

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application

Serial No.: 88/227050

Filing Date: December 12, 2018

Mark: MYYOGATEACHER

Classes: 009, 038, 041

Applicant: MyYogaTeacher, Inc.

TRADEMARK APPLICATION

Law Office: 121

Trademark Attorney: Geraldine Ingold

RESPONSE

Commissioner of Trademarks
PO Box 1451
Arlington, Virginia 22313-1451

Applicant MyYogaTeacher, Inc. (“Applicant”) hereby responds to the Office Action mailed on March 15, 2019 in the above-identified application. The Examining Attorney has refused registration of Applicant’s mark, MYYOGATEACHER, based on an alleged likelihood of confusion with the marks MYYOGA (U.S. Reg. No. 3,898,912), two marks for MY YOGA ONLINE (Reg. Nos. 4,493,348 and 4,493,349) and the mark MY YOGAWORKS (Reg. No. 4,414,713). In response to the Office Action, Applicant is deleting the identification of goods/services in Class 009, which eliminates any basis for refusal based on MYYOGA and MYYOGA ONLINE. In addition, as discussed below, there is no likelihood of confusion between MYYOGATEACHER and MY YOGAWORKS given the word “Teacher” is different in sound, meaning, and connotation than the term “Works.”

I. AMENDMENT OF GOODS AND SERVICES

Applicant requests that the Examining Attorney delete the existing identification in Class 009 (below) pursuant to Trademark Rule 2.71(a), 37 C.F.R. §2.71(a), "The applicant may amend the application to clarify or limit, but not to broaden, the identification of goods and/or services."

This rule applies to all applications.

Downloadable physical fitness and exercise instructional videos focusing on one-on-one or group yoga instruction; downloadable video recordings featuring one-on-one or group yoga and meditation instruction; downloadable one-on-one or group yoga and meditation instruction via the internet and wireless devices; downloadable software in the nature of mobile application that provides one-on-one or group yoga instruction.

Further, Applicant accepts the amendments proposed by the Examiner in Class 041.

Those amendments are noted in the response form.

II. THERE IS NO LIKELIHOOD OF CONFUSION WITH MYYOGA or the MY YOGA ONLINE & Design MARKS

Applicant submits that its application to register MYYOGATEACHER is not confusingly similar to MYYOGA, MY YOGA ONLINE or MY YOGA ONLINE & Design (Reg. Nos. 3,898,912; 4,493,348; 4,493,348). First, in light of the deletion of Class 009 from Applicant's application to register MYYOGATEACHER, the refusal to register the mark based on these prior registered marks is no longer proper. Applicant filed its application on an intent to use basis. In light of the refusal to register the mark in Class 9, Applicant abandons its intent to register the mark with the overlapping goods/services in the cited registration for MY YOGA and the MY YOGA ONLINE marks. The addition of the word "Teacher" also differentiates the Applicant's mark in sight, sound and meaning from the cited marks. Applicant respectfully requests that the refusal be withdrawn as it pertains to these prior registrations.

III. THERE IS NO LIKELIHOOD OF CONFUSION WITH MY YOGAWORKS & Design (Reg. No. 4,414,713)

The Examining Attorney is refusing registration of the mark MYYOGATEACHER alleging a likelihood of confusion with the mark MY YOGAWORKS (Reg. No. 4,414,713). Applicant asserts that there is no likelihood of confusion between MYYOGATEACHER and the cited mark based primarily on the two most relevant factors identified in *In re E.I. de Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973)—the marks as a whole are not similar in sound or appearance, and the services descriptions are sufficiently unrelated.

A. Difference In Sound and Appearance

“Similarity of the marks is tested on three levels: sight, sound, and meaning.” *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 351 (9th Cir. 1979). And, the marks must be compared “in their entirety in determining whether there is likelihood of confusion.” *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 1402 (C.C.P.A. 1974).

Applicant’s mark, MYYOGATEACHER, and registrant’s mark, MY YOGAWORKS, are different in sound and appearance when compared in their entirety. MYYOGATEACHER is a mark comprised of a combination of the terms “MY,” “YOGA,” and “TEACHER.” MY YOGAWORKS is a mark containing the terms “MY,” “YOGA,” and “WORKS.” These marks are both compound and the only shared term is “my” and “yoga”. Under the anti-dissection rule, conflicting marks are to be compared by looking at them as a whole, rather than breaking the marks up into their component parts. *McCarthy on Trademarks and Unfair Competition*, § 23:41. As a whole, the mark MYYOGATEACHER has an entirely different commercial impression than the mark MY YOGAWORKS. Although the terms “my” and “yoga” are common to both marks, they are not the dominant portion of the marks.

