

UNITED STATES DISTRICT COURT
MIDDLE DISTRICT OF FLORIDA
FT. MYERS DIVISION

Vive Health LLC,

Civ. No. 2:19-513-FtM-JLB-NPM

Plaintiff,

v.

MEMORANDUM AND ORDER

Andrew Hirschfeld,¹

Defendant.

This matter is before the Court on the parties' cross-Motions for Summary Judgment. For the following reasons, Defendant's Motion is granted and Plaintiff's Motion is denied.

BACKGROUND

In April 2016, Plaintiff Vive Health LLC filed an application for a trademark for "Vive Health." (Admin. R. (Docket No. 20-1) at A1.) The application, which claimed no "particular font, size, style, or color" for the mark, listed the mark's identification as "[o]n-line retail store services featuring a variety of medical equipment, medical supplies and home health products." (Id. at A1-A2.)

The United States Patent and Trademark Office ("USPTO") denied the application under 15 U.S.C. § 1052(d), finding that the applied-for mark was likely to be confused with

¹ Andrew Hirschfeld is now performing the functions and duties of the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office. This official is automatically substituted as Defendant for former Defendant Andrei Iancu pursuant to Federal Rule of Civil Procedure 25(d).

another registered mark, VIVOHEALTH!. (Id. at A14.) The examining attorney noted that the marks both begin with “similar first words, followed by the term ‘Health’” and that “the slight difference in the sound of the wording ‘Vivo’ and ‘Vive’ will not avoid a likelihood of confusion.” (Id.) Further, the examiner found that the services identified by the two marks were related, as the registered mark’s services “are retail and online retail store services featuring health and wellness products, including medical goods.” (Id. at A15.) Plaintiff did not respond to this denial in the six-month response period, and the USPTO deemed Plaintiff’s application abandoned. (Id. at A45.)

Two months later, Plaintiff sought to revive its application, arguing that the examining attorney erred in refusing to register the mark. (Id. at A53-A57.) USPTO revived the application but on June 30, 2017, denied the application because of the likelihood of confusion with the registered mark VIVOHEALTH!. (Id. at A67-A70.) Plaintiff appealed the denial to the Trademark Trial and Appeal Board (“TTAB”), arguing that “Vive” in its sought-after mark is pronounced like “five,” where as “Vivo” in the registered mark is pronounced as “vee-voh.” Plaintiff did not, however, submit any evidence to the TTAB aside from a link to a YouTube video. (See id. at A124.)

While Plaintiff’s appeal was pending, the registrant for the VIVOHEALTH! mark updated the mark’s registration by deleting the reference to online sales, leaving only retail (i.e., brick-and-mortar) services. (See id. at A178.) The record does not reflect whether Plaintiff informed the TTAB of the updated registration for VIVOHEALTH!. After a hearing, the TTAB denied Plaintiff’s appeal, agreeing with the examining attorney that there was a likelihood of confusion between Plaintiff’s mark and the registered mark. (Id.

at A182-A190.) This lawsuit followed, raising a single claim for review of the TTAB decision under 15 U.S.C. § 1071(b). (Compl. (Docket No. 1) ¶¶ 16-18.)

DISCUSSION

A. Standard of Review

15 U.S.C. § 1071 allows a dissatisfied putative trademark registrant to appeal a decision of the TTAB to either the Federal Circuit Court of Appeals or to file a civil action in another federal court, as Plaintiff did here. “The court may adjudge that an applicant is entitled to a registration upon the application involved, that a registration involved should be canceled, or such other matter as the issues in the proceeding require, as the facts in the case may appear.” 15 U.S.C. § 1071(b)(1). Because there is no adverse party, as there would be if, for example, Plaintiff sought to cancel the registered mark in favor of its mark, the Director of the USPTO is the Defendant.

