

THIS OPINION IS NOT
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THE T.T.A.B.

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Butler

Mail date: July 8, 2004

Opposition No. 91154584

Pilates Method Alliance, Inc.

v.

Pilates, Inc.

Before Hanak, Chapman and Holtzman, Administrative Trademark Judges.

By the Board:

Applicant seeks to register the mark PILATES STUDIO for "providing lessons, training, workshops, and seminars for exercise and physical conditioning; physical education services; physical fitness instruction; training in the use and operation of exercise equipment; and teaching in the field of physical fitness" in Class 41 and "providing facilities for exercise and physical conditioning; physical fitness consultation; providing physical rehabilitation and physical therapy" in Class 42. In its application Serial No. 78048238, filed on February 14, 2001, applicant claimed first use and first use in commerce since 1941; and disclaimed the word PILATES. Applicant also claimed ownership of the following registrations on the Principal Register: Registration Nos. 2192971 for the mark PILATES PERFORMER for "exercise equipment, namely, a portable metal framed bed-like platform or carriage that slides along tracks and

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that uses springs for resistance; the carriage is moved by pushing against a bar or by pulling on looped strips with the arms or legs, specifically made for home use";¹ 1960710 for the mark PILATES for "exercise and athletic clothing, namely sweat pants, pants leotards, tights, bathing suits, shorts, shirts, T-shirts, sweatbands, headbands, hats, underpants and bras";² and 1602929 for the mark PILATES STUDIO for "providing facilities for exercise and physical conditioning."³ Applicant further claimed, in its application, that the mark, PILATES STUDIO, has become distinctive of the services as evidenced by ownership of Registration No. 1602929 on the Principal Register of the same mark for related goods and services.

As background, opposer alleges in the notice of opposition that it is a not-for-profit international alliance of individual and business members dedicated to preserving the integrity of the Pilates method of exercise and providing an organization for members of the Pilates community to exchange information. Opposer alleges that it was formed in February 2001, shortly

¹ Such registration issued on October 6, 1998, claiming first use and first use in commerce on January 1, 1996. On December 11, 2000, registrant filed a Section 7 amendment seeking to add a disclaimer of the term PILATES, and the amendment was entered by the USPTO on January 27, 2001.

² Such registration issued on March 5, 1996, claiming first use and first use in commerce on January 1, 1993. Section 8 affidavit accepted; Section 15 affidavit acknowledged.

³ Such registration issued on June 19, 1990 pursuant to Section 2(f) of the Trademark Act, and with a disclaimer of the term STUDIO; claiming first use and first use in commerce on January 1923. The registration was cancelled by the USPTO on January 3, 2002 under Section 37 of the Trademark Act, pursuant to the order of the court in *Pilates, Inc. v. Georgetown Bodyworks Deep Muscle Massage Centers, Inc. a/k/a Georgetown Bodyworks Fitness Centers, Inc. and Willard A. Green*, 157 F.Supp.2d 75 (DDC 2001) (hereinafter *Georgetown Bodyworks*).

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after the decision in *Pilates Inc. v. Current Concepts Corp.*, 120 F.Supp.2d 286, 57 USPQ2d 1174 (SDNY 2000) (hereinafter *Current Concepts*), and that opposer, its members and the public will be damaged by registration of PILATES STUDIO. Opposer alleges that, with respect to applicant's claim of ownership of Registration No. 1602929 for the mark PILATES STUDIO for "providing facilities for exercise and physical conditioning," the District Court for the District of Columbia in *Georgetown Bodyworks, supra*, found that PILATES STUDIO was not registrable, and on August 7, 2001 ordered that the USPTO cancel Registration No. 1602929 for the mark PILATES STUDIO. Opposer alleges that the court ordered the registration cancelled in view of the earlier finding in *Current Concepts* that PILATES is generic; the ensuing agreement by applicant to disclaim the term PILATES in the registration; and the refusal by the USPTO to enter the proposed post registration amendment to include a disclaimer of PILATES for the registration because the term STUDIO was already disclaimed.

