

Appeal No. 24-1041

IN THE
**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

iFIT Inc.,

Appellant

v.

Katherine K. Vidal,

Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office,

Intervenor

Appeal from the U.S. Patent and Trademark Office
Trademark Trial and Appeal Board
Opposition No. 91264855

**CORRECTED NON-CONFIDENTIAL BRIEF FOR
APPELLANT iFIT INC.**

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CERTIFICATE OF INTEREST

The undersigned counsel certifies the following:

1. The full name of every party represented by the undersigned is:

iFIT Inc.

2. For each entity listed above, the name of the real party in interest if the party listed above is not the real party in interest:

N/A

3. All parent companies and any publicly held companies that own 10 percent or more of the stock of the party represented:

iFIT Health & Fitness, Inc. is the parent company of iFIT Inc.

4. The names of all law firms, partners, and associates that (a) appeared for the party represented in the originating agency or (b) are expected to appear in this court (and who have not entered an appearance in this case) are:

None

5. Other than the originating case(s) for this case, are there related or prior cases that meet the criteria under Fed. Cir. R. 47.5(a)?

No

6. Any information required under Fed.R.App.P. 26.1(b) (organizational victims in criminal cases) or 26.1(c) (bankruptcy case debtors and trustees):

None

DATED: March 12, 2024

/s/ Matthew A. Barlow

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CONFIDENTIAL MATERIAL OMITTED

The material omitted on pages 6 and 27 constitutes (1) a dollar amount indicative of iFIT’s average annual revenue over the last twenty years and (2) a dollar amount indicative of iFIT’s annual marketing budget over the last five years.

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STATEMENT OF RELATED CASES

No appeal in or from the proceeding below was previously before this Court or any other appellate court. Counsel for appellant is not aware of any other case in this or any other court that will directly affect or be directly affected by this Court's decision in this appeal.

JURISDICTIONAL STATEMENT

This is an appeal from a decision of the Trademark Trial and Appeal Board in a trademark opposition proceeding. The TTAB order that is the subject of this appeal is a final order that disposes of all parties' claims and is dated June 27, 2023. (Appx1-30.) iFIT filed a notice of appeal on August 23, 2023 (Appx3033-3067), which was timely under 37 C.F.R. § 2.145(d)(1), as promulgated under 15 U.S.C. § 1071(a)(2). Therefore, this Court has jurisdiction over the appeal pursuant to 15 U.S.C. § 1071(a)(1) and 28 U.S.C. § 1295(a)(4)(B).

STATEMENT OF THE ISSUES

1. Did the Board err in concluding that ERB's mark I-FIT FLEX, applied for use in connection with protective eyewear, is not likely to cause confusion with iFIT's IFIT Mark, registered in connection with fitness training services and in connection with fitness and exercise machines?

a. Did the Board fail to rely on substantial evidence in finding that the IFIT Mark lacks "fame," when there is undisputed evidence of fame and

when the Board's only stated reasons for discounting that evidence do not withstand scrutiny and are therefore unreasonable, and did the Board therefore err in failing to give the fame of the IFIT Mark dominating or at least heavy weight in favor of a likelihood of confusion?

b. Did the Board fail to rely on substantial evidence in its finding that the parties' goods and services at issue are "not related," when there is undisputed evidence of relatedness and when the Board relied on faulty and legally erroneous reasoning to discount this evidence, and did the Board therefore err in weighing the relatedness of the parties' goods and services against a likelihood of confusion?

c. Did the Board fail to rely on substantial evidence in its finding that there is insufficient overlap in customers of the parties' goods and services, when there is undisputed evidence of overlapping customers and when the Board relied on faulty reasoning to discount this evidence, and did the Board therefore err in weighing the overlap of customers against a likelihood of confusion?

d. Did the Board err in giving too little weight to its findings that the marks are "highly similar in 'appearance, sound, connotation and commercial impression'" and "similar" overall when the Board merely weighed the similarity of the marks in favor of a likelihood of confusion but

when this Court’s case law requires such similarity to be weighed *heavily* in favor of likelihood of confusion?

STATEMENT OF THE CASE

This is an appeal from a decision of the Trademark Trial and Appeal Board (“the Board”). Applicant ERB Industries, Inc. (“ERB”) applied to register the trademark I-FIT FLEX, and Appellant iFIT Inc. (“iFIT”) filed an opposition to that mark. After a trial, the Board dismissed iFIT’s opposition based on a conclusion that there was no likelihood of confusion between iFIT’s registered marks and ERB’s applied-for mark. iFIT has now appealed.

I. iFIT and the IFIT Mark

iFIT Inc., formerly known as ICON Health & Fitness, Inc., is one of the largest manufacturers and providers of exercise and fitness goods and services in the United States, commanding a considerable share of the market for exercise and fitness equipment. (Appx2280-2281, ¶¶ 3, 4, 10.) In 2021, that market share was over 25% of all exercise products sold in the United States. (Appx2280, ¶ 5; Appx2284-2286.) iFIT has used “IFIT” or “iFIT” or “i-FIT” as a mark in connection with its products (collectively “the IFIT Mark”) since at least as early as 1999, *i.e.*, for over twenty years. (Appx1979, ¶ 4.) Among others, iFIT owns the following U.S. trademark registrations for the IFIT Mark:

<u>Registration No.</u>	<u>Mark</u>	<u>Goods</u>
2,466,474 (filed July 21, 1999)	IFIT.COM	IC 042 – Information and consultation services in the field of exercise equipment and personal health, fitness and nutrition by means of a global computer network.
2,618,509 (filed February 11, 1999)	IFIT	IC 028 – Fitness and exercise machines; IC 041 – educational services, namely personal training in health and fitness.
3,755,592 (filed Aug. 22, 2008)	i-FIT	IC 025 – Foundation garments; women’s undergarments; lingerie; women’s intimate apparel, namely, brassieres
4,450,213 (filed December 27, 2012)	iFIT	IC 041 – Personal fitness training and consultancy including an online computer database system.
4,500,591 (filed February 21, 2013)	IFIT	IC 042: ASP software storing and displaying personal performance data for fitness activities.
4,604,633 (filed December 18, 2013)	IFIT	IC 009 – web-based, downloadable software for the collection and storage of personal performance fitness data.
5,530,425 (filed February 5, 2014)	iFIT	IC 009 – Pedometers; altimeters; scales; multifunctional electronic devices for displaying, measuring, and uploading to the Internet and computer networks information including time, date, heart rate, global positioning, direction, distance, altitude, speed, steps taken, calories burned, navigational information, weather information, temperature, wind speed, changes in heart rate, activity level, hours slept, and quality of sleep; computer software for wireless data communication for receiving, processing, transmitting and displaying information relating to fitness,

		body fat, body mass index, and heart rate; Electronic monitoring devices incorporating microprocessors, digital display, and accelerometers, for detecting, storing, reporting, monitoring, uploading and downloading sport, fitness training, and activity data to the Internet, and communication with personal computers, regarding time, steps taken, calories burned, distance; computer software and computer application software for mobile phones and personal digital devices that provides tips, coaching, and personalized workouts, to improve the user’s fitness level
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(Appx86-87; Appx252-385.)

One of iFIT’s principal offerings under the IFIT Mark is a subscription service providing guided workouts led by leading athletes and trainers. (Appx1980, ¶ 7.) iFIT also uses its marks in connection with fitness and exercise machines such as treadmills, exercise bicycles, ellipticals, rowers, and strength trainers. (Appx1981, ¶ 8.) iFIT also maintains an online store where it markets and sells goods such as clothing, cookbooks, calendars, heart rate monitors, water bottles, and shaker bottles. (See Appx2657, ¶ 5; Appx2665-2668.) Product lines offered in connection with the IFIT Mark include NordicTrack, ProForm, and FreeMotion. (Appx1979.) An article published on Forbes.com observes that for just the NordicTrack product line, the “array of workout choices is staggering” and “so is the array of machines.” (Appx1990, ¶ 33; Appx2127.) The article continues: “No

competitor has a product line this broad, and unlike other companies offering online classes that specialize in one or two types of workouts, NordicTrack makes everything, and one iFit subscription covers them all.” (Appx1990, ¶ 33; Appx2127.)

iFIT has invested significant time and resources in building IFIT in the United States as a premier exercise and fitness brand, with resounding success. (Appx1982, ¶ 9.) For each of the last twenty years, iFIT’s average annual revenue has been at least **DOLLAR AMOUNT**. (Appx2281, ¶ 9.) As already noted above, iFIT sold over 25% of the exercise units sold in the United States in 2021, and its stationary bicycles have been among the top selling stationary bicycles in the United States for the last decade. (Appx2280, ¶¶ 5-6; Appx2288-2291.)

iFIT uses its IFIT Mark on nearly all of its goods and services. (Appx2280, ¶ 4; Appx1979, ¶ 5.) For example, nearly all of the units sold in 2021 were marked with the IFIT mark; “thus, a quarter of all the exercise products sold in the United States in 2021 were marked with the IFIT mark.” (Appx2280, ¶ 5; *see also* Appx2755.) In addition, from 2017 to 2022, “nearly all [iFIT’s] marketing materials, videos, and advertisements ... display or have included the IFIT mark.” (Appx2755 (quoting Appx2280, ¶ 7).)

For approximately the last five years, iFIT’s annual marketing budget has on average been greater than **DOLLAR AMOUNT**. (Appx2280, ¶ 7.) During that time,

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nearly all marketing materials have included the IFIT mark. (*Id.*) iFIT has promoted its IFIT products in online, print, and television advertisements that have appeared throughout the United States, including through (1) online advertising, (2) websites (including ProForm.com, NordicTrack.com, and iFit.com), (3) social media platforms, (4) race sponsorships, (5) television advertisements, (6) radio advertisements, (7) print advertisements in newspapers and magazines, and (8) trade shows. (Appx1986-1987, ¶¶ 17, 20.) iFIT's television commercials for IFIT-branded goods and services have aired on numerous popular nationwide television stations, reaching millions of people across the United States. (Appx1987, ¶ 21.) The addition of Michael Phelps, Alex Morgan, and other Olympic and Paralympic athletes as IFIT trainers was publicized in a series of television advertisements broadcast on NBC throughout the 2020 Summer Olympic Games in Tokyo, Japan. (*Id.*, ¶¶ 18, 21.) iFIT's IFIT-branded goods and services have also been advertised on local and regional television stations throughout each state in the United States. (*Id.*, ¶ 22.) The record includes sample images from IFIT's television ads using and displaying the IFIT Mark. (*See, e.g.*, Appx2047-2061.)

IFIT-branded products are frequently advertised in major newspapers across the United States, including the New York Times, the New York Daily News, Newsday, the New York Post, the Boston Globe, the Boston Herald, the Hartford Courant, the Newark Star-Ledger, the Philadelphia Inquirer, the Baltimore Sun, the

Washington Post, the Chicago Sun-Times, the Chicago Tribune, Detroit News, the St. Paul Pioneer Press, the Star Tribune (Minneapolis, the MN), the Indianapolis Star, the St. Louis Post Dispatch, the Orlando Sentinel, the Miami Herald, the Atlanta Journal Constitution, the Dallas Morning News, the Fort Worth Star-Telegram, the Houston Chronicle, the Rocky Mountain News, the Sacramento Bee, the San Francisco Chronicle, the San Francisco Examiner, the San Jose Mercury News, the Orange County Register, and the Los Angeles Times. (Appx1989-1990, ¶ 29.)

iFIT has also enjoyed significant unsolicited media attention. (Appx1313-1704; Appx2098-2161.) iFIT has been featured in articles appearing in (to name a few) The Wall Street Journal, Wirecutter (which is published by the New York Times), Forbes, NBC News, Insider, Good Housekeeping, PCMag, Runner's World, and Mashable. (*Id.*)

The IFIT website (<https://www.ifit.com>) receives significant Internet user traffic in the United States, with millions of visitors per year accessing the site and its content. (Appx1990, ¶ 30.) iFIT's IFIT app has been purchased by over a million users on the Google Play Store alone. (Appx1991, ¶ 37.)

II. ERB and the I-FIT FLEX Mark

ERB filed an application to register the mark I-FIT FLEX (“the I-FIT FLEX Mark”) in connection with “industrial protective eyewear; safety eyewear” in

International Class 9. (Appx2971.) ERB admits that the term “safety eyewear” is not restricted to eyewear worn exclusively in a construction or industrial setting, and that “the Trademark ID Manual includes ‘sports eyewear’ as an acceptable good” in International Class 9. (Appx425; *see also* Appx862-863, 86:1-87:13; Appx1020.)

ERB also admits that anyone can purchase its goods, including non-industry consumers, including at homedepot.com, Amazon.com, and Walmart.com. (Appx850, 74:1–6; Appx851, 75:11-22; Appx2376, ¶ 41; Appx2657, ¶ 3; Appx2660-2663.) ERB’s I-FIT FLEX-branded are inexpensive. (Appx821, 45:16-22; Appx28.)

III. Both Parties’ Goods and Services Are Purchased by An Overlapping Group of Customers, Namely Cyclists, And Then Used Together

Both parties’ goods and services are purchased by an overlapping group of customers, namely cyclists, and then used together. Specifically, cyclists purchase the type of goods registered to be sold by ERB (safety glasses) and the type of services registered to be sold by iFIT (fitness training sessions) and then use safety glasses during fitness training sessions.

With respect to iFIT’s goods and services, iFIT uses and has registered its IFIT Mark in connection with “conducting personal training in the field of health and fitness” and “personal fitness training services and consultancy.” (Appx93; Appx95.) iFIT’s IFIT Vice President of Member Experience testified that iFIT

“actively markets its goods and services to cyclists.” (Appx1986, ¶ 16; *see also* Appx2280, ¶ 6.) One way it does so is through an “exclusive Tour de France workout series, whereby users of the IFIT-branded programs can virtually ride all 21 stages of the 2020 Tour de France course on their IFIT-enabled exercise bikes.” (Appx1986, ¶ 16; *see also* Appx1993, ¶ 45 (“The current and potential customer base for both parties is essentially an unlimited group that includes any consumer who wants to participate in exercise, sports, or fitness activities, which activities may require or benefit from the use of protective eyewear.”).)

Unsurprisingly, the record shows that cyclists also purchase safety glasses, even from hardware stores. In several blogs and online forums among cyclists, the cyclists discuss purchasing safety glasses from hardware stores to use during cycling. (Appx1124-1171; Appx1178-1179; Appx1188-1194; Appx1200-1218.) In one forum, a user asks whether safety glasses (as opposed to cycling-specific glasses) are suitable for use during cycling (Appx1124), and responses include the following:

- “If they work for you, keep using them.” (Appx1125.)
- “I have the full suite of those same type [of] safety glasses (clear, tinted, yellow) and they’re great for a \$2 solution.” (*Id.*)
- “I’ve been using safety glasses for years.” (Appx1127.)
- “I use generic safety glasses.” (Appx1129.)

In another forum, a cyclist states that he or she purchased safety glasses from a hardware store for cycling. (Appx1134.) Others comment: “People do this. It’s ok”; “Safety glasses are so cheap that I have multiple pairs”; and “I ride with safety glasses I got for 5 bucks at home depot.” (Appx1134; Appx1135; Appx1136.)