The Court’s review of the matter is more akin to a bench trial than to cross-motions for summary judgment. See Fla. Int’l Univ. Bd. of Trustees v. Fla. Nat’l Univ., Inc., 830 F.3d 1242, 1252-54 (11th Cir. 2016) (“FIU”) (discussing trademark infringement action resolved on a stipulated record with oral argument). Though the parties have stipulated to the factual record, the Court must resolve disputes and determine the weight to be afforded the parties’ evidence. Id. at 1254. In the usual case the party claiming infringement bears the burden to show “a likelihood of confusion on the part of customers as to the source, affiliation or sponsorship of the parties’ products.” Invisasox, LLC v. Everything Legwear, LLC, No. 8:18cv2639, 2020 WL 3128864, at *2 (M.D. Fla. June 12, 2020). Here, because there is no adverse party, Plaintiff bears the burden to show that confusion between the

mark it seeks to register and the registered mark is not likely. See, e.g., In re Shell Oil Co., 992 F.2d 1204, 1209 (Fed. Cir. 1993) (noting that doubts about likelihood of confusion are resolved against the unregistered mark). Similarly, in an adversarial infringement action, the likelihood of confusion is a question of fact. Custom Mfg. & Eng'g, Inc. v. Midway Servs., Inc., 508 F.3d 641, 649 (11th Cir. 2007). But here, because the Court is the factfinder in motions under § 1701, “[l]ikelihood of confusion is a question of law based on underlying findings of fact.” In re I.AM.Symbolic, LLC, 866 F.3d 1315, 1322 (Fed. Cir. 2017).

Moreover, in a civil action under § 1071, the Court is not confined to the administrative record of the proceedings before the USPTO. See generally Kappos v. Hyatt, 566 U.S. 431 (2012). Rather, a plaintiff may submit new evidence not submitted to the USPTO or the TTAB, and the court’s review of the underlying decision is de novo. The reviewing court has discretion to afford any new evidence such weight as it deserves, “consider[ing] the proceedings before and findings of the [USPTO].” Id. at 445.

As noted, Plaintiff presented little evidence to the USPTO. Before this Court, however, Plaintiff has hired expert witnesses and submitted voluminous materials to support its claim. As Kappos instructs, the Court will review the TTAB’s decision de novo considering the evidence Plaintiff has submitted, while determining whether that new evidence deserves the great weight Plaintiff assigns to it in light of Plaintiff’s failure to submit it to the USPTO in the first instance.

B. Likelihood of Confusion

“[L]ikelihood of confusion can be found ‘if the respective products [or services] are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.’”

Coach Servs., Inc. v. Triumph Learning LLC, 668 F.3d 1356, 1369 (Fed. Cir. 2012)

(quoting 7-Eleven Inc. v. Wechsler, 82 U.S.P.Q.2d 1715, 1724 (T.T.A.B. 2007)). The

Court considers

seven factors in assessing whether or not a likelihood of consumer confusion exists: (1) the strength of the allegedly infringed mark; (2) the similarity of the infringed and infringing marks; (3) the similarity of the goods and services the marks represent; (4) the similarity of the parties’ trade channels and customers; (5) the similarity of advertising media used by the parties; (6) the intent of the alleged infringer to misappropriate the proprietor’s good will; and (7) the existence and extent of actual confusion in the consuming public.

FIU, 830 F.3d at 1255. “[These] factors are merely a guide to help inform the court’s decision on the ultimate issue: whether it is likely (that is, probable, not merely possible) that an ‘appreciable number of ordinarily prudent purchasers are likely to be misled, or indeed simply confused, as to the source of the goods in question.’” Invisasox, 2020 WL 3128864, at *3 (quoting Custom Mfg., 508 F.3d at 650-51).

1. Strength of Mark

The registered mark is considered incontestable, because it “has been in continuous use for five consecutive years subsequent to the date of such registration and is still in use in commerce.” 15 U.S.C. § 1065. An incontestable mark is generally entitled to “strong protection.” Caliber Auto. Liquidators, Inc. v. Premier Chrysler, Jeep, Dodge, LLC, 605

F.3d 931, 939 (11th Cir. 2010); see also Frehling Enters., Inc. v. Int’l Select Grp., Inc., 192 F.3d 1330, 1336 (11th Cir. 1999) (noting that an incontestable mark “constitutes a relatively strong mark”) (quotation omitted). But an incontestable mark may not be worthy of protection if it is otherwise weak or if another mark is not likely to cause confusion with it. See Homes & Land Affiliates, LLC v. Homes & Loans Magazine, LLC, 598 F. Supp. 2d 1248, 1259 (M.D. Fla. 2009) (noting that incontestability of mark is only one factor to consider in determining a mark’s strength).

