

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB MARCH 10, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Health Letter Associates
v.
Your Child's Wellness Newsletter Inc.

Opposition No. 97,046
to application Serial No. 74/430,030
filed on August 26, 1993

Emerson V. Briggs, III and Michael A. Grow of Arent, Fox,
Kintner, Plotkin & Kahn for Health Letter Associates.

Robert S. Weisbein of Darby & Darby, P.C. for Your Child's
Wellness Newsletter Inc.

Before Hanak, Quinn and Chapman, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

Your Child's Wellness Newsletter Inc. filed an
application to register the mark YOUR CHILD'S WELLNESS
NEWSLETTER on the Principal Register for a "newsletter
relating to health."¹ Applicant disclaimed the terms
"CHILD'S WELLNESS NEWSLETTER."

¹ Application Serial No. 74/430,030, filed August 26, 1993. The
application was originally filed based on applicant's assertion
of a bona fide intent to use the mark in commerce. Applicant
filed an amendment to allege use, which was accepted by the PTO,

Health Letter Associates opposed the application, and as grounds therefor opposer alleges that since at least as early as September 1984 it has continuously used its registered mark, WELLNESS LETTER, for newsletters dealing with topics of health (Registration No. 1,851,436)²; that applicant's mark, when used on its goods, so resembles opposer's previously used and registered mark, as to be likely to cause confusion, mistake, or deception; that opposer's substantial sales and advertising expenditures have resulted in opposer's mark being a distinctive indicator of the origin of opposer's goods; that the term "YOUR CHILD'S" in applicant's mark has no distinctiveness as applied to newsletters dealing with topics pertaining to children; and that the term "YOUR CHILD'S," being merely descriptive of applicant's goods under Section 2(e)(1) of the Trademark Act, should be freely available for use by opposer as well as other competitors who publish materials pertaining to their subscriber's children.

In its amended answer applicant admits that opposer is the owner of Registration No. 1,851,436, but otherwise denies the salient allegations of the notice of opposition. Applicant raises certain "affirmative defenses" including that applicant's own use of the words "Wellness Newsletter"

with claimed dates of first use and first use in commerce of August 26, 1993.

is solely for its generic and/or descriptive meaning; and that applicant disclaimed the descriptive words "Wellness Newsletter."³

The record consists of the pleadings; the file of the opposed application; the testimony, with exhibits, of Rodney Friedman, a partner in Health Letter Associates; and both parties' notices of reliance.⁴ Opposer filed a brief on the case.⁵ Neither party requested an oral hearing.

Mr. Friedman testified that in 1981 or 1982 he (and a now deceased partner) originated the idea of the "wellness" newsletter, choosing the term because it is a "distinct and unique" word symbolizing "a new kind of healthier life-style" (dep., p. 10). He explained the newsletter is "aimed at educating and helping people lead a healthier, more active, more vigorous life" (dep., p. 7); and "it covers a very different area of health. We never talk about surgery. We never talk about drugs, prescription drugs. We always

² Registration No. 1,851,436, issued under Section 2(f) on August 30, 1994. The claimed date of first use is September 1984.

³ Applicant's amended answer also included a counterclaim to cancel opposer's pleaded registration. By Board order dated April 30, 1999 judgment was entered against applicant (as counterclaim petitioner) and the counterclaim was dismissed pursuant to Trademark Rule 2.128(a)(3).

⁴ The Board notes that as to the evidence submitted under Trademark Rule 2.122(e) in the notices of reliance, neither party included a statement of the relevance of that evidence (as required by the rule), leaving the Board to presume what each party intended to establish by said offered material.

⁵ Opposer also filed a combined brief in opposition to applicant's counterclaim and reply brief in support of the opposition. Inasmuch as applicant did not file a brief on the

tell people how they can power themselves so that they can lead a healthier and more robust life." (dep., p. 10).

In June 1984, opposer entered into a publication agreement with The Regents of the University of California (University) whereby the University granted opposer a revocable license to use the name "University of California, Berkeley" as well as the unofficial seal of the University in a publication titled "The University of California, Berkeley, Wellness Letter" through the University's School of Public Health, reserving all rights in the University's name and unofficial seal to the University. In return, opposer agreed to pay the University a royalty based on a percentage of the subscription receipts. Under the agreement opposer is solely responsible for financing the development, production, distribution and marketing of the newsletter; creating a production schedule; and researching and writing the articles to be included therein. The University's responsibilities include submitting ideas for articles; responding and cooperating with opposer in production tasks; reviewing all articles for accuracy; and approving all final versions of the newsletter.

case as defendant in the opposition (or as plaintiff in the counterclaim), opposer's reply brief has not been considered.