The conclusion that cyclists purchase both safety glasses and fitness training services and then use them together is corroborated by the fact that iFIT’s marketing efforts regularly feature IFIT cyclist-trainers wearing protective eyewear. (Appx1986, ¶ 15.) For example, the following posts from iFIT’s Instagram feed show its trainers doing cycling workouts while wearing safety glasses. It is apparent that they are providing IFIT-branded training services because they are wearing IFIT-branded apparel (Appx1982, ¶ 12), and it is equally apparent that they are simultaneously wearing safety glasses:







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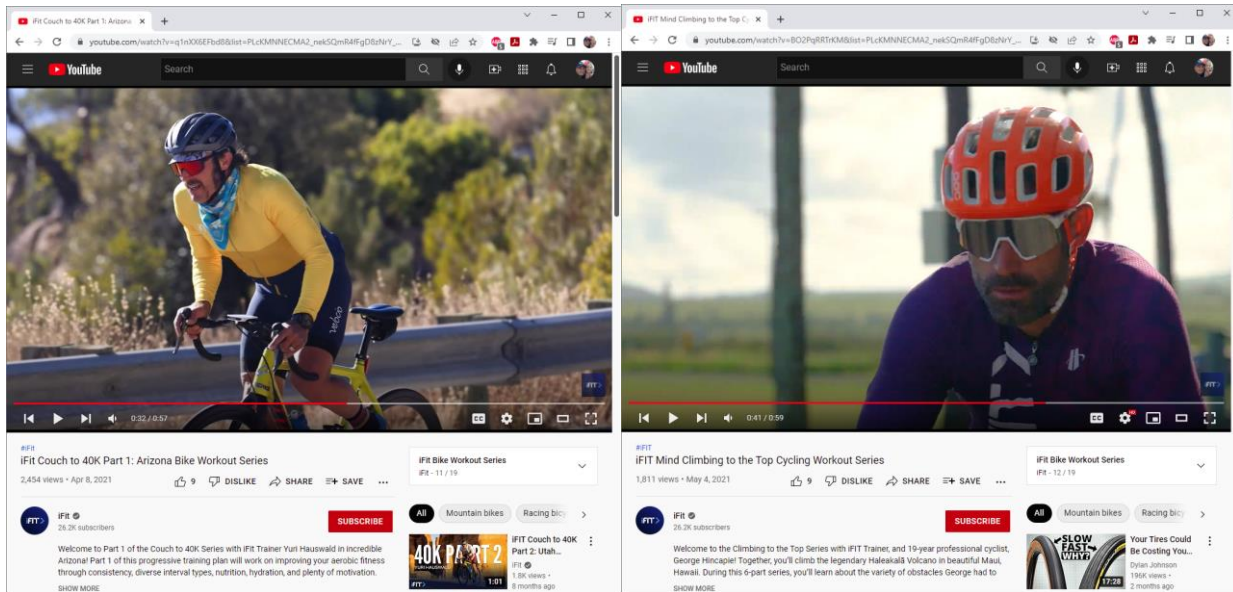
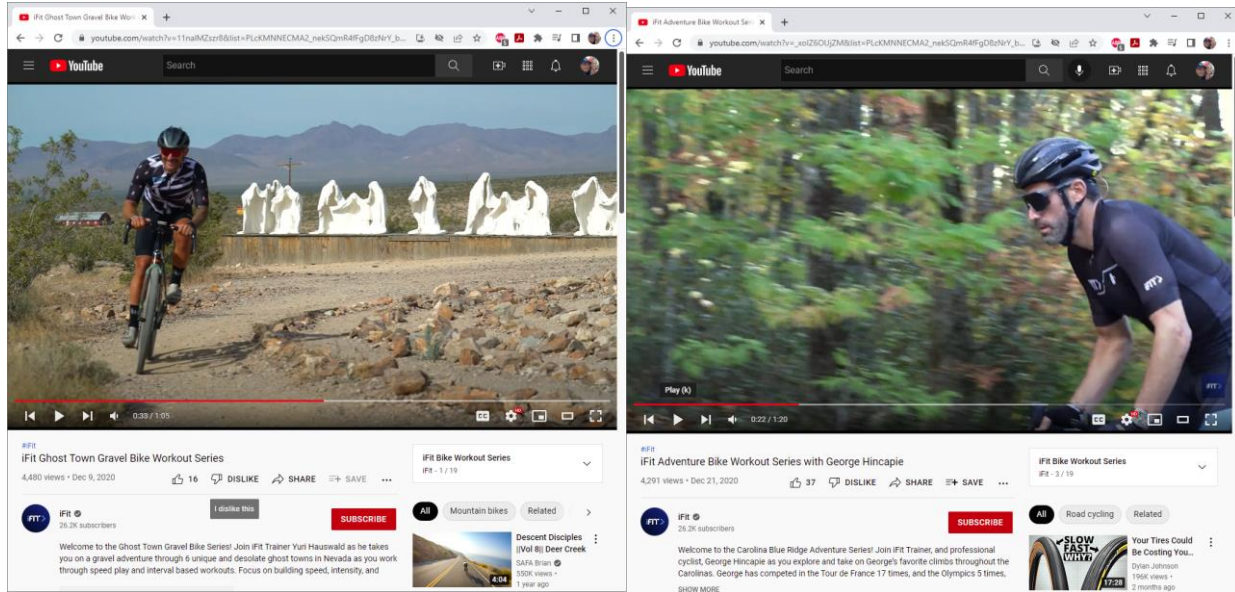
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(Id., ¶ 13.)


Likewise, iFIT's iFIT YouTube channel has numerous videos showing trainers wearing safety glasses while doing cycling workouts, as shown in the examples below:



(Id., ¶ 14.)

IV. Both Parties' Goods and Services Are Registered To Be Sold Together

Not only are both parties' goods and services purchased by an overlapping group of customers, *i.e.*, cyclists, and then used together, but both parties' goods and services are registered to be sold together as well. As noted above, iFIT's registrations for the IFIT Mark not only cover "conducting personal training in the field of health and fitness" (Appx93) and "personal fitness training services and consultancy" (Appx95), but they also cover "[f]itness and exercise machines" (Appx93). And third-party registrations show that there at least five sellers with marks registered for use with both (1) safety glasses and (2)(a) fitness machines or (2)(b) fitness training services, as follows:

UNDER ARMOUR (Reg. No. 513760) and  (Reg. No. 5193655) are registered to the same owner for "protective eyewear" and "electronic devices, namely, data sensors, transmitters and receivers for relaying physical exercise data."

Airwheel (Reg. No. 5429233) is registered for "protective eyewear" and "exercise treadmills."

ATHLETES INSIGHT (Reg. No. 5600176) is registered for "sports eyewear" and "personal fitness training services."

ENDORPHINS MAKE YOU HAPPY (Reg. No. 6070156) is registered for "retail store services featuring...eyewear...exercise equipment..."

HISEA (Reg. No. 5199993) is registered for "protective eyewear" and "exercise machines."

(Appx1224-1226; Appx1227-1228; Appx1231; Appx1238; Appx1263-1265; *see also* Appx1224-1269.) Thus, both parties' goods and services are registered to be sold together.

V. The Board's Decision

A likelihood of confusion analysis involves balancing the thirteen non-exclusive factors set forth in *E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973). Not all the *DuPont* factors are relevant in every case, and only relevant factors need to be considered. *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346 (Fed. Cir. 2010). In this case, the Board considered the following *DuPont* factors:

1. The strength of the IFIT Mark;
2. The similarity of the parties' trademarks;
3. The similarity of the parties' goods and services;
4. The similarity of the parties' classes of consumers;
5. The similarity of the parties' channels of trade;
6. The sophistication of consumers; and
7. Opposer's use of its IFIT Mark for a variety of goods and services.

(*See generally* Appx1-30.)

On the strength of the IFIT Mark, the Board found that iFIT's advertising, market share, and third-party recognition evidence were "significant," "impressive," and "strong." (Appx9; Appx11; Appx18.) Despite this evidence, the

Board concluded that iFIT had not proven “fame” because it perceived that iFIT’s revenue figures were not tied to the IFIT Mark or to the United States (Appx17), even though there is undisputed evidence that the IFIT Mark is used on “nearly all” of iFIT’s goods and services and even though there is undisputed evidence that iFIT commands a considerable share of the market for exercise and fitness equipment and, specifically, a quarter of all the exercise products sold in the United States in 2021. Based on its reasoning, the Board concluded that the IFIT Mark has “strong recognition” and overall has “some commercial strength” (but is not famous, *i.e.*, not “very strong”), weighing in favor of likelihood of confusion but not weighing *heavily* or *dominating* in favor of likelihood of confusion. (Appx16-18; Appx29.)

On the issue of the similarity of the marks, the Board found that the I-FIT FLEX mark is “highly similar” to the IFIT Mark in “appearance, sound, connotation, and commercial impression.” (Appx18-19.) The Board further concluded that ERB “essentially concedes that the disclaimed term FLEX at the end of its involved mark merely describes a feature of Applicant’s identified safety glasses” and found that “I-FIT is the dominant portion of Applicant’s mark” because “it is settled that that descriptive and disclaimed terms such as FLEX are entitled to less weight.” (Appx19.) Even though the Board had already found that the I-FIT FLEX mark is “highly similar” to the IFIT Mark in “connotation,” the

Board then stated that “the term ‘FIT’ conveys a different meaning in [iFIT’s] mark (fitness) than it does in [ERB’s] (the correct size or shape).” (Appx19.) Nevertheless, the Board concluded that “this difference in meaning is outweighed by how similar the parties’ marks are in appearance and sound.” (Appx20.) In its final analysis, the Board relied on a finding that ERB’s mark was “similar” overall to the IFIT Mark and explained that it weighed that similarity in favor of likelihood of confusion but not *heavily* in favor of likelihood of confusion. (Appx29.)

On the issue of the sophistication of consumers, the Board found that ERB’s goods are inexpensive, and consumers are therefore not likely to exercise significant care in purchasing them, also weighing in favor of likelihood of confusion. (Appx28.)

On the issue of whether the IFIT Mark is used for a variety of goods and services, the Board found that the IFIT Mark is only used on goods and services within iFIT’s core field of health and fitness and not as a “typical ‘merchandising mark’” beyond that core, which the Board concluded was a neutral factor. (Appx28-29.)

On the remaining factors, the Board concluded that iFIT failed to show that the parties’ goods and services were related or that they traveled in the same channels of trade to the same classes of consumers (Appx20-28), even though it is undisputed that (1) iFIT uses and has registered its IFIT Mark in connection with

“fitness training services” as well as “[f]itness and exercise machines”; (2) ERB’s application broadly lists “safety eyewear,” which encompasses any type of safety eyewear, including eyewear worn by cyclists; (3) cyclists are likely to purchase safety eyewear and then use such eyewear during “fitness training services” such as outdoor cycling training; and (4) third-party registrations show that there at least five sellers registered to sell both (1) safety glasses and (2)(a) fitness machines or (2)(b) fitness training services.

The Board concluded that there was no “reason to believe that fitness training services would emanate from the same source as safety glasses” because “there is no need for indoor cyclists to protect their eyes from hazards” and because “there is no evidence that indoor cyclists wear safety or protective eyewear” (Appx25), even though there is no “indoor” limitation on the “fitness training services” registered for use with the IFIT Mark. The Board also reasoned that “some racecar drivers and chemists also use safety eyewear, but that does not mean that safety eyewear is related to racecars or ammonia” (Appx26), even though that analogy did not correspond to the relatedness argument that iFIT is making.

With respect to the third-party registrations showing that there at least five sellers with marks registered for use with both (1) safety glasses and (2)(a) fitness machines or (2)(b) fitness training services, the Board reasoned that “there are not

enough of them to be persuasive” (Appx26), even though the Board has found that same number of registrations to be probative in other cases.

As for overlapping classes of consumers, the Board acknowledged that “there is some amount of overlap” involving cyclists, but it concluded that it could not detect “overlap sufficient to make confusion likely.” (Appx28.) It reasoned that “[w]hile some outdoor ‘cyclists’ may work out on indoor stationary bikes during inclement weather, the extent of any such overlap between ‘cyclists’ and consumers of [iFIT’s] products and services has not been established” (Appx28), even though iFIT’s main point was not that safety-glass-purchasing cyclists would purchase “indoor stationary bikes” but that safety-glass-purchasing cyclists would purchase “fitness training services” such as outdoor cycling training. The Board also reasoned that “there is no evidence that any of the cyclists who posted on the Internet that they use safety glasses for cycling are also consumers of the types of goods and services [iFIT] offers under iFIT” (Appx28), even though the record is replete with examples of cyclists using safety glasses and engaging in iFIT-branded “fitness training services.”

Finally, as for overlapping channels of trade, the Board reasoned that the fact that “both parties sell their goods through Amazon and Walmart” is “not persuasive” because there are a wide variety of goods sold through those channels (Appx27-28) and reasoned that the presumption of same channels of trade was not

applicable because the goods and services at issue have not been shown to have been related (Appx26-27). But the Board acknowledged that it should be presumed that “the goods and services move in all channels of trade normal therefor.” (Appx26-27.)

In conclusion, the Board determined that its deemed dissimilarities between the goods, channels, and consumers was “dispositive.” (Appx29.) As a result, the Board concluded that there was no likelihood of confusion. (Appx29.) “[B]ecause the goods are not related,” the Board reasoned, “confusion is unlikely notwithstanding that the marks are similar.” (Appx29.) iFIT has now appealed. (Appx3033-3067.)

SUMMARY OF THE ARGUMENT

The Board’s findings on three of the *DuPont* factors are not supported by substantial evidence, and the Board therefore erred in the weight that it gave to those factors. The Board also erred in the weight that it gave to the similarity of the marks. When those errors are corrected, it is clear that the Board erred in its ultimate conclusion that there was no likelihood of confusion.

First, the Board’s finding that the IFIT Mark is not famous is unsupported by substantial evidence. There is undisputed evidence—including revenue, market share, length of use, marketing spend, and unsolicited media attention—that iFIT’s mark is famous. iFIT has used its marks for twenty years, has had average annual

revenue in the hundreds of millions of dollars, and has had an annual marketing budget in the tens of millions of dollars. iFIT has advertised its IFIT-branded products on nationwide television for years, and advertisements for IFIT-branded products are frequently published in major newspapers across the United States. iFIT has also received considerable unsolicited media attention from major nationwide publications. Indeed, the Board acknowledged that iFIT’s advertising, market share, and third-party recognition evidence was “significant,” “impressive,” and “strong.” However, the Board improperly discounted iFIT’s evidence of fame merely because it believed iFIT’s *revenue figures* were not tied to the IFIT Mark or to the United States. That belief is demonstrably incorrect, and therefore the Board’s finding of no fame is unsupported by substantial evidence. iFIT’s revenue figures *are* tied to the IFIT Mark because there is undisputed evidence that the IFIT Mark is used on “nearly all” of iFIT’s goods and services. Moreover, this Court has not required a revenue tie to the United States to establish fame, but even if such a tie is required, iFIT’s revenue figures *are* tied to the United States because undisputed evidence shows that iFIT commands a considerable market share of all exercise products sold in the United States, and specifically a quarter of all the exercise products sold in the United States in 2021.

Second, the Board’s finding that the parties’ goods and services are unrelated was not supported by substantial evidence. It is undisputed that iFIT uses

and has registered its IFIT Mark in connection with “conducting personal training in the field of health and fitness” and “personal fitness training services and consultancy,” as well as “[f]itness and exercise machines.” ERB’s application broadly lists “safety eyewear,” which encompasses any type of safety eyewear, including eyewear worn by cyclists. Undisputed evidence shows that safety glasses and fitness training services are purchased by an overlapping group of consumers (namely, cyclists) and are used together, *i.e.*, cyclists use safety glasses *during* fitness training services. Likewise, undisputed third-party registrations show that safety glasses and fitness equipment or fitness training services are registered to be sold together by at least five sellers. The Board did not rely on any contrary evidence to reject this evidence. Rather, the Board used faulty and legally erroneous reasoning to do so. As such, there is no reasonable basis for the Board’s conclusion on relatedness of the parties’ goods and services and therefore no substantial evidence to support the Board’s finding of no relatedness.