Plaintiff first argues that the registered mark is not a conceptually strong mark. The classification of a mark determines whether it is conceptually strong or weak. There are four categories of marks:

(1) generic, a term that refers to the nature of a product (e.g. APPLE for apples); (2) descriptive, a term that describes a characteristic or quality about the product (e.g. APPLE for apple-flavored drinks); (3) suggestive, a term that suggests some characteristic about a product, but requires the consumer to use his or her imagination to determine the nature of the product (e.g. APPLE for red dye); and (4) arbitrary, a term that bears no relationship to the product (e.g. APPLE for computers).

White v. Toscano, Inc., No. 8:04cv2438, 2005 WL 8160219, at *3 (M.D. Fla. Oct. 11, 2005). Generic marks are conceptually weak and do not receive trademark protection. Similarly, descriptive marks do not usually merit trademark protection unless the mark “has acquired secondary meaning.” Id.

The registered mark is a suggestive one. The term “vivo” is not descriptive, although the term “health” is. Thus, a consumer must use their imagination to discern the nature of the business at issue. As a suggestive mark, VIVOHEALTH! is thus a relatively

strong mark, “meriting a higher level of protection than if it were categorized as generic or descriptive.” Aronowitz v. Health-Chem Corp., 513 F.3d 1229, 1240 (11th Cir. 2008).

Plaintiff next argues that the strength of the registered mark is diluted by third-party use, pointing to 17 other registrations that use the term “Vivo” as part of the registered mark. (Pl.’s Supp. Mem. (Docket No. 28) at 10-11.) “The relative strength of a trademark is like a sliding scale determined by the degree of third party use. The more extensive use of a phrase by third parties, the weaker the mark.” White, 2005 WL 8160219, at *4.

As Defendant points out, the fact that fewer than 20 other products or services also use the term “VIVO” does not translate into widespread third-party use that diminishes the mark’s strength. Cf. Sterling Acceptance Corp. v. Tommark, Inc., 227 F. Supp. 2d 454, 462 (D. Md. 2002) (finding that mark lacked commercial strength because more than 350 registrations included the term “Sterling”); White, 2005 WL 8160219, at *4 (noting that nearly 200 companies had trademarked the same or similar-sounding name as the plaintiff’s mark); but see Homes & Land, 598 F. Supp. 2d at 1261 (in case challenging a magazine’s use of a similar mark, 18 uses of a similar mark in other publications, coupled with “numerous websites” using similar words, constituted “widespread third-party use” and weighed against the mark’s strength).

The registered mark is incontestable and as a suggestive mark, is relatively strong. Third-party use of similar marks has not diluted the registered mark’s presumed strength, and the Court therefore finds that the registered mark is a strong mark.

2. Similarity of Marks

“In evaluating the similarity of marks, [the court] must consider the overall impression created by the marks, including a comparison of the appearance, sound and meaning of the marks, as well as the manner in which they are displayed.” Wreal, LLC v. Amazon.com, Inc., No. 14cv1385, 2015 WL 12550912, at *4 (S.D. Fla. Aug. 31, 2015). To support its argument that its proposed mark is not similar to the registered mark, Plaintiff proffers the testimony of a linguistic expert, Dr. Ronald R. Butters. (Docket No. 29-3.) Dr. Butters opines that most American English speakers would pronounce “vive” as “five” and not with a long “e” sound, and that most would also pronounce “vive” as a one-syllable word. He further opines that those same speakers would pronounce the “i” in “vivo” with a long “e” sound, and would pronounce it with two syllables. And Plaintiff emphasizes that Dr. Butters believes that the word “vive” connotes “hooray” while “vivo” connotes “life.”

“The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” Coach Servs., 668 F.3d at 1368 (internal quotation omitted). Indeed, “the ‘linguistic similarities’ [or differences] between the parties’ respective marks is not dispositive because the Court must view the commercial impression created by the marks as a whole.” Phelan Holdings, Inc. v. Rare Hosp. Mgmt., Inc., No. 8:15cv2294, 2017 WL 1135266, at *5 (M.D. Fla. Mar. 27, 2017).

