

To: Robert S McArthur(mcarthur@vbllaw.com)
Subject: U.S. Trademark Application Serial No. 97120839 - THE BREAKAWAY
Sent: August 23, 2022 12:02:58 PM EDT
Sent As: tmng.notices@uspto.gov

Attachments

[4935378](#)

**United States Patent and Trademark Office (USPTO)
Office Action (Official Letter) About Applicant's Trademark Application**

U.S. Application Serial No. 97120839

Mark: THE BREAKAWAY

Correspondence Address:

ROBERT S MCARTHUR
VASQUEZ BENISEK & LINDGREN LLP
1550 PARKSIDE DRIVE, SUITE 130
1550 PARKSIDE DRIVE, SUITE 130
WALNUT CREEK CA 94596 UNITED STATES

Applicant: Breakaway Industries, Ltd.

Reference/Docket No. N/A

Correspondence Email Address: mcarthur@vbllaw.com

NONFINAL OFFICE ACTION

The USPTO must receive applicant's response to this letter within six months of the issue date below or the application will be [abandoned](#). Respond using the Trademark Electronic Application System (TEAS). A link to the appropriate TEAS response form appears at the end of this Office action.

Issue date: August 23, 2022

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SUMMARY OF ISSUES:

- Section 2(d) Refusal-Likelihood of Confusion
- Entity Uncertain

SECTION 2(d) REFUSAL-LIKELIHOOD OF CONFUSION

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 4935378. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the attached registration.

Applicant's mark is THE BREAKAWAY for Downloadable software in the nature of a mobile application for designing, providing, planning, tracking and managing athletic and fitness workouts, training and coaching plans; Downloadable software in the nature of a mobile application providing exercise demonstration and information

Registrant's mark is BREAKAWAY for Downloadable mobile applications for setting goals, identifying behaviors, providing coaching, tools and information which assist users in identifying, achieving and adhering to their personal and professional goals; Downloadable mobile applications for setting goals, identifying behaviors, providing coaching, tools and information which assist users in identifying, achieving and adhering to their personal and professional goals in the fields of self-improvement, personal growth, personal development, wellness and well-being, happiness, improving relationships, improving personal finances, personal health, diet planning and weight loss, physical fitness and exercise, quitting smoking, quitting drinking alcohol, anger management, stress management, improving sleep, career growth, communication skills, personal effectiveness, time management, and productivity; Downloadable mobile applications for identifying, monitoring, tracking and measuring users' behaviors, cognitions and emotions, for monitoring, assisting and influencing an individual's decision-making process, delivery of content, information and advice to change and form healthy habits and lifestyle choices, for communicating with other individuals and/or social networking with respect to content and the decision-making process, for utilizing calculation tools for setting goals, monitoring progress, and tracking completion, and for displaying daily and historic data to users for motivational and logging purposes

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties. *See* 15 U.S.C. §1052(d). Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the “*du Pont* factors”). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Any evidence of record related to those factors need be considered; however, “not all of the *DuPont* factors are relevant or of similar weight in every case.” *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services. *See In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) (“The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”); TMEP §1207.01.

Similarity of the Marks

In a likelihood of confusion determination, the marks in their entireties are compared for similarities in appearance, sound, connotation, and commercial impression. *In re i.am.symbolic, llc*, 866 F.3d 1315, 1323, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017); *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b)-(b)(v).

In the present case, applicant’s mark is THE BREAKAWAY and registrant’s mark is BREAKAWAY. These marks are virtually identical in appearance, sound, and meaning, “and have the potential to be used . . . in exactly the same manner.” *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015), *aff’d*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017). The only difference being the additional wording “THE” in applicant’s mark. When comparing similar marks, the Trademark Trial and Appeal Board has found that inclusion of the term “the” at the beginning of one of the marks will generally not affect or otherwise diminish the overall similarity between the marks. *See In re Thor Tech Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009) (finding WAVE and THE WAVE “virtually identical” marks; “[t]he addition of the word ‘The’ at the beginning of the registered mark does not have any trademark significance.”); *In re Narwood Prods. Inc.*, 223 USPQ 1034, 1034 (TTAB 1984) (finding THE MUSIC MAKERS and MUSIC-MAKERS “virtually identical” marks; the inclusion of the definite article “the” is “insignificant in determining likelihood of confusion”). Additionally, because they are virtually identical, these marks are likely to engender the same connotation and overall commercial impression when considered in connection with applicant’s and registrant’s respective goods. *Id.*

Therefore, the marks are confusingly similar.

Similarity of the Goods

The applicant’s and registrant’s goods are provided above. The compared goods need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000); TMEP §1207.01(a)(i). They need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the

mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

Determining likelihood of confusion is based on the description of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)).