As grounds for the opposition, opposer alleges that the term PILATES STUDIO is generic; that applicant made false statements to the USPTO concerning its claimed 1941 date of first use and first use in commerce; that applicant's rights to the term PILATES STUDIO were allegedly acquired by assignment; that, in accordance with the court's determination in *Current Concepts*, because the assignment to applicant of the mark PILATES was found to be an invalid assignment in gross, the assignment to applicant of the PILATES STUDIO mark, made in the same transaction, is also

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an invalid assignment in gross; that applicant knew others were entitled to use, and had the right to use, PILATES STUDIO, but submitted a declaration to the contrary as part of its application; that applicant's claim of acquired distinctiveness, based solely on its ownership of Registration No. 1602929, was invalid, and applicant had a duty of candor, when the application was still pending, to inform the USPTO that the court had ordered cancelled the registration upon which applicant was basing its claim of acquired distinctiveness; and that applicant's claim of acquired distinctiveness is insufficient because it cannot provide evidence of substantially exclusive and continuous use of the applied for mark for the five years immediately preceding the filing date of the application.⁴

In its answer, applicant, acknowledging the decisions and holdings in *Current Concepts* and *Georgetown Bodyworks*, otherwise denies the salient allegations of the notice of opposition, and affirmatively asserts that opposer does not have standing to bring this opposition.

This case now comes up on opposer's motion for summary judgment on each of the claims set forth in the notice of opposition, and applicant's cross-motion for summary judgment on its affirmative defense that opposer does not have standing.⁵

⁴ The Board notes that the application does not contain a claim of acquired distinctiveness based on substantially exclusive and continuous use of the mark for the five years prior to the filing date of the application, but rather, refers only to ownership of the registration.

⁵ The parties' stipulated protective agreement, filed with the Board on October 22, 2003, has now been associated with and entered into the

Preliminary matters addressed

Before turning to the parties' respective motion and cross-motion for summary judgment, the Board addresses the following matters: (i) applicant's objection to the timeliness of opposer's motion for summary judgment; (ii) opposer's objection to applicant's submission of evidence in its response to opposer's motion for summary judgment, assertedly requested by opposer during discovery not provided by applicant; (iii) opposer's objection to applicant's conditional proposed amendment to its application, submitted in response to opposer's motion for summary judgment, to change the basis of its claim of acquired distinctiveness; and (iv) a discussion of the decisions in *Current Concepts* and *Georgetown Bodyworks, supra*.

Applicant's objection to opposer's motion for summary judgment on the basis of timeliness

In its March 2, 2004 response to opposer's motion for summary judgment, applicant objects to the timing of opposer's motion, filed February 2, 2004. More specifically, applicant argues that it "...never received a response" to opposer's motion of October 14, 2003 to extend discovery and trial dates.

Suffice it to say that opposer's motion for summary judgment is timely, having been filed prior to the commencement of the first testimony period as reset by the Board's order of January 13, 2004 granting opposer's October 14, 2003 motion to extend

electronic file. The Board regrets the delay occasioned in entering the protective agreement.

dates. See Trademark Rule 2.127(e); and TBMP Section 528.02 (2nd ed. Rev. 1 March 2004).

In view thereof, applicant's objection to the timeliness of opposer's motion for summary judgment is overruled.⁶

Opposer's objection to applicant's evidentiary submissions

In its response to opposer's motion for summary judgment, applicant indicates that it "...now has a number of Exhibits, B-BC, which were not prepared at the time it responded, May 22, 2003, to Opposer's Interrogatory Number 20 in Exhibit 15, which do refute the causes of action raised in the Notice of Opposition." Opposer, in its reply brief, comments on "...the impropriety of applicant's admission of presenting evidence after the close of discovery that it believes are material to the case, and which existed prior to the close of discovery..." Opposer, nonetheless, acknowledges that the Board may choose to review all the evidence in making its decision in this case and, thus, submits its reply brief addressing the merits of applicant's evidentiary submissions.

⁶ Informationally, to the extent that applicant is arguing it did not receive a copy of the Board's January 13, 2004 order granting opposer's October 14, 2003 motion to extend dates, applicant is referred to the TTABVUE database now available at www.uspto.gov. This database was made available to the public in the fall of 2003 and, in addition to being a status resource, allows viewing and printing of most filings, motions and orders in any particular proceeding.

Moreover, the Board has provided on-line status databases for several years, albeit the older database only provided status and did not permit the viewing of documents. Cf. *Old Nutfield Brewing Company, Ltd. V. Hudson Valley Brewing Company, Inc.*, 65 USPQ2d 1701 (TTAB 2002) ("If opposer had any doubt as to the official status of the case at any time, it had only to call the Board, view the proceeding information on the Internet, or inspect (or have an agent inspect) the public file in person at the Board.")

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Applicant has not explained why its submissions were not previously prepared in response to opposer's discovery requests and, generally, a party found to have purposefully withheld discovery responses may be precluded later from introducing evidence so purposefully withheld. *See, for example*, TMBP Sections 527.01(a) and 527.03 (2nd ed. Rev. 1 March 2004). However, because opposer addressed the evidence on the merits and because this involves a summary judgment motion, opposer's objections to the evidence are overruled.

