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Serial No. 78/699926
Filing Date: August 24, 2005
Mark: TENDERFEETSHOES DIABETIC FOOTWEAR & Design
Applicant: BGizunt, Inc.
Office Action: March 20, 2006
Applicant Phone: 818-991-4001
Applicant Zip Code: 91301
Applicant E-mail: bob@bgizunt.com

**Request for Reconsideration of Final Action
and Amendment to Identification of Goods**



03-12-2007

U.S. Patent & TMO/TM Mail Rept Dt. #30

The Applicant, pursuant to 37 CFR §2.64 (b), intends to file a notice of appeal to the Trademark Trial and Appeal Board. However, since the evidentiary record in an application should be complete prior to filing an appeal, the Applicant is supplying additional evidence to support its conclusion that there is no likelihood of confusion between the Applicant's and Registrant's marks. Additionally, in order to clearly establish that the Applicant's goods should be regarded as professional products, the Applicant wishes to clarify and limit the identification of goods pursuant to Trademark Rule §2.71 (a). We hereby request the Examining Attorney reconsider our arguments in light of this new evidence and amended description.

I. Comparison of the Goods

Attached to the Examining Attorney's second Office action dated October 12, 2006 were 47 third-party registrations which ostensibly suggested that the goods listed therein, namely footwear (shoes) and/or inserts or inner soles are of a kind that may emanate from a single source. While that may be so, we don't see its relevance to the present case because, as we stated on the very first page of our prior response: *"In this case, the goods are at least in part related – orthotic inserts for footwear and orthopedic inner soles..."* While we agree that several

(2)

Serial No. 78/699926
Law Office 104
Carol Spils

manufacturers produce orthopedic footwear as well as orthotic inserts (as we do ourselves), we view the proof of that relationship as moot since we have already admitted the relationship of the Applicant's and Registrant's products. Additionally, the Registrant has not claimed orthopedic footwear as part of their recitation.

This large number of registrations does raise an interesting question, since the vast majority of them – 35 out of 47 – are for Class 025 (clothing) items and have nothing to do with custom made orthotic inserts which are, as described in our prior response, medical devices which deal with the prevention or correction of joints and ligaments. See attached definitions for the terms orthopedic and orthotic taken from Dictionary.com and the American Heritage Dictionary [EXHIBITS 1 and 2].

It is the Applicant's contention that although its product is obviously similar to the product of the cited Registrant, the fact that each individual insert is exclusively made for an individual patient, the prescribing doctor (the actual customer in the supply chain) views and evaluates the product in terms of how well it conforms to his prescription. This is not a case where two low price products, used for the same or similar purposes, are marketed side by side in a supermarket and purchased with a minimum of care. Rather, in the present case, the goods are of a highly technical nature and are custom made appliances. They are purchased with a high degree of care as we shall describe in a later section.

II. Amendment to Identification of Goods

In order to make clear that the Applicant's goods are intended as therapeutic medical devices, the Applicant offers the following amendment to the identification of goods:

Please substitute the following identification for that given previously:

Prescription orthopedic footwear; Prescription orthotic inserts
for footwear in International Class 010.

III. Weakness of the Marks

The Examining Attorney has pointed out that the terms TENDERFEET and TENDERFOOT are clearly the dominant element in the Applicant's and Registrant's marks. We agree with this analysis but we need to emphasize that in relation to the goods at hand, the term TENDERFOOT is a weak and highly suggestive expression. Whether a term is suggestive is determined not in the abstract, but in relation to the goods for which registration is sought and the context in which it is being used in connection with those goods. According to the American Heritage® Dictionary of the English Language, the meaning of the term "tender" is:

*1a. Easily crushed or bruised; 5a. Easily hurt; sensitive;
5b. Painful; sore* [EXHIBIT No. 3]

Thus, a tender foot is a sensitive, sore and painful condition that is addressed by orthotic inserts which are commonly used to treat such conditions. When a term has a well known and particular significance in an industry, it is considered as a suggestive term. [See *United States Shoe Corp. v. Chapman*, 229 USPQ 74 (TTAB 1985) at 75.]

As additional evidence of the connection between the terms "tender feet" and "orthotic inserts" to which the public has been exposed, we present six articles taken from the popular press [see EXHIBITS No. 4 through 9]. These articles were found on the LexisNexis Academic database under the categories of Medical and Health News as well as the general category of U.S. News.

