

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

May 15, 2014

Applicant: Lifestyle Innovations, Inc.  
Serial No.: 86135084  
Filing Date: December 04, 2013  
Mark: LIFESTYLE INNOVATIONS  
Examining Attorney: Suzanne Blane  
Law Office: Law Office 114

**REQUEST FOR RECONSIDERATION:  
A DISCLAIMER OF THE WORDING IN THE MARK IS INAPPROPRIATE**

Applicant has applied to register the mark **LIFESTYLE INNOVATIONS** for personal fitness training services and consultancy. The Examining Attorney has requested a disclaimer of the wording LIFESTYLE on the grounds it is descriptive of the services. Applicant respectfully disagrees. A disclaimer of the wording LIFESTYLE from the mark is inappropriate because Applicant's mark is not descriptive. As indicated below, Applicant's mark is suggestive. The Examining Attorney presents evidence of the mark's descriptiveness, but this evidence does not support the Examining Attorney's claim. All doubt as to whether LIFESTYLE is merely descriptive must be resolved in Applicant's favor.

**1. Applicant's Mark is Not Descriptive**

A term is deemed to be merely descriptive of goods or services, within the meaning of Trademark Act Section 2(e), if it directly conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose, or use of the goods or services. *See, e.g., In re Pallotta Teamworks*, Serial No. 75929463, 2002 T.T.A.B. LEXIS 587 (September 13, 2002); *Stix Products, Inc. v. United Merch. & Mfrs., Inc.*, 295 F. Supp. 479, 160 U.S.P.Q. 777 (S.D.N.Y. 1968).

The term LIFESTYLE does not convey a direct idea or an immediate sense as to what Applicant's services entail. Applicant's services include: Personal fitness training services and consultancy in International Class 041. The term LIFESTYLE does not convey a description of personal fitness training. LIFESTYLE is not a synonym for fitness. It applies broadly to the way in which a person or group lives. Further, there is no evidence in the

record to rebut the presumption that LIFESTYLE INNOVATIONS is distinctive and functions as a trademark. *See* TMEP § 1209.02.

The Examining Attorney provided dictionary definitions for LIFESTYLE, which includes definitions such as “[a] way of life or style of living that reflects the attitudes and values of a person or group”. This “way of life” or “style of living” does not convey an immediate connection to personal fitness training. Instead, the term LIFESTYLE, alone, requires imagination, thought, or perception to reach a conclusion as to the nature of Applicant’s services. Other marks, for example FEET UP LIFESTYLE, Reg. No. 4523183, explain the types of attitudes or values reflected by the person or group by modifying LIFESTYLE with an adjective or descriptive phrase. *See* Exhibit A (FEET UP LIFESTYLE, Reg. No. 4523183).

The dictionary pages provided by the Examining Attorney reflect that there are several meanings that can be ascribed to LIFESTYLE. For example, one definition states that LIFESTYLE is, “[t]he constellation of habitual activities unique to a person, which lend consistency to activities, behavior, manners of coping, motivation, and thought processes, and define the way in which he/she lives; *lifestyle activities include* diet, level of physical activity, substance abuse, social and personal interactions.” (Emphasis added). As a result of these varied definitions, LIFESTYLE can signify everything from alcoholics to sci-fi movie buffs. The term LIFESTYLE both alone and in the mark LIFESTYLE INNOVATIONS does not in any way give an immediate sense as to the nature, quality, and purpose of the services offered under Applicant’s mark. Therefore, Applicant’s mark is not merely descriptive.