Opposition No. 97046

From 1984⁶ to about 1990 opposer published a monthly newsletter under the name UNIVERSITY OF CALIFORNIA, BERKELEY WELLNESS LETTER, presented in the format shown below.

Thereafter, because the University required that the newsletter reflect the word "at" in place of the comma in the University name, the monthly newsletter has been published presented in the format shown below.

Health Letter Associates (opposer) obtained a registration on the Principal Register under Section 2(f) for the mark WELLNESS LETTER for "newsletters dealing with topics of health" in 1994. Mr. Friedman testified that if opposer's contract with the University terminated or expired, opposer would market its newsletter under the mark WELLNESS LETTER, without the University's name.

Opposer sells newsletter subscriptions primarily through direct mail advertising, with some limited use of television (e.g., CNBC), radio, and magazine (e.g., Modern

⁶ In March 1984 opposer sent a mailing to 150,000 people inquiring about interest in subscribing to the newsletter; and

Maturity) advertising. Subscriptions also come in through "white mail," which refers to those coming in from people who learned about opposer's newsletter mentioned in other publications (e.g., in a book review of The Wellness Encyclopedia⁷). From 1984 to 1996 opposer spent approximately \$100 million for advertising, marketing and promotion, with 5-10% of that amount spent on non-direct mail. Opposer's sales revenues are about \$13 to \$15 million annually. The current annual subscription price is \$28.00 for 12 issues.

The circulation figures for opposer's newsletter reached about 250,000 within the first 18 months after publication of the first issue of October 1984, making it one of the largest health newsletters behind those of Harvard and the Mayo Clinic. The peak circulation was about 1 million subscribers in 1990, and thereafter the circulation declined to about 600,000 in 1996. Opposer targets a very broad demographic group covering virtually all adults. While opposer does not expect to sell its newsletter to children, the newsletter covers topics of interest to the parents or other caregivers of children.

Mr. Friedman also testified that in addition to the UNIVERSITY OF CALIFORNIA AT BERKELEY WELLNESS LETTER,

the first issue was mailed in September 1984 carrying a publication date of October 1984.

opposer has also published several other publications which include the term WELLNESS, such as The Wellness Low Fat Cookbook, The Wellness Encyclopedia, Wellness Made Easy⁸, and a series of "Wellness" reports.

While opposer's registered mark is WELLNESS LETTER, the record is clear that the mark used by opposer (through a license agreement with the University) is and has always been UNIVERSITY OF CALIFORNIA AT BERKELEY WELLNESS LETTER. For example, on cross-examination, when asked if it is correct to say that the name of the involved publication is the "University of California at Berkeley Wellness Letter" Mr. Friedman answered "yes." (dep., p. 90). Also, on page 2 of opposer's newsletter in the required "Statement of ownership, management, and circulation" the publication is identified as follows: "Title of Publication: University of California at Berkeley Wellness Letter." (Opposer's exhibit 4).

Further, when asked if the name "University of California at Berkeley" always appears in close connection with the name WELLNESS LETTER, he answered as follows:

In all of the things that we
publish it always appears as the

⁷ This book, first published in 1990, consists of a compilation of articles that have appeared in opposer's newsletter.

⁸ This paperback book consists of a compilation of tips which have appeared in the newsletter. Since about 1993 opposer has given away a copy of this book with each subscription to the newsletter.

University of California at Berkeley
Wellness Letter.

Other people certainly--you see it referred to in the press sometimes as Berkeley Wellness and sometimes just the Wellness Letter. If we publish it it will always bear those two names together. (dep., p. 90).

And in response to a question about whether all promotional materials and other publications opposer produces include the full title with the University name, he answered as follows:

Everything that Health Letter Associates publishes or produces carries the name University of California at Berkeley Wellness Letter. (dep., p. 89).

Applicant first solicited subscriptions for its newsletter under the mark YOUR CHILD'S WELLNESS NEWSLETTER in June 1993, and published and distributed its newsletter in or about August 1993. Its newsletter carries the sub-slogan "A monthly review of children's health issues." Applicant targets its newsletter to the parents of young children, and it was once distributed to the offices of pediatricians.

Applicant advertises through direct mailings, but not through printed advertisements or radio or television. However, the editor of applicant's newsletter, Dr. Reuben Reiman, has been interviewed on various television and radio

broadcasts, as well as for various print stories, in all of which he referenced applicant's newsletter.

