

Mark: HENRY

Serial No.: 88284217

Date: October 15, 2019

Response to Office Action Dated 4/15/2019

The Office Action has initially refused registration under Section 2(d) based on the following prior registrations:

- Reg. No. 5419560 for HENRY HALL



- Reg. No. 5419776 for



- Reg. No. for **HENRY HALL**

Each cited registration claims in relevant part “health club services, namely, providing instruction and equipment in the field of physical exercise.”

Applicant respectfully submits that the Office Action in comparing the marks did not consider the different commercial impressions made by the respective marks and did not take into account overwhelming evidence that Registrant’s marks are commercially weak and are, therefore, entitled to only narrow protection. In comparing the goods and services, the Office Action evidences a lack of understanding about the practice of yoga, which Applicant seeks to clarify. Given the narrow scope of protection Registrant is entitled to, the differences between the commercial impressions of the marks and the differences between the goods and services are more than enough to avoid a likelihood of consumer confusion.

The Marks

The Office Action concluded that the shared word “Henry” between Applicant’s mark and Registrant’s marks “creates a similar overall commercial impression,” but this is clearly not the case because each of Registrant’s marks also contains the word “Hall.” The word “Hall” is defined to refer to a building:

hall 



NOUN

1 The room or space just inside the front entrance of a house or flat.

[+ More example sentences](#) [+ Synonyms](#)

1.1 *North American* A corridor or area on to which rooms open.

[+ More example sentences](#) [+ Synonyms](#)

2 A building or large room used for meetings, concerts, or other events.

'the village hall'

[+ More example sentences](#) [+ Synonyms](#)

<https://www.lexico.com/en/definition/hall>, captured 10/14/2019

HENRY HALL then, refers to a building called Henry Hall or, more generally, a location where one would find a building, and the inclusion of “NYC” in one of Registrant’s marks reinforces the idea that Registrant’s marks refer to a particular location. The commercial impression created by Registrant’s mark is that of a particular building or location.

In contrast, Applicant’s mark is only HENRY, which is a popular male given name. See BabyName.com at Exhibit G (“Henry is currently #3 on the Baby Names popularity charts”). The Office Action overlooked the fact that Applicant’s mark refers to a person, while Registrant’s marks refer to a particular building or location. The commercial impressions created by each mark are, then, quite distinct. Consumers will remember Applicant’s mark as referring to a person involved with yoga and Registrant’s mark as a place where they can utilize health club services. This difference in commercial impression outweighs any similarities in the components of the marks.

Weakness of Registrant’s Marks

The Office Action also overlooked the fact that “Henry” is very commonly use in connection with Registrant’s fitness services. “[E]vidence of third-party use bears on the strength or weakness of [a mark].” Juice Generation, Inc., v. GS Enter. LLC, 794 F.3d 1334, 1338 (Fed. Cir. 2015). Indeed, such proof is “powerful on its face.” Id. at 1339. At Exhibit A, Applicant submits Internet evidence of 50 uses of “Henry” in marks for fitness services:

1. Henry St. Fitness
2. Henry’s Fitness Center
3. Martin Henry Fitness
4. Henry’s Personal Training

5. Breanna Henry Fitness
6. Shannon Henry Fitness
7. Henry Mayo Fitness and Health
8. Martin Henry Fitness Trainer
9. Pat and Karl Henry Fitness Centre
10. Jessica Henry Fitness
11. Michelle Henry Fitness
12. Henry Halse Personal Trainer
13. Henry Ford Health System
14. Patrick Henry Family YMCA
15. Henry Community Health
16. Henry Tolstedt Fitness Specialist
17. Henry Country Hospital
18. Henry Ford College Fitness Center
19. Sir Henry Fitness
20. Henry Ford Allegiance Wellness Center
21. Henry's Dynatorium
22. Henry James Fitness
23. Official Henry Gym
24. Patrick Henry Family YMCA
25. Henry J. Vais Gymnasium
26. James Henry Gymnasium
27. Henry Crown Field House