This conclusion is supported by the fact that, in the past, the Patent and Trademark Office has not required disclaimers of the term LIFESTYLE for other marks in Class 41, including the following: PRECISION LIFESTYLE, Reg. No. 3566587, whose services include online physical fitness instruction, namely, providing instruction regarding physical fitness via an internet website, *see* Exhibit B (PRECISION LIFESTYLE, Reg. No. 3566587); SYNERGISTICS LIFESTYLE, Reg. No. 3725951, whose services include education services, namely, providing instructional lectures in the field of health and wellness, exercise and fitness; non-downloadable video recordings in the field of exercise and fitness, accessible via an internet website, *see* Exhibit C (SYNERGISTICS LIFESTYLE, Reg. No. 3725951); UPGRADE LIFESTYLE, Reg. No. 3760724, whose services include personal training and physical fitness consultation; personal training services, namely, strength and conditioning training; organizing and conducting fitness events, namely, road, swimming, and cycling races, and triathlons, *see* Exhibit D (UPGRADE LIFESTYLE, Reg. No. 3760724); and LIFESTYLE 180, Reg. No. 3794011, whose services include educational services, namely, classes and seminars on nutrition, cooking, exercise, stress management, and health- and wellness-related topics, and course materials distributed therewith; and providing a web site featuring information on exercise and fitness, *see* Exhibit E (LIFESTYLE 180, Reg. No. 3794011).<sup>1</sup>

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<sup>1</sup> *See also* several examples of Registrants not disclaiming the phrase LIFESTYLE in other International Classifications: LIFESTYLE LEARNING, Reg. No. 4511757, whose services include providing online non-downloadable comic books and graphic novels, *see* Exhibit F (LIFESTYLE LEARNING, Reg. No. 4511757);

## 2. Applicant's Mark is Suggestive

Applicant respectfully submits that its mark is suggestive. “A term is suggestive if it requires imagination, thought, and perception to reach a conclusion as to the nature of the goods.” *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 11, 189 U.S.P.Q. 769 (2d Cir. 1976). In relation to the services claimed in connection with Applicant’s Mark, the term LIFESTYLE is suggestive, not descriptive.

Suggestive terms require some thought on the part of a prospective purchaser of the goods or services before the nature or substance of the product or service can be ascertained. *In re Gyulay*, 820 F.2d 1216, 3 U.S.P.Q.2d 1009 (Fed. Cir. 1987). A consumer encountering the mark in the marketplace separate from the services would have no idea that the mark is used for personal fitness training services and consultancy. Imagination is required to make the leap that LIFESTYLE INNOVATIONS relates to these services. In fact, the word LIFESTYLE alone, and even more so when placed together with LIFESTYLE INNOVATIONS, can refer to any number of goods or services. For example, see ENTREE LIFESTYLE, Reg. No. 4420842, whose products include apparel, *see* Exhibit I (ENTREE LIFESTYLE, Reg. No. 4420842); FITTING LIFESTYLE Reg. No 4138487, whose products include canned meats, *see* Exhibit J (FITTING LIFESTYLE Reg. No 4138487); LIFESTYLES UNLIMITED, Reg. No. 4497370, whose services include mentoring in the field of real estate investing, *see* Exhibit K (LIFESTYLES UNLIMITED, Reg. No. 4497370); and MODERN LIFESTYLES Reg. No 4414314, whose products include blankets and towels, *see* Exhibit L (MODERN LIFESTYLES Reg. No 4414314).

If information about the product or service given by the term used as a mark is indirect or vague, then this indicates that the term is being used in a suggestive, not descriptive, manner. As Professor McCarthy notes, “a mark that connotes two meanings -- one possibly descriptive, and the other suggestive of some other association -- can be called suggestive, as the mark is not ‘merely’ descriptive.” 1 J. McCarthy, *McCarthy on Trademarks and Unfair Competition*, §11:19 at page 11-26 (4th ed. 1998). As such, Applicant’s mark is suggestive, not descriptive.

