

USSN 88/248469

Mark: LADDER

## REMARKS

In response to the Examining Attorney's Request for Information, Applicant has attached several excerpts from its web site showing how its LADDER mark is used as the name of its mobile application and online platform offering and rendering remote physical training and related services. Applicant can also advise the Examining Attorney that its services do not include, require, endorse or otherwise feature the use of exercise ladders. Applicant's use of the LADDER term is purely that of a trademark used to identify Applicant's online platform used in connection with the development and management of its services related to the connection of users to certified personal trainers and other health and wellness professionals.

### Descriptiveness Refusal

The Examining Attorney has refused registration of the LADDER mark on the Principal Register by asserting:

*As used by applicant, the term LADDER refers to a portable structure consisting of two long sides crossed by parallel rungs, used to climb up and down. Therefore, the term LADDER merely describes a device which can be used or featured in applicant's physical fitness training. e.g. a physical exercise training/workout/classes using a ladder. See attached article from the Google search engine. Accordingly, registration on the Principal Register is denied.*

In response to the Examining Attorney's Request for Information, Applicant has affirmatively stated that it does not use an exercise ladder in connection with the offering and rendering of its services. Applicant has provided definitive evidence showing that its use of the LADDER mark is as a trademark for an online platform that enables consumers to connect with personal trainers for the creation and undertaking of exercise, fitness and wellness plans. Applicant is not a producer of exercise ladders and does not endorse or otherwise reference the use of such an exercise device anywhere on its platform.

The Merriam-Webster online dictionary offers the following definitions of the term "ladder":

- 1: a structure for climbing up or down that consists essentially of two long sidepieces joined at intervals by crosspieces on which one may step;
- 2: something that resembles or suggests a ladder in form or use especially; or

- 3: a series of usually ascending steps or stages : [SCALE](#) climbing up the corporate ladder.

Please see the attached Exhibit.

Applicant's adoption of the LADDER mark is based upon the above Definition No. 3 as associated with the act of ascending in stages. As Professor McCarthy noted, "A mark that connotes two meanings -- one possibly descriptive and the other suggestive of some other association -- can be called suggestive, as the mark is not "merely" descriptive." 2 J. McCarthy, *McCarthy on Trademarks and Unfair Competition*, Section 11:19 at page 11-26 (4th Ed. 1998).

As can be seen from Applicant's attached web site evidence (See also <https://joinladder.com/> and <https://joinladder.com/coaches>), Applicant's online platform pairs its users with a real, certified coach who builds a "completely custom workout program and gives you consistent guidance and motivation." Accordingly, Applicant submits that its LADDER mark covering Applicant's narrowly defined online platform for connecting users with certified personal trainers and coaches is not at all descriptive.

The primary test for determining whether the LADDER mark is descriptive of Applicant's goods and services within the meaning of Section 2(e)(1) of the Lanham Act is whether the wording immediately conveys to consumers the nature of Applicant's goods and/or services, or whether consumers must use "imagination, thought and perception" to draw that conclusion. See *Stix Prod., Inc. v. United Merchants & Mfrs., Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968); see also *In re Gyulay*, 820 F.2d 1216 (Fed. Cir. 1987) citing *In re Qwik-Print Copy Shops, Inc.*, 616 F.2d 523 (CCPA 1980); *In re Cemco, Inc.*, 2010 TTAB LEXIS 259 (TTAB 2010)(reversing refusal to register after determining the mark KOOLER KIOSK was not merely descriptive of a water cooler attachment because the mark did not immediately convey to a consumer what goods/services the mark pertained to). A merely descriptive mark is literal and points directly to the goods or services with which it is used.

The LADDER Mark is not merely descriptive of Applicant's goods and services and does not immediately convey to consumers the nature or purpose of Applicant's use of the mark as an online platform to connect users with certified personal trainers and coaches. Applicant disputes that consumers would immediately associate or expect Applicant's goods and/or services to rely on or even feature the use of an exercise ladder. Thus, Applicant submits that the LADDER term cannot be deemed to be descriptive of its goods and services recited in the instant application.

Applicant is not a producer of exercise equipment or the owner or operator of fitness centers. Rather, Applicant's offerings pertain to the provision of an online platform that enables consumers to remotely manage their physical fitness, wellness and nutrition needs. In the current environment of the pandemic and stay at home orders, Applicant's goods and service offerings are in even more demand as homebound consumers are seeking online platforms to deliver remote advice, support and coaching in connection with their personal well-being.