In this case, the registration use(s) broad wording to describe broad goods, which presumably encompasses all goods of the type described, including applicant’s more narrow goods. *See, e.g., In re Solid State Design Inc.*, 125 USPQ2d 1409, 1412-15 (TTAB 2018); *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015). Thus, applicant’s and registrant’s goods are legally identical. *See, e.g., In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1629 (TTAB 2018) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 1336, 209 USPQ 986, 988 (C.C.P.A. 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *Baseball Am. Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1847 n.9 (TTAB 2004)).

Additionally, the goods of the parties have no restrictions as to nature, type, channels of trade, or classes of purchasers and are “presumed to travel in the same channels of trade to the same class of purchasers.” *In re Viterro Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)).

Accordingly, registrant's Downloadable mobile applications for setting goals, identifying behaviors, providing coaching, tools and information which assist users in identifying, achieving and adhering to their personal and professional goals; Downloadable mobile applications for setting goals, identifying behaviors, providing coaching, tools and information which assist users in identifying, achieving and adhering to their personal and professional goals in the fields of self-improvement, personal growth, personal development, wellness and well-being, happiness, improving relationships, improving personal finances, personal health, diet planning and weight loss, physical fitness and exercise, quitting smoking, quitting drinking alcohol, anger management, stress management, improving sleep, career growth, communication skills, personal effectiveness, time management, and productivity; Downloadable mobile applications for identifying, monitoring, tracking and measuring users' behaviors, cognitions and emotions, for monitoring, assisting and influencing an individual's decision-making process, delivery of content, information and advice to change and form healthy habits and lifestyle choices, for communicating with other individuals and/or social networking with respect to content and the decision-making process, for utilizing calculation tools for setting goals, monitoring progress, and tracking completion, and for displaying daily and historic data to users for motivational and logging purposes

could encompass applicant's Downloadable software in the nature of a mobile application for designing, providing, planning, tracking and managing athletic and fitness workouts, training and coaching plans; Downloadable software in the nature of a mobile application providing exercise demonstration and information. Thus, applicant’s and registrant’s goods are related.

In total, the marks are virtually identical, and the goods are related. Therefore, consumers are likely be confused and mistakenly believe that the goods come from common source. Accordingly, registration

is refused under Section 2(d) of the Trademark Act.

Although applicant's mark has been refused registration, applicant may respond to the refusal by submitting evidence and arguments in support of registration.

If applicant responds to the refusal, applicant must also respond to the requirement set forth below.

ENTITY UNCERTAIN

The designation "LTD" is included in applicant's name; however, the legal entity is set forth as a "corporation." Generally, "LTD" identifies a "limited liability company, or limited company" and not a corporation. Therefore, applicant must specify whether the legal entity is a limited liability company or limited company, or a corporation and amend the application accordingly. TMEP §803.03(h); *see* 37 C.F.R. §§2.32(a)(2), (a)(3)(ii), 2.61(b).

If applicant is a limited liability company or limited company, applicant must amend the legal entity and provide the U.S. state under whose laws it is organized. 37 C.F.R. §2.32(a)(3)(ii); TMEP §803.03(h). If applicant is a corporation, applicant must provide the legal name of the corporation and U.S. state or foreign country of incorporation or organization. *See* 37 C.F.R. §2.32(a)(3)(ii); TMEP §803.03(c).

If, in response to the above request, applicant provides information indicating that it is not the owner of the mark, registration will be refused because the application was void as filed. *See* 37 C.F.R. §2.71(d); TMEP §§803.06, 1201.02(b). An application must be filed by the party who owns or is entitled to use the mark as of the application filing date. *See* 37 C.F.R. §2.71(d); TMEP §1201.02(b).

Please call or email the assigned trademark examining attorney with questions about this Office action. Although an examining attorney cannot provide legal advice, the examining attorney can provide additional explanation about the refusal(s) and/or requirement(s) in this Office action. *See* TMEP §§705.02, 709.06.

The USPTO does not accept emails as responses to Office actions; however, emails can be used for informal communications and are included in the application record. *See* 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05.

How to respond. [Click to file a response to this nonfinal Office action.](#)

/Shavell McPherson-Rayburn/
Shavell McPherson-Rayburn
(571) 272-6121
shavell.mcperson-rayburn@uspto.gov

RESPONSE GUIDANCE

- **Missing the response deadline to this letter will cause the application to [abandon](#).** The response must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. TEAS maintenance or [unforeseen circumstances](#) could affect an applicant's ability to timely respond.
- **[Responses signed by an unauthorized party](#)** are not accepted and can **cause the application to [abandon](#)**. If applicant does not have an attorney, the response must be signed by the individual applicant, all joint applicants, or someone with [legal authority to bind a juristic applicant](#). If applicant has an attorney, the response must be signed by the attorney.
- If needed, **find [contact information for the supervisor](#)** of the office or unit listed in the signature block.

