

United States of America

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SERVICE MARK

PRINCIPAL REGISTER

CURRY, KEVIN A. (UNITED STATES INDIVIDUAL)
1111 S. AKARD ST. #414
DALLAS, TX 75215

FOR: PROVIDING A WEBSITE FEATURING INFORMATION IN THE FIELD OF RECIPES
AND COOKING, IN CLASS 43 (U.S. CLS. 100 AND 101).

FIRST USE 11-19-2012; IN COMMERCE 11-19-2012.

THE MARK CONSISTS OF THE LETTERING "FITMENCOOK" ARCHED OVER A HALF-
LENGTH DEPICTION OF A BODY BUILDER STRIKING A FRONT DOUBLE BICEPS POSE
AND WEARING A TANK TOP, WITH A FORK-SHAPED FEATURE AND A KNIFE-SHAPED
FEATURE DEFINED IN THE THORACIC REGION OF THE BODY BUILDER / TANK TOP.

SER. NO. 86-093,598, FILED 10-17-2013.

SANJEEV VOHRA, EXAMINING ATTORNEY



Michelle K. Lee

Deputy Director of the United States
Patent and Trademark Office

PTO Form 1957 (Rev 9/2005)

OMB No. 0651-0050 (Exp. 05/31/2014)

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. **86093598** (Stylized and/or with Design, see [mark](#)) has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

I. INTRODUCTION

As indicated in the Office Action dated February 10, 2014 (“Office Action”), the Examiner has initially refused registration of Applicant’s FITMENCOOK (and design) mark, asserting that it creates a likelihood of confusion in view of REAL MEN COOK (U.S. Registration No. 3250375), and the Examiner has objected to Applicant’s initial and/or previous recitation of the services provided under Applicant’s mark. In response to the Examiner’s objection, Applicant has amended the recitation of the services (as suggested by the Examiner) to “[p]roviding a website featuring information in the field of recipes and cooking [in International Class 43],” and Applicant respectfully thanks the Examiner for the Examiner’s courteous suggestions regarding the amendment. In response to the initial refusal in view of REAL MEN COOK, Applicant respectfully traverses, as discussed further below.

II. THE MARKS IN THEIR ENTIRETIES SHOW NO LIKELIHOOD OF CONFUSION

Applicant respectfully submits that comparing Applicant’s FITMENCOOK (and design) mark and the cited REAL MEN COOK mark in their entireties shows no likelihood of confusion. As noted in the Trademark Manual of Examining Procedure (“TMEP”), “[t]he Court of Appeals for the Federal Circuit has provided the following guidance for evaluating the marks:”

The basic principle in determining confusion between marks is that marks must be compared in their entireties and must be considered in connection with the particular goods or services for which they are used. It follows from that principle that likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark. On the other hand, in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, 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.

Indeed, this type of analysis appears to be unavoidable.

TMEP § 1207.01(b) (citing *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985) (footnotes omitted) (citations omitted)) (emphasis added).

As noted by the Examiner, comparing marks in their entireties involves comparing their overall appearances, sounds, connotations, and commercial impressions. Office Action (citing *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) and TMEP §1207.01(b)-(b)(v)). Here, comparing the marks in their entireties reveals that FITMENCOOK (and design) creates a significantly different commercial impression than REAL MEN COOK. At the outset, it should be appreciated that FITMENCOOK (and design) includes “FIT” and/or “FITMEN,” while REAL MEN COOK includes “REAL” and/or “REAL MEN.” Clearly, “FIT” and/or “FITMEN” looks and sounds much different than “REAL” and/or “REAL MEN.”

Further, the meanings of “FIT” include “in good physical condition” and “in good health;” whereas, the

meanings of “REAL” include “genuine,” “not counterfeit, artificial, or imitation,” and “authentic.” See Dictionary.com at [http://dictionary.reference.com/browse/fit?s=t\[8/10/2014 8:53:09 PM\]](http://dictionary.reference.com/browse/fit?s=t[8/10/2014 8:53:09 PM]) (a true and accurate copy of which, as found on the Internet, being respectfully submitted contemporaneously herewith as Exhibit A) and see [http://dictionary.reference.com/browse/real\[8/10/2014 8:47:16 PM\]](http://dictionary.reference.com/browse/real[8/10/2014 8:47:16 PM]) (a true and accurate copy of which, as found on the Internet, being respectfully submitted contemporaneously herewith as Exhibit B). Moreover, the most recent specimens of use filed in support of the cited REAL MEN COOK mark expressly reveal an affiliation between REAL MEN COOK and Real Men Charities, Inc., and expressly refer to “real men” as “the unsung heroes of the black community – who care for their families throughout the year.” See Combined Declaration of Use and Incontestability under Sections 8 & 15 [filed on or about June 12, 2013, in support of U.S. Trademark Registration No. 3250375] (a true and accurate copy of which, including the specimens of use, as found in the USPTO on-line records, being respectfully submitted contemporaneously herewith as Exhibit C). Thus, “FIT” and/or “FITMEN” gives FITMENCOOK (and design) connotations of youth, physical strength, athleticism, good health, and perhaps even a modicum of vanity; whereas, “REAL” and/or “REAL MEN” gives REAL MEN COOK connotations of fatherhood, maturity, genuineness, civic responsibility, and perhaps even a modicum of paternalism.

