

Office Action Response Remarks  
Mark: MIRROR  
App. Serial No.: 90128175

REMARKS

This letter is in response to the Office Action mailed on December 23, 2020.

Applicant sought registration of the word mark MIRROR (“Applicant’s Mark”) in connection with the following services:

Education services, namely, providing panel discussions in the field of exercise, fitness, wellness, personal development, professional development, and self-improvement; providing group coaching and in-person learning forums in the field of exercise, fitness, wellness, personal development, professional development, and self-improvement; membership club services, namely, providing training to members in the field of exercise, fitness, wellness, personal development, professional development, and self-improvement in International Class 41

Medical, physical rehabilitation, and physical therapy services; providing information in the field of nutrition; consulting services in the fields of health and nutrition; providing a website featuring information on health and nutrition; providing healthy lifestyle and nutrition services, namely, personal assessments, personalized routines, maintenance schedules, and counseling in International Class 44

Providing information in the field of personal development, namely, personal improvement, self-improvement, self-fulfillment, interpersonal communication, and improving oneself through achievement of timely and challenging goals; providing a resource website providing information in the field of personal development; membership club services, namely, providing on-line information to members in the fields of personal growth and motivation, personal image development, and personal development, namely, self-improvement, self-fulfillment, and interpersonal communication; counseling in the field of personal development, namely, self-improvement, self-fulfillment, and interpersonal communication in International Class 45

Registration of the subject application (the “Application”) was refused as to the services in International Class 44 on the basis of Section 2(d) citing a likelihood of confusion with one prior registration and a potential likelihood of confusion with two prior-filed applications, as set forth below:

Reference	Cited Mark	Owner	Goods/Services
Cited Mark #1	LE MIROIR Reg. No. 5467739	Zhang Yanna	Cl. 44: Beauty spa services, namely, cosmetic body care; Body waxing services for hair removal in humans; Cosmetic hair removal by means of Laser hair removal service; Cosmetic services, namely, non-permanent hair removal; Day spa services, namely, nail care, manicures, pedicures and nail enhancements; Dermatologic laser removal of hair; Health spa services for health and wellness of the body and spirit; Health spa services for health and wellness of the body and spirit offered at a health club facility; Health spa services for health and wellness of the body and spirit offered at a health resort; Health spa services for health and wellness of the body and spirit, namely, providing massage, facial and body treatment services, cosmetic body care services; Health spa services for health and wellness of the mind, body and spirit; Health spa services for health and wellness of the mind, body and spirit offered in or from a remote, mobile or temporary on-site location; Health spa services, namely, body wraps, mud treatments, seaweed treatments, hydrotherapy baths, and body scrubs; Health spa services, namely, cosmetic body care services; Health spa services, namely, laser treatments for acne, rejuvenation, scars, tattoo removal and for facials and massage; Health spa services, namely, providing weight loss programs; Laser hair removal services; Laser and intense pulse light skin enhancement procedures; Medical spa services, namely, minimally and non-invasive cosmetic and body fitness therapies; Medical clinic providing weight loss solutions, services and programs, nutrition counseling, hormone therapy, including, bioidentical hormone replacement, anti-aging therapy, and natural hormone therapy, medical aesthetic procedures, including, laser hair removal, laser peels, botulinum toxin treatments, microdermabrasion, liposuction, vein treatments, vein therapy, cellulite treatments, body contouring treatments, injectable filler treatments, facials, and skin care; Permanent hair removal and reduction services; Personal hair removal services.
Cited Mark #2	INTERNAL MIRROR App. No. 88699642	Kelly S. Wynn	Cl. 41: Education services, namely, providing classes, seminars, workshops in the fields of personal growth, resilience, coping, psychotherapy.
Cited Mark #3	MIRROR App. No. 90026416	lululemon athletica canada inc.	Cl. 3: Dry shampoos; skin moisturizers; skin cleansers; lip balm; deodorants for personal use; cosmetic creams; non-medicated foot creams; massage oils; essential oils for cosmetic purposes; aromatic essential oils; fragrances for personal use; air fragrance reed diffusers; topical skin sprays for cosmetic purposes; hair mousse; wipes impregnated with a skin cleanser; cleansing and moisturizing creams; foam cleansers for personal use; skin cleansing lotions; moisturizing body lotions; beauty masks; pre-moistened cosmetic tissues and wipes; wipes impregnated with skin cleansers; cloth pads or tissues impregnated with skin cleansers; face powder on coated paper; beauty serums; make-up primer; beauty balm creams; perfume oils; body oils for cosmetic purposes; hair shampoo; hair conditioners; hair emollients; hair moisturizers; hair nourishers; hair oils; hair spray; hair care lotions; hair masks; beauty gels; shower and bath gels; non-medicated body soaks; antiperspirants for personal use; sunscreen creams for cosmetic purposes; anti-chaffing preparations, namely, skin creams, skin lotions and body sprays; eye make-up; facial make-up; eye liner; mascara; eye shadows; cosmetic pencils; face powder; rouge; lipsticks; lip glosses; eyebrow pencils; make-up; foundation; lip pomades for cosmetic purposes; non-medicated skin care preparations, namely,