28. Henry Country YMCA
29. Henry Fitness
30. Henry Dean Fitness
31. Robert Henry Fitness
32. Henry's Fitness Center
33. Henry's Wellness and Fitness
34. Chris "Fitness King" Henry
35. Becca Henry Fitness
36. Tara Henry Fitness
37. Henry Suarez Fitness
38. Heather Henry Fitness & Nutrition
39. Paula Henry Fitness
40. Henry Manning Fitness
41. Chrissy Henry Fitness & Lifestyle
42. Louisa Russell-Henry Fitness
43. Henry Jazzercise & Fitness Studio
44. The Henry
45. Henry Memorial Center
46. J.A. Henry Community YMCA
47. Henry H. Brigham Community Center
48. Daniel Henry Fitness
49. Henry's Sports and Fitness Training
50. Henry Barratt Personal Trainer


Both the Federal Circuit and the Board regularly reverse 2(d) refusals based on much less evidence of third-party use than Applicant has provide. See., e.g., Jack Wolfskin Ausrüstung fur Draussen GmbH & Co. KGaA v. New Millennium Sports, S.L.U., 797 F.3d 1363, 116 USPQ2d 1129 (Fed. Cir. 2015) (14 uses); Juice Generation (26 uses or registrations); In re R. Young Enterprises, Inc., Serial No. 86671271 (December 23, 2016) (30 uses); In re Boston Juicery, LLC., Serial No. 86877537 (August 21, 2018) (12 registrations).




Applicant’s evidence of third-party use shows that consumers of these services are “educated to distinguish between different marks on the basis of minute distinctions.” Juice Generation, 794 F.3d at 1338 (quoting McCarthy). “The weaker [Registrant’s] mark, the closer [Applicant’s] mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.” Id. at 1674. The Office Action did not take into account this “powerful on its face” evidence, which impermissibly expands the scope of Registrant’s rights rather than narrowing them.

The Goods and Services

The Office Action erroneously found that Applicant’s “downloadable software for yoga instruction” and Registrant’s “health club services, namely, providing instruction and equipment in the field of physical exercise” are “closely related” on the basis of only three pieces of Internet evidence that do support that conclusion. More broadly, the Office Action incorrectly conflates the practice of yoga with health club services or fitness services, overlooking the fact that the two are not the same and that consumers of the respective services are seeking to fulfill very different purposes.

Applicant believes that a better understanding of yoga will clarify for the Office that its goods are not closely related to Registrant’s services. Yoga is a spiritual practice that uses both meditation techniques and ancient body postures:

yoga 

NOUN

[mass noun]

A Hindu spiritual and ascetic discipline, a part of which, including breath control, simple meditation, and the adoption of specific bodily postures, is widely practised for health and relaxation.

[as modifier] ‘yoga classes’

[+ More example sentences](#)

The yoga widely known in the West is based on hatha yoga, which forms one aspect of the ancient Hindu system of religious and ascetic observance and meditation, the highest form of which is raja yoga and the ultimate aim of which is spiritual purification and self-understanding leading to samadhi or union with the divine

The purposes for which consumer practice yoga are very distinct:

- “[R]ealizing who you are is the ultimate goal of all yoga practices, which include not only physical postures, but also meditation, chanting, and contemplation practices.” “What’s the Point of Yoga?” Huffpost, Olivia Rosewood, at Exhibit B.
- “[T]hrough dedicated practice and the cultivation of detachment, we will stop identifying with the thoughts, feelings, and sensations that can cause us so much emotional pain—and we will open to an experience of our true self.” “What Is The True Purpose of Yoga?,” Deepak Chopra, at Exhibit C.
- “Its purpose can be found in the literal meaning of the word yoga: ‘union’—of our individual consciousness or soul with the infinite, eternal Bliss, or Spirit.” “What’s the Heart of Yoga?” at Exhibit D.
- “Yoga is a physical, mental, and spiritual practice that originated in India. The ultimate goal of practicing yoga is to attain tranquility in the mind and spirit, and making this goal achievable by means of yoga poses and meditation.” “What is Yoga? A Beginner’s Guide” at Exhibit E.
- “From the perspective of a beginning practitioner, the term yoga describes the goal sought through practice. Yoga means union. Under this definition, one practices postures and meditation—two common disciplines of yoga—to harmonize body and mind. . . . [T]he disciplines of yoga can clear obstacles that prevent us from being who and what we truly are.” “What Is Yoga?” at Exhibit F.