(4) STANDARD CHARACTER MARK

BREAKAWAY

Mark Punctuated
BREAKAWAY

Translation

Goods/Services

- IC 009. US 021 023 026 036 038.G & S: Downloadable mobile applications for setting goals, identifying behaviors, providing coaching, tools and information which assist users in identifying, achieving and adhering to their personal and professional goals; Downloadable mobile applications for setting goals, identifying behaviors, providing coaching, tools and information which assist users in identifying, achieving and adhering to their personal and professional goals in the fields of self-improvement, personal growth, personal development, wellness and well-being, happiness, improving relationships, improving personal finances, personal health, diet planning and weight loss, physical fitness and exercise, quitting smoking, quitting drinking alcohol, anger management, stress management, improving sleep, career growth, communication skills, personal effectiveness, time management, and productivity; Downloadable mobile applications for identifying, monitoring, tracking and measuring users' behaviors, cognitions and emotions, for monitoring, assisting and influencing an individual's decision-making process, delivery of content, information and advice to change and form healthy habits and lifestyle choices, for communicating with other individuals and/or social networking with respect to content and the decision-making process, for utilizing calculation tools for setting goals, monitoring progress, and tracking completion, and for displaying daily and historic data to users for motivational and logging purposes. FIRST USE: 20150102. FIRST USE IN COMMERCE: 20150102

Mark Drawing Code
(4) STANDARD CHARACTER MARK

Design Code

Serial Number
86660855

Filing Date
20150612

Current Filing Basis
1A

Original Filing Basis
1A

Publication for Opposition Date
20160126

Registration Number
4935378

Date Registered

20160412

Owner

(REGISTRANT) Breakaway Labs Inc. CORPORATION DELAWARE 1507 Carob Ln Los Altos
CALIFORNIA 94024

Priority Date

Disclaimer Statement

Description of Mark

Type of Mark

TRADEMARK

Register

PRINCIPAL

Live Dead Indicator

LIVE

Attorney of Record

XAVIER MORALES

United States Patent and Trademark Office (USPTO)

USPTO OFFICIAL NOTICE

Office Action (Official Letter) has issued
on August 23, 2022 for
U.S. Trademark Application Serial No. 97120839

A USPTO examining attorney has reviewed your trademark application and issued an Office action. You must respond to this Office action in order to avoid your application abandoning. Follow the steps below.

- (1) **[Read the Office action](#)**. This email is NOT the Office action.
- (2) **Respond to the Office action by the deadline** using the Trademark Electronic Application System (TEAS). Your response must be received by the USPTO on or before 11:59 p.m. **Eastern Time** of the last day of the response period. Otherwise, your application will be **[abandoned](#)**. See the Office action itself regarding how to respond.
- (3) **Direct general questions** about using USPTO electronic forms, the USPTO **[website](#)**, the application process, the status of your application, and whether there are outstanding deadlines to the **[Trademark Assistance Center \(TAC\)](#)**.

After reading the Office action, address any question(s) regarding the specific content to the USPTO examining attorney identified in the Office action.

GENERAL GUIDANCE

- **[Check the status](#) of your application periodically** in the **[Trademark Status & Document Retrieval \(TSDR\)](#)** database to avoid missing critical deadlines.
- **[Update your correspondence email address](#)** to ensure you receive important USPTO notices about your application.
- **[Beware of trademark-related scams](#)**. Protect yourself from people and companies that may try to take financial advantage of you. Private companies may call you and pretend to be the USPTO or may send you communications that resemble official USPTO documents to trick you. We will never request your credit card number or social security number over the phone. And all official USPTO correspondence will only be emailed from the domain “@uspto.gov.” Verify the correspondence originated from us by using your Serial Number in our database, **[TSDR](#)**, to confirm that it appears under the “Documents” tab, or contact the **[Trademark Assistance Center](#)**.

- **Hiring a U.S.-licensed attorney.** If you do not have an attorney and are not required to have one under the trademark rules, we encourage you to hire a U.S.-licensed attorney specializing in trademark law to help guide you through the registration process. The USPTO examining attorney is not your attorney and cannot give you legal advice, but rather works for and represents the USPTO in trademark matters.

User: Shavell McPherson-Rayburn

Statistics for Case 97120839						
#	Search	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/Search Duration
1	97120839[sn]	1	0	1	1	0:00
2	97120839[sn]	1	0	1	1	0:00
3	*breakaway*[bi,ti] not dead[ld]	73	0	73	73	0:01
4	*break*[bi,ti] not dead[ld]	3375	0	0	0	0:01
5	*away*[bi,ti] not dead[ld]	2489	0	0	0	0:01
6	4 and 5	88	0	88	88	0:00
7	*bre{"ea"}{"ckq"}aw{v}y*[bi,ti] not dead[ld]	73	0	73	73	0:00

Session started 08/23/2022 10:31 am

Session ended 08/23/2022 10:42 am

Total search duration 3.00

Session duration 10 minutes 43 seconds

Adjacency Level 1

Near Level 1