Third, the Board’s finding that the parties’ consumers do not sufficiently overlap is unsupported by substantial evidence. The undisputed evidence shows that iFIT’s services and ERB’s goods are both purchased by cyclists. iFIT actively markets its goods and services to cyclists. Evidence from iFIT’s marketing and internet forums demonstrates that cyclists purchase safety eyewear—even the “industrial” safety eyewear sold in hardware stores. The Board discounted this

evidence because it erroneously focused solely on iFIT's registration for "[f]itness and exercise machines" and ignored iFIT's registration for "fitness training services." The record is replete with examples of cyclists using safety glasses and engaging in iFIT-branded fitness training services. Thus, the Board had no reasonable basis for discounting the undisputed evidence of overlapping customers, and its finding that the parties' consumers do not sufficiently overlap is therefore unsupported by substantial evidence.

Fourth, the Board did not apply a proper weight to the first *DuPont* factor, the similarity of the marks. As this Court recently explained in *Naterra Int'l, Inc. v. Bensalem*, ___ F.4th ___, 2024 WL 629148 (Fed. Cir. Feb. 15, 2024), similar marks such as those involved here must be weighed "heavily" in favor of a likelihood of confusion, not just weighed in favor of a likelihood of confusion.

When the Board's findings are corrected and the *DuPont* factors are properly weighed, the correct conclusion is that there is a likelihood of confusion between the parties' marks. As noted above, the Board failed to weigh heavily the similarity of the marks. The Board also failed to find that the goods and services at issue are related and are sold to a common group of purchasers, namely cyclists. When proper weight is given to the similarity of the marks and the relatedness of the goods is recognized, the proper conclusion is a likelihood of confusion. In addition, the Board failed to find fame and therefore improperly weighed the strength of the

IFIT Mark in its analysis. Given its proper weight, the fame of the IFIT Mark tips the scales in favor of a likelihood of confusion regardless of the relatedness of the parties' goods and services.

ARGUMENT

I. Standard of Review

This Court “review[s] the Board’s factual findings on each relevant *DuPont* factor for substantial evidence, but ... review[s] the Board’s weighing of the *DuPont* factors *de novo*.” *Tiger Lily Ventures Ltd. v. Barclays Cap. Inc.*, 35 F.4th 1352, 1362 (Fed. Cir. 2022) (citing *QuikTrip West, Inc. v. Weigel Stores, Inc.*, 984 F.3d 1031, 1034 (Fed. Cir. 2021)). The Board’s ultimate conclusion as to whether there is likelihood of confusion is also reviewed *de novo*. *In re Chatam Int’l Inc.*, 380 F.3d 1340, 1342 (Fed. Cir. 2004).

“Substantial evidence is more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion.” *In re Gartside*, 203 F.3d 1305, 1312 (Fed. Cir. 2000) (quoting *Consolidated Edison Co. v. NLRB*, 305 U.S. 197, 229–30 (1938)). Under the substantial evidence standard, the reviewing court examines the record “as a whole, taking into account evidence that both justifies and detracts from an agency’s decision.” *Id.*

II. The Board's Finding That There Is No Fame Is Unsupported By Substantial Evidence

A. There Is Undisputed Evidence That the IFIT Mark Is Famous

The Board's finding that the IFIT Mark is strong but not famous is not supported by substantial evidence. iFIT's sales figures, market share figures, advertising figures, length of use, and unsolicited media attention provide undisputed evidence that the IFIT Mark is famous. As further discussed below, the Board did not have a reasonable basis for discounting this evidence; indeed, its reasoning was demonstrably faulty. Therefore, the Board's finding that the IFIT Mark is not famous is unsupported by substantial evidence.

1. *iFIT's Length of Use, Sales Figures, Market Share, Advertising Figures, and Unsolicited Media Attention are Undisputed Evidence of the Fame of the IFIT Mark*

"[T]he fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident." *Bose Corp. v. QSC Audio Prod., Inc.*, 293 F.3d 1367, 1371 (Fed. Cir. 2002). This Court has "consistently accepted statistics of sales and advertising as indicia of fame," and "when the numbers are large, [it has] tended to accept them without any further supporting proof." *Id.*

For example, in *Bose*, this Court found the mark ACOUSTIC WAVE to be famous based on uncontested evidence of "over 17 years of use on the products

covered by the mark, with annual sales of over \$50 million, which translates to approximately 50,000 units sold annually, ... approximately 850,000 units sold since the product debuted, ... [and] more than \$5 million [spent] annually to advertise the covered products.” *Id.* at 1372.

Comparing the facts of this case to the facts in *Bose* demonstrates that the IFIT Mark is famous. iFIT has used its mark for twenty years—longer than the ACOUSTIC WAVE mark had been used in *Bose*. iFIT’s revenue and marketing numbers are also higher than the markholder’s revenue and marketing numbers in *Bose*. For each year from 2002 to 2022, iFIT’s average annual revenue has been at least **DOLLAR AMOUNT**. (Appx2755; Appx2281, ¶ 9.) For the years 2017 to 2022, iFIT’s annual marketing budget has on average been greater than **DOLLAR AMOUNT**. *Id.* iFIT’s IFIT app has been purchased by over a million users on the Google Play Store alone. (Appx1991, ¶ 37.)

iFIT’s evidence of fame is also comparable to evidence of fame in other cases. *See, e.g., Kimberly-Clark Corporation v. Douglas Enterprises, Inc.*, 774 F.2d 1144, 1146–47 (Fed. Cir. 1985) (finding the HUGGIES mark to be famous based on \$300 million in sales, \$15 million in advertising, and nine years of use); *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 674–75 (Fed. Cir. 1984) (finding the SPICE ISLANDS mark to be famous based on \$25

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million in annual sales, “several millions of dollars” spent on advertising, and forty years of use).

iFIT’s market share further demonstrates the fame of iFIT’s mark. “Large market shares of product sales or large percentages of advertising expenditures in a product line would buttress claims to fame.” *Bose*, 293 F.3d at 1375; *see also Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1622 (TTAB 1989) (finding the SUAVE mark to be famous based on evidence that SUAVE shampoos and conditioners were the “largest selling” brands in the United States). The undisputed evidence in this case is that the IFIT Mark commands a considerable share of the market for exercise and fitness equipment in the United States and, specifically, that the IFIT Mark was used in connection with a quarter of all the exercise products sold in the United States in 2021. (Appx2280-2281, ¶¶ 3, 4, 5, 10.)

In *Bose*, this Court found that the Board erred in its fame analysis when it “only referred to the sales and advertising data and did not give any weight to the vast evidence of public notice given to the marked products.” 293 F.3d at 1373. This Court discussed the “nationwide” critical attention focused on the opposer’s trademarked device in publications such as “the Boston Herald, Chicago Tribune, Metrowest Business Review, Stereo Guide, Consumer Electronics Show Daily, Sound and Vision, High Fidelity, Popular Science, The Atlantic, and Chicago.” *Id.*

at 1372; *see also Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 1320 (Fed. Cir. 2018) (finding that “considerable contextual evidence of the type of advertisements and promotions” used by the markholder, including nationwide television campaigns and “mention[s]” in the Wall Street Journal, New York Times, and LA Times, provided context for sales and advertising figures); *Loreal S.A. & Loreal USA, Inc. v. Marcon*, 102 USPQ2d 1434, 1437 (TTAB 2012) (finding fame after noting that “Opposer and its marks have enjoyed significant unsolicited media coverage in national publications such as The New York Times, The Wall Street Journal, and The Washington Post”).

Similar to the markholder in *Bose*, iFIT and its IFIT-branded products have received significant unsolicited media attention from nationwide publications such as (to name a few) The Wall Street Journal, Wirecutter (which is published by the New York Times), Forbes, NBC News, Insider, Good Housekeeping, PCMag, Runner’s World, and Mashable. (Appx1313-1704; Appx2098-2161.) This attention has not been limited to “health and fitness media,” as the Board seemed to indicate. (Appx17.) Instead, iFIT’s mark has received attention in many publications outside the health and fitness space, such as most of the publications listed above.

In addition, iFIT has advertised on nationwide television for years, including commercials targeted at nearly every demographic group in the United States. (Appx1987-1988, ¶¶ 21-24.) For example, the addition of Michael Phelps, Alex

Morgan and other Olympic and Paralympic athletes as IFIT trainers was publicized in a series of television advertisements broadcast on NBC throughout the 2020 Summer Olympic Games. (Appx1987, ¶¶ 18, 21.) The record includes sample images from IFIT’s television ads. (See, e.g., Appx2047-2061.) These show that the IFIT Mark is prominently displayed in iFIT’s television advertising. See, e.g., *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 1570 (Fed. Cir. 1983) (finding a mark was famous in part because the markholder “has enjoyed considerable exposure through the media, having been featured on national television as well as locally”); *Loreal*, 102 USPQ2d 1434 (finding fame after noting that a mark had been promoted in television commercials and by famous spokespersons).

Advertisements for IFIT-branded products are also frequently published in major newspapers across the United States, including the New York Times, the New York Daily News, Newsday, the New York Post, the Boston Globe, the Boston Herald, the Hartford Courant, the Newark Star-Ledger, the Philadelphia Inquirer, the Baltimore Sun, the Washington Post, the Chicago Sun-Times, the Chicago Tribune, Detroit News, the St. Paul Pioneer Press, the Star Tribune (Minneapolis, the MN), the Indianapolis Star, the St. Louis Post Dispatch, the Orlando Sentinel, the Miami Herald, the Atlanta Journal Constitution, the Dallas Morning News, the Fort Worth Star-Telegram, the Houston Chronicle, the Rocky

Mountain News, the Sacramento Bee, the San Francisco Chronicle, the San Francisco Examiner, the San Jose Mercury News, the Orange County Register, and the Los Angeles Times. (Appx1989-1990, ¶ 29.)

Thus, there is a mountain of undisputed evidence demonstrating the fame of iFIT's mark, and the Board correctly found that iFIT's advertising, market share, and third-party recognition evidence were "significant," "impressive," and "strong." (Appx9; Appx11; Appx18.).

2. *ERB Did Not Dispute the Fame of iFIT's Mark*

Despite iFIT's evidence of fame, the Board found that the IFIT Mark was not famous. The Board's finding that the IFIT Mark is not famous was not based on any arguments from ERB. ERB did not argue that iFIT's mark is not famous. ERB merely argued that "Opposer's asserted fame is not enough to dominate the likelihood of confusion analysis." (Appx2787.) ERB further argued that Opposer's fame was irrelevant because the parties' markets do not overlap. (Appx2789.) ERB's first argument is simply wrong as a legal matter. "[T]his court and its predecessor court have consistently stated that fame of the mark is a dominant factor in the likelihood of confusion analysis for a famous mark, independent of the consideration of the relatedness of the goods." *Recot, Inc. v. Becton*, 214 F.3d 1322, 1328 (Fed. Cir. 2000). ERB's second argument is wrong as a factual matter, as will be discussed in Sections III and IV below.

B. The Board Had No Reasonable Basis for Discounting iFIT's Evidence of Fame

The Board had no reasonable basis for discounting iFIT's evidence of fame. As noted above, the Board found that iFIT's advertising, market share, and third-party recognition evidence were "significant," "impressive," and "strong." (Appx9; Appx11; Appx18.) However, it then discounted this evidence solely because it determined that iFIT's revenue figures were not specifically tied to the IFIT Mark or limited to the United States. (Appx17.) That determination is demonstrably incorrect. Therefore, the Board had no reasonable basis to discount iFIT's evidence of fame and its finding that the IFIT Mark is not famous is unsupported by substantial evidence.

First, iFIT's revenue figures *are* clearly tied to the IFIT Mark because the undisputed evidence is that the IFIT Mark is used on "nearly all" of iFIT's goods and services, as shown throughout the record:

- "[T]he IFIT trademark is used on nearly all the goods and services marketed and sold by [iFIT]." (Appx2280, ¶ 4.)
- "[A] quarter of all the exercise products sold in the United States in 2021 were marked with the IFIT mark." (Appx2280, ¶ 5.)
- "[iFIT] has been using the IFIT brand continuously in connection with nearly all of ICON's health and fitness-related goods and services ... since February 1999." (Appx1979, ¶ 4.)

- “The IFIT trademark is used on nearly all the goods and services marketed and sold by [iFIT].” (Appx1979, ¶ 5)
- “During [the years 2017 to 2022], nearly all marketing materials, videos, and advertisements ... display or have included the IFIT mark across all of the [iFIT] equipment and accessory lines.” (Appx1987, ¶ 19)

Given this undisputed evidence, the Board’s first rationale for discounting the evidence of fame is simply not reasonable.

The Board’s second rationale for discounting the evidence of fame was that iFIT’s revenue figures were “not limited to revenues derived from the United States.” (Appx17.) When analyzing fame, however, this Court has not required or specifically referenced sales only in the United States. *See, e.g., Bose*, 293 F.3d at 1372. In any event, even if a tie to the United States is required, iFIT’s sales and advertising numbers “are bolstered by overwhelming evidence of confirmatory context.” *Id.* at 1376. For example, the undisputed market share evidence demonstrates that iFIT “commands a considerable share of the market for exercise and fitness equipment” and, specifically, that “[iFIT] sold over 25% of the exercise units sold *in the United States* in 2021.” (Appx2280, ¶¶ 4, 5.) Moreover, the undisputed evidence further establishes that “[n]early all of these units were marked with the IFIT mark; thus, a quarter of all the exercise products sold *in the United States* in 2021 were marked with the IFIT mark.” (Appx2280, ¶ 5.) Given

this undisputed evidence, the Board's second rationale for discounting the evidence of fame is also not reasonable. As such, the Board had no reasonable basis for discounting iFIT's evidence of fame, and the Board's finding of no fame is unsupported by substantial evidence.

In conclusion, iFIT's decades of use of its marks, its hundreds of millions of dollars in sales, its dominating market share, its tens of millions of dollars spent on advertising, and its unsolicited nationwide recognition are undisputed evidence that the IFIT Mark is famous. "When the full record is considered, only one conclusion can be reached regarding the fame of the [IFIT] marks: they are famous and thus entitled to broad protection." *Bose*, 293 F.3d at 1376. The Board's finding otherwise is not supported by substantial evidence.

III. The Board's Finding That the Parties' Goods and Services Are Unrelated Is Not Supported By Substantial Evidence

The Board's finding that the parties' goods and services are unrelated was also not supported by substantial evidence. The undisputed evidence shows that the goods and services at issue are both (1) purchased by an overlapping group of consumers, *i.e.*, cyclists, and then used together and (2) registered to be sold together by at least five sellers.

A. The Legal Standard Is Whether Goods and Services Are Related, Not Identical or Competitive

The question under this *DuPont* factor is whether the parties' goods and services are "related"—not "identical." Consumers understand that "companies frequently cross product lines and manufacture products ... which complement each other in the market place." *Frank Brunckhorst Co. v. G. Heileman Brewing Co.*, 875 F. Supp. 966, 979 (E.D.N.Y. 1994). In the likelihood of confusion analysis, goods and services must merely be "related in some manner such that their marketing under the same or a similar mark would lead purchasers or ultimate consumers to believe that they emanate from the same source or that there is an association between their respective sources." *Allstate Ins. Co. v. Delibro*, 6 USPQ2d 1220, 1222 (TTAB 1988); *see also In re Save Venice New York, Inc.*, 259 F.3d 1346, 1355 (Fed. Cir. 2001) ("The related goods test measures whether a reasonably prudent consumer would believe that non-competitive but related goods sold under similar marks derive from the same source, or are affiliated with, connected with, or sponsored by the same trademark owner.").