			<p>creams, pomades for cosmetic purposes, lotions, gels, body emulsions, body balms, moisturizers, body milks, essential oils, cleansers, soaps and peels</p> <p>Cl. 18: Purses; pouches for holding make-up, keys and other personal items; handbags; fanny packs; messenger bags; cosmetic bags sold empty; sport bags; beach bags; tote bags; athletic bags; duffle bags; waist bags; boston bags; shoulder bags; travelling trunks; clutch bags; wallets; key cases; reusable shopping bags; luggage; shoe bags for travel; all-purpose sports bags; backpacks; knapsacks; rucksacks; vanity cases, not fitted; waterproof protective covers specifically adapted for backpacks; umbrellas; synthetic leather; leather straps; leather and imitation of leather bags; imitation of leather; general purpose bags for carrying yoga mats; straps for carrying a yoga mat</p> <p>Cl. 25: T-shirts; shirts; tank tops; tops being clothing; sweatshirts; sweaters; raincoats; cardigans; pullovers; sport jerseys; jackets; coats; rain jackets; shell jackets; vests; ponchos; kimonos; underwear; sport singlets; slippers being undergarments; panties; underpants; drawers being clothing; briefs; boxer briefs; bras; pajamas; socks; warm-up suits; skirts; bodysuits; leotards; unitards; dresses for women; pants; sweatpants; shorts; trousers; tights; leggings; knitwear being clothing, namely, shoulder wraps, wraps, shirts, sweaters, dresses, neck warmers, muffs, hats, gloves, mittens, and scarves; waterproof jackets and pants; athletic uniforms; dance clothing, namely, bras, jackets, pants, shorts, close-fitting one-piece garment in the nature of leotards, jumpsuits, sweaters, tights, leotards, shirts, skirts, leg warmers, tank tops; bathing suits; beach coverups; swimsuits; bikinis; clothing for children, namely, body suits, caps being headwear, coats, coverups, dresses, gloves, hats, headbands, headwear, jackets, leg warmers, leggings, leotards, pants, scarves, shirts, shorts, shoulder wraps, skirts, socks, sweat pants, sweat shirts, sweaters, t-shirts, tank tops, tights, toques, underwear, vests, sun visors being headwear, warm up suits; shoulder wraps being clothing; wraps being clothing; arm warmers being clothing; neck warmers; gloves being clothing; muffs being clothing; mittens; belts being clothing; bandanas being neckerchiefs; scarves; wristbands being clothing; sandals; shoes; soles for footwear, headwear, namely, toques; headbands being clothing; caps being headwear; hats; cap peaks; caps with visors; berets; hoods being clothing; ear muffs being clothing; visors being headwear for athletic use</p> <p>Cl. 27: Yoga mats; bags specially adapted for yoga mats; yoga towels specially adapted for yoga mats</p> <p>Cl. 28: Yoga blocks; yoga bolsters; yoga straps; yoga swings; yoga wheels; gym balls in the nature of exercise balls for yoga; yoga gloves; work-out gloves; collapsible exercise foam rollers; straps used for fitness activities; electronic game equipment with a watch function; yoga blankets</p> <p>Cl. 35: Retail store services featuring clothing, footwear, headwear, yoga and athletic accessories, yoga equipment, athletic equipment, bags, cosmetics, electronic devices, and stretch bands; online retail store services featuring clothing, footwear, headwear, yoga and athletic accessories, yoga equipment, athletic equipment, bags, cosmetics, electronic devices, and stretch bands; retail store services featuring pastry products; food kiosk services; retail store services featuring packaged food and drink and household containers; promoting the special events of others in the fields of</p>
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			yoga, physical fitness, meditation, healthy living, mindfulness, goal setting, leadership development and personal development; promotion of goods and services through sponsorship of sports events; business assistance, namely, outsourcing services; demonstration of goods; shop window dressing; sales promotion for others; promotional sponsorship of athletic events; promotion services to increase public awareness about the benefits of physical activity; business administration of consumer loyalty programs; online advertising and marketing services in the fields of clothing and yoga accessories; online advertising and marketing services in the fields of clothing, yoga accessories, and electronic devices
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For the reasons discussed herein, Applicant asserts that there is no likelihood of confusion and requests that the Application proceed to publication.