Applicant's proposed amendment to its application Serial No. 78048238

In its response to opposer's motion for summary judgment, and addressing, in part, opposer's allegations that applicant's claim of acquired distinctiveness, based solely on Registration No. 1602929, is insufficient, applicant submitted an affidavit from its owner⁷ in support of acquired distinctiveness based on applicant's substantially exclusive and continuous use of the mark PILATES STUDIO for all recited services for the five years preceding the filing date of the application. Applicant provides the statement in the event "... the Board finds that the Examining Attorney inappropriately approved the 2(f) registration under an existing mark."

Opposer objects to applicant's conditional proposed amendment, arguing that it does not consent to the proposed

⁷ Mr. Gallagher, affiant, identifies himself as "owner" of Pilates, Inc. In *Georgetown Bodyworks*, 157 F.Supp2d at 78, he is identified as "President and sole shareholder" of Pilates, Inc.

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amendment; that the proposed amendment changes the basis for applicant's claim of acquired distinctiveness and, as such, is a fundamental and substantive change in the application; and that the proposed amendment is, in any event, insufficient.

An application which is the subject matter of an *inter partes* proceeding before the Board may not be amended in substance except with the consent of the adverse party and the approval of the Board or upon motion granted by the Board. See Trademark Rule 2.133(a); and TBMP Section 514 (2nd ed. Rev. 1 March 2004). Opposer affirmatively states it does not consent to applicant's conditional proposed amendment. Moreover, because any such amendment would be futile for reasons that will become evident later in this decision, opposer's objection to applicant's conditional proposed amendment is sustained and applicant's request to amend its application is denied.

The Two Court cases

The decisions in the *Current Concepts* and *Georgetown Bodyworks* cases, *supra*, provide an historical backdrop to the present controversy before us. In addition, the parties reference the cases and findings made therein by the courts in their respective arguments. Thus, we will briefly summarize the cases before we turn to the merits of parties' respective motion and cross-motion for summary judgment.

Current Concepts involved two federally registered trademarks asserted by plaintiff Pilates, Inc. (applicant herein), both for the term PILATES, for exercise instruction

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services⁸ and exercise equipment.⁹ Defendants in that case asserted affirmative defenses including that the marks were generic; that the marks were abandoned; that the marks were improperly assigned in gross; and that the marks were registered fraudulently. Although the defendants also challenged the registered PILATES STUDIO mark (Registration No. 1602929), the court determined that, because the defendants lacked standing with respect to this mark and the mark was not asserted against defendants, there was no justiciable case or controversy with respect to the PILATES STUDIO mark.¹⁰ The court found, among other findings, that PILATES is generic for exercise instruction and exercise equipment; that the PILATES mark for exercise equipment had been abandoned by Pilates, Inc.'s immediate predecessor in interest; that the transfer to Pilates, Inc. from its immediate predecessor in interest of the PILATES mark for instruction services was an invalid assignment in gross; and that the application for registration of the PILATES mark for equipment, filed by Pilates, Inc., contained material and knowing misrepresentations and the ensuing registration was, thus,

⁸ Registration No. 1405304 issued on August 12, 1986 to Aris Isotoner Gloves, Inc., and was subsequently purchased by Pilates, Inc. This registration was cancelled by the USPTO pursuant to the order of the court, in accordance with Trademark Act Section 37.

⁹ Registration No. 1907447 issued on July 25, 1995 to Pilates, Inc. (applicant herein). This registration was cancelled by the USPTO pursuant to the order of the court, in accordance with Trademark Act Section 37.

¹⁰ See *Current Concepts* 120 F.Supp.2d at 290-294, 57 USPQ2d at 1176-1181 for a detailed history of the Pilates exercise method, use of the term PILATES, involved businesses, and assignments. See *Georgetown Bodyworks* 157 F.Supp.2d at 77-79 for a condensed background recitation.

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invalid. In its decision of October 19, 2000, the court ordered the two PILATES registrations cancelled. Subsequently, on December 4, 2000, the parties entered into a settlement agreement in accordance with the court's decision wherein Pilates, Inc. agreed, among other things, to submit post registration amendments seeking to disclaim the term PILATES in certain registrations, including Registration No. 1602929 for the mark PILATES STUDIO.

