim does not own a registration, the Section 2(d) priority test is not whether the plaintiff's unregistered mark or trade name was "previously used" as of the defendant's application filing date, but rather whether it was "previously used" as of the earliest date on which the defendant can rely for priority purposes. See, e.g., *American Security Bank v. American Security and Trust Co.*, 571 F.2d 564, 1997 USPQ 65, 66 (CCPA 1978); *Corporate Document Services Inc. v. I.C.E.D. Management Inc.*, 48 USPQ2d 1477 (TTAB 1998); and *Intersat Corp. v. International Telecommunications Satellite Organization*, 226 USPQ 154, 156 n.5 (TTAB 1985).

Further, while Section 2(d) governs a party's entitlement to concurrent registration with a substantially similar mark under certain conditions and limitations, entitlement to such concurrent use registration is determined by the Board solely within the context of a concurrent use proceeding. See generally, TBMP § 1100 et. seq and the authorities cited therein.

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