Obviously, some imagination is required to connect Applicant’s chosen mark with the benefits applicant offers. *See In re Talking Car, Inc.*, Serial No. 75121820 (TTAB 2001). Nothing about the phrases LIFESTYLE or INNOVATIONS indicate that Applicant’s services entail personal fitness. LIFESTYLE alone, and in connection to INNOVATIONS, could indicate any number of “way of life” improvements. When a word suggests a number of things, it does not describe any one thing in particular and is thus suggestive. *See, e.g., West & Company, Inc. v. Arica Institute, Inc.*, 557 F.2d 338, 195 USPQ 466 (2nd Cir. 1977) (While

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WHOLE ENERGY LIFESTYLE, Reg. No. 4465136, whose services include educational services, namely, providing training of life coaches and mental health professionals for certification in the field of behavioral health, *see* Exhibit G (WHOLE ENERGY LIFESTYLE, Reg. No. 4465136); and LIFESTYLES AFTER 50, Reg. No. 4308028, whose services include providing online publications in the nature of newspapers and magazines in the field of news and articles featuring topics of general interested to adult readers over the age of fifty, *see* Exhibit H (LIFESTYLES AFTER 50).

the word PSYCHOCALISTHENICS suggests a number of things about physical exercises, it does not describe any one thing in particular, and hence is suggestive); *In re HUNT, d.b.a. The Fontaine Organization*, 132 USPQ 564 (TTAB 1962) (MARRIAGE PROPONENTS suggestive for prospective marriage partner services inasmuch as applicant itself does not make marriage proposals); *In re Aid Laboratories, Inc.*, 221 USPQ 1215, 1216 (TTAB 1983) (PEST PRUF merely suggests a possible end result of the use of animal shampoo having insecticide properties); *In re Frank J. Curran Co.*, 189 USPQ 560 (TTAB 1975) (CLOTHES FRESH suggestive of an end result of the use of spray deodorant product for clothes); and *In re C. J. Webb, Inc.*, 182 USPQ 63, 64 (TTAB 1974) (BRAKLEEN is suggestive of a desired result of a brake cleaner). In the instant case, making a connection between Applicant's mark and Applicant's services will involve a multistage reasoning process. Applicant's mark suggests that a "way of life" will "change," but the mark does not indicate what type of lifestyle will be innovated, or what type of change will occur. Therefore, Applicant's use of the word LIFESTYLE is suggestive, rather than merely descriptive of its services.

### **3. Examining Attorney's Evidence Does Not Support The Claim That The Word LIFESTYLES Is Merely Descriptive**

The Examining Attorney has the burden of proof in showing that LIFESTYLE, as used in the phrase LIFESTYLE INNOVATIONS, is merely descriptive. *See In re Mavety*, 31 U.S.P.Q. 2d 1923, 1925 (T.T.A.B. 1994). To do so, the Examining Attorney presents evidence of seven registered marks that have disclaimed the word LIFESTYLE: Registration Numbers 3292993, 3675131, 3393745, 3906000, 4179579, 4370204, and 4387109. This evidence does not contradict Applicant's assertion that LIFESTYLE, as used in Applicant's mark, is not descriptive. In any event, Applicant should not be bound by prior determinations made by third-party Registrants. Each case must be decided on its own set of facts. *See In re Commerce Bancorp, Inc.*, Serial No. 76129795 (July 10, 2006). Applicant's mark is distinguishable from all listed registrations. Therefore, Applicant should not be bound by these third-party registrations.

#### **a. DE>>FINE DOWNTOWN'S FIRST LIFESTYLE ENHANCEMENT CLUB (with design), Reg. No. 3292993**

Registrant DE>>FINE DOWNTOWN'S FIRST LIFESTYLE ENHANCEMENT CLUB (with design), Reg. No. 3292993, disclaimed the phrase DOWNTOWN'S FIRST LIFESTYLE ENHANCEMENT CLUB as used in connection to its health club services. *See Exhibit M (DE>>FINE DOWNTOWN'S FIRST LIFESTYLE ENHANCEMENT CLUB, Reg. No. 3292993)*. Unlike Applicant's mark, this Registrant was not required to disclaim LIFESTYLE alone, but a phrase containing the word LIFESTYLE. This phrase contains a number of other descriptive elements beyond the word LIFESTYLE, such as DOWNTOWN, FIRST, and CLUB. Taken as a whole, this phrase is arguably descriptive of Registrant's services. Applicant's mark, however, does not contain such additional wording. Applicant's mark does not contain an indication of type of LIFESTYLE its services reflect. As such, Applicant's mark is distinguishable from Reg. No. 3292993.