In evaluating the similarities between marks, the emphasis must be on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (citing *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991)). Here, consumers have come to expect yoga services to feature the term “yoga.” Because many yoga-formative marks exist for yoga-related services, the general recollection of the consumer is not the term yoga, but rather the terms that serve to distinguish the many yoga marks. The word “my” is also a very common term and would not be recalled by the average purchaser.

Instead, here, consumers are likely to focus on the non-similar term as the dominant portion of the marks. In Applicant’s mark the dominant term is “teacher.” In registrant’s mark the dominant term is “works.” Again, because the marks should not be dissected, they must be read as MYYOGATEACHER and MY YOGAWORKS. The compound term, “yogateacher”

has a significantly different meaning than the compound term, “yogaworks” which serves to sufficiently distinguish the marks based on appearance and sound.

MYYOGATEACHER also looks different than MY YOGAWORKS. Applicant’s mark features no spacing and is compound in its entirety. Registrant’s mark on the other hand is compound only as it features “yogaworks.” Additionally, registrant’s mark features a design element of the “my” encircled in a black opaque circle. Although Applicant’s mark is in standard characters and could foreseeably be displayed in any iteration, Applicant is limited to using the terms as a compound mark. The spacing in registrant’s mark and the design further suggest the emphasis is intended to be on “yogaworks.” By separating the term “my” in its mark, registrant imprints in the minds of consumers that the mark is two separate words, requiring consumers to view the mark in two parts. Applicant’s mark on the other hand appears as a single word “MYYOGATEACHER” and is viewed differently than registrant’s mark. On these bases, these two marks appear different.

B. Applicant’s Services Are Distinguishable From Those Included In The Registration For MY YOGAWORKS

Applicant’s services only overlap with registrant’s services in that both feature yoga related instruction. However, Applicant submits that by the Examiner’s own admission, many entities featuring the term “yoga” in their marks are providing some type of yoga instruction. This suggests that consumers will not believe the services emanate from the same source. The Examining Attorney attaches internet evidence consisting of screenshots from Sweet Escape Yoga (features “yoga”), Core Power Yoga (features “yoga”), My Virtual Yoga (features “yoga”), and Plus Performance Yoga (features “yoga”), to indicate that similar entities commonly provides the relevant goods and services. Applicant does not disagree. The Examiner’s evidence indicates that many entities are using the term “yoga” in connection with yoga instruction, whether online or through videos. This clearly indicates that consumers can distinguish between the source of the goods and services if there is a differentiating term, which exists here. Although the services may arguably be related, they are distinguishable when

encountered with the mark MYYOGATEACHER. Applicant's primary service offering is one-on-one yoga classes with specialized instructors. The registration for MY YOGAWORKS by contrast appears geared for use with all yoga instruction. As Applicant demonstrates below, the market for yoga instruction marks is saturated. As such, differences in the goods and services are sufficient to obviate likelihood of confusion.

C. The Crowded Trademark Marketplace Diminishes Registrant's Rights In The Mark MY YOGAWORKS

The term "yoga" is a part of numerous third party applications/registrations covering related services. "[C]onsumers are less likely to be confused by marks where several similar marks exist in the same marketplace. In such a crowd, customers will not likely be confused between any two of the crowd and may have learned to carefully pick out one from the other." *Miss World (UK) Ltd. v. Mrs. America Pageants, Inc.* 856 F.2d 1445, 1449 (9th Cir. 1988) (abrogated in part on other grounds, *Eclipse Assoc. Ltd. v. Data Gen. Corp.*, 894 F.2d 1114, 1116 n.1 (9th Cir. 1990) (noting that the court in *Miss World* "misstated the standard of review" for a district court's finding of likelihood of confusion). And, in this crowded trademark marketplace, registrant's mark is not entitled to broad protection. *Halo Management, LLC v. Interland, Inc.*, 308 F.Supp.2d 1019, 1034 (N.D. Cal. 2003) (noting that in a crowded field, "the ability of any member of this field to prevent use by others is relatively weak").