Consumers are not contacting Applicant in the mistakenly belief that Applicant can provide an exercise ladder for home use.

The question of whether or not a mark is merely descriptive must be determined not in the abstract but rather in relation to the goods or services for which registration is sought, the context in which the mark is used in connection with those goods or services, and the possible significance which the mark would have, because of the context in which it is used, to the average purchaser of the goods or services in the marketplace. *See In re MetPath Inc.*, 223 U.S.P.Q. 88 (T.T.A.B. 1984) and *In re Nibco Inc.*, 195 U.S.P.Q. 180 (T.T.A.B. 1977).

The Board has stated in the past that the determination of whether a particular term is merely descriptive is determined in relation to the goods for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *See In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). In other words, the question is not whether someone presented only with the mark could guess the products listed in the description of goods. Rather, the question is whether someone who knows what the products are will understand the mark to convey information about them. *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-1317 (TTAB 2002); *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990); *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985). Accordingly, Applicant submits that its use of LADDER is not at all descriptive of an online platform used to connect users to certified personal trainers for the creation, implementation and management physical fitness, nutrition and wellness plans.

Lastly Applicant notes that it has long been held that because the distinction between merely descriptive and suggestive terms is “nebulous,” and because competitors have the opportunity to oppose registration once a mark is published, the Board’s practice is to resolve any doubts as to whether a mark or wording is merely descriptive or suggestive in favor of the Applicant. *See In re Schutts*, 217 U.S.P.Q. at 364 (invoking rule that doubt as to whether a mark is descriptive should be resolved in favor of Applicant); *see also In re Morton-Norwich Products, Inc.*, 209 USPQ 791, 791 (TTAB 1981)(The Board's practice is "to resolve doubts in applicant's favor and publish the mark for opposition"); *see also In re Murad, Inc.*, 2010 TTAB LEXIS 31 (TTAB 2010).

Because the LADDER Mark is susceptible to alternative meanings and thus, does not immediately convey to the consumer what the Applicant’s goods/services offerings are, let alone describe such goods/services with the necessary degree of particularity necessary to enable a consumer to make a “mental leap” to connect the term to Applicant’s intended goods and service offerings, Applicant submits that, at best, its mark is suggestive of an online platform that offers users a means to seek individualized personal training and health and wellness-related services. In the Examining Attorney remains skeptical, Applicant asserts tat any doubt as to whether the LADDER Mark is merely descriptive should be decided in its favor and that the subject application should be approved for publication to permit the public to decide as to whether Applicant’s mark is descriptive of an object that can also be used as an exercise device.

## Likelihood of Confusion

The Examining Attorney has maintained a likelihood of confusion refusal citing to the presence of Registration No. 5117125 for FUSE LADDER as a bar to registration. In the instant Office Action, the Examining Attorney merely stated “ At this time, the 2(d) refusal is maintained because the marks are similar and the services are related.” For the reasons discussed below, Applicant respectfully requests reconsideration and withdrawal of the refusal based upon the cited Registration.

In the prior Office Action, the Examining Attorney asserted that “the term LADDER has the same commercial impression in both marks” and that “applicant’s mark does not create a distinct commercial impression from the registered mark because it contains some of the wording in the registered mark and does not add any wording that would distinguish it from that mark.” Applicant disagrees and remains of the position that a refusal premised on the fact that Applicant’s mark merely contains “some of the wording in the registered mark” is simply not enough to support a likelihood of confusion refusal.

The inherent weakness of the LADDER term as used by the owner of the cited FUSE LADDER registration must be taken into consideration in any likelihood of confusion analysis, given the fact that the owner of the cited Registration previously disclaimed the exclusive rights to the LADDER term. When a party chooses a trademark or portion thereof which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. *Sure-Fit Products, Co. v. Saltzon Drapery Company*, 117 USPQ 295 (CCPA 1958). *See also, Penn Dairies, Inc. v. Pennsylvania Agricultural Marketing Association*, 200 USPQ 462 (TTAB 1978). Such marks, are generally accorded a limited scope of protection. *See, e.g., Stouffer Corp. v. Health Valley Natural Foods Inc.*, 1 USPQ2d 1900 (TTAB 1986); *EZ Loader Boat Trailers, Inc. v. Cox Trailers, Inc.*, 217 USPQ 986 (Fed. Cir. 1983). Thus, Applicant submits that the Examining Attorney is attributing a much broader scope of protection to the LADDER portion of the cited mark than is warranted, especially in view of the owner’s disclaimer of this very wording.