Applicant respectfully submits that consumers of Registrant’s health club services are not seeking to “realize who they are,” to unite “with the infinite, eternal Bliss,” or to be “who and what [they] truly are.” Registrant’s consumers are seeking, instead, to use treadmills, weights, and other exercise equipment. The stark differences between what consumers of yoga instruction on the one hand and consumers of health club services on the other are seeking underscores that consumers are not going “to assume a connection between the parties.”

The Office Action includes only three pieces of Internet evidence to support the conclusion that yoga and health club services are closely related. Even if the evidence established what the Office Action purports, Applicant submits that substantially more evidence would be required to meet the Office’s burden of proof. But the evidence, indeed, does not establish that the services are closely related. Applicant takes each piece of evidence on record in turn:

1. Heart of Yoga: The Office Action includes a screen capture from a website that offers yoga instruction from a yogi named Mark, including through an app. The evidence includes no reference to health club services or to fitness services more generally and establishes only that people offer yoga instruction. Indeed, the evidence submitted with the Office Action supports Applicant’s argument that yoga is

distinct from Registrant's services, as seen in this snippet directly from the evidence of record:

A great gift awaits you! The purpose of this app is to give you the life transforming practices from the great wisdom traditions. It will change your life in 21 days or less. I promise! This is the easy practical means to empower your life. This potent breathing meditation will heal and nurture you and your family. You will understand the wisdom of the ancients, how the practice works and how appropriate it is to practice in the way that is right for you.

2. YogaWorks: The Office Action includes a screen capture from a second website that offers yoga instruction, including through an app. Again, the evidence includes no reference to health club services or to fitness services more generally and establishes only that people offer yoga instruction.
3. CorePower Yoga: The Office Action includes a screen capture from a second website that offers yoga instruction. The evidence includes no references to health club services and, although it does include the word "fitness," the full use is "yoga fitness." It is clear from the website that the services are consistent with Applicant's description of yoga above, not with health club services: "Yoga can be traced back to ancient India more than 5,000 years ago. Yoga is a Sanskrit word meaning to join, or yoke; a union. Conceptually, yoga is the practice of fully uniting the body, mind and spirit." See <https://www.corepoweryoga.com/content/yoga-classes-faq> (visited 10/15/2019). The evidence of record also support's Applicant's arguments regarding the purpose of yoga: "Unroll your yoga mat for an invigorating full-body flow where you'll explore the yoga postures and fundamental principles of Vinyasa yoga" and "This signature class strengthens, balances and detoxifies your entire body and mind as you move through more challenging postures and connected breath." Moreover, one incidental use of the words "yoga" and "fitness" together is not enough to establish that Applicant's yoga app and Registrant's health club services are "closely related."

Conclusion

Applicant has made of record 50 uses of marks containing HENRY in Registrant's field of fitness services, which is very strong evidence that Registrant's marks are very weak and entitled to only narrow protection. Both the Board and the Federal Circuit accept substantially less evidence to overturn 2(d) refusals. So many other uses is strong evidence that consumers are already educated to distinguish between mark owners "on the basis of minute distinctions." Applicant submits that the differences in the commercial impression made by each mark (a person v. a place), as well as the other differences between the marks, and the differences between the goods and services (training in an ancient spiritual tradition v. running on treadmills and lifting dumbbells) are significantly more than the "minute distinctions" needed to avoid a likelihood of consumer confusion. Applicant therefore requests that the refusal be lifted and that its application be allowed to proceed to publication.