A search of the USPTO database indicates that over 111 pending applications/registrations exist for "YOGA" formative marks covering goods/services relating to online instruction. (See Exhibit A). Below is a random third party selection of Yoga-formative marks, which establish a crowded trademark marketplace:

1. YOGA TEACHERS COLLEGE (Class 041), owned by Yogabody Naturals LLC, for "Education services, namely, mentoring in the field of yoga; Educational services, namely, conducting programs in the field of yoga; Educational services, namely, conducting training in the field of yoga and distribution of training material in connection therewith; Educational services, namely, providing internships and apprenticeships in the field of yoga; Educational

services, namely, providing online instruction in the field of yoga”. (See Exhibit B, Registration Certificate No. 5,168,816 from the U.S. Patent and Trademark Office.)

2. I AM YOGA, (Classes 009, 041, 042) Owned by Amrit Yoga Foundation, Inc. for Class 042: “Providing a website featuring on-line non-downloadable software that enables users to listen to and view MP3 files, MP3 recordings, photographs, video recordings, written articles and sound recordings in the field of yoga, yoga therapy, meditation, and energetic healing. (See Exhibit B, Registration Certificate 5,200,558, printout from the U.S. Patent and Trademark Office.)

3. YOUR HOME FOR ONLINE YOGA (Class 041) owned by Gottfurcht, Grant E., for “Yoga instruction”. (See Exhibit B, Registration Certificate No. 4,770,290 from the U.S. Patent and Trademark Office.)

4. YOGA U | YOGAONLINE.COM ONLINE YOGA EDUCATION FOR EVERY BODY, (Class 041) owned by Auriga Group, LLC, for “Education services, namely, providing classes, seminars, workshops in the field of yoga; Yoga instruction.” (See Exhibit B, Registration Certificate No. 4,959,090 from the U.S. Patent and Trademark Office.)

5. YOGA YOUTH TEACHER TRAINING (Class 041), owned by Individuals, Pamela Casey Ann Maples, for “Educational services, namely, teacher training in the field of yoga provided on a real-time basis during classroom instruction.” (See Exhibit B, Registration Certificate No. 5,619,462 from the U.S. Patent and Trademark Office.)

6. INNER TEACHER YOGA (Class 041), owned by an individual, Jessica Rush DBA Inner Teacher Yoga, for “Yoga instruction; Providing fitness training services in the field of yoga.” (See Exhibit B, Registration Certificate No. 5,576,975 from the U.S. Patent and Trademark Office.)

7. MY AREA YOGA (Class 041), owned by My Area Yoga, LLC, for “Providing a website featuring information regarding yoga studios, yoga events and yoga information.” (See Exhibit B, Registration Certificate No. 5,761,463 from the U.S. Patent and Trademark Office.)

8. MY WORKPLACE YOGA (Class 041), owned by My Workplace Yoga, LLC,

for “Providing physical fitness and exercise service, namely, indoor cycling and yoga instruction” (See Exhibit B, Registration Certificate No. 4,702,852 from the U.S. Patent and Trademark Office.)

These various registrations, including the cited marks by the Examiner, all co-exist on the Federal Register. Based on the use of YOGA for yoga instruction by third-party registrants, consumers are “not likely be confused between any two of the crowd” because they “have learned to carefully pick out one from the other.” *Miss World (UK) Ltd.*, 856 F.2d at 1449; *see also Sun Banks of Florida, Inc. v. Sun Federal Sav. and Loan Ass’n*, 651 F.3d 311, 317 (5th Cir. 1981) (finding “widespread use” of the term “sun” militated against a finding of likelihood of confusion). Here, consumers will look to other features in the marks in this crowded trademark marketplace (including Applicant’s and registrant’s marks) eliminating the likelihood of confusion. Applicant is entitled to registration of its mark MYYOGATEACHER. Obviously, if all of these marks are allowed to co-exist, Applicant does not see why it should be precluded from also co-existing in this crowded field. In sum, there is no likelihood of confusion between the cited registration and Applicant’s mark.

IV. CONCLUSION

On the foregoing bases, Applicant respectfully asserts that there is no likelihood of confusion between MYYOGATEACHER and MY YOGAWORKS. Accordingly, Applicant respectfully requests reconsideration of the Examining Attorney’s refusal of registration.

Respectfully submitted,

Date: September 16, 2019

/Scott Pink/
Scott Pink
Attorney for Applicant
O’MELVENY & MYERS LLP
2765 Sand Hill Road
Menlo Park, California 94025
415-984-8700 Telephone
spink@omm.com