

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Mad Dogg Athletics, Inc.
v.
Wen Cheng Hsieh

Opposition No. 91164860
to application Serial No. 78349982
filed on January 9, 2004

Konrad K. Gatien of Keats McFarland & Wilson LLP for Mad
Dogg Athletics, Inc.

Edward A. Sokolski, Esq. for Wen Cheng Hsieh.

Before Quinn, Hairston and Taylor, Administrative Trademark
Judges.

Opinion by Hairston, Administrative Trademark Judge:

Wen Cheng Hsieh (Applicant) seeks registration on the
Principal Register of the mark shown below,

SPNERGY

for goods ultimately identified as "exercise equipment,
namely, stationary cycles."¹

¹ Application Serial No. 78349982, filed on January 9, 2004,
which is based on a bona fide intention to use the mark in
commerce.

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Registration has been opposed by Mad Dogg Athletics, Inc. (Opposer). Opposer alleges that it is the owner of the mark SPINNER for stationary exercise bicycles and goods and services used in connection therewith; that it markets its stationary exercise bicycles and related goods and services under the "SPINNER brand family of trademarks" (Notice of Opposition, Paragraph No. 2); that it has expended substantial time, effort and financial resources to develop and protect its SPINNER brand family of trademarks; that as a result, its SPINNER brand family of trademarks enjoys wide popularity among consumers and is associated with high-quality goods and services; and that applicant's SPNERGY mark, when applied to applicant's goods, so resembles opposer's SPINNER brand family of trademarks for stationary exercise bicycles and related goods and services, as to be likely to cause confusion.² Opposer pleaded ownership of the following registrations: Registration No. 1972363, issued May 7, 1996 (renewed), for the mark SPINNER for "exercise equipment in the nature of stationary exercise bicycles and accessories, and weight training machines;"

² Opposer also alleged in the notice of opposition that registration of applicant's mark "will dilute the distinctiveness of [o]pposer's SPINNER brand family of trademarks." (Paragraph No. 13). However, opposer did not allege in the opposition that its SPINNER brand family of trademarks became famous prior to the filing date of applicant's intent-to-use application. See *Toro Co. v. Torohead, Inc.*, 61 USPQ2d 1164 (TTAB 2001). Accordingly, opposer did not properly plead a dilution claim in this proceeding. Under the circumstances, we will treat the opposition as setting forth a Section 2(d) claim only.

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Registration No. 1780650, issued July 6, 1993 (renewed,) for the mark SPINNING for "providing training and instruction to others by simulating an outdoor bicycle workout completed indoors on a stationery [sic] bicycle;" Registration No. 2003922, issued October 1, 1996 (renewed), for the mark SPINNING for, inter alia, "exercise equipment in the nature of stationary exercise bicycles and weight training machines;" Registration No. 2173202, issued July 14, 1998 (Affidavits under Sections 8 and 15 accepted and acknowledged), for the mark SPIN for "stationary exercise bicycles" and "physical fitness instruction;" and Registration No. 2296323, issued November 30, 1999 (Affidavits under Sections 8 and 15 accepted and acknowledged), for the mark SPINCIRCUIT for, inter alia, "exercise equipment, namely, stationary exercise bicycles and weight lifting machines."³

Applicant, in his answer, admitted that opposer markets its goods and services under the SPINNER brand family of trademarks, and that opposer owns the pleaded registrations. Applicant denied the remaining salient allegations in the notice of opposition.

³ Opposer also pleaded ownership of Registration No. 2375582, issued August 8, 2000, for the mark SPINGYM for "exercise equipment, namely, stationary exercise bicycles and weight lifting machines." However, USPTO records show that this registration was cancelled on May 12, 2007 under the provisions of Section 8 of the Trademark Act. Thus, we have given no consideration to this registration.