The *Georgetown Bodyworks* case involved Pilates, Inc.'s asserted federally registered PILATES STUDIO mark for providing facilities for exercise and physical conditioning (Registration No. 1602929), against which the defendants asserted counterclaims, including one for declaratory relief on the ground that the mark was invalid and should be ordered cancelled because plaintiff's requested amendment to disclaim PILATES in the mark PILATES STUDIO "...creates an invalid non-registrable mark."¹¹ The court noted that the registration was registered with a disclaimer of the term STUDIO;¹² that, subsequent to the decision in *Current Concepts*, Pilates, Inc. filed a post registration amendment to enter a disclaimer of the term PILATES; and that such amendment was denied on January 23, 2001 by the USPTO because the attempt to disclaim PILATES when there already

¹¹ During the pendency of the *Georgetown Bodyworks* case, the parties agreed that Pilates, Inc.'s asserted PILATES marks and registrations were no longer contested in view of the cancellation of the registrations by the USPTO, as ordered by the court in *Current Concepts*.

¹² The court did not comment on the registration being under Trademark Act Section 2(f), acquired distinctiveness.

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existed a disclaimer of the term STUDIO would result in an impermissible disclaimer of the entire mark. The court observed that Pilates, Inc. filed a new application on February 20, 2001 (the application which is the subject of this instant opposition), "... in which the term STUDIO is not disclaimed, based on a secondary meaning theory." See *Georgetown Bodyworks* at 82. The court indicated this apparent attempt to re-register previously disclaimed matter was not before it because it has no bearing on the initial registration for PILATES STUDIO; and limited its determination to "...the validity of the original PILATES STUDIO mark (Reg. No. 1602929), and its attempted amendment." *Id.* The court found that, "...because a composite mark cannot be amended to disclaim all portions of the mark individually and remain valid, the original PILATES STUDIO mark is invalid and should be cancelled." *Id.* In view of this finding, the court expressly stated that it need not consider whether PILATES STUDIO is generic or whether the mark was the subject matter of an invalid assignment in gross. *Id.*

Opposer's motion and applicant's cross-motion for summary judgment

In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issue of material fact and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56. The movant is held to a stringent standard. See 10A Wright, Miller & Kane, Federal Practice and Procedure: Civil 3d § 2727 (1998). A genuine dispute with

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respect to a material fact exists if sufficient evidence is presented that a reasonable fact-finder could decide the question in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts as to whether any particular factual issues are genuinely in dispute must be resolved in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ 1542 (Fed. Cir. 1992).

We turn first to applicant's cross-motion for summary judgment on its affirmative defense concerning opposer's standing.

Applicant's cross-motion for summary judgment

In support of its cross-motion, applicant argues that opposer is "... a representational organization and has not pled a personal interest in this matter, either for itself or its members..." Applicant further argues that opposer has "... only alleged that they and the public will be damaged without describing how..." they will be damaged.

In response, opposer argues that, as an association, it has standing to represent its members where any organizational member on its own would have standing to sue; that, because it has alleged that applicant's mark is generic, it has standing because any member of the public could sue a trademark owner on the basis that the term is generic; that the interests opposer seeks to protect are germane to its organizational mission; and that the

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relief sought, denial of registration, results in an overall protection of the Trademark Register, and does not require the participation of the individual members.

Section 13 of the Trademark Act permits "[a]ny person who believes that he would be damaged by the registration of a mark" to file an opposition thereto. To establish standing, it must be shown that a plaintiff has a "real interest" in the outcome of a proceeding; that is, plaintiff must have a direct and personal stake in the outcome of the opposition. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999). It has been held that trade associations have standing to oppose registration of a mark. See *Institut Nat'l Des Appellations D'Origine v. Vinter Int'l Co.*, 958 F.2d 1574, 22 USPQ2d 1190 (Fed. Cir. 1992); *Jeweler's Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987), on remand, 5 USPQ2d 1622 (TTAB 1992), rev'd, 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988) (opposition was sustained on its merits); and *Tanners' Council of America, Inc. v. Gary Industries, Inc.*, 440 F.2d 1404, 169 USPQ 608 (CCPA 1971). Where registration is opposed on the ground of descriptiveness or genericness, an opposer "... need only assert an equal right to use the mark for the goods. Proprietary rights in opposer are not required." See *Jeweler's Vigilance Committee*, 2 USPQ2d at 2024.

Opposer has properly alleged its standing by virtue of its allegations that it believes it, its members and the public will be damaged by the registration of the term PILATES STUDIO.

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Moreover, opposer has established its standing as a matter of law. Opposer has shown that at least some of its members use the term PILATES STUDIO. One example is provided by Balanced Body, Inc. on its website to assist the consuming public in finding a geographically convenient Pilates studio. See opposer's Exhibit 10, paragraph 5 and accompanying exhibit. Another example is provided by Stotts Pilates, a subsidiary of Merrithew Corporation, on its flyer for STOTT PILATES STUDIOS offering workshops. See opposer's Exhibit 12, paragraph 3 and accompanying exhibit.

In view thereof, applicant's cross-motion for summary judgment on the basis that opposer lacks standing is denied.