With regard to the question of priority, we find that opposer's pleaded registration is of record herein.⁹

Because opposer owns a valid and subsisting registration of its mark, the issue of priority does not arise. See *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); and *Carl Karcher Enterprises Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125 (TTAB 1995). Moreover, the evidence clearly shows that opposer's first use preceded that of applicant.

The only issue to be determined, therefore, is whether applicant's mark, YOUR CHILD'S WELLNESS NEWSLETTER, when used on a "newsletter relating to health," so resembles either opposer's registered mark, WELLNESS LETTER, or

⁹ Opposer did not make its registration of record either through submission of a current status and title copy under a notice of reliance or through appropriate identification and introduction during the testimony of a witness. See TBMP §703.02(a). A photocopy of the pleaded registration was introduced as an exhibit to Mr. Friedman's testimony, but the witness did not testify as to status and/or title of said registration. (ftnt cont.) However, in applicant's amended answer (as well as in the original answer) applicant admitted opposer's ownership of the pleaded registration, and during cross-examination of Mr. Friedman applicant introduced a photocopy of the file history of opposer's registration (applicant's exhibit I). In fact, applicant filed a counterclaim petition to cancel same, and therefore the registration file became part of the record to the extent provided in Trademark Rule 2.122(b). Moreover, presumably applicant would have no interest in petitioning to cancel a registration which was not subsisting. In these circumstances, we find that both the status and the title of opposer's pleaded registration have been established, and said registration is of record herein. See *Tiffany & Co. v. Columbia Industries, Inc.*, 455 F.2d 582, 173 USPQ 6 (CCPA 1977).

opposer's mark as actually used (through a license with the University), UNIVERSITY OF CALIFORNIA AT BERKELEY WELLNESS LETTER for its "newsletters dealing with topics of health," that confusion is likely as to the origin or affiliation of the parties' goods. Upon consideration of the pertinent factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), for determining whether a likelihood of confusion exists, we find that confusion is not likely.

Turning first to the similarity of the goods, both parties publish newsletters dealing with health topics. There is no question that applicant's and opposer's goods are virtually identical as identified. See *Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

Further, the record shows that both parties utilize the same channels of trade to reach the same classes of purchasers. First, there is no limitation in either the application or the registration as to purchasers or channels of trade (see *Canadian Imperial v. Wells Fargo*, supra). Second, even if applicant in fact markets its newsletter only to parents of children, opposer markets to virtually all adults, including parents of children, thus encompassing applicant's targeted market. Moreover, both parties obtain the majority of their subscriptions from direct mailings.

Thus, the parties' channels of trade as well as the prospective purchasers are similar.¹⁰

Turning to a consideration of the involved marks, we must compare applicant's mark with opposer's registered mark, as well as with the mark used by opposer, in their entirety. See *Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). That is, in determining likelihood of confusion, the marks are not dissected or split into component parts and each part compared with other parts. It is the impression created by the marks as a whole that is important. See 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §23:41 (4th ed. 1999).

When considering applicant's mark YOUR CHILD'S WELLNESS NEWSLETTER, and opposer's mark as used UNIVERSITY OF CALIFORNIA AT BERKELEY WELLNESS LETTER, we find these marks are not similar in sound, appearance, connotation and/or commercial impression. In fact, the only word the marks have in common is WELLNESS. The commercial impression and connotation of opposer's mark clearly relates to the

¹⁰ Opposer also argues that there are physical similarities in the format and content of the parties' newsletters, such as, both are eight pages, both have the title banners at the top of the first page with their sub-slogans in similar block type, both carry articles of the same general length, and both include similar boxes with bulleted tips on health. The physical layout and content of the parties' respective newsletters is irrelevant to the question of the registrability of applicant's mark in this opposition proceeding. Moreover, any of those characteristics could be changed at any time by either or both parties.

University of California and good health, while applicant's mark connotes a reference to children and their well being and good health. The name of the University appearing in opposer's mark as used sufficiently distinguishes that mark from applicant's mark.

With regard to applicant's mark and opposer's registered mark WELLNESS LETTER, we also find these two marks are sufficiently different to preclude a finding of likelihood of confusion. Opposer's registered mark simply connotes a generalized concept of good physical and mental health, as distinguished from the connotation of applicant's mark relating to children. Each of the three involved marks has a different meaning and creates a separate commercial impression.

