

Hearing:
December 16, 1999

Paper No. 18
HRW

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JUNE 21, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re 24 Hour Fitness, Inc.

Serial No. 75/161,148

Donald L. Beeson for 24 Hour Fitness, Inc.

Steven R. Fine, Trademark Examining Attorney, Law Office
107 (Thomas Lamone, Managing Attorney).

Before Hairston, Wendel and Holtzman, Administrative
Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

24 Hour Fitness, Inc. has filed an application to
register the mark depicted below for "health club
services."¹

¹ Serial No. 75/161,148, filed September 5, 1996, claiming a
first use date of December 1982 and a first use in commerce date
of December 21, 1995. The application has been amended to one
seeking registration under the provisions of Section 2(f).

Registration has been finally refused on the grounds that the proposed mark is merely descriptive under Section 2(e)(1) of the Trademark Act and that the evidence submitted by applicant is insufficient to demonstrate acquired distinctiveness under Section 2(f). If the evidence is found sufficient to show that the mark has acquired distinctiveness, the Examining Attorney has made final the requirement for a disclaimer of the term 24 HOUR, on the basis that the term is generic with respect to applicant's services.²

Both applicant and the Examining Attorney have filed briefs and both participated in an oral hearing.

As a starting point, we would hasten to assure applicant that its proposed mark is being considered in its entirety, i.e., as a composite mark consisting of the term 24 HOUR as displayed on a darkened circle background.

Although we find no reason to construe this darkened circle as a ball design,³ as applicant insists it should be viewed,

² The prosecution of this case has been long and convoluted, with the Examining Attorney reversing himself twice on the issue of genericness of the term 24 HOUR and switching his reasons for finding the evidence of acquired distinctiveness insufficient. We have sought to bring the issues on appeal to coincide with those with which we believe applicant was adequately apprised during the examination process.

³ The fact that applicant has submitted one sample of stationary in which the impression is created that the black circle is a ball is not sufficient to establish that the circle would

we have considered the commercial impression created by the combination of 24 HOUR and the circle design as a whole.

Nonetheless, our first determination is whether the term 24 HOUR is merely descriptive when used in connection with applicant's health club services. A word or phrase is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys information about a characteristic or feature of the goods or services with which it is being used. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978).

Applicant insists that the term 24 HOUR is ambiguous, since 24 HOUR may well be viewed as referring to the fact that fitness is an "around the clock lifestyle" as well as to the operating hours of the health club. We agree with the Examining Attorney, however, that the much more likely interpretation for the term would be that the club is open twenty-four hours a day. We find the Nexis excerpts made of record by the Examining Attorney more than adequate to demonstrate that the phrase "24 hour health clubs" is used to refer to clubs of this nature. Furthermore, even applicant's evidence supports this interpretation. In the declaration of John McCarthy, which applicant has submitted

normally be interpreted in this manner by purchasers. None of the other samples of use create this ball image.

in connection with its arguments that the term "24 hour" is not generic, Mr. McCarthy states that

Occasionally, a health club may be described as being a "24 hour health club." This description only means that the health club referred to is open around the clock....

Moreover, we believe that this information would be immediately and directly conveyed by the phrase, whether or not any other more subtle connotation might also be perceived by some purchasers. As such, the term 24 HOUR is merely descriptive under Section 2(e)(1).

Our analysis does not end, however, at this point. Even though the term may be merely descriptive, a distinctive design may render the mark as a whole registrable, provided the term is disclaimed. In re Clutter Control, Inc., 231 USPQ 588 (TTAB 1986). If the design features of the asserted mark do not create an impression on purchasers separate and apart from the impression made by the term itself, i.e., the design features are not inherently distinctive, a display of descriptive matter is only registrable on the Principal Register if it can be shown by evidence that the particular display which applicant has adopted has acquired distinctiveness. See In re Guilford Mills, Inc., 33 USPQ2d 1042(TTAB 1994).

Here applicant is simply using a common geometric shape, namely, a circle, as the background for its descriptive term 24 HOUR. While the placement and relative sizes of 24 and HOUR and the darkening of the circle are also elements of the display, we find nothing in this combination of design features which would render the display inherently distinctive.

Accordingly, we turn to the evidence which applicant has submitted to support its claim of acquired distinctiveness under Section 2(f). This consists of the declaration of Tony Bakos, Vice President and General Counsel of applicant, in which he describes applicant as a chain of fitness centers located throughout the western United States which extensively promotes and advertises its health club services through a variety of media, including newspapers, billboards, signage at sports events, radio and television. Mr. Bakos states that the mark sought to be registered is "prominently featured" in this advertising. Mr. Bakos sets forth advertising expenditures for the years 1995 to 1997 ranging from \$9.4 million to \$19.1 million and net revenues for the same period ranging from \$114 million to \$279 million. Applicant has also submitted examples of applicant's use of the mark sought to be registered in a

newspaper advertisement, a club magazine, a sign in front of one of its clubs and on a shirt worn by staff members.

We agree with applicant that the Examining Attorney was incorrect in summarily dismissing this evidence because it did not show use of the circle design apart from the term 24 HOUR. As previously stated, the mark as a whole must be taken into consideration. The question is whether the particular display which applicant has adopted for the term 24 HOUR has caused the mark as a whole to have acquired distinctiveness.

The deficiency in applicant's claim of distinctiveness lies in the absence of any evidence of promotion of the term 24 HOUR and the circle design as a separate mark. In reviewing applicant's advertising for purposes of determining whether a particular designation (here the combination of 24 HOUR and the display thereof) has become distinctive, we must consider not only the extent of advertising but also whether the use of the designation has been of such a nature to create an association of the designation with the user and its goods and/or services. See *In re Semel*, 189 USPQ 285 (TTAB 1975). Although applicant's declarant states that the mark sought to be registered is "prominently featured" in applicant's extensive advertising, we note that in each example of use

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of the particular 24 HOUR and circle design sought to be registered, the 24 HOUR and circle design always immediately precedes the word FITNESS, or in the earlier instances of use, the word NAUTILUS. Applicant's counsel acknowledged at oral hearing that there was no evidence of record of promotion of the 24 HOUR and circle design alone. In the evidence of record, the commercial impression is that of a single composite mark, 24 HOUR FITNESS, with the 24 HOUR portion being in a particular display, not of two separable marks. There is no evidence which would indicate that there has been the potential for consumer perception of the term 24 HOUR in applicant's particular circle display as an independent indication of origin. There simply is no evidence of separate use of the mark sought to be registered.

While applicant points to the high advertising and sales figures for its health club services, as attested to by Mr. Bakos, these figures cannot overcome the absence of any evidence of promotion of the 24 HOUR and circle design as a separate mark. Although applicant's sales may be impressive, these merely demonstrate a growing popularity of its health club services, not that there has been any recognition of a particular designation as an indication of origin of these services, as is necessary to show acquired

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distinctiveness. See *In re Pingel Enterprise Inc.*, 46 USPQ2d 1811 (TTAB 1998).

Accordingly, we find that applicant has failed to demonstrate acquired distinctiveness of the mark sought to be registered under Section 2(f). In view of this determination, we need not consider the further issue of whether the term 24 HOUR is generic, thus requiring a disclaimer if the mark were registerable under Section 2(f).

Decision: The refusals to register under Section 2(e)(1) and under Section 2(f) are affirmed.

P. T. Hairston

H. R. Wendel

T. E. Holtzman
Administrative Trademark Judges,
Trademark Trial and Appeal Board

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