Goods and services that may appear to be uncompetitive have nevertheless been found to be related for likelihood of confusion purposes, including the following:

- *Allstate*, 6 USPQ2d at 1223 (TTAB 1988) (insurance services vs. tractor trailer driver training services);

- *Kabushiki Kaisha Hattori Seiko v. Satellite Int'l Ltd.*, 29 USPQ2d 1317, 1319 (TTAB 1991) (watches vs. shoes);
- *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 1336 (CCPA 1981) (board games vs. T-shirts);
- *Safeway Stores, Inc. v. Safeway Properties, Inc.*, 307 F.2d 495, 499 (2d Cir. 1962) (retail grocery business vs. real estate business);
- *Turner Ent. Co. v. Nelson*, 38 USPQ2d 1942, 1945-46 (TTAB 1996) (a television series vs. suntan lotion);
- *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570 (Fed. Cir. 1983) (supermarkets vs. fast food restaurants);
- *Frank Brunckhorst Co. v. G. Heileman Brewing Co.*, 875 F. Supp. 966, 979 (E.D.N.Y. 1994) (deli meats vs. beer);
- *L.C. Licensing, Inc. v. Cary Berman*, 86 USPQ2d 1883, 1890 (TTAB 2008) (apparel vs. automotive accessories);
- *In re Eldorado Motor Corp.*, 6 USPQ2d 1732, 1734 (TTAB 1988) (boats vs. motorhomes);
- *K2 Corp. v. Philip Morris Inc.*, 192 USPQ 174, 178 (TTAB June 15, 1976) (skis vs. cigarettes);
- *Gap, Inc. v. G.A.P. Adventures Inc.*, 100 USPQ2d 1417, 1429-30 (S.D.N.Y. June 24, 2011) (apparel vs. travel tours);

- *In re Hester Indus., Inc.*, 231 USPQ 881, 884 (TTAB July 31, 1986) (bakery goods vs. frozen chicken);
- *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1110 (TTAB 2007) (toilets and lavatories vs. door hardware); and
- *Tiger Lily Ventures Ltd. v. Barclays Cap. Inc.*, 35 F.4th 1352, 1363 (Fed. Cir. 2022) (financial services vs. bar and restaurant services).

When—as here—the senior user’s mark is “virtually identical” to the junior user’s mark, “there need only be a viable relationship between the goods to find that there is a likelihood of confusion.” *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1636 (TTAB 2009) (precedential) (citing *In re Shell Oil Co.*, 992 F.2d 1204, 1207 (Fed. Cir. 1993) (“[E]ven when the goods or services are not competitive or intrinsically related, the use of identical marks can lead to the assumption that there is a common source....”). ERB’s goods must be considered as they are described in ERB’s application, and “the description must be construed most favorably to the opposing prior user.” *Monopoly*, 648 F.2d at 1337.

For example, in *Kohler*, the senior user registered its mark in connection with toilets and lavatories and petitioned to cancel a mark that had been registered in connection with “metal door hardware.” 82 USPQ2d at 1100. The junior user claimed its metal door hardware was unrelated to the senior user’s goods in part because the junior user’s metal door hardware was primarily used on exterior doors

in new construction projects. *Id.* However, the senior user argued that the junior user's broad description of goods also encompassed bathroom door hardware. *Id.* The Board found that the description of goods extended to bathroom door hardware and found the goods to be related based on that description because they were likely to be found in the same area of the house and to be purchased by the same consumers (i.e., consumers purchasing products for their bathrooms). *Id.*

B. The Undisputed Evidence Shows That The Parties' Goods and Services Are Related Because They Are Purchased By An Overlapping Group of Consumers, i.e., Cyclists, And Then Used Together

Similar to the goods at issue in *Kohler*, iFIT and ERB's goods and services are "complementary" in that they may be used together. *See, e.g., Kohler*, 82 USPQ2d at 1110 ("[T]he goods may be viewed as complementary in that they may be used together."); *see also In re Louis Vuitton Malletier*, 777 F. App'x 984, 989 (Fed. Cir. 2019) (nonprecedential) ("[E]vidence shows that perfumery and hair care products are complementary products which often emanate from the same source."); *Hester*, 231 USPQ at 883 (finding relatedness between goods that "might well be sold to the same purchasers ... for use together"). Specifically, they are purchased by an overlapping group of consumers, *i.e.*, cyclists, and then used together.

As explained above, iFIT uses and has registered its IFIT Mark in connection with fitness training services. (Appx2726-2727.) The undisputed

evidence shows that iFIT's fitness training services are not limited to fitness training services offered "inside" or in connection with fitness machines such as exercise bikes or treadmills. Rather, the description of goods and services in iFIT's Reg. No. 2,618,509 merely specifies "educational services, namely, conducting personal training in the field of health and fitness." (Appx299.) And iFIT's Reg. No. 4,450,213 merely specifies "[p]ersonal fitness training services and consultancy; [p]hysical fitness instruction; [and] [p]hysical fitness training services." (Appx321.) iFIT also uses and has registered its IFIT Mark in connection with "[f]itness and exercise machines," including stationary bicycles. (Appx299.)

ERB's application specifies that its mark is to be used for "industrial protective eyewear; safety eyewear." (Appx2971.) It is undisputed that the broad description "safety eyewear" encompasses any type of safety eyewear, including eyewear worn by cyclists.

The undisputed evidence shows that cyclists purchase safety eyewear and then use it during fitness training services (e.g., during outdoor cycling training).¹

¹ In its brief before the TTAB, ERB argued that iFIT markets its goods and services only to stationary cyclists, not outdoor cyclists. (Appx2777.) This assumes that "stationary cyclists" are a class that never overlaps with "outdoor cyclists." The argument is also refuted by iFIT's evidence that iFIT "actively markets its goods and services to **cyclists.**" (Appx1986, ¶ 16 (emphasis added).) Even the Board acknowledged that "some outdoor 'cyclists' may work out on indoor stationary bikes during inclement weather." (Appx28.)

This is established by several pieces of undisputed evidence. First it is established by evidence that cyclists purchase safety glasses. In several blogs and online forums, cyclists discuss purchasing safety glasses, even from hardware stores, to use during cycling. (Appx1124-1171; Appx1178-1179; Appx1188-1194; Appx1200-1218.) In one forum, a user asks whether safety glasses (as opposed to cycling-specific glasses) are suitable for use during cycling (Appx1124), and responses include the following:

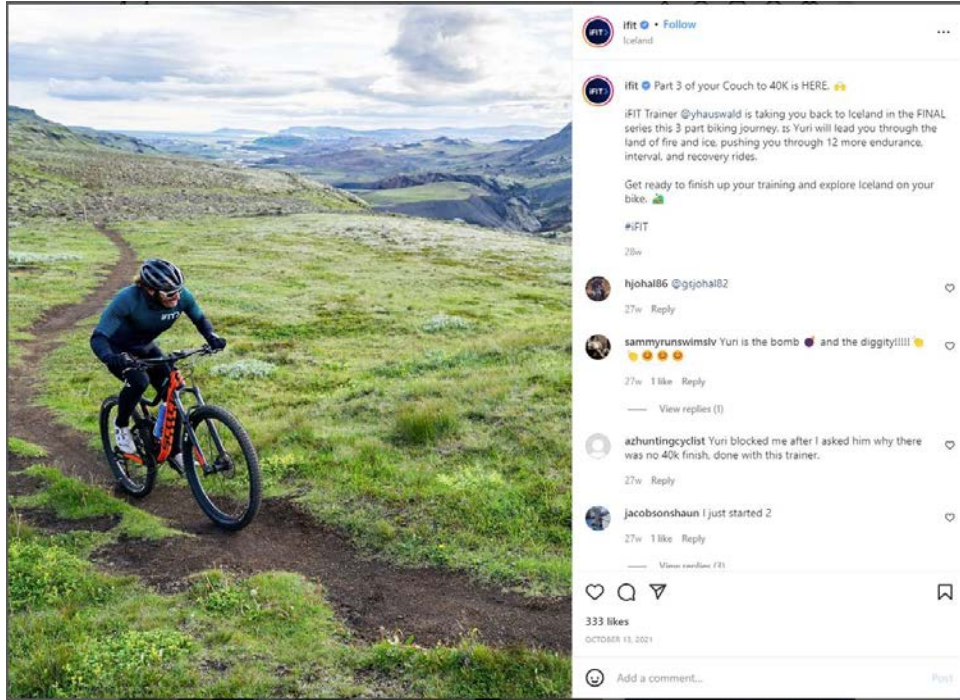
- “If they work for you, keep using them.” (Appx1125.)
- “I have the full suite of those same type [of] safety glasses (clear, tinted, yellow) and they’re great for a \$2 solution.” (*Id.*)
- “I’ve been using safety glasses for years.” (Appx1127.)
- “I use generic safety glasses.” (Appx1129.)

In another forum, a cyclist states that he or she purchased safety glasses from a hardware store for cycling. (Appx1134.) Others comment: “People do this. It’s ok”; “Safety glasses are so cheap that I have multiple pairs”; and “I ride with safety glasses I got for 5 bucks at home depot.” (Appx1134; Appx1135; Appx1136.)

A second collection of evidence shows that once cyclists purchase safety eyewear, they use it during fitness training services (e.g., during outdoor cycling training). This is established with multiple images of iFIT’s fitness instructors

wearing safety eyewear while providing fitness instruction related to cycling, as shown in the examples below:





ifit • Follow
Iceland

ifit Part 3 of your Couch to 40K is HERE 🏆

iFIT Trainer @yhauswald is taking you back to Iceland in the FINAL series this 3 part biking journey. ts Yuri will lead you through the land of fire and ice, pushing you through 12 more endurance, interval, and recovery rides.

Get ready to finish up your training and explore Iceland on your bike. 🏆

#iFIT

28w

njohal86 @ggjohal82
27w Reply

sammyrunswimstv Yuri is the bomb 🏆 and the diggity!!!! 🏆
27w 1 like Reply

— View replies (1)

azhuntingcyclist Yuri blocked me after I asked him why there was no 40k finish, done with this trainer.
27w Reply

jacobsonshaun I just started 2
27w 1 like Reply

— View replies (1)

333 likes
OCTOBER 13, 2021

Add a comment... Post



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ifit New cycling series AND a new iFIT Trainer? Let's get after it, iFIT! 🏆

Join Olympic silver medalist, and Tour de France podium finisher @bobby.julich for his Progressive Peak Performance Series. 🏆

In this intermediate to advanced series, you'll work through 4 different types of rides: fit, strong, powerful and fast. Each ride focuses on steady state, torque, 40/20 and progressive efforts. The first 8 rides are intermediate while the last 4 are advanced.

Add the series to your iFIT library at the link in our bio.

#iFIT

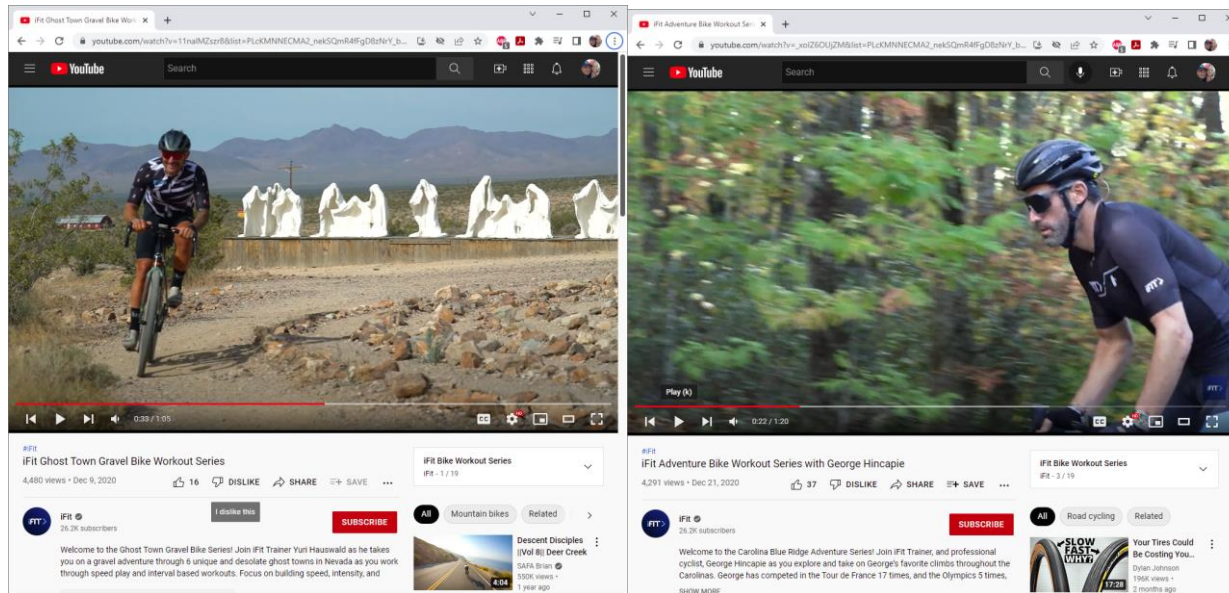
426 likes
AUGUST 30, 2021

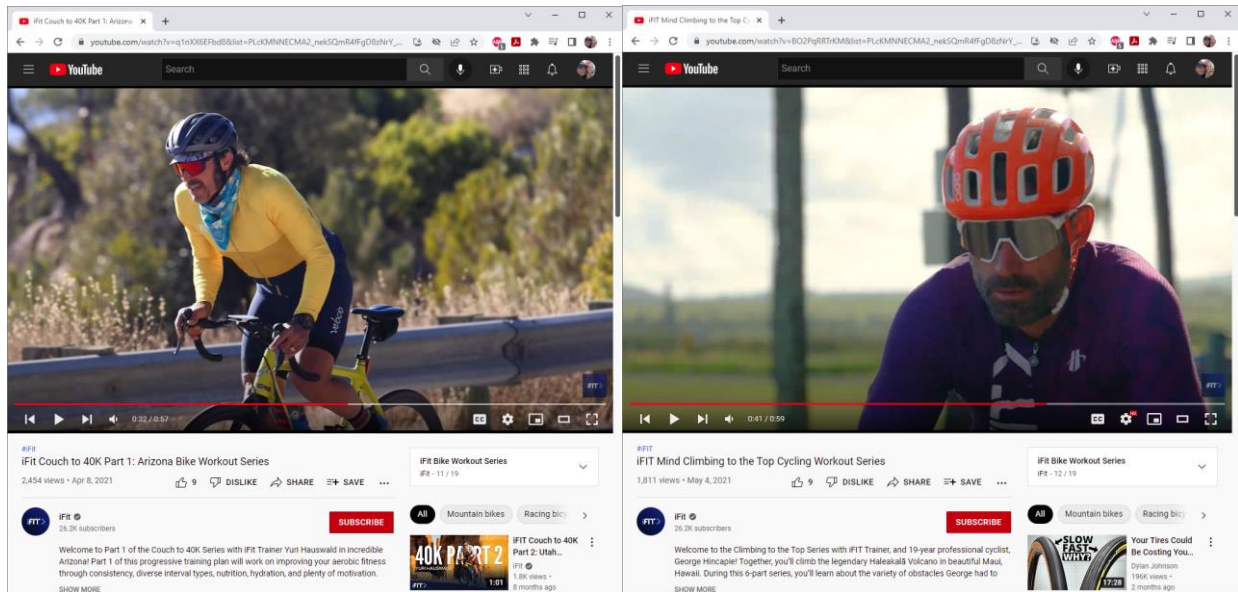
Add a comment... Post



(Id., ¶ 13.)