Likewise, the Examining Attorney appears to dismiss the value of the inclusion of the FUSE wording. Long established case law holds otherwise, as the marks must be regarded as a whole when evaluating their similarities. *See In re National Data Corp.*, 224 U.S.P.Q. 749 (Fed. Cir. 1985). Examining Attorneys will continue to consider the question of likelihood of confusion, under Section 2(d) of the statute, in relation to the marks as a whole. *See In re MCI Communications Corp.*, 21 U.S.P.Q.2d 1534, 1539 (TTAB 1991), *see also In re Shell Oil Co.*, 992 F.2d 1204, 1206 (Fed. Cir. 1993). Thus, the differences between the cited FUSE LADDER and Applicant’s LADDER mark results in the creation of marks having different meanings and commercial impressions.

The Examining Attorney’s analysis and conclusion of similarity between the respective marks appears inconsistent with the interpretation of the TTAB and various courts in a number of similar cases addressing the issue of whether trademarks are confusingly similar if they share a common word or words. For instance, in *Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 507 F.2d 1404 (C.C.P.A. 1975), the court held COUNTRY VOGUES and VOGUE do not look

or sound alike. As the only similarity between the respective marks was that "Vogue" was part of the mark COUNTRY VOGUES, the dissimilarities between the marks when viewed in their entireties were held to outweigh any similarity.

Applicant submits that COUNTRY VOGUES/VOGUE case is more on point here, where the inclusion of the FUSE term in the cited FUSE LADDER mark creates a different unitary mark having a different sound, appearance, connotation, and commercial impression from the applied for mark. The validity and distinctiveness of a composite trademark is determined by viewing the trademark as a whole. *See California Cooler, Inc. v. Loretto Winery Ltd.* 227 U.S.P.Q. 808 (9th Cir. 1985). For this very reason, the use of same wording does not automatically mean that the two marks are similar. *See General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627 (8<sup>th</sup> Cir. 1987) (determining that OATMEAL RAISIN CRISP and APPLE RAISIN CRISP are not confusingly similar)). What's more, here, the LADDER term appearing in the cited Registration is descriptive and disclaimed (and not even dominant as used by its owner) – thus further weakening the position that the marks are to be found similar. Therefore, it is submitted that although the applied for and cited marks may consist of or incorporate the LADDER term, it is improper for the Examining Attorney to ignore that (1) the cited mark is FUSE LADDER; and (2) the owner of the cited registration has disclaimed the exclusive right to the LADDER term.

As set forth above and as can be seen in the attached excerpts from Applicant web site, Applicant's goods and services are also quite distinguishable from the services of the cited Registration and have nothing to do with an actual ladder. Applicant's selection of the LADDER mark was derived upon a desire for its users to more figuratively associate the ladder term with its other definition related to an individual navigating a series of ascending steps or stages via Applicant's online personal coaching platform; the training and certification of individuals who will be rendering Applicant's services; and the operation of a web site that matches consumers with personal trainers and other health and wellness professionals.

The Examining Attorney's attention is again directed to the attached Exhibits from the web site of the owner of the cited mark (See also <https://www.fuseladder.com/>) showing how the owner of the cited registration is fully using the FUSE LADDER mark in connection with an actual "ladder" and exercise classes that rely on use of an actual ladder. Content on the foregoing web site states:

"The Fuse Ladder is the most versatile strength, flexibility, and balance training apparatus on the market today. Its sleek and space-saving design fits seamlessly into any home gym or studio setting at a price point that makes it more accessible than expensive weight machines or Pilates equipment."

It should also be noted that the use of the cited mark on the Registrant's web site clearly shows that the FUSE term is the dominant portion of the cited mark.

