

Goodman

**THIS OPINION IS NOT  
A PRECEDENT OF  
THE T.T.A.B.**

**UNITED STATES PATENT AND TRADEMARK  
OFFICE**

**Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451**

Mailed: April 20, 2007

Opposition No. 91168719

Pat Barone

v.

Carol Goldberg

Before, Hairston, Drost and Walsh, Administrative Trademark Judges.

By the Board:

Applicant has filed an application to register the mark CATALYST COACHING in standard character form for "coaching services, namely providing advice, motivation, and skills training to develop, improve, and enhance work and success" in International Class 41.<sup>1</sup> As grounds for opposition, opposer has alleged that applicant's mark, when used in connection with the recited services, so resembles opposer's previously used CATALYST, CATALYST COACHING AND CATALYST WEIGHT MANAGEMENT marks for "coaching services, namely providing advice, motivation and skills training to develop, improve and enhance work and success" as to be likely to cause confusion, mistake, or to deceive.

---

<sup>1</sup> Application Serial No. 78594667, filed March 24, 2005; "coaching" disclaimed and claiming a date of first use in commerce of March 23, 2005.

In her answer, applicant denies the salient allegations in the notice of opposition.

This case now comes up on the following motions:

- 1) opposer's motion for summary judgment, filed October 10, 2006;
- 2) applicant's motion to amend the recitation of services, filed November 6, 2006, as part of her response to opposer's motion for summary judgment; and
- 3) opposer's motion to strike applicant's sur-reply, filed December 14, 2006.

Turning first to opposer's motion to strike, inasmuch as sur-replies are not provided for by the Trademark Rules, opposer's motion is granted. We have not considered applicant's filing dated December 7, 2006.<sup>2</sup>

We now turn to opposer's motion for summary judgment.

A party is entitled to summary judgment when it has demonstrated that there are no genuine issues as to any material fact and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). In a motion for summary judgment, the evidentiary record and all reasonable inferences to be drawn from the undisputed facts must be viewed in the light most favorable to the nonmoving party. *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

---

<sup>2</sup> We also have not considered the document filed December 11, 2007, which seeks to correct an error in the sur-reply.

Turning first to standing, which opposer must establish to prevail, opposer has provided statements in her declaration averring to her use of the mark CATALYST COACHING in connection with coaching services. See Declaration of Pat Barone. Therefore we find no genuine issue as to opposer's standing.

Turning next to priority, since opposer has no application or registration for the mark at issue, she must establish common law priority to overcome applicant's constructive use priority date of March 24, 2005. See Section 7(c) of the Trademark Act.

With respect to priority, a flyer for weight loss coaching and weight management dated July 21, 2001 and an invoice dated July 25, 2001 establish prior use of the CATALYST COACHING mark in connection with weight loss coaching as early as July 2001. Yellow page advertisements from February 2004 and February 2005 establish Ms. Barone's use of the mark CATALYST COACHING in connection with life coaching services in the areas of fitness, life balancing, creativity, careers and sales; brochures and flyers dating from 2004 and 2005 (advertised seminar dates of February 10, 2004, February 3, 2005, and March 5-6, 2005) show use of CATALYST COACHING in connection with professional coaching services. Ms. Barone's continuous use of the CATALYST COACHING mark is shown by e-mails to clients in 2002 and

2003, marketing brochures and advertisements dated from 2004 and 2005, and yellow page advertisements for the years 2004, 2005, and 2006. We find that the evidence establishes opposer's prior and continuous use from at least as early as 2004 of the mark CATALYST COACHING for life coaching services in the areas of fitness, life balancing, creativity, careers and sales.

Applicant has made equivocal statements regarding her first use of the mark in discovery and elsewhere. These statements would be insufficient to raise a genuine issue with respect to priority. Applicant also makes the following statement in her brief: "[t]he Opposition's claim to priority of use is not being challenged by the Applicant as to the date of first use . . . ." The only reasonable inference we can make with respect to this statement is that applicant concedes the issue of priority. Therefore, we find that opposer's established first use date (at least as early as 2004) is earlier than the filing date of applicant's application which is the earliest date on which applicant can rely. Thus we find that there is no genuine issue that opposer has priority.

Turning next to the issue of likelihood of confusion, we are guided by the factors set forth in the case of *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). We are not required to consider every

*DuPont* factor but "need only consider those factors that are relevant and of record." *M2 Software Inc. v. M2 Communications Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006). In this case, the relevant factors are the similarity of the marks, the similarity of the services, and the similarity of the trade channels and classes of purchasers.

With respect to the similarity of the marks, we consider opposer's CATALYST COACHING mark as the most relevant. We find that the parties' CATALYST COACHING marks are identical in sound, connotation, appearance and commercial impression. Therefore, we find there is no genuine issue that the parties' marks are identical.

With respect to the relatedness of the services, we find that both parties provide related, if not identical, coaching services. The yellow page advertisements that accompany opposer's declaration establish that opposer provides "life coach" services in the areas of fitness, life balance, creativity, career and sales, which are highly similar to applicant's "coaching services, namely providing advice, motivation, and skills training to develop, improve, and enhance work and success." Although applicant has argued that her services are different because she is a licensed psychologist, she has provided no evidence to raise

a genuine issue. Therefore, we find no genuine issue that the parties' services are highly related, if not identical.

With respect to the similarity or dissimilarity of trade channels and classes of purchasers, we find that applicant's recited services and opposer's services are rendered in identical or at least overlapping trade channels and the classes of purchasers are identical. Although applicant has argued that "consumers seeking services from a licensed professional ... are not the same people who seek services of those without such credentials," she has submitted no evidence to raise a genuine issue with respect to the trade channels and classes of purchasers. Moreover, the recitation of services in applicant's application is unrestricted as to trade channels or classes of purchasers, and we must presume that the recited services are marketed in all normal trade channels for such services and to all normal classes of purchasers for such services. *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Therefore, we find no genuine issue of material fact exists as to channels of trade and classes of purchasers.

In summary, considering the identical marks, the identical or related nature of the services, the identical or at least overlapping trade channels, and the identical

classes of purchasers, we find that there are no genuine issues of material fact that confusion is likely to result.<sup>3</sup>

In view thereof, we find that opposer has carried her burden of proof and that no genuine issues of material fact remain as to opposer's standing, priority, or the ground of likelihood of confusion. Opposer's motion for summary judgment is granted, the opposition is sustained on the likelihood of confusion ground, and registration of applicant's mark is refused.

---

<sup>3</sup> Applicant's motion to amend the recitation of services is moot. However, even if we allowed the amendment, it would not have changed the result herein because we would nonetheless find that there is no genuine issue that "psychological coaching services, namely providing advice, motivation, and skills training to develop, improve, and enhance work and success" are related to opposer's coaching services.