#### **b. FITNESS LIFESTYLE BY EQUINOX, Reg. No. 3675131**

Registrant FITNESS LIFESTYLE BY EQUINOX, Reg. No. 3675131, disclaimed the phrase FITNESS LIFESTYLE as used in connection to its fitness, health spa, and concierge services. *See* Exhibit N (FITNESS LIFESTYLE BY EQUINOX, Reg. No. 3675131). Unlike Applicant's mark, this Registrant was not required to disclaim LIFESTYLE alone, but a phrase containing the word LIFESTYLE. Here, Registrant's mark modifies the word LIFESTYLE with the word FITNESS. As the Examining Attorney has indicated, lifestyle activities can include dietary habits and exercise. Here, consumers immediately know that Registrant's services involve health and fitness because the mark itself modifies the word LIFESTYLE with the word FITNESS. Applicant's mark does not include a descriptive modifier, describing the qualities or characteristics of its services, and is therefore distinguishable from Reg. No. 3675131.

**c. INTERNATIONAL HEALTHY LIVING LIFESTYLES, Reg. No. 3393745**

Registrant INTERNATIONAL HEALTHY LIVING LIFESTYLES, Reg. No. 3393745, avoided a descriptiveness refusal by amending its mark to the Supplemental Register. *See* Exhibit O (INTERNATIONAL HEALTHY LIVING LIFESTYLES, Reg. No. 3393745). Registrant's products include printed matter, namely, magazines featuring health, nutrition, food, and physical fitness. Unlike Applicant's mark, Registrant did not disclaim the word LIFESTYLE alone, but a phrase containing the word LIFESTYLE. Here, Registrant's mark modifies the word LIFESTYLE with the wording HEALTHY LIVING. As the Examining Attorney has indicated, lifestyle activities can include dietary habits and exercise. Here, consumers immediately know that Registrant's products involve health and fitness because the mark itself modifies the word LIFESTYLE with the word HEALTHY LIVING. Applicant's mark does not include a descriptive modifier, describing the qualities or characteristics of its services, and is therefore distinguishable from Reg. No. 3393745.

**d. INTEGRATED LIFESTYLE SOLUTIONS, Reg. No. 3906000**

Registrant INTEGRATED LIFESTYLE SOLUTIONS, Reg. No. 3906000, avoided a descriptiveness refusal by amending its mark to the Supplemental Register. *See* Exhibit P (INTEGRATED LIFESTYLE SOLUTIONS, Reg. No. 3906000). Registrant's services include conducting workshops and seminars in personal awareness; counseling services in the field of physical fitness; education services, namely, providing seminars and workshops in the field of personal and professional motivation, conducting seminars, lectures, teleseminars, teleclasses, and workshops in personal awareness; life coaching services in the field of human potential and personal development; personal coaching services in the field of fitness and wellness; physical fitness consultation; professional coaching services in the field of time management, communication, behavioral and organizational skills; and training services in the field of professional presentation and image consulting.

Unlike Applicant's mark, Registrant did not disclaim the word LIFESTYLE alone, but a phrase containing the word LIFESTYLE. Here, Registrant's mark modifies the word LIFESTYLE with the wording INTEGRATED and SOLUTIONS. Registrant's services contain a number of different counseling, coaching, and training services in International Class 041.

If Registrants services touch on every aspect of a client's personal life, such as personal awareness, personal motivation, personal development, and personal fitness and wellness, then Registrants services are truly INTEGRATED. The phrase INTEGRATED LIFESTYLE describes the quality of Registrant's service, namely a hands-on, personal approach to finding LIFESTYLE SOLUTIONS. Applicant's mark, in contrast, does not contain such a connection to its services. Without additional wording modifying the meaning of the word LIFESTYLE, Applicant's clients are required to use at least some imagination to connect Applicant's chosen mark with the benefits Applicant offers. *See, supra, In re Talking Car, Inc.*, Serial No. 75121820 (TTAB 2001). As such, Applicant's mark is distinguishable from Reg. No. 3906000.