In this case applicant's mark, and opposer's registered mark as well as its mark as used, are all descriptive of the respective goods, newsletters on health topics.¹¹ Opposer's

¹¹ The Courts and the Board have recognized that the titles of publications are not considered differently from trademarks for other products. See *In re Waverly Inc.*, 27 USPQ2d 1620 (TTAB 1993). Nonetheless, titles of publications can present a unique problem in trademark law especially when considering the descriptiveness of the involved mark. As Judge Rich stated in his dissent in the case of *In re Simulations Publications, Inc.*, 521 F.2d 797, 187 USPQ 147 (CCPA 1975):
"What we are dealing with here are magazine titles which, realistically, are in a somewhat different category from marks used on the usual run of manufactured products. ... I doubt that purchasers of two magazines in the same field normally have any interest in whether they are published by the same or different publishers. Magazines are bought for their expected contents and

registered mark issued under Section 2(f) of the Trademark Act, thus opposer conceded its mark is merely descriptive. See *Yamaha International v. Hoshino Gakki*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988). Further, applicant submitted under a notice of reliance, inter alia, four dictionary definitions of the term "wellness," including the following two definitions:

(1) "The condition of good physical and mental health, esp. when properly maintained," The American Heritage College Dictionary (3rd ed.); and

(2) "The quality or state of being in good health esp. as an actively sought goal," Merriam-Webster's Collegiate Dictionary (10th ed.).

Applicant also introduced seventeen third-party registrations, all of which include the term "wellness," and all are for publications dealing with health and well being (most of which specifically include "newsletters") or printed material. Examples of the third-party registrations

their titles are the means by which the desired contents are obtained... Furthermore, in one way or another, periodical titles, even though registrable as trademarks, have a way of strongly suggesting their contents. ... Since magazine purchasers are used to the idea that there is more than one magazine in the same field, perforce containing similar contents-...-magazine purchasers have a degree of sophistication or selection know-how which does not necessarily exist in the purchase of a can of beans or paint. They normally discriminate. (Emphasis in original.) (footnote continued)

See also, *Gruner + Jahr USA Publishing v. Meredith Corp.*, 793 F. Supp. 1222, 25 USPQ2d 1520 (SDNY 1992).

include WELLNESS ADVOCATE¹², WELLNESS MATTERS¹³, WELLNESS WATCH¹⁴, and POSITIVE HEALTH & WELLNESS!.¹⁵ Of course, third-party registrations are not evidence of use of the

¹² Registration No. 1,974,932, issued May 21, 1996, with a disclaimer of the term "wellness."

¹³ Registration No. 1,928,735, issued October 17, 1995, with a disclaimer of the term "wellness."

¹⁴ Registration No. 1,743,076, issued December 29, 1992, with a disclaimer of the term "wellness."

¹⁵ Registration No. 1,388,286, issued April 1, 1986, with a disclaimer of the terms "health & wellness."

marks shown therein, or that the public is familiar with them. But they may be used to indicate that a commonly registered element has a suggestive or descriptive meaning for particular goods such that the differences in other portions of the marks may be sufficient to render the marks as a whole distinguishable. See *Aries Systems Corp. v. World Book Inc.*, 23 USPQ2d 1742, footnote 15 (TTAB 1992).

The record shows that the word "wellness" is a weak term in the field of publications dealing with topics of health. Therefore, opposer's registered mark and the mark as used by opposer are entitled to only a narrow scope of protection. See *Sure-Fit Products Company v. Saltzson Drapery Company*, 254 F.2d 158, 117 USPQ 295, 297 (CCPA 1958); *In re General Motors Corp.*, 23 USPQ2d 1465 (TTAB 1992); and *In re J.C. Penney Company, Inc.*, 179 USPQ 184 (TTAB 1973). Cf. *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

As the Court of Customs and Patent Appeals stated in *Sure-Fit v. Saltzson*, *supra*: "Where a party chooses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. The essence of what we have said is that in the former case there is not the possibility of confusion that exists in the latter case." More recently, the Court of Appeals for the

Federal Circuit stated the following in the case of *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985): "Where consumers are faced with various usages of descriptive words, our experience tells that we and other consumers distinguish between these usages."

The mere fact that opposer's marks (as registered and as used) and applicant's mark all include the term "wellness" is not enough for a finding of likelihood of confusion given the weakness/descriptiveness of "wellness" in relation to the goods, and the other specific differences between the marks. See 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, *supra* at §§11:73 and 11:74.

Regarding opposer's contention that its mark, through acquired distinctiveness, is a strong mark, opposer bases this assertion on its advertising expenditures, television infomercials, appearances of Mr. Rodney Friedman on national television shows (e.g., The Today Show), and its commercial success in terms of sales and circulation numbers of its newsletter. While opposer's registered mark is for the mark WELLNESS LETTER, there is no question that all of the evidence relied on by opposer to prove the strength of its mark is for the mark UNIVERSITY OF CALIFORNIA AT BERKELEY WELLNESS LETTER. There is virtually no evidence of the strength of opposer's registered mark standing alone.