Furthermore, the design feature of Applicant’s FITMENCOOK (and design) mark, which includes a half-length depiction of a tank-top-wearing body builder striking a front double biceps pose, even further distinguishes Applicant’s mark from REAL MEN COOK in at least two additional respects. Firstly, Applicant’s design increases the difference in appearance between the marks. Secondly, as opposed to the REAL MEN COOK mark’s above-noted connotations of fatherhood, maturity, genuineness, civic responsibility, etc., the design feature gives Applicant’s mark even more striking connotations of youth, physical strength, athleticism, and good health, etc.

Consequently, overall, FITMENCOOK (and design) creates a different commercial impression than REAL MEN COOK. By reducing the comparison of the marks to a mere comparison of their respective “MENCOOK” and “MEN COOK” parts, the initial refusal was improperly predicated on a dissection of the mark(s). Properly comparing the marks in their entireties shows no likelihood of confusion.

III. “MENCOOK” AND/OR “MEN COOK” IS WEAK

Even if “MENCOOK” and/or “MEN COOK” is considered to be a common element of FITMENCOOK (and design) and REAL MEN COOK, the element is generic, descriptive, or highly suggestive of the cooking-related goods and/or services provided under the marks. “If the common element of two marks is ‘weak’ in that it is generic, descriptive, or highly suggestive of the named goods or services, it is unlikely that consumers will be confused unless the overall combinations have other commonality.” TMEP § 1207.01(b) (viii) (citing, *inter alia*, *In re Bed & Breakfast Registry*, 791 F.2d 157, 159 229 USPQ 818, 819 (Fed. Cir. 1986) (reversing TTAB’s holding that contemporaneous use of BED & BREAKFAST REGISTRY for making lodging reservations for others in private homes, and BED & BREAKFAST INTERNATIONAL for room booking agency services, is likely to cause confusion, because, *inter alia*, the descriptive nature of the shared wording weighed against a finding that the marks are confusingly similar); *U.S. Shoe Corp. v. Chapman*, 229 USPQ 74 (TTAB 1985) (holding COBBLER’S OUTLET for shoes, and CALIFORNIA COBBLERS (in typed and stylized forms) for footwear and women’s shoes, not likely to cause confusion); *In re Istituto Sieroterapico E Vaccinogeno, Toscano “SCLAVO” S.p.A.*, 226 USPQ 1035 (TTAB 1985) (holding ASO QUANTUM (stylized, with “ASO” disclaimed) for diagnostic laboratory reagents, and QUANTUM I for laboratory instruments for analyzing body fluids, not likely to cause confusion)).

Firstly, the services provided under Applicant’s FITMENCOOK (and design) mark are (as amended) “a website featuring information in the field of recipes and cooking,” while the goods purportedly provided under the cited REAL MEN COOK mark include “cook books;” “hot sauce, sweet potato pound cake mix, sweet potato pancake mix, sweet potato pound cake;” and “clothing.” Thus, even if “MENCOOK” and/or “MEN COOK” is considered to be a common element of FITMENCOOK (and design) and REAL MEN COOK, the element is generic, descriptive, or highly suggestive of the cooking-related goods and/or services provided under the marks. Such weakness of “MENCOOK” and/or “MEN COOK” is further demonstrated by the most recent specimens of use filed in support of the cited REAL MEN COOK mark, which, for example, show REAL MEN COOK used in

connection with cookbooks providing “soul-satisfying recipes, from real men who do it in the kitchen!” See Combined Declaration . . . Sections 8 & 15 (a true and accurate copy of which, as noted above, being respectfully submitted contemporaneously herewith as Exhibit C).