The evidence shows that sore and tender feet are a common condition and that orthotic inserts are frequently prescribed to remedy this problem. According to the National Center for Health Statistics, 76% of Americans have foot problems. [Exhibit 4] The articles go on to say that prescription orthotic devices typically work more effectively than off-the-shelf inserts found in stores. [Exhibit 5] Also mentioned in these articles are the special foot problems encountered by diabetics and the pain and sensitivity that they endure. [Exhibit 6]

(4)

Serial No. 78/699926
Law Office 104
Carol Spils

A portion of a mark may be weak in the sense that such portion is highly suggestive or is in common use by many other sellers in the market. In our previous response to the first Office action, we pointed out that the electronic records of the USPTO contain seven active registrations or applications where the term "TENDERFOOT" is used in connection with goods or services related to care of the feet. Although third-party registrations, by themselves, are entitled to little weight on the question of likelihood of confusion, they can be probative as to the meaning of a mark or part of a mark:

"[Third-Party registrations] are, however, competent to establish that a portion common to the marks involved in a proceeding has a normally understood and well known meaning; that this has been recognized by the Patent and Trademark Office by registering marks containing such a common feature for the same or closely related goods where the remaining portions of the marks are sufficient to distinguish the marks as a whole; and that therefore the inclusion of [the common element] in each mark may be an insufficient basis upon which to predicate a holding of confusing similarity." [See American Hospital Supply Corporation v. Air Products and Chemicals, Inc., 194 USPQ 340 (TTAB 1997) at 343]

See also Tetronix, Inc. v. Daktronics, Inc., 189 USPQ 693 (CCPA 1976) where the Court of Customs and Patent Appeals stated:

"Because marks, including any suggestive portions thereof, must be considered in their entireties, the mere presence of a common, highly suggestive portion is usually insufficient to support a finding of likelihood of confusion."

We also find in a recent decision of the Trademark Trial and Appeal Board -- In re Box Solutions Corp., Serial No. 76267086, TTAB May 23, 2006:

"The connotation of the marks, derived from the common word BOX, implying computer, is similar, but applicant's mark has a slight variation due to the additional word SOLUTIONS which creates a difference in sound. Overall, we find the differences outweigh the similarities given the weakness of the common element."

One of the key factors in determining whether there is a likelihood of confusion between two marks is *"The number and nature of similar marks in use on similar goods."* In *The Matter of The Application of E.I. DuPont DeNemours & Co.* 177 USPQ 563 (CCPA 1973). [DuPont Factor No. 6] This factor is actually an inquiry into the strength or weakness of the opposing mark in question. The Examining Attorney's conclusion that there is a likelihood of confusion is based on the premise that the cited mark and the Applicant's mark both contain the "dominant" wording TENDERFOOT or TENDERFEET. Inherent in this premise is the assumption that the wording TENDERFOOT is both strong and distinctive. However, the Applicant submits additional evidence to show that the opposite is true. This additional evidence consists of web pages taken from several of the third-party registrants indicating that the marks are in current use and could well be familiar to consumers of these products. [See EXHIBITS No. 10 through 13]

The highly suggestive nature of the term TENDERFOOT towards orthotic appliances renders this term to have little source identifying power. In situations like this, purchasers distinguish slight differences among the marks under consideration. In the present case, the marks are fairly distinct from each other, certainly in terms of appearance and sound as was discussed in our response to the first Office action. We would also draw the Examining Attorney's attention to the letters attached to our first response from the doctors who purchase the Applicant's orthopedic shoes and orthotic inserts. In all cases, those customers refer to the Applicant as "TenderfeetShoes" or "Tenderfeet Shoes." It is clear from this evidence that the term "SHOES" is viewed as an integral part of the Applicant's mark. Undoubtedly, these customers are more likely to rely on the additional elements in the Applicant's mark, including its design feature of a shoe, to select their desired source for orthopedic shoes or orthotic inserts.

Applicant appreciates that a "word mark" registration is not limited to any particular design, and thus could *possibly* be used with a design closely resembling the one chosen by the Applicant. However, the Lanham Act *"does not talk in terms of remote possibilities of confusion but, rather, the likelihood of such confusion occurring in the marketplace."* [See *Triumph Machinery Co. v. Kentmaster*, 1 USPQ2d 1826 (TTAB 1987)]

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