Likewise, iFIT’s iFIT YouTube channel has numerous videos showing trainers wearing safety glasses while doing cycling workouts, as shown in the examples below:






(Appx1982-1986, ¶¶ 13–14; Appx1106-1118.)

These images of iFIT’s fitness instructors may be some of the best evidence that the parties’ goods and services are related because iFIT’s trainers are wearing goods covered by ERB’s application (safety eyewear) while providing iFIT’s services (fitness instruction services). *See, e.g., Motion Picture Ass’n of Am., Inc. v. Respect Sportswear, Inc.*, 83 USPQ2d 1555, 1563 (TTAB 2007) (finding apparel to be related to “entertainment services rendered through the medium of motion pictures” after considering, among other evidence, images of T-shirts printed with the titles of motion pictures).

C. The Undisputed Evidence Shows That The Parties’ Goods and Services Are Also Related Because They Are Registered to Be Sold Together

Not only are both parties’ goods and services purchased by and then used together by an overlapping group of customers, *i.e.*, cyclists, but both parties’

goods and services are registered to be sold together. iFIT's registrations for the IFIT Mark not only cover "conducting personal training in the field of health and fitness" (Appx93) and "personal fitness training services and consultancy" (Appx95), but they also cover "[f]itness and exercise machines" (Appx93). And third-party registrations show that there at least five sellers with marks registered for use with both (1) safety glasses and (2)(a) fitness machines or (2)(b) fitness training services, as follows:

UNDER ARMOUR (Reg. No. 513760) and  (Reg. No. 5193655) are registered to the same owner for "protective eyewear" and "electronic devices, namely, data sensors, transmitters and receivers for relaying physical exercise data."

Airwheel (Reg. No. 5429233) is registered for "protective eyewear" and "exercise treadmills."

ATHLETES INSIGHT (Reg. No. 5600176) is registered for "sports eyewear" and "personal fitness training services."

ENDORPHINS MAKE YOU HAPPY (Reg. No. 6070156) is registered for "retail store services featuring...eyewear...exercise equipment..."

HISEA (Reg. No. 5199993) is registered for "protective eyewear" and "exercise machines."

(Appx1224-1226; Appx1227-1228; Appx1231; Appx1238; Appx1263-1265; *see also* Appx1224-1269.) Thus, there is undisputed evidence that both parties' goods and services are registered to be sold together.

“[T]hird-party registrations which individually cover a number of different items and which are based on use in commerce may have some probative value to the extent that they serve to suggest that the listed goods and/or services are of a type which may emanate from a single source.” *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993); *see also In re Davey Prod. Pty Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009) (“[Third-party registrations] have probative value to the extent that they serve to suggest that the goods listed therein are of a kind which may emanate from a single source under a single mark.”); *In re Charger Ventures*, 64 F.4th 1375, 1379, 1382 (Fed. Cir. 2023) (affirming Board decision relying on third-party registrations to conclude that services at issue were related); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1267 (Fed. Cir. 2002) (evidence that “a single company sells the goods and services of both parties, if presented, is relevant to the relatedness analysis”). Thus, the undisputed evidence that both parties’ goods and services are registered to be sold together is relevant to establishing that those goods and services may be “related in some manner such that their marketing under the same or a similar mark would lead purchasers or ultimate consumers to believe that they emanate from the same source or that there is an association between their respective sources.” *Allstate Ins. Co. v. Delibro*, 6 USPQ2d 1220, 1222 (TTAB 1988).

D. The Board Did Not Provide a Reasonable Basis For Discounting the Undisputed Evidence of Relatedness

The Board did not provide a reasonable basis for discounting the undisputed evidence of relatedness, and therefore the Board's finding on relatedness was not supported by substantial evidence.

The Board's first reason for discounting the evidence of relatedness was because "there is no need for *indoor* cyclists to protect their eyes from hazards" and because "there is no evidence that *indoor* cyclists wear safety or protective eyewear." (Appx25 (emphasis added).) But there is no "indoor" limitation on the "fitness training services" registered for use with the IFIT Mark and in connection with which cyclists use safety glasses. The Board's reasoning manifests the classic legal error of failing to rely on the goods and services as they are listed in the registration rather than on a limitation of goods or services from elsewhere. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1491-93 (Fed. Cir. 1987); *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 1407-08 (Fed. Cir. 1997) ("Likelihood of confusion must be determined based on an analysis of the mark as applied to the services recited in applicant's application vis-à-vis the services recited in a registration, rather than what the evidence shows the services to be." (cleaned up)); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1267 (Fed. Cir. 2002) ("This 'relatedness of the goods' factor compares

the goods and services in the applicant's application with the goods and services *in the opposer's registration.*" (emphasis added)).

The Board's next rationale for discounting the evidence of relatedness was couched in the form of an analogy involving "racecar drivers and chemists." The Board stated: "[S]ome racecar drivers and chemists also use safety eyewear, but that does not mean that safety eyewear is related to racecars or ammonia." (Appx26.) But that analogy misses the point. iFIT is not arguing that because cyclists use safety glasses, safety glasses are related to bicycles (even though they might be) or that because cyclists use safety glasses, safety glasses are related to bicycle tires, which is what the Board's use of its analogy suggests. Instead, iFIT is arguing that safety glasses are related to fitness training services because cyclists are likely to purchase safety eyewear and then use it during fitness training services. Thus, the more appropriate analogy involving racecar drivers or chemists would be that because racecar drivers use safety eyewear *during racing*, then safety eyewear is related to *racing* and that because chemists use safety eyewear *while performing experiments with ammonia*, then safety eyewear is related to *performing experiments with ammonia*.

As such, neither of the Board's two rationales for concluding that safety glasses and fitness training services are not related withstand scrutiny, and therefore its finding of no relatedness is unsupported by substantial evidence.

With respect to the relatedness of safety glasses and exercise equipment (as opposed to the relatedness of safety glasses and fitness training services already addressed above), the Board based its finding of no relatedness on its reasoning that “there is no evidence that any third parties offer both industrial protective or safety eyewear and fitness or exercise machines.” (Appx25.) But in fact there is such evidence. As discussed above, iFIT presented third-party registrations showing that both safety glasses and exercise machines are registered to be sold together by several sellers.

The Board discounted those third-party registrations based solely on the number of registrations presented. (Appx26.) But that rationale is inconsistent with common sense and with the Board’s own prior cases. Even a handful of third-party examples can be probative of relatedness of goods and can help demonstrate that a single entity may offer all the listed goods, as the Board has previously held. *See, e.g., Kohler*, 82 USPQ2d at 1110 (finding five third-party registrations to be “far from overwhelming” but nevertheless having “probative value” to suggest the parties’ goods were “of a type that emanate from the same source”); *Motion Picture Ass’n*, 83 USPQ2d 1555, 1562-63 (finding relatedness of goods and services based in part on six third-party trademark registrations); *In re Annovium Prod., LLC*, 2014 WL 343261, *10–11 (TTAB Jan. 24, 2014) (finding goods to be related based in part on five third-party trademark registrations and two third-party

websites); *In re Iron Balls Int'l*, 2019 WL 646091, *5 (TTAB Jan. 16, 2019) (finding a commercial relationship between the parties' goods based in part on eight third-party trademark registrations and five third-party websites); *In re Compute N. LLC*, 2022 WL 17370220, *6 (TTAB Nov. 16, 2022) (finding services to be related based in part on five third-party trademark registrations and three third parties' actual use). Thus, the undisputed third-party registration evidence shows that the parties' goods are "of a type that emanate from the same source" and the Board's rationales for concluding that safety glasses and exercise machines are not related do not withstand scrutiny. Therefore, the Board's finding of no relatedness for those goods is unsupported by substantial evidence.

IV. The Board's Finding That the Parties' Customers Do Not Sufficiently Overlap Is Not Supported By Substantial Evidence

The Board acknowledged that there is "certainly some amount of overlap" between the parties' consumers involving cyclists. (Appx28.) However, it concluded that it could not detect "overlap sufficient to make confusion likely." (Appx28.) The Board's failure to detect sufficient overlap is based on faulty reasoning, and therefore it had no reasonable basis for finding insufficient overlap.

A. There Is Undisputed Evidence of Overlapping Customers, Namely Cyclists

It is undisputed that iFIT's and ERB's goods and services are both purchased by cyclists. The IFIT Vice President of Member Experience testified

that iFIT “actively markets its goods and services to cyclists.” (Appx1986, ¶ 16; *see also* Appx2280, ¶ 6.) One way it does so is through an “exclusive Tour de France workout series, whereby users of the IFIT-branded programs can virtually ride all 21 stages of the 2020 Tour de France course on their IFIT-enabled exercise bikes.” (Appx1986, ¶ 16; *see also* Appx1993, ¶ 45 (“The current and potential customer base for both parties is essentially an unlimited group that includes any consumer who wants to participate in exercise, sports, or fitness activities, which activities may require or benefit from the use of protective eyewear.”).)

The undisputed evidence also demonstrates that cyclists purchase the types of goods included in ERB’s application. ERB’s application lists both “industrial protective eyewear” and, more broadly, “safety eyewear,” with no limitations as to type of safety eyewear or targeted consumers. It is common knowledge that cyclists use safety eyewear. (*See, e.g.*, Appx1982-1986, ¶¶ 13–14 (showing images of cyclists wearing safety glasses while cycling).) As discussed above, the record includes screenshots of several online cyclist forums wherein the cyclists discuss purchasing safety glasses, even from hardware stores, to use during cycling. (Appx2750; Appx1124-1171; Appx1178-1179; Appx1188-1194; Appx1200-1218.) Thus, there is undisputed evidence that the parties’ consumers overlap.

B. The Board Had No Reasonable Basis for Disregarding the Evidence of Overlapping Customers

The Board had no reasonable basis for disregarding the undisputed evidence that cyclists constitute a group of overlapping customers. The Board first reasoned that “[w]hile some outdoor ‘cyclists’ may work out on indoor stationary bikes during inclement weather, the extent of any such overlap between ‘cyclists’ and consumers of [iFIT’s] products and services has not been established.” (Appx28.) But iFIT’s main point is not that safety-glass-purchasing cyclists would purchase “indoor stationary bikes” but that safety-glass-purchasing cyclists would purchase “fitness training services,” such as outdoor cycling training. In other words, in analyzing the overlap of customers, the Board erred in focusing solely on iFIT’s registration for “[f]itness and exercise machines” and ignoring iFIT’s registration for “fitness training services.”

The Board also reasoned that “there is no evidence that any of the cyclists who posted on the Internet that they use safety glasses for cycling are also consumers of the types of goods and services [iFIT] offers under iFIT.” (Appx28.) But, again, one of the “services” that iFIT offers under the IFIT Mark is “fitness training services,” and the record is replete with examples of cyclists using safety glasses and engaging in iFIT-branded fitness training services. Thus, none of the reasons that the Board gave for discounting the undisputed evidence of overlapping customers withstands scrutiny.

Even when goods and services are not identical, the TTAB and this Court “have not hesitated to find likelihood of confusion” where the goods and services “could be sold to the same classes of purchasers for complementary use.” *See Hester*, 231 USPQ at 882; *see also In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1567 (Fed. Cir. 1984) (“[C]omplementary use has long been recognized as a relevant consideration in determining a likelihood of confusion.”). Here, safety glasses are in “complementary use” with fitness training services. And because there is at least some overlap in purchasing customers, this factor weighs in favor of likelihood of confusion, not “heavily against” such a finding. *See, e.g., Piccolo Sportswear, Inc. v. Mast Indus., Inc.*, 227 USPQ 710, 714 (TTAB 1985) (finding a likelihood of confusion after noting “some overlap of purchasers” between the two parties).

V. A Proper Weighing of the *DuPont* Factors Demonstrates A Likelihood of Confusion Between The Marks

The Board erred in weighing the *DuPont* factors by 1) giving too little weight to the similarity of the marks, 2) giving no weight to the fame of iFIT’s mark and therefore insufficient weight to the strength of iFIT’s mark, and 3) giving an improper weight to its unsupported findings on the relatedness of the parties’ goods and services and on the overlap of customers. When the *DuPont* factors are weighed properly, the correct conclusion is that there is a likelihood of confusion.

A. The Board Did Not Properly Weigh the Similarity of the Marks

The Board did not apply the proper weight to first *DuPont* factor, the similarity of the marks. The Board held that the marks IFIT and I-FIT FLEX are “highly similar” in “appearance, sound, connotation, and commercial impression” (Appx18) and that the marks are “similar” overall (Appx29), but then only weighed this factor “in favor of a finding of likelihood of confusion” rather than weighing this factor “*heavily* in favor of a finding of likelihood of confusion” (Appx19).

In *Naterra Int’l, Inc. v. Bensalem*, ___ F.4th ___, 2024 WL 629148 (Fed. Cir. Feb. 15, 2024), this Court reviewed a Board decision involving BABY MAGIC and BABIES’ MAGIC TEA, two marks that the Board had found to be “more similar than dissimilar as to appearance, sound, connotation and commercial impression.” *Id.* at *1, *4. Naterra did not challenge the Board’s factual finding on similarity but argued that the Board had not given the similarity of the marks sufficient weight. *Id.* at *4. This Court agreed, explaining that the Board had erred by failing to “weigh heavily” the similarity of the marks. *Id.* at *4; *see also In re Detroit Athletic Co.*, 903 F.3d 1297, 1304 (Fed. Cir. 2018) (affirming finding that similarity of marks “weighs heavily in the confusion analysis”).

Here, the Board found that the marks were even more similar to each other than the marks in *Naterra* and yet failed to conclude that the similarity of the

marks weighed heavily in favor of a likelihood of confusion. That was error. The first *DuPont* factor should—at a minimum—have been weighed *heavily* in favor of finding a likelihood of confusion.

B. The Board Did Not Properly Weigh the Fame of the IFIT Mark

Because the Board discounted iFIT’s evidence of fame, it also failed to properly weigh the fame of the IFIT Mark in the likelihood of confusion analysis. The fame of an opposer’s marks “plays a dominant role in the process of balancing the *DuPont* factors. ...Famous marks thus enjoy a wide latitude of legal protection.” *Recot*, 214 F.3d at 1327. Indeed, the fame of a mark is so dominant in the analysis that it overcomes a finding that the goods and services at issue are not related. *Id.* at 1328 (“[F]ame of the mark is a dominant factor in the likelihood of confusion analysis for a famous mark, independent of the consideration of the relatedness of the goods.”).

As explained above, the Board’s finding that the IFIT Mark is not famous was not supported by substantial evidence. The fame of the IFIT Mark should therefore have dominated in the likelihood of confusion analysis. Given the correct finding and the proper weight, this factor tips the scales in favor of a likelihood of confusion regardless of the relatedness of the parties’ goods.

C. When the *DuPont* Factors In This Case Are Correctly Assessed and Properly Weighed, There Is a Likelihood of Confusion

When the *DuPont* factors are correctly assessed and properly weighed, there is a likelihood of confusion between the parties' marks. The marks (iFIT vs. I-FIT FLEX) are "highly similar" in "appearance, sound, connotation, and commercial impression." (Appx18-19.) There is undisputed evidence that the IFIT mark is famous. (See section II, *supra*.) There is also undisputed evidence that the parties' goods and services are related and are likely to be purchased by overlapping consumers. (See sections III and IV, *supra*.) ERB's goods are inexpensive, and consumers are not likely to exercise significant care in purchasing them. (Appx28.) As such, there is a likelihood of confusion. The Board erred in concluding otherwise.

CONCLUSION

For the foregoing reasons, the TTAB's judgment should be reversed.