As a preliminary matter, Applicant notes that a likelihood of confusion with respect to Cited Mark #3 for MIRROR, owned by lululemon athletica canada inc., is inappropriate in this case because Applicant and lululemon athletica canada inc. constitute a single source. Specifically, lululemon athletica canada inc. acquired Applicant, and therefore there is a unity of control, a single source, and no likelihood of confusion.

As to Cited Mark #1 for LE MIROIR, owned by Zhang Yanna, Applicant informs the Examiner that, on May 11, 2021, the USPTO’s Trademark Trial and Appeal Board (“TTAB”) granted Applicant’s petition to cancel this registration for non-use. A copy of the relevant TTAB decision, which states, *inter alia*, that “Registration No. 5467739 will be cancelled in due course by the Commissioner for Trademarks,” is attached hereto as Exhibit A. In light of this TTAB decision, Cited Mark #1 is no longer an obstacle to the Application, and the citation should be withdrawn.

As to Cited Mark #2, as more fully discussed below: (1) Applicant’s Mark and this mark are dissimilar and create an overall different commercial impression from one another; (2) the services in the Application, on the one hand, and in the application for Cited Mark #2, on the other hand, are not related as alleged and are actually quite

dissimilar, and (3) the shared element MIRROR is diluted for goods and services in the general field of personal development and personal growth.

I. The Marks Are Dissimilar

Applicant's Mark is the single word mark MIRROR. In contrast, Cited Mark #2 is the composite mark INTERNAL MIRROR. A consumer viewing Applicant's Mark would not simply disregard the additional element INTERNAL, particularly since that term is the initial and arguably dominant element of Cited Mark #2. Furthermore, the element INTERNAL is important to consumers' connotative impression of Cited Mark #2 given the context in which Cited Mark #2 is used: consumers seeking the personal growth, resilience, coping and psychotherapy courses offered under Cited Mark #2 will understand that the mark alludes to an "internal mirror" that the owner of Cited Mark #2 is figuratively holding up for them to assist them in their emotional growth and development. Thus, Applicant's Mark, MIRROR, creates an overall different commercial impression from Cited Mark #2, INTERNAL MIRROR.

II. The Services Are Dissimilar

The services listed in the Application are education, coaching, medical, consulting, counseling, and information, all pertaining to personal development, health, and wellness of a consumer's physical body and external appearance and behaviors. These services are a natural extension of the health, fitness, and exercise goods and services that Applicant has provided in United States commerce under its MIRROR trademark for nearly three years. A TESS printout of the USPTO record for Applicant's existing US registration for its MIRROR mark for these goods and services (Reg. No. 5973398) is attached as Exhibit B.

In contrast Cited Mark #2 includes only: “Education services, namely, providing classes, seminars, workshops in the fields of personal growth, resilience, coping, psychotherapy” – namely, education services pertaining to a consumer’s mind and internal emotional state. These services are readily distinguishable from the services in the Application.

III. The Shared Element MIRROR Is Diluted for Goods and Services in the General Field of Personal Development and Personal Growth

The Examiner appears to believe that Applicant’s Mark and Cited Mark #2 may be confusingly similar because of a perceived overlap in the services listed in each application, namely, that both applications include services in the general field of personal development and personal growth. As noted above, Applicant’s services are overall different from the services listed in Cited Mark #2. However, to the extent that both Applicant’s services and the services listed in Cited Mark #2 fall within the general field of personal development and personal growth, Applicant respectfully notes that multiple MIRROR-formative marks are already registered and coexisting in this general field. TESS print-outs showing a non-exhaustive list of such registrations is attached as Exhibit C. Against this background, there is surely room for Applicant’s Mark and Cited Mark #2 to coexist as well.

CONCLUSION

For the foregoing reasons, Applicant respectfully requests that the 2(d) refusal be withdrawn and that the Application be approved for publication.