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Briefs have been filed.⁴ The record is summarized at page 7 of opposer's brief.⁵

Because opposer has properly made of record certified status and title copies of its registrations for its pleaded marks, we find that opposer has established its standing to bring the opposition.⁶ See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v Ralston Purina Co.*, 670 F.2d 1074, 213 USPQ 185 (CCPA 1982). In addition, in view of opposer's ownership of valid and subsisting registrations of its pleaded marks, there is no issue as to opposer's priority. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

As noted, opposer pleaded ownership of a "SPINNER brand family of trademarks" and applicant admitted that opposer markets its goods and services under this family of marks.

⁴ Applicant contends in his brief that opposer's SPINNER mark is descriptive. Such a contention constitutes an impermissible collateral attack on opposer's pleaded registration for this mark. In the absence of a counterclaim for cancellation, this argument cannot be considered. See Trademark Rule 2.106(b)(ii) and TBMP §313.01 (2d ed. rev. 2004) and cases cited therein.

⁵ Opposer states in its brief at p. 8, n. 2 that "by letter agreement", the parties stipulated to the submission of testimony by affidavit. Thus, in reaching our decision herein, we have considered the affidavits submitted by opposer, notwithstanding that a stipulation was not filed with the Board. We note that applicant did not object to opposer's submission of testimony by affidavit, nor did he take testimony or submit any other evidence.

⁶ Opposer submitted certified status and title copies of its pleaded registrations with the affidavit of its president, John Baudhuin.

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As the Board stated in *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991):

A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be a recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods.

In the present case, opposer made of record registrations for the marks SPINNER, SPINNING, SPIN, and SPINCIRCUIT and introduced evidence with respect to its use of these marks. It is readily apparent, however, that these marks do not have SPINNER as a common feature or family "surname." Thus, notwithstanding applicant's admission, opposer's claim of a SPINNER brand family of trademarks for its goods and services must fail. Moreover, opposer's brief focuses on likelihood of confusion vis-à-vis its SPINNER mark for stationary exercise bicycles and applicant's SPNERGY mark for exercise equipment, namely, stationary cycles. In view thereof, and because opposer's SPINNER mark is the most pertinent of its marks, we will do the same. Thus, the question of likelihood of confusion in this case turns on whether applicant's SPNERGY mark so resembles

opposer's SPINNER mark as to be likely, when used on the respective goods, to cause confusion.⁷

Our determination of the issue of likelihood of confusion 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 & 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). The du Pont factors deemed pertinent to this proceeding are discussed below.

The first factor we consider is the relatedness of the parties' goods. We observe that the "stationary exercise bicycles" identified in opposer's pleaded registration for the mark SPINNER and the "exercise equipment, namely, stationary cycles" in applicant's application are legally identical for purposes of our likelihood of confusion determination. This factor weighs in opposer's favor.

Further, in the absence of any limitations in the parties' identifications of goods, we must presume that the goods move through all reasonable channels of trade for such goods to all usual classes of consumers for such goods. *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). Thus, it must be

⁷ In view thereof, we need not determine whether opposer owns a family of marks with SPIN as the common feature.

presumed that the parties' goods will be sold by distributors of exercise equipment, and retailers like sporting goods stores and health and fitness products stores. Indeed, the evidence shows this to be the case for both parties' goods.⁸ Likewise, it is presumed that the goods will be purchased not only by health and fitness clubs, but ordinary consumers exercising nothing more than ordinary care in their purchasing decision. The factors of similar trade channels and classes of purchasers also weigh in favor of opposer.

The next du Pont factor is fame, because fame of the prior mark, if it exists, plays a dominant role in likelihood of confusion cases. *Recot, Inc. v. M. C. Becton*, 214 F.3d 1322, 54 USPQ 1894 (Fed. Cir. 2000). Opposer argues that its SPINNER mark for stationary exercise bicycles is a famous mark entitled to a broad scope of protection. Opposer sells its SPINNER stationary exercise bicycles throughout the United States and worldwide. Opposer and its licensees sold an average of 40,000 SPINNER stationary exercise bicycles in each of the years 2003, 2004, and 2005 to realize gross revenues of approximately \$25,000,000 per year. Opposer's sales of SPINNER stationary

⁸ Although applicant's application is based on an intent to use the mark in commerce, applicant stated in response to an interrogatory that he began use of his SPNERGY mark in November 2004.