Opposer's motion for summary judgment

As explained above, there is sufficient evidence to show that no genuine issue of material fact exists as to opposer's standing. Thus, opposer has established standing. We now consider whether any genuine issue of material fact exists as to opposer's claim that PILATES STUDIO is generic.

In support of its motion, opposer argues that the term PILATES STUDIO is generic, being widely used throughout the industry and recognized by the public as identifying instruction in the Pilates exercise system, providing facilities for exercise, and providing physical therapy. Opposer also contends, in emphasizing that PILATES STUDIO when viewed as a whole is generic, that applicant simply has combined the generic term

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PILATES, as determined by the court in *Current Concepts*, with the generic term STUDIO, as it is used in the industry.

Opposer's motion is accompanied by the declaration, with exhibits, of its attorney, Gordon E.R. Troy, who also identifies himself as a member of opposer's board of directors. Among the exhibits attached to the Troy declaration are examples of use of the term PILATES STUDIO by Pilates professionals not affiliated with or licensed by applicant. See Exhibits 28-64. Opposer also submitted the declarations, with exhibits, of three of its alliance members, who further identify themselves as equipment manufacturers, and who provide various statements, including information from their respective customer databases about the use as part of a name of the terms "pilates studio" or "pilates" and "studio." See Exhibits 10-12.

Opposer also submitted the following: (i) a copy of the October 1, 2003 Office action in applicant's presently pending related application Serial No. 78030281 for the mark THE NEW YORK PILATES STUDIO, on the Supplemental Register, and in which applicant offered to disclaim "both PILATES and STUDIO"; and where the Examining Attorney, among other things, required "...a disclaimer of the generic unitary wording PILATES STUDIO," supporting her requirement for the disclaimer with twenty excerpts of stories retrieved the NEXIS database (see Exhibit 6); (ii) three third-party registrations for instruction and exercise services where the term STUDIO is disclaimed (see Exhibits 7-9); (iii) a copy of the cover, title page, selected pages, and

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Appendix A from The Everything Pilates Book, by Amy Taylor Alpers and Rachel Taylor Segel, where Appendix A is a list of Pilates instructors by state, some of whom use the terms "studio" and "pilates studio" in their business names (see Exhibit 17); and (iv) additional examples of use by Pilates professionals of the term "studio" with respect to their instruction services and services of providing facilities for independent practice of the Pilates exercise method (see Exhibits 19-25).

In response, applicant argues that the Examining Attorney did not refuse registration of PILATES STUDIO as generic; and that applicant's proffered disclaimer of both "PILATES and STUDIO" in its pending application Serial No. 78030281 is not an admission "... that the words are descriptive."¹³ Applicant further argues that the mark must be considered as a whole, not in separate parts; that opposer's dictionary definition of "studio" does not indicate that the term refers to a location where one may receive exercise services; and that the term "studio" suggests "... a tie to the performing arts community..." and "... evokes a more female friendly atmosphere..." and, as such, is suggestive.

Applicant acknowledges that the court in *Current Concepts* found the term PILATES to be generic; and that applicant "... does not deny that the term studio is used within the Pilates community." Applicant argues that there is "... a proliferation of

¹³ Action on this application is presently suspended at Law Office 102, and the disclaimer issue remains pending.

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locations calling themselves Pilates Studio's (*sic*) since the *Georgetown* decision in 2001 and maybe even the *Current Concepts* decision in 2000" and further comments it may need to be more aggressive in addressing the problem. However, applicant argues that PILATES STUDIO is not generic because the term "... does not simply refer to a location, but to a brand of Pilates instruction and a place where someone can go to learn to teach that brand of Pilates instruction"; that opposer's three members who provided statements are equipment manufacturers in competition with applicant's official equipment manufacturer and "... could benefit by claiming they produce ... Pilates Studio quality equipment"; that there is no evidence anyone else has a superior interest in the mark; and that applicant's submissions demonstrate that PILATES STUDIO is associated with applicant as its mark.