Moreover, even considering this evidence in terms of opposer's mark as used or registered, extensive advertising and/or sales may indicate the commercial success of a product, but they do not alone establish consumer recognition of the mark as the source of the involved goods.¹⁶

We now address opposer's argument in its brief (p. 9) that opposer has a family of "WELLNESS" marks. First, opposer's pleadings (original and amended) referred only to opposer's mark WELLNESS LETTER, with no reference in a specific or even a generalized manner to any other alleged marks which include the term WELLNESS. Second, even if we considered this issue pursuant to Fed. R. Civ. P. 15(b), it is well settled that mere adoption and use (and even registration) of a number of marks having a common feature for similar or related goods or services does not in and of itself establish a family of marks. Rather, in order to establish a family of marks, it must be demonstrated that

¹⁶ We are aware that opposer's witness, Mr. Friedman, testified that he conducted a market test in or around 1994. He rented a random sample of potential mailing lists and mailed those people an advertisement package, with 50,000 carrying the University name and the words WELLNESS LETTER, while another 50,000 carried only the words WELLNESS LETTER. The subscription response rate to those with WELLNESS LETTER alone was about 10% lower than the subscription response rate to those with the University name. Mr. Friedman characterized this as a close response rate and one strong enough for opposer to publish a newsletter under the mark WELLNESS LETTER. (dep., pp. 31-35). We do not find that this testimony alone proves strong consumer recognition of the term WELLNESS LETTER as identifying opposer as the source of the goods.

the marks asserted to comprise the "family," or a number of them, have been used and advertised in promotional material or used in everyday sales activities in such a manner as to create common exposure and thereafter recognition of common ownership based upon a feature common to each mark. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Witco Chemical Co. v. Whitfield Chemical Co.*, 418 F.2d 403, 164 USPQ 43 (CCPA 1969); and *Dan River, Inc. v. Apparel Unlimited, Inc.* 226 USPQ 186 (TTAB 1985). Further, a question arises as to whether a family of marks could be based on a descriptive common element (e.g., the term "WELLNESS"). See *Hester Industries Inc. v. Tyson Foods Inc.*, 2 USPQ2d 1646 (TTAB 1987). See also, *Spraying Systems Co. v. Delavan Inc.*, 975 F.2d 387, 24 USPQ2d 1181 (7th Cir. 1992).

Opposer has offered evidence regarding its use of the mark UNIVERSITY OF CALIFORNIA AT BERKELEY WELLNESS LETTER, but has failed to offer convincing evidence of common exposure and public recognition of opposer's common ownership of the various other marks in its asserted family of "WELLNESS" marks, including "The Wellness Encyclopedia" and "Wellness Made Easy." Opposer's evidence is wholly inadequate to establish a family of marks.

Finally, the Trademark Act does not speak in terms of remote possibilities of confusion, but rather, the

likelihood of such confusion occurring in the marketplace. Our primary reviewing court has stated that more than a mere possibility of confusion must be shown; instead, there must be demonstrated a probability or likelihood of confusion. See *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992). See also, *Triumph Machinery Company v. Kentmaster Manufacturing Company Inc.*, 1 USPQ2d 1826 (TTAB 1987).

Based on the dissimilarities in the marks, and the narrow scope of protection afforded opposer's marks, we find that confusion is unlikely. See *Kellogg Co. v. Pack'Em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). See also, *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270 (TTAB 1992) (FIBER 7 FLAKES and FIBER ONE, both for ready to eat breakfast cereal, held not confusingly similar); *Stouffer Corporation v. Health Valley Natural Foods Inc.*, 1 USPQ2d 1900 (TTAB 1986) (LEAN LIVING and LEAN CUISINE, both for food products, held not confusingly similar); and *Electronic Water Conditioners, Inc. v. Turbomag Corporation*, 221 USPQ 162 (TTAB 1984) (TURBO-MAG and ELECTRO-MAG, both for water conditioning units for electromagnetically treating water and removing scale, held not confusingly similar).

Decision: The opposition is dismissed.¹⁷

E. W. Hanak

T. J. Quinn

B. A. Chapman
Administrative Trademark Judges,
Trademark Trial and Appeal Board

¹⁷ Opposer argued in its brief (p. 29) that the opposition should be sustained because applicant's mark creates a false suggestion of a connection with opposer and brings opposer into contempt or disrepute [both grounds being under Section 2(a) of the Trademark Act]. Neither of these grounds was pleaded by opposer, nor is there any evidence of record on these issues in this case. Obviously, any ground which is neither pleaded nor proven must fail.