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exercise bicycles are unmatched by any of its competitors, with its closest competitor selling approximately 15,000 stationary exercise bicycles each year. Opposer's evidence on fame also includes its advertising expenditures. Opposer spent approximately \$1,000,000 for each of the years 2003, 2004, and 2005 advertising and promoting its goods and services. Opposer has placed advertisements and promotions in virtually every type of media throughout the United States and worldwide. Further, opposer has exhibited and promoted its SPINNER stationary exercise bicycles at the leading health and fitness trade shows throughout the United States and worldwide. Based on this evidence, we find that the SPINNER mark is indeed well known and a strong mark in the field of stationary exercise bicycles. However, we cannot conclude on this record that the SPINNER mark is a famous mark. Thus, we find that the factor of the strength of the mark favors opposer, but not to the extent that it would if the mark were truly famous.

The next du Pont factor we consider is the similarity or dissimilarity of the marks when compared in their entirety in terms of appearance, sound, connotation and commercial impression. In doing so, we are mindful of the proposition that when marks appear on identical or closely related goods, the degree of similarity of the marks necessary to support a finding of likelihood of confusion is

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not as great as when the goods are different. See *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

Further, the test under this 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. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Comparing the marks first in terms of sound, we find that it is very likely that purchasers will pronounce applicant's SPENERGY mark as "spinnergy" which is quite similar to the way opposer's SPINNER mark is pronounced. With respect to appearance, we note that because opposer's SPINNER mark is registered in the form of a typed drawing, the depiction thereof is not limited to a particular manner of display. See, e.g., *Phillips Petroleum Co. v. C.J. Webb, Inc.*, 442 F.2d 1376, 170 USPQ 35 (CCPA 1971). The registration therefore covers the use of the SPINNER mark by opposer in any reasonable style of lettering, including the bold and slanted manner in which applicant depicts its SPENERGY mark. In terms of connotation, because opposer's mark consists of the term SPINNER and applicant's SPENERGY

mark is very likely to be pronounced as "spinergy," we find that the marks have similar connotations, that is, something that spins.⁹ In view of the above similarities between the marks SPINNER and SPNERGY in terms of sound, appearance and connotation, the overall commercial impressions conveyed by the marks are similar as well. Such similarities are therefore a du Pont factor which favors opposer.

As to the du Pont factor of the length of time during and conditions under which there has been "concurrent use" without evidence of actual confusion, the record is clear that neither opposer nor applicant is aware of any instances of actual confusion with respect to the marks at issue. Applicant argues that this fact is evidence that there is no likelihood of confusion. However, the absence of evidence of actual confusion may be explained by the fact that applicant has limited sales of his SPNERGY stationary exercise bicycles (\$175,000) over a short period of time (since November 2004). Thus, there has been limited opportunity for incidents of actual confusion to occur. The circumstances therefore have not been such that the absence

⁹ In this regard, we take judicial notice that the word "**spinner**" is defined as, inter alia, "[o]ne that spins." The American Heritage Dictionary (4th ed. 2006). The Board may take judicial notice of dictionary definitions. See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 312 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

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of any incidents of actual confusion can be said to be probative of a lack of a likelihood of confusion.

Given the identity of the goods, trade channels and purchasers, we find that applicant's mark SPNERGY is sufficiently similar to opposer's mark SPINNER that confusion is likely.

A final argument made by applicant requires comment. Applicant argues that the fact that the examining attorney allowed his mark for publication is evidence that his SPNERGY mark is not likely to cause confusion with opposer's SPINNER mark. It is well settled, however, that the Board is not bound by decisions of examining attorneys. See *Cineplex Odeon Corp. v. Fred Wehrenberg Circuit of Theatres Inc.*, 56 USPQ2d 1538 (TTAB 2000).

We conclude that purchasers familiar with opposer's stationary exercise bicycles offered under its mark SPINNER, would be likely to believe, upon encountering applicant's SPNERGY mark for the identical goods, that the respective goods originated with or were somehow associated with or sponsored by the same entity.

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