Applicant's response is accompanied by the declaration of its attorney and general counsel, Andrew L. Spence, and by numerous exhibits including the following: (i) several news and magazine articles, some electronic, where applicant is identified as PILATES STUDIO and THE PILATES STUDIO, and which sometimes reference its website address, www.pilates-studio.com (see Exhibits C-Z); (ii) the cover page and table of contents for The Pilates Pregnancy by Mari Winsor and excerpts from The Pilates® Method by Sean P. Gallagher & Romana Kryzanowska, both of which refer to the Pilates Studio® (see Exhibits AA and AB); (iii) declarations or affidavits from one Pilates professional and ten of applicant's students stating, in relevant part, as follows:

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I consider the words Pilates Studio to refer to a place where one can receive training in the original style of Pilates instruction developed by Joseph Pilates and carried on by Romana Kryzanowska and later Pilates, Inc.
(Paragraph No. 3)

The Pilates Studio is where it all started and for others to use this term without having received the Pilates, Inc. training could lead consumers to believe that they are getting the original style of Pilates instruction, when in fact they are not. (Paragraph No. 4)

(see Exhibits AC, AE, AZ, BA-BC); and (iv) the declaration of applicant's owner, Sean Gallagher, concerning the history of Pilates development and marks as understood by him, his corporation's acquisition of the marks in 1992 and subsequent use of the marks, involvement in litigation over the marks, and attempts to take reasonable steps with respect to the marks.

In addition, applicant has submitted the following: (i) a copy of its 2000 calendar displaying The Pilates Studio®, and a copy of its 2002 calendar displaying The Pilates Studio™ (see Exhibits AF and AI); (ii) various news articles, newsletter articles, invoices, business records, an excerpt from the 2000-2001 Bell Atlantic Yellow Pages for Manhattan listing the phone number and address for applicant's Pilates Studio, and sample advertisements, which are dated between 1992 and 2001, referring to The Pilates Studio® and The NY Pilates Studio™, both owned by applicant (see Exhibits AG, AM-AU); (iii) more recent electronic articles referring to The Pilates Studio™ (see Exhibits AK-AL); and (iv) selected copies of the publication *The Pilates Guild News* for dates between April 1995 and Spring 1998, which include articles updating readers on the status of litigation in which

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applicant was involved at the time, and names of persons and companies with whom applicant had come to agreement over use of the marks PILATES and PILATES STUDIO (see Exhibits AV-AY).

Determining whether a mark is generic requires a two-step analysis. The first step is to identify the genus (category or class) of goods and/or services at issue. The second step is to determine whether the term sought to be registered is understood by the relevant public primarily to refer to that category of class of goods and/or services. See *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999) citing *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986).

In this case, we must determine if there is any genuine issue of material fact as to opposer's claim of genericness. The general categories of applicant's services are providing exercise instruction and providing facilities for exercise. The test for making a determination as to whether PILATES STUDIO is generic for the categories of identified services turns upon how the term is perceived by the relevant public; that is, the primary significance of the term to the relevant public. See *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991). The relevant public in this case consists of those providing and seeking exercise instruction in the Pilates method and those providing and seeking facilities to practice the Pilates method of exercise, and includes the general public.

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Opposer has submitted ample evidence demonstrating how PILATES STUDIO is perceived by the relevant public, including, generally, advertisements, signage, and declarations from some of its members. More specifically, opposer has made of record numerous examples of use of the term PILATES STUDIO for such services. Among those examples, opposer has submitted photos of signage, including: PILATES STUDIO OF FAIRFIELD (CT); MILL VALLEY HEALTH CLUB & SPA ... PILATES STUDIO (CA); FINETUNE PILATES STUDIO (NY); PILATES STUDIO LAKEWOOD ATHLETIC CLUB (CO); and MINDFUL BODY PILATES STUDIO (VT).¹⁴ Opposer has submitted copies of brochures from businesses, including: REFORMING NEW YORK PILATES STUDIO, offering instructional classes and massage therapy; SYNERGY SYSTEMS PILATES STUDIO, Encinitas, CA, offering classes; THE PILATES CENTER OF OLYMPIA, Olympia, WA, offering instruction and classes at a "fully-equipped Pilates studio..."; BODYTIME PILATES STUDIO, offering classes, instruction, open studio, and massage therapy; PILATES & BEYOND, Corte Madera, CA, offering "Pilates Studio Instruction," and "In the Personal Pilates Studio" instruction; MOTION IN MOVEMENT ... Pilates Studio, St. Petersburg, FL, offering instruction and independent workouts; and FREEDOM PILATES STUDIO, three locations in Wisconsin, offering classes and physical therapy.¹⁵ Opposer submitted a printout from Verizon's SuperPages.com consisting of

¹⁴ See opposer's Exhibit Nos. 44, 48, 55, 63, and 65, respectively. See also opposer's Exhibit No. 1 at corresponding paragraph nos. 44, 48, 55, 63, and 65 for geographical locations.

¹⁵ See opposer's Exhibit Nos. 31, 34, 37, 50, 59, and 62, respectively. Locations, where indicated, are in the referenced brochures.