Secondly, third-party uses of “MEN” in conjunction with “COOK” further demonstrate the weakness of “MENCOOK” and/or “MEN COOK.” “Evidence of third-party use falls under the sixth *du Pont* factor [of a likelihood of confusion analysis] – the ‘number and nature of similar marks in use on similar goods.’” TMEP § 1207.01(d)(iii) (citing *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). “If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, it ‘is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.’” *Id.* (citing *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). Here, the presence of 100 MEN WHO COOK (U.S. Registration No. 4449295) demonstrates that consumers are capable of distinguishing between more than one “MEN COOK”-type mark in connection with cooking-related goods/services. See 100 MEN WHO COOK (U.S. Registration No. 4449295) (a true and accurate copy of which, as found in the USPTO on-line records, being respectfully submitted contemporaneously herewith as Exhibit D). Additionally, on-line marketing of the cookbook entitled, *Cajun Men Cook: Recipes, Stories & Food Experiences from Louisiana Cajun Country* further demonstrates that “MEN COOK” is generic, descriptive, or highly suggestive of the cooking-related goods/services provided under Applicant’s FITMENCOOK (and design) mark and the cited REAL MEN COOK mark. See http://www.amazon.com/Cajun-Men-Cook-Experiences-Louisiana/dp/0964248603/ref=cm_... 8/8/2014 (a true and accurate copy of which, as found on the Internet, being respectfully submitted contemporaneously herewith as Exhibit E).

Aside from the weak “MENCOOK” and/or “MEN COOK,” FITMENCOOK (and design) and REAL MEN COOK have no appreciable commonality. Moreover, as discussed above in connection with comparing the marks in their entireties, FITMENCOOK (and design) creates a different commercial impression than REAL MEN COOK. Consequently, again, it is unlikely that consumers will be confused by Applicant’s mark.

IV. GOODS/SERVICES SIMILARITY DOES NOT MANDATE REFUSAL

Even a very strong similarity in the goods/services provided under different marks does not mandate a determination of a likelihood of confusion. See, e.g., *In re Bed & Breakfast Registry*, 791 F.2d 157, 159 229 USPQ 818, 819 (Fed. Cir. 1986) (reversing TTAB’s holding that contemporaneous use of BED & BREAKFAST REGISTRY for making lodging reservations for others in private homes, and BED & BREAKFAST INTERNATIONAL for room booking agency services, is likely to cause confusion, because, inter alia, the descriptive nature of the shared wording weighed against a finding that the marks are confusingly similar); *U.S. Shoe Corp. v. Chapman*, 229 USPQ 74 (TTAB 1985) (holding COBBLER’S OUTLET for shoes, and CALIFORNIA COBBLERS (in typed and stylized forms) for footwear and women’s shoes, not likely to cause confusion); *In re Istituto Sieroterapico E Vaccinogeno, Toscano “SCLAVO” S.p.A.*, 226 USPQ 1035 (TTAB 1985) (holding ASO QUANTUM (stylized, with “ASO” disclaimed) for diagnostic laboratory reagents, and QUANTUM I for laboratory instruments for analyzing body fluids, not likely to cause confusion).

In most, if not all, of the cases that have been cited in support of the initial refusal to register Applicant’s mark in view of the goods/services, it was not only the goods/services that were highly related; in addition, strong (or at least not highly descriptive) parts of the marks were nearly identical. See *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (BIGG’S nearly identical to BIGGS in that the two marks merely differ by an apostrophe or lack thereof); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB nearly identical to THE “21” CLUB (stylized)); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE (stylized) nearly identical to CREST CAREER IMAGES (stylized)); *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433 (TTAB 1983) (STEELCARE INC. nearly identical to STEELCASE in that “STEELCARE” and “STEELCASE” differ by only one letter).

Again, as discussed above, the marks must be considered in their entireties. Notwithstanding any similarities of the services and/or channels of trade connected with Applicant’s mark to the goods and/or channels of trade connected with the cited mark, the above-discussed differences between the marks preclude a likelihood of confusion.

V. THE PROFFERED PARSING OF THE MARKS IS UNSUPPORTED

Applicant respectfully submits that in this case there is no rational support for the proffered parsing of the marks or the proffered identification of “MENCOOK” and/or “MEN COOK” as “dominant” portions of the marks. The Administrative Procedure Act of 1946 (as amended) prohibits, among other things, actions that are “arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law.” 5 U.S.C. § 500, *et seq.* Further, as noted above in connection with comparing the marks in their entireties:

[I]n articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, *for rational reasons*, 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.