Moreover, the test is not whether most consumers would be confused by the marks' similarity, but whether "an appreciable number" of consumers would be confused. John H. Harland Co. v. Clarke Checks, Inc., 711 F.2d 966, 979 n.22 (11th Cir. 1983). Defendant's expert witness, Dr. Edward H. Blair, performed a survey of consumers and found that 41 percent of respondents did not pronounce "Vive" with the same "i" sound as "five." (Docket No. 33-2 at 8.) Plaintiff notes that nearly 57 percent did pronounce "Vive" the same as "five," but cannot dispute that 41 percent of consumers constitutes an appreciable number. And 23 percent of the survey participants pronounced "Vive" as a two-syllable word, which is presumably how every English speaker would pronounce "VIVO." Again, 23 percent is an appreciable number.

Plaintiff also points to the difference in Vive Health, which is two words with initial capitals, and VIVOHEALTH!, which is all capital letters and one word. But the registrations for each mark are not limited by font or type, and thus the minimal effect of the use of capital and lower-case letters is not relevant to the Court's analysis. See SquirtCo v. Tomy Corp., 697 F.2d 1038, 1041 (Fed. Cir. 1983) (noting that an "argument concerning a difference in type style is not viable" where the registrations are not limited to a certain type style).

Considering the overall impression of the marks at issue, Plaintiff's mark is sufficiently similar to the registered mark as to likely cause consumers to be confused as to whether the two marks are connected. This factor weighs in favor of the USPTO's refusal to register Plaintiff's mark.

3. Similarity of Products, Trade Channels, and Consumers

The VIVOHEALTH! mark’s registration, as amended in the renewal registration, covers services such as “retail pharmacy services; retail stores featuring health and wellness products, namely, prescription drugs and over the counter medications, consumer medical products [and] spa products” (Admin. R. at A183.) The original mark also encompassed “online retail stores,” but this term was stricken in the renewal registration. (Kennedy Decl. (Docket No. 28-2) Ex. 2.) Plaintiff’s proposed “Vive Health” mark purported to cover “On-line retail store services featuring a variety of medical equipment, medical supplies and home health products.” (Admin. R. at A2.) The TTAB “presume[d] that [Plaintiff’s] services and those in the cited registration are legally identical.” (Admin. R. at A185.) The TTAB found that Plaintiff’s identification of online retail services featuring “medical equipment, medical supplies and home health products” encompassed “all such services featuring any type of medical equipment, supplies or home health products.” (*Id.*) The TTAB also noted that Plaintiff did not present any evidence or argument regarding this factor and determined that this factor weighed “heavily in favor of a likelihood of confusion.” (*Id.* at A186.)

“The greater the similarity between the products and services the greater the likelihood of confusion.” Ross Bicycles, Inc. v. Cycles USA, Inc., 765 F.2d 1502, 1507 (11th Cir. 1985). Plaintiff does not specifically argue that the products and services between the two marks are different, rather arguing that the channels of trade are different and that this difference means that the products and services of the two marks are not

similar. But Plaintiff acknowledges that this argument depends on the registered mark's renewal registration's deletion of "online retail stores" from its description of services.

The renewal registration is not as dispositive on this issue as Plaintiff contends. Although it may be true that the owner of the VIVOHEALTH! mark does not offer an online retail service, it may also be true that the renewal mark simply deleted "online retail store" from the registration because that term is redundant.

[T]he term "retail store services" is not limited to sales through brick and mortar stores; rather it includes any business that brings together merchandise in a single location for sale to the ultimate consumer. Accordingly, the term "retail stores services" in a description of services encompasses sales through brick and mortar facilities, as well as through online sales (e.g., an online retail store).

P.C. Richard & Son Long Island Corp. v. Jon Bargains, Inc., No. 91223383, 2019 WL 3380749, at *5 (T.T.A.B. July 25, 2019), aff'd, 825 F. App'x 921 (Fed. Cir. 2020). Plaintiff criticizes Defendant's citation of cases in which the registrant "did not intentionally delete online retail stores, as the registrant did in filing its statement of use" in this case. (Pl.'s Opp'n Mem. (Docket No. 34) at 18.) But neither does Plaintiff provide any authority that the deletion of a broad term such as "online retail stores" constitutes evidence that the registrant was abandoning its mark in that arena. Indeed, while Plaintiff insists that the registrant's deletion of "online" from its renewal registration must mean that the mark does not encompass online services, Plaintiff offers no legal authority or evidence supporting this view.