Respectfully submitted,

/s/ Matthew A. Barlow

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Attorneys for Appellant iFIT Inc.

DATED: March 12, 2024

ADDENDUM

This Opinion is Not a
Precedent of the TTAB

Mailed: June 27, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

*iFIT Inc.*¹
v.
ERB Industries, Inc.
—

Opposition No. 91264855

—
Matthew A. Barlow and Brittany Frandsen of Workman Nydegger
for iFIT, Inc.

Olivia M. Muller of Erik M. Pelton & Associates, PLLC
for ERB Industries, Inc.

—
Before Adlin, Heasley and Johnson, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Applicant ERB Industries, Inc. seeks registration of I-FIT FLEX, in standard characters (FLEX disclaimed), for “industrial protective eyewear; safety eyewear,” in International Class 9.² In its notice of opposition, Opposer iFIT, Inc. alleges prior use

¹ As explained below, Opposer was formerly known as Icon Health & Fitness, Inc. See Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) § 512.02 (2022).

² Application Serial No. 88692606, filed November 14, 2019 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on first use anywhere and in commerce since at least as early as December 31, 2017.

and registration of IFIT and variations thereof for a variety of health and fitness products and services, including: indoor exercise equipment such as stationary bikes, treadmills and rowing machines; and personal training and fitness monitoring services provided over the Internet and via a mobile app.³ As grounds for opposition, Opposer alleges that use of Applicant's mark would be likely to cause confusion with Opposer's marks. In its answer, Applicant denies the salient allegations in the notice of opposition, and purports to assert "affirmative defenses" which in fact merely amplify its denials.

I. The Record

The record consists of the pleadings, and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of Applicant's involved application. In addition, Opposer introduced:

Notice of Reliance ("NOR") No. 1 on official records including its pleaded registrations ("Opp. NOR 1"). 18 TTABVUE.⁴

NOR No. 2 on Applicant's discovery responses ("Opp. Nor 2"). 19 TTABVUE.

NOR No. 3 on Internet printouts ("Opp. Nor 3"). 21 TTABVUE.

³ Registration Nos. 2466474, 2618509, 3755592, 4450213, 4500591, 4604633, 5228698, 5382573, 5530425 and 5500842, described in more detail below. Some of Opposer's pleaded registrations are over five years old, and the underlying applications in all of them were filed before both the involved application and Applicant's claimed first use date.

⁴ Citations to the record are to TTABVUE, the Board's online docketing system. Specifically, the number preceding "TTABVUE" corresponds to the docket entry number(s), and any number(s) following "TTABVUE" refer to the page number(s) of the docket entry where the cited materials appear.

NOR No. 4 on its discovery deposition of Applicant (“App. Disc. Tr.”) under Fed. R. Civ. P. 30(b)(6) (“Opp. NOR 4”). 23 and 52 TTABVUE.

NOR Nos. 5-10 on Internet printouts and official records (“Opp. Nor 5” – “Opp. NOR 10”). 25-30 TTABVUE.

Testimony Declaration of David Chase Watterson, its Vice President of Member Experience, and the exhibits thereto (“Watterson Dec.”). 31 TTABVUE.

Testimony Declaration of Emily Wilson, one of its legal assistants, and the exhibits thereto (“Wilson Dec.”). 33 TTABVUE.

Testimony Declaration of Colleen Logan, its iFIT brand manager, and the exhibits thereto (“Logan Dec.”). 34 TTABVUE.

Rebuttal Testimony Declaration of Mr. Watterson, and the exhibits thereto (“Watterson Reb. Dec.”). 40 TTABVUE.

Applicant introduced:

NOR No. 1 on Internet printouts (“App. NOR 1”). 36 TTABVUE.

NOR No. 2 on third-party registrations (“App. NOR 2”). 37 TTABVUE.

NOR No. 3 on Opposer’s discovery responses (“App. NOR 3”). 38 TTABVUE.

Testimony Declaration of Jacqueline Barker, an employee in its Price and Rebate Management department, and the exhibits thereto (“Barker Dec.”). 39 TTABVUE.

II. Background

For the most part the parties agree on the pertinent facts but disagree as to their legal significance.

A. Opposer and Its Pleaded IFIT Marks

Opposer “is one of the world’s largest manufacturers of exercise and fitness equipment and sells exercise and fitness goods and services throughout the United States” 31 TTABVUE (Watterson Dec. ¶ 3). “[P]roduct lines offered in connection with IFIT include NORDICTRACK, PROFORM, and FREEMOTION.” *Id.* (Watterson Dec. ¶ 5). “[C]ustomers who purchase Opposer’s IFIT-branded goods are typically individuals seeking to engage in exercise and fitness-related activities and/or improve their overall health and fitness.” 38 TTABVUE 13, 14 (Opposer’s response to Interrogatory Nos. 5 and 8).

Since 1999 Opposer has used its IFIT brand in connection with not just “fitness and exercise machines,” but also “personal exercise training services, and other exercise and fitness-related apparel and accessories.” 31 TTABVUE 3 (Watterson Dec. ¶ 4). Opposer changed its name from “ICON Health & Fitness, Inc.” to “iFIT Inc.” in 2021. 33 TTABVUE 3, 8-10 (Wilson Dec. ¶ 3 and Ex. A).

Opposer’s pleaded registrations are summarized in the following chart:

<u>Mark/Reg. No.</u>	<u>Issue Date/ Status</u>	<u>Goods/Services and Class</u>
IFIT.COM Reg. No. 2466474	July 3, 2001 Renewed	“providing information and consultation services in the field of exercise equipment and personal health, fitness and nutrition by means of a global computer network,” in International Class 42
IFIT Reg. No. 2618509	September 10, 2002 Renewed	“fitness and exercise machines,” in International Class 28 “educational services, namely, conducting personal training in the field of health and fitness,” in International Class 41

<u>Mark/Reg. No.</u>	<u>Issue Date/ Status</u>	<u>Goods/Services and Class</u>
i-FIT Reg. No. 3755592	March 2, 2010 Renewed	“foundation garments; women’s undergarments; lingerie; women’s intimate apparel, namely, brassieres,” in International Class 25
iFIT Reg. No. 4450213	December 17, 2013 Section 8 Declaration accepted; Section 15 Declaration acknowledged	“personal fitness training services and consultancy; physical fitness instruction; physical fitness training services; providing an on-line computer database featuring information regarding exercise and fitness; providing information in the field of exercise training,” in International Class 41
IFIT Reg. No. 4500591	March 25, 2014 Section 8 Declaration accepted; Section 15 Declaration acknowledged	“an application service provider (ASP) featuring software for use with mobile devices, tablet, and computers for tracking, storing, and displaying personal performance data for various fitness activities; ASP featuring application programming interface (API) software for connecting and interacting with software applications on mobile devices, tablets, and computers to track, store, and display personal performance data for various fitness activities,” in International Class 42
IFIT Reg. No. 4604633	September 16, 2014 Section 8 Declaration accepted	“web-based, downloadable software for the collection, storage and display of personal performance data from various fitness activities, display of nutritional information and fitness and athletic programs and workouts, software for tracking, monitoring and planning fitness training activities,” in International Class 9
IFIT Reg. No. 5228698	June 20, 2017	“mattresses,” in International Class 20
IFIT Reg. No. 5382573	January 16, 2018	“nutritional supplement in the nature of a nutrient-dense, protein-based drink mix; powdered nutritional supplement drink mix; protein supplement shakes for weight gain purposes,” in International Class 5

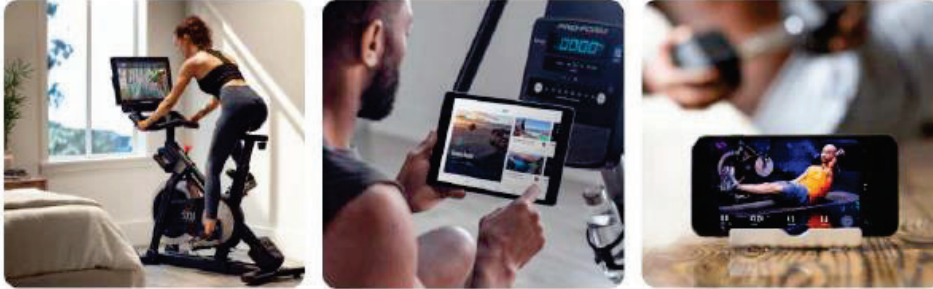
<u>Mark/Reg. No.</u>	<u>Issue Date/ Status</u>	<u>Goods/Services and Class</u>
iFIT Reg. No. 5530425	July 31, 2018	“pedometers; altimeters; scales; multifunctional electronic devices for displaying, measuring, and uploading to the Internet and computer networks information including time, date, heart rate, global positioning, direction, distance, altitude, speed, steps taken, calories burned, navigational information, weather information, temperature, wind speed, changes in heart rate, activity level, hours slept, and quality of sleep; computer software for wireless data communication for receiving, processing, transmitting and displaying information relating to fitness, body fat, body mass index, and heart rate; electronic monitoring devices incorporating microprocessors, digital display, and accelerometers, for detecting, storing, reporting, monitoring, uploading and downloading sport, fitness training, and activity data to the Internet, and communication with personal computers, regarding time, steps taken, calories burned, distance; computer software and computer application software for mobile phones and personal digital devices that provides tips, coaching, and personalized workouts, to improve the user's fitness level,” in International Class 9
IFIT Reg. No. 5500842	June 26, 2018	“footwear, excluding golf shoes,” in International Class 25

Opposer’s “ifit.com” website offers “access to an exercise and fitness community that includes workouts led by leading athletes and trainers, fitness tracking technology, and other health-related information by way of a subscription service.” 31 TTABVUE 4 (Watterson Dec. ¶ 7). The IFIT subscription service is incorporated

into an app, as well as Opposer's treadmills, exercise bikes, ellipticals, rowers and strength trainers, "all of which bear the iFIT mark":

iFIT APP

3 ways to use iFIT



Use our equipment **Use your equipment** **Just use our app**

Sign up today

Start your free trial and use iFIT whenever, wherever.

MEMBERSHIP INCLUDES:

- ✓ **60+ workout types**
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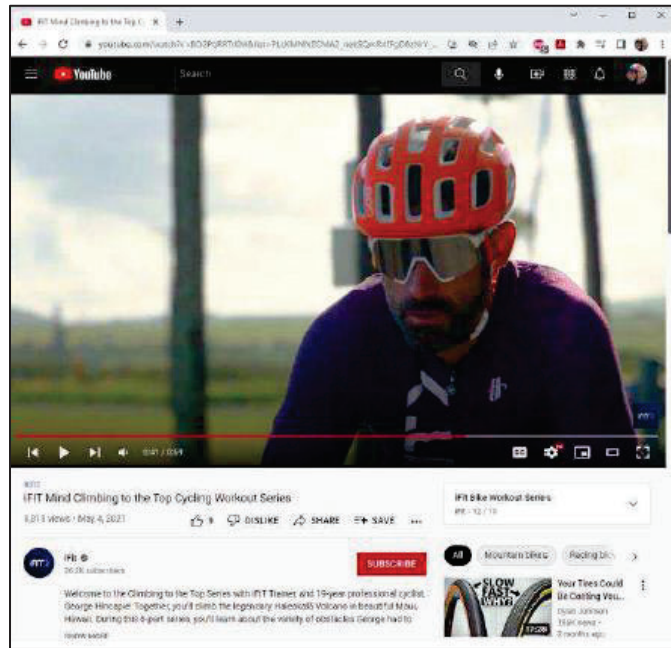
 <p>Running</p> <p>Run the distance and train in new ways with cutting-edge treadmills.</p> <p>Explore Treadmills</p>	 <p>Cycling</p> <p>Cycle closer to your goals with entertaining workouts and personalized training.</p> <p>Explore Bikes</p>	 <p>Cross-Training</p> <p>Enjoy low-impact workouts that still deliver elevated calorie burn alongside motivating trainers.</p> <p>Explore Elliptical</p>
 <p>Rowing</p> <p>Row your way to total-body fitness through trainer-led cardio workouts filmed on epic waterways.</p>	 <p>Strength</p> <p>Complete your strength and cardio workouts simultaneously with groundbreaking equipment and interactive workouts.</p>	 <p>Fitness Mirrors</p> <p>Improve your body form with interactive, mirrored workouts and unique, total-body training.</p>

Id. at 5, 22, 23 (Watterson Dec. ¶ 8 and Ex. A). Well known athletes and celebrities, including Michael Phelps, Alex Morgan and Jillian Michaels, “have provided

streaming workouts, runs, rides, and routines to IFIT customers and subscribers.”

Id. at 6 (Watterson Dec. ¶ 10).

“IFIT trainers involved in cycling-related exercise videos often wear protective eyewear,” as shown below:



Id. at 10 (Watterson Dec. ¶¶ 14-15). While Opposer’s exercise bikes are for indoor use, and its IFIT bike classes and other bike-related content are intended for users of indoor stationary bikes, Opposer “actively markets its goods and services to cyclists,” including by “providing a streaming exclusive Tour de France workout series, whereby users of the IFIT-branded programs can virtually ride all 21 stages of the 2020 Tour de France on their IFIT-enabled **exercise bikes.**” *Id.* at 10, 67-69 (Watterson Dec. ¶¶ 16 and Ex. K) (emphasis added).

Opposer’s average “annual marketing budget” for the five years prior to trial was significant, but designated “Confidential,” and “[d]uring that time, nearly all marketing materials ... display or have included the IFIT mark across all of

[Opposer's] equipment and accessory lines." *Id.* at 11 (Watterson Dec. ¶ 19). Opposer's "television commercials for IFIT-branded goods and services," which include commercials aired during the 2020 Olympics and Monday Night Football, have "reached millions of people across the United States." *Id.* (Watterson Dec. ¶¶ 21, 24). Opposer has "sponsored major sporting events using IFIT," including the Tour de France ("which takes place in France but has extensive television coverage in the United States") and Boston Marathon. *Id.* at 12 (Watterson Dec. ¶ 25). Opposer's "IFIT-branded goods are also promoted by large national brick-and-mortar and online retailers in the United States, such as Sears, Dick's Sporting Goods and Walmart." *Id.* (Watterson Dec. ¶ 28).

Ads associated with these "large retailer-driven marketing efforts" have appeared in the *New York Times*, *Boston Globe*, *Philadelphia Inquirer*, *Washington Post*, *Chicago Sun-Times*, *St. Louis Post Dispatch*, *Miami Herald*, *Atlanta Journal Constitution*, *San Francisco Chronicle* and *Los Angeles Times*. *Id.* at 13-14 (Watterson Dec. ¶ 29). Opposer's treadmills, exercise bikes and other products are reviewed in a variety of publications, often quite favorably. *Id.* at 14, 122-185 (Watterson Dec. ¶¶ 32-33 and Ex. P). According to *Forbes*, "unlike other companies offering online classes that specialize in one or two types of workouts, NordicTrack makes everything, and one iFit subscription covers them all." *Id.* at 14, 151 (Watterson Dec. ¶ 33 and Ex. P).

Opposer's average annual revenue for the 20 years preceding trial is also significant, but it too is designated "Confidential." *Id.* at 14 (Watterson Dec. ¶ 34).

