

**To:** Unbreakable Performance LLC ([ip@msf-law.com](mailto:ip@msf-law.com))

**Subject:** U.S. TRADEMARK APPLICATION NO. 87218147 - UNBREAKABLE PERFORMANCE CENTER - 5033-2 - Request for Reconsideration Denied - Return to TTAB

**Sent:** 3/9/2018 9:56:13 PM

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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

**U.S. APPLICATION**  
SERIAL NO. 87218147

**MARK:**  
UNBREAKABLE  
PERFORMANCE  
CENTER

**\*87218147\***

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INFORMATION:**

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**APPLICANT:**  
Unbreakable Performance  
LLC

**REFERENCE/DOCKET  
NO:**

5033-2

**CORRESPONDENT  
E-MAIL ADDRESS:**

ip@msf-law.com

**REQUEST FOR RECONSIDERATION DENIED**

**ISSUE/MAILING DATE: 3/9/2018**

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. *See* 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The following refusal made final in the Office action dated August 21, 2017, is **maintained and continues to be final**:

- **SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION.**

*See* TMEP §§715.03(a)(ii)(B), 715.04(a).

The following requirement made final in the Office action is satisfied:

- **DISCLAIMER REQUIREMENT**

*See* TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, applicant's request has not resolved the outstanding issue, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

If applicant has already filed a timely notice of appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

If no appeal has been filed and time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to (1) comply with and/or overcome any outstanding final requirement(s) and/or refusal(s), and/or (2) file a notice of appeal to the Board. TMEP §715.03(a)(ii)(B); *see* 37 C.F.R. §2.63(b)(1)-(3). The filing of a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); *see* TMEP §§715.03, 715.03(a)(ii)(B), (c).

**SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION**

The examining attorney has considered the applicant's arguments carefully but has found them unpersuasive. Accordingly, the refusal under Section 2(d) is maintained and continues to be **FINAL**.

In the first Office Action, the examining attorney refused registration of the proposed mark because of a likelihood of confusion with the mark in U.S. Registration No. 3432415. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.*

In this case, the applicant's mark is **UNBREAKABLE PERFORMANCE CENTER** in standard characters for "Personal fitness training services and consultancy; Providing classes, workshops, seminars and camps in the fields of fitness, exercise, boxing, kick boxing and mixed martial arts; Providing general fitness and mixed martial arts facilities that require memberships and are focused in the fields of general fitness, exercise, and mixed martial arts; Providing health and fitness educational and training services in the field of recovery techniques"; the registrant's mark is **UNBREAKABLE WOMAN** in standard characters for "self-defense and fitness classes, seminars and workshops."

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant(s). See 15 U.S.C. §1052(d). Determining likelihood of confusion is made on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). However, "[n]ot all of the [ *du Pont*] factors are relevant to every case, and only factors of significance to the particular mark need be considered." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1366, 101 USPQ2d 1713, 1719 (Fed. Cir. 2012) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010)). The USPTO may focus its analysis "on dispositive factors, such as similarity of the marks and relatedness of the goods [and/or services]." *In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); see TMEP §1207.01.

### Comparison of the Marks

As discussed in the previous action, marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)); TMEP §1207.01(b).

In the present case, applicant's mark is **UNBREAKABLE PERFORMANCE CENTER** in standard characters and registrant's mark is **UNBREAKABLE WOMAN** in standard characters.

In the first action, the examining attorney found the marks similar in sound, appearance, and connotation because of the dominant wording "UNBREAKABLE" common to both marks.

Marks may be confusingly similar in appearance where similar terms or phrases or similar parts of terms or phrases appear in the compared marks and create a similar overall commercial impression. See *Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1495, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987) (finding COMMASH and COMMUNICASH confusingly similar); *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985) (finding CONFIRM and CONFIRMCELLS confusingly similar); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983) (finding MILTRON and MILLTRONICS confusingly similar); TMEP §1207.01(b)(ii)-(iii).

Applicant has submitted printed or electronic copies of third-party registrations for marks containing the wording **UNBREAKABLE** to support the argument that this wording is weak, diluted, or so widely used that it should not be afforded a broad scope of protection. Only one of these registrations, Reg. No. 5109676, appears to be for services that would be properly considered similar to those identified in applicant's application. The remaining registrations or pending applications, by contrast, cover goods that range from, at best, complementary, to distantly related, to applicant's services.