Moreover, Plaintiff's challenge to the registered mark is not appropriate in this proceeding. Plaintiff has not challenged the VIVOHEALTH! mark in an inter partes

proceeding, where the registrant could present evidence regarding its intent in removing “online” from its renewal application. Given the ambiguous possibilities for that deletion, the Court cannot presume that the services and channels of trade are indeed dissimilar. “Likelihood of confusion ‘must be resolved on the basis of the goods named in the registration and, in the absence of specific limitations in the registration, on the basis of all normal and usual channels of trade and methods of distribution.’” In re I.AM.Symbolic, LLC, 866 F.3d at 1325 (quoting SquirtCo, 697 F.2d at 1042-43). The services and channels-of-trade factors weigh either in favor of the TTAB’s decision or are at best neutral in the likelihood-of-confusion analysis.

As before the TTAB, Plaintiff has proffered no evidence regarding its customers and how those customers might differ from those of the registered mark’s services. Although Plaintiff points out that the registered mark is primarily used in New York, Plaintiff’s concedes that its own services are not geographically limited, and thus is it possible that some of the same consumers could use the services of the registered mark and Plaintiff’s services. This factor, as with the services and trade-channel factors, at most weighs neither for nor against the registration of Plaintiff’s mark.

4. Similarity of Advertising Media

Plaintiff argues that this factor weighs in favor of registering Plaintiff’s mark because online advertising is nationwide, while advertising for a retail pharmacy is “normally advertised locally for the retail location so customers may visit and purchase at retail.” (Pl.’s Supp. Mem. at 19.) But Plaintiff offers no authority for this proposition and no evidence to support it. While it may be logical that a local pharmacy advertises only

locally, it may also be true that a local pharmacy has an online presence that may appear in any internet search, similar to Plaintiff's services. Plaintiff has not demonstrated that the advertising media of the two marks is so different as to weigh in favor of registering Plaintiff's mark.

5. Intent

There is no evidence that Plaintiff intended to trade on any goodwill of VIVOHEALTH! when it sought to register the mark at issue. However, "the absence of such evidence does not avoid a ruling of likelihood of confusion." J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 1462 (Fed. Cir. 1991). This factor is neutral in the Court's analysis.

6. Actual Confusion

Although Plaintiff is correct that evidence of actual confusion may be an important factor in determining a likelihood of confusion, the absence of such evidence does not necessarily weigh against a finding of likelihood of confusion. "The lack of evidence of actual confusion carries little weight, especially in an ex parte context." In re Majestic Distilling Co., Inc., 315 F.3d 1311, 1317 (Fed. Cir. 2003) (citation omitted). And "uncorroborated statements of no known instances of actual confusion are of little evidentiary value." Id.; see also In re Bissett-Berman Corp., 476 F.2d 640, 642 (C.C.P.A. 1973) (testimony of corporate president's unawareness of instances of actual confusion was not conclusive on the issue of actual confusion or likelihood of confusion). Moreover, as Defendant points out, there is no evidence from the registrant of VIVOHEALTH! regarding actual confusion, and despite Plaintiff's implication, it is not Defendant's burden

to produce that evidence. The burden in this case rests with Plaintiff, which has come forward with no evidence from which the Court could conclude that there is no actual confusion aside from its CEO's self-serving testimony in that regard, no matter how sincere that testimony is. This factor is neutral in the Court's analysis.

CONCLUSION

On balance, the likelihood-of-confusion factors weigh in favor of the TTAB's decision here. Accordingly, **IT IS HEREBY ORDERED that:**

1. Defendant's Motion for Summary Judgment (Docket No. 33) is **GRANTED**;
2. Plaintiff's Motion for Summary Judgment (Docket No. 28) is **DENIED**; and
3. This matter is **DISMISSED with prejudice**.

The Clerk shall enter judgment accordingly, terminate all remaining deadlines as moot, and close the file.

Dated: March 23, 2021

s/ Paul A. Magnuson
Paul A. Magnuson
United States District Court Judge