TMEP § 1207.01(b) (citing *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985) (footnotes omitted) (citations omitted)) (emphasis added).

Applicant's FITMENCOOK (and design) mark and the cited REAL MEN COOK mark might just as easily, if not more easily, be considered as having the common feature “COOK” (and the opposing features “FITMEN/REAL MEN”) as having the common feature “MENCOOK/MEN COOK.” No reason has been articulated for parsing the marks in the manner proffered by the Office Action. Moreover, no reason has been articulated for considering “MENCOOK/MEN COOK” or “COOK” to be a “dominant” portion of the marks. In fact, the most recent specimens of use filed in support of the cited REAL MEN COOK mark (1) expressly reveal an affiliation between REAL MEN COOK and *Real Men* Charities, Inc. (emphasis added), (2) expressly refer to “*real men*” as “the unsung heroes of the black community – who care for their families throughout the year (emphasis added),” and (3) show REAL MEN COOK used in connection with cookbooks providing “soul-satisfying recipes, from *real men* who do it in the kitchen! (emphasis added),” which all show that if REAL MEN COOK actually has any truly identifiably dominant portion, such portion is more likely to be “REAL MEN” than “MEN COOK.” See Combined Declaration . . . Sections 8 & 15 (a true and accurate copy of which, as noted above, being respectfully submitted contemporaneously herewith as Exhibit C).

VI. CONCLUSION

For at least the foregoing reasons, Applicant respectfully submits that the objection to Applicant's recitation of services has been mooted and the initial refusal to register Applicant's mark should be withdrawn. Further, Applicant respectfully submits that the subject application is in condition for allowance and, accordingly, advancement toward that end is respectfully requested.

EVIDENCE

Evidence in the nature of Copy of Dictionary.com definitions of “fit” (submitted as Exhibit A); Copy of Dictionary.com definitions of “real” (submitted as Exhibit B); Copy of Combined Declaration of Use and Incontestability under Sections 8 & 15, including specimens, filed on or about June 12, 2013, in support of U.S. Trademark Registration No. 3250375 (submitted as Exhibit C); Copy of U.S. Registration No. 4449295 for 100 MEN WHO COOK (submitted as Exhibit D); Copy of Amazon.com on-line marketing of the cookbook entitled, *Cajun Men Cook: Recipes, Stories & Food Experiences from Louisiana Cajun Country* (submitted as Exhibit E) has been attached.

[Evidence-1](#) [evi_10819497224-170557507_.20140810_fit_Dictionary.com_-_Exhibit_A.pdf]

[Evidence-2](#) [evi_10819497224-170557507_.20140810_real_Dictionary.com_-_Exhibit_B.pdf]

[Evidence-3](#) [evi_10819497224-170557507_.REAL_MEN_COOK_Reg.No._3250375_Sect_8_and_15_-_Exhibit_C.pdf]

[Evidence-4](#) [evi_10819497224-170557507_.100_MEN_WHO_COOK_Reg.No._4449295_certificate_-_Exhibit_D.pdf]

[Evidence-5](#) [evi_10819497224-170557507_.20140808_Cajun_Men_Cook_amazon.com_-_Exhibit_E.pdf]

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant hereby deletes the following class of goods/services from the application.

Class 041 for Providing on-line information in the field of recipes and food choices for health and fitness

Applicant hereby adds the following class of goods/services to the application:

New: Class 043 (Original Class: 041) for Providing a website featuring information in the field of recipes and cooking

Filing Basis: Section 1(a), Use in Commerce: The mark was first used at least as early as 11/19/2012 and first used in commerce at least as early as 11/19/2012, and is now in use in such commerce.

CORRESPONDENCE ADDRESS CHANGE

Applicant proposes to amend the following:

Current:

GERALD W. ROBERTS

The Roberts Law Firm of Dallas, PLLC

5001 Spring Valley Road, Suite 400 East

DALLAS

Texas (TX)

US

75244-3910

Proposed:

GERALD W. ROBERTS of G. W. Roberts Law Firm, PLLC, having an address of

5001 Spring Valley Road, Suite 400 East DALLAS, Texas 75244-3910

United States

gwroberts@robertslawdallas.com;geraldwroberts@netzero.net

972-383-1383

The attorney docket/reference number is 00319.00002.

SIGNATURE(S)**Response Signature**

Signature: /Gerald W. Roberts/ Date: 08/11/2014

Signatory's Name: Gerald W. Roberts

Signatory's Position: Attorney of record, Texas bar member

Signatory's Phone Number: 972-383-1383

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

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