The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks in use in the marketplace in connection with similar goods and/or services. See *Nat'l Cable Tel. Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Evidence of widespread third-party use of similar marks with similar goods and/or services "is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection" in that particular industry or field. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005); see *In re Coors Brewing Co.*, 343 F.3d 1340, 1345, 68 USPQ2d 1059, 1062-63 (Fed. Cir. 2003).

However, evidence comprising only a small number of third-party registrations for similar marks with similar services, as in the present case, is generally entitled to little weight in determining the strength of a mark. See *In re i.am.symbolic, llc*, 866 F.3d 1315, 1328-29, 123 USPQ2d 1744, 1751-52 (Fed. Cir. 2017); *AMF Inc. v. Am. Leisure Products, Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973).

Moreover, to the extent the registrations applicant cites cover goods that are meaningfully similar or related to the services at issue, these few registrations are "not evidence of what happens in the market place or that customers are familiar with them." *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d at 1406, 177 USPQ at 269; see *Richardson-Vicks Inc. v. Franklin Mint Corp.*, 216 USPQ 989, 992 (TTAB 1982). Thus, the few similar third-party registrations submitted by applicant are insufficient to establish that the wording UNBREAKABLE is weak or diluted as

Further, evidence comprising third-party registrations for similar marks with different or distantly related goods and/or services, as is the case with the majority of the registrations applicant cites, has “no bearing on the strength of the term in the context relevant to this case.” See *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1058 (TTAB 2017) (citing *In re i.am.symbolic, llc*, 866 F.3d at 1328, 123 USPQ2d at 1751)). Thus, these third-party registrations submitted by applicant are insufficient to establish that the wording UNBREAKABLE is weak or diluted as applied to the applicant’s and registrant’s services.

It should also be noted that, while the term UNBREAKABLE is suggestive as applied to the applicant’s and registrant’s services, it is descriptive of a quality or characteristic of many of the goods covered by the registrations applicant cites. Accordingly, this undermines the argument that the term is diluted or weak with respect to the fitness and therapeutic services at issue here.

To the extent there were merit to applicant’s weak-mark argument, it is nevertheless unpersuasive. The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed “weak” or merely descriptive are still entitled to protection under Section 2(d) against the registration by a subsequent user of a similar mark for closely related goods and/or services. TMEP §1207.01(b)(ix); see *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010).

Applicant argues that the marks are distinguishable in part because of the differences in the wording that follows “UNBREAKABLE” in the marks, i.e., “WOMAN” in the registered mark and “PERFORMANCE CENTER” in the applied-for mark.

In this case, the addition of “PERFORMANCE CENTER” in the applied-for mark does not distinguish it from the registered mark because it is descriptive of or generic for applicant’s services and, as such, has been properly disclaimed by the applicant. Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Vitera Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Disclaimed matter that is descriptive of or generic for a party’s goods and/or services is typically less significant or less dominant when comparing marks. See *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat’l Data Corp.*, 753 F.2d at 1060, 224 USPQ at 752; TMEP §1207.01(b)(viii), (c)(ii).

Similarly, applicant’s argument that the term “WOMAN” in the cited mark is at once merely descriptive but also capable of distinguishing the parties’ marks, is unpersuasive. In this case, the descriptive nature of “WOMAN” increases, rather than diminishes, the likelihood of confusion because, as a term describing the intended users of the services, it, like the wording “PERFORMANCE CENTER” in the applied-for mark is accorded less weight in a marks-comparison analysis. Matter that is descriptive of or generic for a party’s goods and/or services is typically less significant or less dominant in relation to other wording in a mark. See *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1824-25 (TTAB 2015) (citing *In re Chatam Int’l Inc.*, 380 F.3d 1340, 1342-43, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004)).

Thus, the additional differing wording in the marks is less significant in terms of affecting the marks’ commercial impressions, and renders the wording UNBREAKABLE the more dominant, source-indicating element of both parties’ marks.

Applicant’s argument that the examining attorney’s marks-comparison analysis constitutes “an improper dissection” of the marks is unpersuasive in light of the descriptive nature of the additional differing wording in the marks. Applicant correctly notes that marks must be compared in their entireties and should not be dissected; however, a trademark examining attorney may weigh the individual components of a mark to determine its overall commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1322, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014) (“[Regarding the issue of confusion,] there is nothing improper in stating that . . . more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties.”) (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985))).

Thus, having given appropriate weight to each feature of the marks, the examining attorney maintains that the marks, when considered in their entireties, are sufficiently similar to cause confusion or mistake as to the source of the services.

### Comparison of the Services

As discussed in the previous action, the goods and/or services of the parties need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i).

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