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187 nationwide listings, including business name, address and phone number, for businesses including the terms PILATES STUDIO and PILATES and STUDIO in their name.¹⁶

Opposer has also provided the declarations of three of its members who manufacture Pilates equipment. Kenneth Endelman, owner of Balanced Body, Inc. (formerly Current Concepts) avers that he has been in the business since 1976; that there is a Pilates studio in virtually every state; and that Pilates professionals call their facilities "studios" and "Pilates studios."¹⁷ He further avers that his company's customer and potential customer database brought up 145 business names using PILATES STUDIO or containing PILATES and STUDIO in the names, six of which he acknowledges may be affiliated with applicant. He provides a representative listing of names retrieved, the first three being ARETE PILATES STUDIO (Washington), ASCENDING PHOENIX PILATES STUDIO (Arizona), and AWAKEN PILATES STUDIO (Minnesota); fifty-one to fifty-three being ONE ON ONE PILATES EXERCISE STUDIO (Texas), PACIFIC PILATES & YOGA STUDIO (California) and PERSONAL BEST PILATES STUDIO (Kansas); and the last three being YOGA TIME/PILATES STUDIO (California), YOUR PILATES & YOGA STUDIO (Maryland), and ZELOSA PILATES & MASSAGE STUDIO (Colorado).

¹⁶ Some examples include: SOUL STRETCH PILATES STUDIO, St. Petersburg, FL (at 76-90); IMX PILATES STUDIO, Indianapolis, IN (at 91-105); BACK & BODY PILATES STUDIO, Norwell, MA (at 106-120); SHERI PILATES STUDIO, Kingston, PA (at 151-165); and PILATES MOD BOD STUDIO, Orlando, FL (at 76-90).

¹⁷ See opposer's Exhibit 10.

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Julie Lobell, owner of Peak Body Systems, avers that her company has been in business nearly twenty years; that many Pilates professionals call their facilities "studios" and "Pilates studios"; that "studio" is a generic description of the facilities where the Pilates method of exercise is taught; and that "Pilates Studio" is a generic designation of the nature and type of instruction services that are taught in a particular facility.¹⁸ She also avers that her business's database of customers, potential customers and trainers retrieved ninety-nine names of Pilates professionals using PILATES STUDIO in their name, five of which she believes are affiliated with applicant; and that a representative listing includes: A PILATES STUDIO (California); A PILATES STUDIO (Wisconsin); ABVANTAGE PILATES STUDIO (Arizona); PILATES STUDIO ONE (Florida); PORTLAND PILATES STUDIO (Oregon); RANKIN STUDIO FOR PILATES (New Jersey); YOUR BALANCED BODY PILATES STUDIO (Washington); ZELOS PILATES STUDIO (Colorado); and ZOE'S PILATES STUDIO (California).

Lindsay G. Merrithew, owner of Merrithew Corporation, avers that her company has been in business for fifteen years; that many Pilates professionals refer to their facilities and services as "studios" and "Pilates studios"; that "studio" is a generic description of the facilities where the Pilates method of exercise is taught; and that "Pilates Studio" is a generic designation of the nature and type of instruction services that

¹⁸ See opposer's Exhibit 11.

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are taught in a particular facility.¹⁹ She also avers that her business's database of Pilates professionals, including customers and prospective customers, retrieved eighty-six businesses using the term PILATES STUDIO in their name, four of whom she believes are affiliated with applicant; and that a representative listing includes: ART OF FITNESS PILATES STUDIO (New York); BELLA FORMA PILATES STUDIO (California); BENEFITNESS PILATES STUDIO (Rhode Island); FREEDOM PILATES STUDIO (Wisconsin); VITALITY PILATES STUDIO (Washington); and ZOOM FITNESS AND PILATES STUDIO (California).

Opposer has submitted a copy of the October 1, 2003 Office action with respect to applicant's related pending application Serial No. 78030281, for the mark THE NEW YORK PILATES STUDIO, with accompanying NEXIS articles, some of which are excerpted as follows: "...who plans to open Yo Play, a new yoga and pilates studio..." from *The Post and Courier* (Charleston, SC); and "Relish also carries all the class schedules for yoga and Pilates studios in Albuquerque," from the *Albuquerque Journal* (NM).

Applicant, on the other hand, relies heavily on materials existing before its registered trademark for PILATES STUDIO for "providing facilities for exercise and physical conditioning" was ordered cancelled by the court in *Georgetown Bodyworks* in its decision dated August 7, 2001. That is, much of the material submitted by applicant in its response to opposer's motion for summary judgment is dated from the period of time that

¹⁹ See opposer's Exhibit 12.