There is no indication that the figure provided covers only the United States, nor is this figure tied specifically to Opposer’s pleaded IFIT marks. Nonetheless, Opposer’s share of the market for “exercise units sold in the United States in 2021” is impressive by any measure, and its share of the market for “stationary bicycles in the United States for the last decade” is as well. 35 TTABVUE 3, 7-14 (Logan Dec. ¶¶ 5-6 and Exs. A, B). Moreover, the IFIT app “has been downloaded by more than one million users on the Google Play store alone.” Opposer does not specify how many of these users are from the United States, however. 31 TTABVUE 15 (Watterson Dec. ¶ 37).⁵

B. Applicant and Its Involved I-FIT FLEX Mark

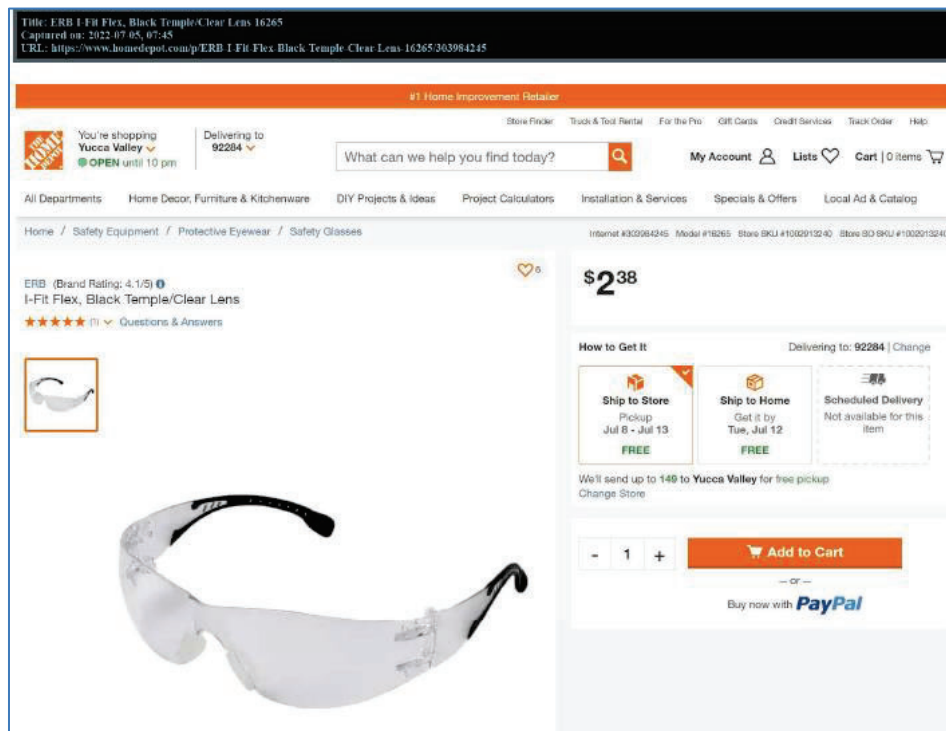
Applicant is “in the safety products industry.” 39 TTABVUE 3 (Barker Dec. ¶ 12). It has offered “personal protection products” since 1971. *Id.* (Barker Dec. ¶ 13). Its products, which include “head protection, eye protection, extremity protection (such as gloves), high visibility apparel, weather protection, and first-aid products” are “sold for the purpose of protecting workers from potentially dangerous working conditions in the construction, manufacturing, and other manual-labor heavy industries.” *Id.* (Barker Dec. ¶¶ 16, 17). *See also* 52 TTABVUE 26-28 (App. Disc. Tr. 21-23).

Applicant “has used its I-FIT FLEX mark solely in connection with protective eyewear” since 2017. 39 TTABVUE 4 (Barker Dec. ¶ 19). The mark is not used with

⁵ Opposer claims to have made “numerous and ongoing efforts to protect” its pleaded marks. 33 TTABVUE 5 (Wilson Dec. ¶ 7). However, the “efforts” are not specifically described and any results achieved are not revealed. Instead, Opposer merely provided a list of case names and numbers, application numbers, and a cursory description of “cease and desist” efforts against third-party uses of marks containing the term “fit.” *Id.* at 34-43 (Wilson Dec. Ex. M).

“general non-safety eyewear,” and Applicant does not manufacture or sell “general non-safety eyewear.” *Id.* (Barker Dec. ¶¶ 23-25).

Applicant’s I-FIT FLEX products are sold through its “printed catalog, qualified sales representatives, and e-commerce website at e-erb.com.” *Id.* at 5 (Barker Dec. ¶ 31). Applicant’s own “website sales are exclusively for wholesalers and distributors,” but Applicant “does not control third-party marketing.” *Id.* at 6 (Barker Dec. ¶¶ 37, 39). In fact, Applicant’s “products can be purchased through homedepot.com,” as shown below:



Id. (Barker Dec. ¶ 41); 36 TTABVUE 25.

III. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action is a requirement in every inter partes case. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020), *cert. denied*, 142 S.Ct. 82 (2021) (citing

Lexmark Int'l, Inc. v. Static Control Components, Inc., 572 U.S. 118, 125-26 (2014)).

A party in the position of plaintiff may oppose registration of a mark when doing so is within the zone of interests protected by the statute and it has a reasonable belief in damage that would be proximately caused by registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *6-7 (Fed. Cir. 2020), *cert. denied*, 141 S.Ct. 2671 (2021) (holding that the test in *Lexmark* is met by demonstrating a real interest in opposing or cancelling a registration of a mark, which satisfies the zone-of-interests requirement, and a reasonable belief in damage by the registration of a mark, which demonstrates damage proximately caused by registration of the mark). Here, Opposer's pleaded registrations establish that it is entitled to oppose registration of Applicant's mark on the ground of likelihood of confusion. 18 TTABVUE 13-146 (Opp. NOR 1 Exs. 2-11); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (registration establishes "standing").

IV. Priority

Because Opposer's pleaded registrations are of record, 18 TTABVUE 13-146, and Applicant has not counterclaimed to cancel any of them, priority is not at issue with respect to the marks and goods identified therein. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

V. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth

factors to be considered); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

Opposer bears the burden of establishing that there is a likelihood of confusion by a preponderance of the evidence. *Cunningham*, 55 USPQ2d at 1848. We consider the likelihood of confusion factors about which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

A. Strength of Opposer’s Mark

We turn first to the strength of Opposer’s mark, to determine the scope of protection to which it is entitled. There are two types of strength: conceptual and commercial. *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength ... and its marketplace strength”).

Turning first to conceptual strength, Applicant introduced a dictionary definition revealing that “fit” is an adjective meaning “sound physically and mentally: HEALTHY.” 36 TTABVUE 6.⁶ To illustrate how the term is used, the definition states

⁶ <https://www.merriam-webster.com/dictionary/fit>.

that people may “keep[] fit by playing tennis and handball.” *Id.* Applicant also introduced two third-party registrations for marks containing the term “fit” that are

registered for fitness-related goods or services: **i will be fit** (Reg. No. 2987040) for “exercise fitness program provided via an online computer database;” and FIT-I-M (Reg. No. 5733185) for “stretch bands used for yoga and physical fitness purposes.” 37 TTABVUE 5, 8. While two registrations is not a substantial number, these registrations tend to corroborate the dictionary definition, as they show how “a mark is used in ordinary parlance.” *Juice Generation, Inc. v. GS Enter., LLC*, 794 F.2d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015). Opposer’s use of the term “fit” is consistent with the dictionary definition and the third-party registrations. In fact, in an Instagram post it promoted a “cycling series” featuring “4 different types of rides: fit, strong, powerful and fast.” 31 TTABVUE 48 (Watterson Dec. Ex. H). Thus, when the term “fit” is used for health and fitness-related products or services, it is suggestive of physical fitness and entitled to less weight in our analysis than an arbitrary term.

While there is little evidence concerning the meaning of the “I” in Opposer’s pleaded IFIT/I-FIT marks, we agree with Applicant that in Opposer’s marks the “I” is most likely to “refer[] to the person using the goods or services, indicating that the goods and services make the user healthier.” 47 TTABVUE 25.

Of course, we must presume that Opposer’s pleaded registered marks are inherently distinctive overall, i.e. that they are, at worst, suggestive of Opposer’s goods and services. 15 U.S.C. § 1057(b) (registration is “prima facie evidence of the

validity of the registered mark”); *In re Fiesta Palms, LLC*, 85 USPQ2d 1360, 1363 (TTAB 2007) (when a mark is registered on the Principal Register, “we must assume that it is at least suggestive”). *See also In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997). Nonetheless, we have no doubt that “fit” is conceptually weak for fitness-related goods and services, and to a slightly lesser extent IFIT is as well. We therefore find that Opposer’s inherently distinctive marks are conceptually fairly weak.

Turning to commercial strength, Opposer argues that its pleaded marks are “famous.” 43 TTABVUE 39-43. Fame is not “an all-or-nothing” proposition, however. *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734-35 (Fed. Cir. 2017). Rather, we must determine where to place IFIT on the “spectrum” of marks, which ranges from “very strong to very weak.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003)). The stronger the mark, the greater the scope of protection to which it is entitled. *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1056 (TTAB 2017) (“A very strong mark receives a wider latitude of legal protection in the likelihood of confusion analysis.”); *Nike, Inc. v. WNBA Enters., LLC*, 85 USPQ2d 1187, 1198 (TTAB 2007). When a mark is famous or very strong, that plays a dominant role in the likelihood of confusion analysis. *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002) (quoting *Recot, Inc. v. Benton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir.

2000)); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Fame or commercial strength “of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident.” *Bose*, 63 USPQ2d at 1305. Other relevant factors include “length of use of the mark, market share, brand awareness, licensing activities, and variety of goods bearing the mark.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012).

Here, Opposer’s evidence falls short of establishing that its pleaded marks are famous. On the one hand, Opposer has used IFIT for over 20 years, its pleaded marks have been fairly prominent in health and fitness media for much of that time, the “ifit.com” website has had many visitors, Opposer’s confidential revenue and advertising figures are significant, and its market share for stationary bicycles “for the last decade,” and exercise units in 2021, is impressive. 31 TTABVUE 11-14, 122-185 (Watterson Dec. ¶¶ 19, 21, 24, 25, 28-30, 32, 34 and Ex. P); 35 TTABVUE 3, 7-14 (Logan Dec. ¶¶ 5-6 and Exs. A, B).

On the other hand, and crucially, Opposer’s average annual revenue figure is apparently not limited to revenues derived from the United States, nor is the figure specifically tied to Opposer’s pleaded IFIT marks. 31 TTABVUE 14 (Watterson Dec. ¶ 34). And while Opposer’s following on social media is consistent with some public recognition, the follower and subscriber numbers for its IFIT goods and services fall

short of establishing “fame,” as they are significantly less than those for marks found to be “famous.” 31 TTABVUE 14, 111-120 (Watterson Dec. ¶ 31 and Ex. O).

Considering the evidence of commercial strength as a whole, we find that Opposer’s pleaded IFIT marks are commercially strong. However, as a result of the evidentiary gaps in the record, Opposer has fallen short of its heavy burden to “clearly prove” fame. *Coach Servs.*, 101 USPQ2d at 1720; *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

We find that on balance Opposer’s pleaded marks are conceptually somewhat weak, but enjoy strong recognition among consumers of exercise and fitness equipment, and fitness-related services provided online.

B. The Marks

The marks (I-FIT FLEX vs. iFIT) are highly similar in “appearance, sound, connotation and commercial impression.” *Palm Bay*, 73 USPQ2d at 1691 (quoting *Du Pont*, 177 USPQ at 567). In fact, the hyphen and trailing term FLEX in Applicant’s mark I-FIT FLEX do not meaningfully distinguish it from Opposer’s IFIT mark.⁷

The hyphen in Applicant’s mark is minor punctuation that does not appreciably distinguish it – in appearance, sound, meaning or commercial impression – from Opposer’s IFIT marks. *See Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016) (finding “the hyphen in Applicant’s mark MINI-MELTS [did]

⁷ Opposer pleaded ownership of I-FIT for clothing, a mark that like Applicant’s involved mark includes a hyphen between “I” and “FIT.” We have not focused on this pleaded mark, however, because Opposer’s argument that the goods and services are related is not based on its use of iFIT on clothing.

not distinguish it from Opposer's mark [MINI MELTS]"); *Mag Instrument Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701, 1712 (TTAB 2010), *aff'd*, 2011 WL 5400095 (Fed. Cir. 2011) (“[B]oth marks begin with the term MAGNUM or MAG-NUM. Thus, the initial term in both marks is essentially identical; the hyphen in the Mag Instrument’s mark does not distinguish them.”); *Charette Corp. v. Bowater Comm’n Papers Inc.*, 13 USPQ2d 2040, 2042 (TTAB 1989) (finding PRO-PRINT confusingly similar to PROPRINT, and stating “[i]t is also quite obvious that the marks are identical except for the division of registrant’s mark by a hyphen between the syllables”).

Moreover, Applicant essentially concedes that the disclaimed term FLEX at the end of its involved mark merely describes a feature of Applicant’s identified safety glasses. 24 TTABVUE 31-33 (App. Disc. Tr. 26-28). Thus, I-FIT is the dominant portion of Applicant’s mark, as it is settled that descriptive and disclaimed terms such as FLEX are entitled to less weight in our analysis. *Cunningham*, 55 USPQ2d at 1846 (“Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’”) (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985)); *see also In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (DELTA, not the disclaimed term CAFÉ, is the dominant portion of the mark THE DELTA CAFÉ).

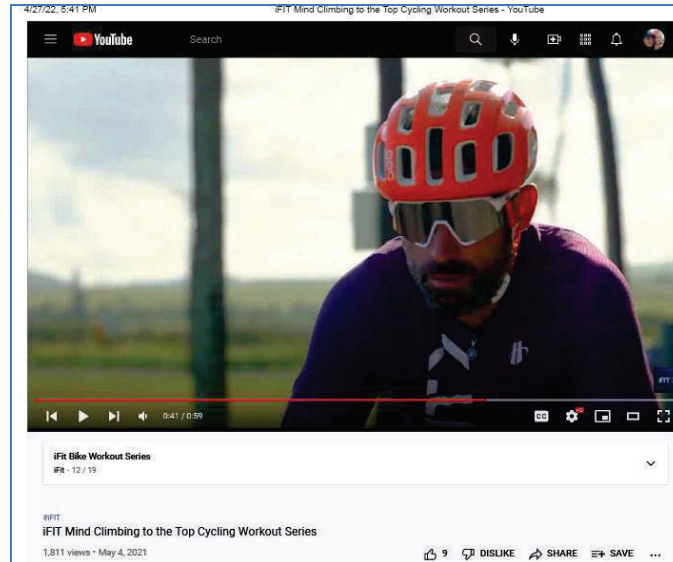
We acknowledge that the term “FIT” conveys a different meaning in Opposer’s mark (fitness) than it does in Applicant’s (the correct size or shape). We find, however,

that this difference in meaning is outweighed by how similar the parties' marks are in appearance and sound. This factor also weighs in favor of finding a likelihood of confusion.

C. The Goods and Their Channels of Trade and Classes of Consumers

In considering the goods and services, we have kept in mind that they need not be identical or even competitive in order to find a likelihood of confusion. Rather, the question is whether the goods and services are marketed in a manner that “could give rise to the mistaken belief that [the] goods [or services] emanate from the same source.” *Coach Servs.*, 101 USPQ2d at 1722 (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). *See also Hewlett-Packard Co. v. Packard Press Inc.*, 227 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (“Even if the goods and services in question are not identical, the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services.”); *Recot*, 54 USPQ2d at 1898 (“even 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”).