**e. HEALTHY LIFESTYLE CONCEPTS (with design), Reg. No. 4179579**

Registrant HEALTHY LIFESTYLE CONCEPTS (with design), Reg. No. 4179579, disclaimed the phrase HEALTHY LIFESTYLE as used in connection to its personal coaching services. *See Exhibit Q (HEALTHY LIFESTYLE CONCEPTS, Reg. No. 4179579)*. Unlike Applicant's mark, this Registrant was not required to disclaim LIFESTYLE alone, but a phrase containing the word LIFESTYLE. Here, Registrant's mark modifies the word LIFESTYLE with the word HEALTHY. As the Examining Attorney has indicated, lifestyle activities can include dietary habits and exercise. Here, consumers immediately know that Registrant's services involve health and fitness because the mark itself modifies the word LIFESTYLE with the word HEALTHY. Applicant's mark does not include a descriptive modifier, describing the qualities or characteristics of its services, and is therefore distinguishable from Reg. No. 4179579.

**f. HEALTHY MATURE LIFESTYLES, Reg. No. 4370204**

Registrant HEALTHY MATURE LIFESTYLES, Reg. No. 4370204, avoided a descriptiveness refusal by amending its mark to the Supplemental Register. *See Exhibit R (HEALTHY MATURE LIFESTYLES, Reg. No. 4370204)*. Registrant's services include educational services, namely, providing personal health, exercise and fitness instruction for mature adults. Unlike Applicant's mark, Registrant did not disclaim the word LIFESTYLE alone, but a phrase containing the work LIFESTYLE. Here, Registrant's mark modifies the word LIFESTYLE with the wording HEALTHY MATURE. As the Examining Attorney has indicated, lifestyle activities can include dietary habits and exercise. Here, consumers immediately know that Registrant's products involve health and fitness for mature adults because the mark itself modifies the word LIFESTYLE with the word HEALTHY MATURE. Applicant's mark does not include a descriptive modifier, describing the qualities or characteristics of its services, and is therefore distinguishable from Reg. No. 4370204.

**g. LIFESTYLE ADVOCATES (with design), Reg. No. 4387109**

Finally, the Examining Attorney cites LIFESTYLE ADVOCATES (with design), Reg. No. 4387109, amongst the evidence showing LIFESTYLE to be considered descriptive of goods and services related to fitness. *See Exhibit S (LIFESTYLE ADVOCATES, Reg. No. 4387109)*. Registrant's services include both athletic apparel and personal fitness training

services and consultancy. Unlike Applicant's mark, Registrant's mark is a design mark. This design includes a stylized image of a barbell and wings. While the wording contained in Registrant's mark does not indicate a connection to Registrant's services, the image of a barbell, surrounding the word LIFESTYLE, creates a strong and immediate indication of what Registrant's services entail. The wording in Registrant's mark becomes more descriptive when coupled with the imagery of a barbell. Applicant's mark, in contrast, does not immediately indicate such a relationship. Therefore, Applicant's mark is distinguishable from Reg. No. 4387109.