Applicant does not produce exercise ladders nor does Applicant endorse or advocate the use of any such exercise equipment. Rather, Applicant's platform functions as a mechanism to connect users with certified personal trainers and other health and wellness experts in order to

not only establish and manage physical fitness plans, but to also improve upon the user's overall health and wellness and will serve as a vehicle to train and certify instructors who will be rendering services on behalf of Applicant and others. Thus, while the services of the respective parties may both broadly pertain to physical fitness, the use of the cited FUSE LADDER mark as the name of an actual product used as a workout tool and in connection with an exercise class relying upon use of an actual ladder is much different than Applicant's online platform offering a variety of tiered personal coaching and other health and wellness-related services.

It is well settled that the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in Applicant's application vis-a-vis the goods and/or services recited in the cited registration. *See Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 1 U.S.P.Q. 2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co.*, 177 U.S.P.Q. 76 (C.C.P.A. 1973). In view of the nature of those services set forth in the cited Registration and the applied for mark, it is submitted that consumers seeking FUSE LADDER -branded exercise ladders or physical fitness classes rendered via the use of an exercise ladder are not going to be misled into believing that the same services are provided by or related to a company offering a LADDER-branded online platform offering tiered remote personal training and health and wellness-related services.

To find a likelihood of confusion, the goods and/or services for which the marks have been applied or registered must be sufficiently related. The issue is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of the goods/services. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). If the goods and/or services are not related or marketed in such a manner that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely. *See, e.g., Local Trademarks, Inc. v. Handy Boys, Inc.*, 16 U.S.P.Q.2d 1156 (T.T.A.B. 1990) ("LITTLE PLUMBER" for drain opener held not confusingly similar to "LITTLE PLUMBER" and Design for advertising services); T.M.E.P. § 1207.01(a)(i).

The realities of the marketplace are such that Applicant's LADDER -branded platforms for use in connection with connecting users with personal trainers are simply not marketed together, offered or rendered in close proximity to Registrant's FUSE LADDER exercise ladder and physical fitness classes offered and rendered via the use of an actual ladder. The non-competitive nature of the products/services is a relevant factor in all cases. *See Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc.*, 197 U.S.P.Q. 629 (T.T.A.B. 1977). The services of Applicant and the owner of the cited Registration are markedly diverse and emanate from different, unrelated sources. In turn, given that consumers would recognize these apparent distinctions, each mark can coexist in the marketplace without any likelihood of confusion.

The Board and various other courts have held that when determining whether one mark is likely to cause confusion with another, the likelihood that there will be confusion must be strong. The mere possibility that some consumers will be confused is not enough. *Vitek Systems, Inc. v. Abbott Laboratories*, 675 F.2d 190, 192 (8<sup>th</sup> Cir. 1982). *See also HMH Publishing Co., Inc. v. Brincat*, 504 F.2d 713, 717 (9<sup>th</sup> Cir. 1974). The issue is not the mere theoretical possibility of confusion, deception or mistake, or with *de minimis* situations, but with practicalities of the

commercial world. *In re Massey-Ferguson Inc.*, 222 USPQ 367 (T.T.A.B. 1983); *Witco Chemical Co., Inc. v. Whitfield Chemical Co., Inc.*, 164 USPQ 43 (CCPA 1969). As stated in *Lever Brothers Co. v. American Bakeries Co.*, 693 F.2d 251, 253 (2d Cir. 1982), the “crucial issue is whether there exists a likelihood that an appreciable number of ordinary prudent purchasers will be misled, or simply confused, as to the source of the goods in question.” See also *General Adjustment Bureau, Inc. v. General Insurance Adjustment Co., Inc.*, 381 F.2d 991, 993 (10<sup>th</sup> Cir. 1967). Here, it is quite unlikely that an appreciable number of purchasers would assume that services of the foregoing parties are related, let alone encounter and be confused by the presence of the respective marks, especially given the fact that the narrowly defined services covered by the cited mark are exercise classes rendered via the use of the owner’s FUSE LADDER-branded apparatus.

Applicant has shown that the respective marks as a whole are different in appearance, sound and meaning and that the goods /services offered, rendered and sold by the respective parties are readily distinguishable. As such, it is submitted that consumers will continue to be able to distinguish between the applied for and cited marks and that the registration of Applicant's LADDER mark for the recited services will not at all result in an occurrence or increase in likelihood of confusion. In view of the foregoing, it is respectfully submitted that the refusal of registration under Section 2(d) should be withdrawn.