Here, Opposer argues that “Applicant’s protective eyewear is related to Opposer’s exercise equipment and fitness training services because protective eyewear is commonly used in connection with physical activities such as cycling.” 43 TTABVUE 31. It specifically points out that the “iFIT trainers in iFIT’s cycling exercise videos often wear protective eyewear, *id.*, and that “iFIT actively markets its goods and services to cyclists,” as shown below:



31 TTABVUE 9-10, 63 (Watterson Dec. ¶ 14 and Ex. J); 43 TTABVUE 34.

Moreover, Opposer introduced evidence that in online forums “cyclists discuss purchasing safety glasses from hardware stores to use during cycling.” 43 TTABVUE 35. For example, a cyclist posted on reddit.com that after his cycling glasses broke he used a pair of safety glasses he “got at work” instead, and said he was “quite pleased” with them because: they are “light, cheap, keep my eyes safe from dirt, debris, wind and even UVA/B;” and he had no “problem with fogging or sweat building up around the frame or in my eyes.” He asked, “[i]s there anything I’m missing? Are there any major safety or performance issues I am not considering?” 26 TTABVUE 6. The vast majority of responses were supportive, and included the following comments:

“if they work for you, keep using them. I can’t think of any reason to switch or performance you’d be missing out on;”

“those will be fine;”

“I’ve also been using safety glasses for years;”

“I use safety glasses when cycling, too, because I use safety glasses professionally;” and

“As long as they state some level of reliable safety, they’re probably designed to withstand a faulty nail gun firing in your eye. So I trust them on my commute.”

Id. at 6-12. The responses to a quite similar question from another reddit.com poster included the following:

“people do this. it’s ok;”

“can confirm;”

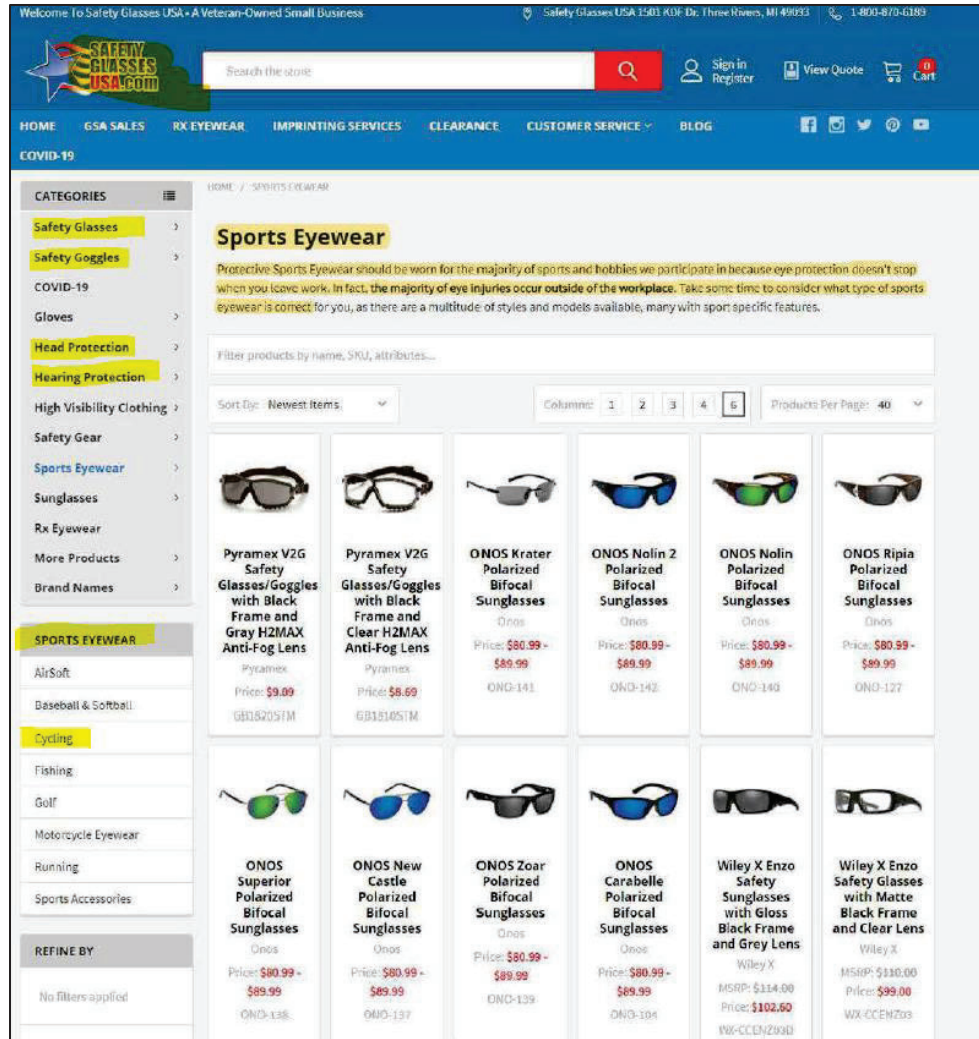
“I’ve seen it mentioned multiple times here ... ‘Cycling’ glasses do end to be a little lighter weight, but that only matters on really long rides;”

“I ride safety glasses I got for 5 bucks at home depot;”

“Cycling glasses are expensive just ‘cos they are marketed differently.”

Id. at 16-20; *see also id.* at 22-31, 49-53.


Opposer also introduced evidence that three third-party sources of safety glasses also offer sports eyewear, including cycling eyewear, as shown in the example below:



Id. at 54, 57; *see also id.* at 62-67, 77-81. As shown, the “safetyglassesusa.com” website offers not just “safety glasses,” “safety goggles,” “head protection” and “hearing protection,” but also “sports eyewear,” including “cycling” eyewear. *Id.*

Finally, Opposer relies on third-party registrations that it argues cover “both protective eyewear and fitness goods, including fitness trackers, treadmills, weights, fitness training services.” 43 TTABVUE 35. However, we do not find any third-party registrations covering safety or protective eyewear and weights probative, because Opposer does not plead ownership of any marks used for weights. Similarly, we do

not find any third-party registrations for eyeglasses but not protective or safety eyewear probative, because Applicant's involved application does not identify eyeglasses. We also have not considered Registration No. 4735699, 27 TTABVUE 21-44, because it is a certification mark covering an astronomically large number of disparate goods. The remaining probative third-party registrations Opposer relies upon which cover safety or protective eyewear on the one hand and fitness trackers, fitness machines or fitness training services on the other are:

UNDER ARMOUR (Reg. No. 5137860) and  (Reg. No. 5193655) are registered to the same owner for "protective eyewear" and "electronic devices, namely, data sensors, transmitters and receivers for relaying physical exercise data."

Airwheel (Reg. No. 5429233) is registered for "protective eyewear" and "exercise treadmills."

ATHLETES INSIGHT (Reg. No. 5600176) is registered for "sports eyewear" and "personal fitness training services."

ENDORPHINS MAKE YOU HAPPY (Reg. No. 6070156) is registered for "retail store services featuring ... eyewear ... exercise equipment"

HISEA (Reg. No. 5199993) is registered for "protective eyewear" and "exercise machines."

27 TTABVUE 6-10, 13, 20, 45-47.⁸ "Third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, although

⁸ The following registrations identify "eyewear" or "eye shields" but not fitness trackers, machines or training services, and are therefore not relevant: Registration Nos. 5568587, 5710702, 5726043, 6062130, 5423902 and 5423901. 27 TTABVUE 11-12, 14-17, 48-51.

not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, may nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source.” *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1998).

Opposer’s evidence does not persuade us that the parties’ goods are related. We accept that outdoor cyclists often use eyewear to protect from debris, dirt, wind or other hazards. But that does not establish that “industrial protective eyewear; safety eyewear” is related to Opposer’s indoor stationary bikes or other fitness or exercise machines. Indeed, there is no need for indoor cyclists to protect their eyes from hazards, and, more to the point, there is no evidence that indoor cyclists wear safety or protective eyewear. Furthermore, there is no evidence that any third-parties offer both industrial protective or safety eyewear and fitness or exercise machines.⁹ While it seems likely that some users of indoor stationary bikes also bike outdoors, that does not make it likely that they would believe that fitness and exercise machines and “industrial protective eyewear; safety eyewear” emanate from the same source. *Coach*

Registration No. 6062130 does not identify fitness trackers, machines or training services, and, although it identifies “eyeglasses,” it does not identify protective eyewear or goods encompassing protective eyewear (i.e. “eyewear”). 27 TTABVUE 18-19.

⁹ The third-party registrations Opposer introduced are not evidence of the extent of third-party use of the registered marks in the marketplace. *See In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009) (citing *Olde Tyme Foods Inc. v. Roundy’s Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992)); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009); *see also AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) (“The existence of these registrations is not evidence of what happens in the market place or that customers are familiar with them”).

Servs., 101 USPQ2d at 1722. For example, some racecar drivers and chemists also use safety eyewear, but that does not mean that safety eyewear is related to racecars or ammonia. There is even less reason to believe that fitness training services, whether offered by a personal trainer or an app, would emanate from the same source as safety glasses.

While third-party registrations such as those Opposer introduced here “may serve to suggest” that the parties’ “goods or services are of a type which may emanate from a single source,” *In re Mucky Duck*, 6 USPQ2d at 1470 n.6, here there are not enough of them to be persuasive. The fact that a mere five third parties own registrations covering safety or protective eyewear on the one hand and fitness trackers, fitness machines or fitness training services on the other is simply not enough to carry Opposer’s burden of proving a relationship between the parties’ goods and services, especially where the third-party registrations are unsupported by any persuasive corroborating evidence of a relationship between the goods and services.

Nor has Opposer established that the channels of trade or classes of consumers for the parties’ goods and services overlap. Opposer mistakenly claims that because the identifications of goods and services in the pleaded registrations and involved application are unlimited as to channels of trade or classes of consumers, the goods and services “are presumed to travel in the same channels of trade to the same class of purchasers.” 43 TTABVUE 36. In fact, the presumption on which Opposer seeks to rely applies only when the goods and services are identical or quite closely related. Here, where the goods have not been shown to be related at all, the lack of trade

channel restrictions means that we simply presume the goods and services move in all channels of trade normal therefor. *See Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-62 (Fed. Cir. 2014); *Citigroup Inc. v. Cap. City Bank Grp., Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (goods presumed to be “offered in all channels of trade which would be normal therefor”); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

Moreover, Opposer’s evidence and argument that both parties sell their goods through Amazon and Walmart, 43 TTABVUE 36-37, is not persuasive. “A wide variety of products, not only from different manufacturers within an industry but also from diverse industries, have been brought together in the modern supermarket for the convenience of the customer. The mere existence of such an environment should not foreclose further inquiry into the likelihood of confusion arising from the use of similar marks on *any* goods so displayed.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *Mini Melts*, 118 USPQ2d at 1472; *Morgan Creek Prods. Inc. v. Foria Int’l Inc.*, 91 USPQ2d 1134, 1142 (TTAB 2009) (“It has long been held that the mere fact that two different items can be found in a supermarket, department store, drugstore or mass merchandiser store is not a sufficient basis for a finding that the goods are related.”); *7-Eleven v. Wechsler*, 83 USPQ2d at 1724 (“Opposer contends that because applicant’s products may be sold in convenience stores and because opposer sells pet products, the channels of trade overlap. However, we must recognize the following facts: (i) opposer is a convenience

store chain whose individual stores sell a wide variety of products including groceries, snacks, drugstore items, and sometimes gasoline; and (ii) the products at issue are of such diverse nature and utilized for such different purposes that even if all of the products are sold in opposer's convenience stores, consumers would not believe that they emanate from a single source.”).

Opposer's argument that the classes of consumers are the same because “Applicant's goods may be purchased by cyclists,” 43 TTABVUE 37, is also not well-taken. While some outdoor “cyclists” may work out on indoor stationary bikes during inclement weather, the extent of any such overlap between “cyclists” and consumers of Opposer's products and services has not been established. While there is certainly some amount of overlap, we cannot assume overlap sufficient to make confusion likely without evidence. Here there is no evidence that any of the cyclists who posted on the Internet that they use safety glasses for cycling are also consumers of the types of goods and services Opposer offers under iFIT, nor is the number of Internet postings sufficient to establish a meaningful overlap in consumers.

These factors weigh heavily against finding a likelihood of confusion.

D. Consumer Sophistication and Care

We accept Opposer's argument, *id.*, that because Applicant's goods are so inexpensive, Applicant's consumers will not exercise significant care in purchasing. This factor weighs in favor of finding a likelihood of confusion.

E. Opposer's Use of IFIT for a Variety of Goods and Services

Opposer argues that because it offers a “wide variety of health and fitness-related goods and services” under its pleaded marks, consumers may be more likely to believe

that there is a connection between Opposer and Applicant's goods. 43 TTABVUE 43-44. However, because IFIT is not a typical "merchandising mark" used on goods and services beyond Opposer's core field of health and fitness, this factor is neutral. *Cf. DC Comics v. Pan Am. Grain Mfg. Co.*, 77 USPQ2d 1220, 1225-27 (TTAB 2005) (plaintiff's mark was used on "collateral products"); *Time Warner Entm't. Co. v. Jones*, 65 USPQ2d 1650, 1661-62 (TTAB 2002) ("The evidence shows that opposer has licensed that character for use on a wide variety of goods, including automotive items ... and office stationary items"); *Harley-Davidson Motor Co., Inc. v. Pierce Foods Corp.*, 231 USPQ 857 (TTAB 1986) (HARLEY-HOG for pork likely to be confused with HARLEY-DAVIDSON and HARLEY for motor vehicles and a wide range of unrelated consumer products including beverages and chocolate bars but not meat).

VI. Conclusion

Although the parties' marks are similar and Opposer's pleaded marks enjoy some commercial strength, Opposer uses its marks on health and fitness goods and services, while Applicant's mark is used for industrial protective eyewear and safety eyewear. Opposer has failed to show that the parties' goods and services are related, or that they travel in the same channels of trade to the same classes of consumers. This failure is dispositive. Here, because the goods are not related, confusion is unlikely notwithstanding that the marks are similar. *See Kellogg Co. v. Pack'em Enters. Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) ("We know of no reason why, in a particular case, a single *duPont* factor may not be dispositive."); *Local Trademarks Inc. v. The Handy Boys Inc.*, 16 USPQ2d 1156, 1158 (TTAB 1990) ("even though opposer's services and applicant's product are or can be marketed to

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the same class of customers, namely plumbing contractors, these services and goods are so different that confusion is not likely even if they are marketed under the same mark”); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668, 1669-70 (TTAB 1986) (opposition dismissed because the goods were “quite different,” notwithstanding that the marks were the same).

Decision: The opposition is dismissed.

CERTIFICATE OF COMPLIANCE

I certify that according to the word-processing system used in preparing it, the foregoing **CORRECTED NON-CONFIDENTIAL BRIEF FOR APPELLANT iFIT INC.** is 11,063 words in length, excluding those portions exempted by Fed.R.App.P. 32(f) and Fed.Cir.R. 32(b)(2), and therefore complies with the type-volume limitation set forth in Fed.Cir.R. 32(b)(1).

DATED: March 12, 2024

/s/ Matthew A. Barlow

MATTHEW A. BARLOW

CERTIFICATE OF CONFIDENTIAL MATERIAL

Pursuant to Fed.Cir.R. 25.1(e)(2), I certify that in the foregoing **CORRECTED NON-CONFIDENTIAL BRIEF FOR APPELLANT iFIT INC.**, there are 2 unique words (including numbers) that are sought to be marked confidential, and it therefore complies with the unique-word limit set forth in Fed.Cir.R. 25.1(d)(1)(A).

DATED: March 12, 2024

/s/ Matthew A. Barlow

MATTHEW A. BARLOW

CERTIFICATE OF SERVICE

I certify that I caused the foregoing **CORRECTED NON-CONFIDENTIAL BRIEF FOR APPELLANT iFIT INC.** to be served via email on the following counsel at the email addresses indicated below, who have consented in writing to service by email:

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