#### **4. All Doubts Of Whether LIFESTYLE Is Merely Descriptive Must Be Resolved in Applicant's Favor**

All doubt as to whether LIFESTYLE, as used in the phrase LIFESTYLE INNOVATIONS, is descriptive should be resolved in the Applicant's favor. *See In re Aid Laboratories, Inc.*, 221 U.S.P.Q. 1215, 1216 (T.T.A.B. 1983). The Board acknowledges that determining whether a word or mark is descriptive necessitates highly subjective judgments, and mandates that close questions be resolved through the publication process. *In re J. Ray McDermott & Co.*, 170 U.S.P.Q. 524 (T.T.A.B. 1971). In finding that the mark DRI-FOOT was not merely descriptive of foot antiperspirant, the Board stated that although their conclusion was not free from doubt, the mark should be published so that "any person who believes that he would be damaged by the registration of said mark [may] present evidence to that effect." *In re Pennwalt Corp.*, 173 U.S.P.Q. 317, 319 (T.T.A.B. 1972). Accordingly, Applicant requests that any potential doubts be resolved in Applicant's favor so that LIFESTYLE need not be disclaimed. To the extent that there may be any doubt, the Examining Attorney should resolve such doubt in favor of the publication of Applicant's mark for oppositions. *See In re Aid Laboratories, Incorporated, supra*; *In re Conductive Systems, Inc.*, 220 USPQ 84, 86 (TTAB 1983); *In re Morton-Norwich Products, Inc.*, 209 USPQ 791 (TTAB 1981); and *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972).

#### **CONCLUSION**

Applicant contends that the term LIFESTYLE as used in the mark, LIFESTYLE INNOVATIONS, should not be disclaimed. LIFESTYLE is not merely descriptive because consumers must take multiple mental steps to determine what services are identified by the mark. For example, applicant asserts that assuming LIFESTYLE means "a way of life," and consumers must next perform additional mental steps to conclude what type of LIFESTYLE may be involved in Applicant's services. The Examining Attorney's cited evidence does not support her claim that LIFESTYLE, as it appears in Applicant's mark, is descriptive. All doubt as to whether LIFESTYLE is merely descriptive must be resolved in Applicant's favor. Therefore, Applicant respectfully asks that the Examining Attorney withdraw the refusal and allow Applicant's mark to proceed to publication.

If further information or response is required, please contact Applicant's Attorney of Record, Shannon C. Stahlin, Esq.; or Travis J. Copenhaver, Esq., associate attorney to the Attorney of Record at 574.536.7185, or by email at [travis@stahlinlaw.com](mailto:travis@stahlinlaw.com).

## **Exhibits**

- Exhibit A: Example of a Registrant modifying LIFESTYLE with an adjective or descriptive phrase.
- Exhibit B: Example of the PTO not requiring Registrant to disclaim the term LIFESTYLE.
- Exhibit C: Example of the PTO not requiring Registrant to disclaim the term LIFESTYLE.
- Exhibit D: Example of the PTO not requiring Registrant to disclaim the term LIFESTYLE.
- Exhibit E: Example of the PTO not requiring Registrant to disclaim the term LIFESTYLE.
- Exhibit F: Example of the PTO not requiring Registrant to disclaim the term LIFESTYLE.
- Exhibit G: Example of the PTO not requiring Registrant to disclaim the term LIFESTYLE.
- Exhibit H: Example of the PTO not requiring Registrant to disclaim the term LIFESTYLE.
- Exhibit I: Example of the word LIFESTYLE referring to a variety of different goods or services.
- Exhibit J: Example of the word LIFESTYLE referring to a variety of different goods or services.
- Exhibit K: Example of the word LIFESTYLE referring to a variety of different goods or services.
- Exhibit L: Example of the word LIFESTYLE referring to a variety of different goods or services.
- Exhibit M: Evidence cited by the Examining Attorney demonstrating that third-party Registrant has disclaimed the word LIFESTYLE.
- Exhibit N: Evidence cited by the Examining Attorney demonstrating that third-party Registrant has disclaimed the word LIFESTYLE.
- Exhibit O: Evidence cited by the Examining Attorney demonstrating that third-party Registrant has disclaimed the word LIFESTYLE.
- Exhibit P: Evidence cited by the Examining Attorney demonstrating that third-party Registrant has disclaimed the word LIFESTYLE.
- Exhibit Q: Evidence cited by the Examining Attorney demonstrating that third-party Registrant has disclaimed the word LIFESTYLE.
- Exhibit R: Evidence cited by the Examining Attorney demonstrating that third-party Registrant has disclaimed the word LIFESTYLE.
- Exhibit S: Evidence cited by the Examining Attorney demonstrating that third-party Registrant has disclaimed the word LIFESTYLE.