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Registration No. 1602929 subsisted.²⁰ It is clear that applicant has expended significant effort and resources in attempting to enforce its marks. In addition to the present opposition, and the *Current Concepts* and *Georgetown Bodyworks* cases referenced throughout this decision, applicant was involved in at least one other court case, *Pilates, Inc. v. Pilates Institute, Inc., dba Institute for the Pilates Method, and Joan Breibart*, 891 F.Supp. 175 (SDNY 1995) (on July 10, 1995 defendant's motion to dismiss was denied; and the parties were directed to submit a pretrial scheduling order). Applicant's owner, referring to the PILATES and PILATES STUDIO marks he purchased in 1992, prior to forming his corporation, submitted a declaration, stating that he has spent millions of dollars in defense of the mark(s). See applicant's Exhibit AD at paragraph 9. Applicant's submissions consisting of certain editions of The Pilates Guild News (apparently published by applicant) also report on applicant's efforts with respect to the litigation referenced above and in coming to settlement with individuals and businesses. See applicant's Exhibits AV-AY; for example, Exhibit AY at p. 8 has a list of "Organizations/Individuals who have agreed to stop using the Pilates® Trademarks").

²⁰ See, for example, applicant's Exhibit C, *Self's Picks: 8 Bare-all Essentials, Self*, May 2000 ("The Pilates Studio® is loaded with all things Pilates."); Exhibit G, Wagner, Marsha, *Pilates - a world famous conditioning method now at BIG Arts, Islander*, December 29, 2000-January 4, 2001 ("The Pilates Studio opened in Fort Myers in the fall of 1999..."); Exhibit P, *Sitting, In Style*, Summer 2000 ("...of New York City's Pilates Studio."); and Exhibit T, Murray-Wilson, *Exercise Secrets of the Stars: The Pilates Method is Attracting People with Disabilities, We Magazine*, July August 2000).

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Nonetheless, "[a] generic term ... can never be registered as a trademark because such a term is "merely descriptive" within the meaning of § 2(e)(1) and is incapable of acquiring de jure distinctiveness under § 2(f)." See *H. Marvin Ginn Corp., supra*, 782 F.2d 987, 228 USPQ 528, 530. That is, "[o]nce determined to be generic, no amount of purported evidence of secondary meaning can serve to give legal protection to a generic term." See 2 McCarthy on Trademarks and Unfair Competition §12:46 (4th ed. March 2004). "Mere usage, advertising and repetition alone cannot give trademark significance to a generic term." *Id.*

Thus, notwithstanding applicant's claim of acquired distinctiveness based on its now cancelled Registration No. 1602929, applicant's evidence of its long-standing use of the term PILATES STUDIO, eleven declarations of customers,²¹ and other evidence, if PILATES STUDIO is a generic term, it is not a trademark, and cannot be registered.

After careful consideration of the arguments and evidentiary submissions presented by each party,²² we find that opposer has met its burden of establishing that no genuine issue of material fact exists that the term PILATES STUDIO is generic for the specified education and training services, as well as for providing facilities for exercise, physical fitness conditioning

²¹ It is acknowledged that declarations are self-serving in nature. See TBMP Section 528.05(b) (2nd ed. Rev. 1 March 2004). Being cognizant of this, the Board comments in passing that it gave the declarations submitted by both parties an appropriate probative weight in view of the complete evidentiary record.

²² While each and every submission has not been discussed, we have carefully considered the record presented.

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and physical rehabilitation and therapy. Opposer's evidence demonstrates that there are no genuine issues of material fact, and that the relevant public perceives PILATES STUDIO as referring to services providing Pilates exercise instruction and providing facilities for exercise.

In coming to this conclusion, we have considered applicant's evidence of acquired distinctiveness and found it unpersuasive. Applicant's claim of acquired distinctiveness is based on its now cancelled Registration No. 1602929, which was registered under its own claim of acquired distinctiveness with a disclaimer of the term STUDIO. Inasmuch as generic terms, and other unregistrable matter, that are not part of a unitary term, are disclaimed to permit registration on the Principal Register (including registration under Section 2(f) of the Trademark Act), applicant cannot rely on its now cancelled registration for PILATES STUDIO, wherein STUDIO was disclaimed, as a basis for acquired distinctiveness. See TMEP Sections 1212.02(e) and 1213.03(b) (3rd ed. Rev. 2 June 2002).

Inasmuch as there is no genuine issue of material fact that PILATES STUDIO is generic for applicant's identified services, opposer's motion for summary judgment in its favor on its claim that PILATES STUDIO is generic is granted.

The opposition is hereby sustained on the ground that the mark is generic and registration to applicant is refused.²³

²³ In light of our decision granting opposer's motion for summary judgment on its claim that PILATES STUDIO is generic and, thus, not registrable, we decline to consider opposer's remaining claims.