

## Request for Reconsideration after Final Action

**The table below presents the data as entered.**

Input Field	Entered
<b>SERIAL NUMBER</b>	85143400
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 107
<b>MARK SECTION (no change)</b>	
<b>EVIDENCE SECTION</b>	
<b>EVIDENCE FILE NAME(S)</b>	
<b>ORIGINAL PDF FILE</b>	<a href="#">evi_10726443-165939422_. Second Office Action Reply.pdf</a>
<b>CONVERTED PDF FILE(S) (14 pages)</b>	<a href="#">\\TICRS\EXPORT11\IMAGEOUT11\851\434\85143400\xml8\RFR0002.JPG</a>
	<a href="#">\\TICRS\EXPORT11\IMAGEOUT11\851\434\85143400\xml8\RFR0003.JPG</a>
	<a href="#">\\TICRS\EXPORT11\IMAGEOUT11\851\434\85143400\xml8\RFR0004.JPG</a>
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	<a href="#">\\TICRS\EXPORT11\IMAGEOUT11\851\434\85143400\xml8\RFR0015.JPG</a>
<b>DESCRIPTION OF EVIDENCE FILE</b>	Response to Office Action
<b>SIGNATURE SECTION</b>	

RESPONSE SIGNATURE	/kevinkeener/
SIGNATORY'S NAME	Kevin Keener
SIGNATORY'S POSITION	Attorney of record, Illinois bar member
SIGNATORY'S PHONE NUMBER	312-523-2096
DATE SIGNED	02/09/2012
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO
<b>FILING INFORMATION SECTION</b>	
SUBMIT DATE	Thu Feb 09 17:02:55 EST 2012
TEAS STAMP	USPTO/RFR-107.2.64.43-201 20209170255601016-8514340 0-490c590cd69ffa57b1c14c2 64e68b8d158-N/A-N/A-20120 209165939422668

**Request for Reconsideration after Final Action  
To the Commissioner for Trademarks:**

Application serial no. **85143400** has been amended as follows:

**EVIDENCE**

Evidence in the nature of Response to Office Action has been attached.

**Original PDF file:**

[evi\\_10726443-165939422\\_2\\_Second Office Action Reply.pdf](#)

**Converted PDF file(s)** (14 pages)

- [Evidence-1](#)
- [Evidence-2](#)
- [Evidence-3](#)
- [Evidence-4](#)
- [Evidence-5](#)
- [Evidence-6](#)
- [Evidence-7](#)
- [Evidence-8](#)

[Evidence-9](#)

[Evidence-10](#)

[Evidence-11](#)

[Evidence-12](#)

[Evidence-13](#)

[Evidence-14](#)

**SIGNATURE(S)**

**Request for Reconsideration Signature**

Signature: /kevinkeener/ Date: 02/09/2012

Signatory's Name: Kevin Keener

Signatory's Position: Attorney of record, Illinois bar member

Signatory's Phone Number: 312-523-2096

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85143400

Internet Transmission Date: Thu Feb 09 17:02:55 EST 2012

TEAS Stamp: USPTO/RFR-107.2.64.43-201202091702556010

16-85143400-490c590cd69ffa57b1c14c264e68

b8d158-N/A-N/A-20120209165939422668



**KEENER MCPHAIL SALLES, LLC**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

February 9, 2012

David A. Hoffman  
Examining Attorney  
Law Office 107  
United States Patent and Trademark Office

Re: Serial No: 85143400  
Mark: Barefoot Consultants  
Applicant: Barefoot Consultants, Inc.  
Office Action of August 10, 2011

**SUBSTANTIVE RESPONSE TO OFFICE ACTION**

The following is the substantive response of the Applicant, Barefoot Consultants, Inc., by Counsel, to the office action of August 10, 2011 by Examining Attorney David A. Hoffman.

**Section 2(d) Refusal - Likelihood of Confusion**

The Examining Attorney has refused registration of the proposed mark pursuant to Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the grounds that the mark is likely to be confused with the prior registered mark BAREFOOT SERVICE, Registration No. 3644125 (hereafter the "cited mark"). For the following reasons, the Applicant respectfully disagrees with the findings and requests that the Examining Attorney reconsider the statutory refusal and allow registration of the Applicant's mark.

**I. The Examining Attorney Should Withdraw the Rejection Under Section 2(d) Because the Common Element in the Marks Is Diluted and the Cited Mark Creates a Different Commercial Impression**

Marks may contain elements in common and still not create consumer confusion if either 1) the matter common to the marks is merely descriptive or diluted, or 2) the marks as a whole create different commercial impressions. See, e.g. *In re Farm Fresh Catfish Co.*, 231 USPQ 495 (TTAB 1986) (CATFISH BOBBERS (with "CATFISH" disclaimed) for fish held not likely to be confused with BOBBER for restaurant services); *In re Shawnee Milling Co.*, 225 USPQ 747 (TTAB 1985) (GOLDEN CRUST for flour held not likely to be confused with ADOLPH'S GOLD'N CRUST and design (with "GOLD'N CRUST" disclaimed) for coating and seasoning for food items).

In this case, Applicant's mark BAREFOOT CONSULTANTS is not likely to cause confusion with the Registered mark BAREFOOT SERVICE, in spite of the common material, because that common material is highly diluted as related to the goods, and additionally because the marks create entirely different commercial impressions.

**A. The Examining Attorney Should Withdraw the Rejection Under Section 2(d) Because the Common Element in the Marks Is Diluted**

The word BAREFOOT, common between the marks, is diluted as applied to educational and consulting services and related publications. Dilution and descriptiveness of a common element can be shown by the existence of several third-party registrations, or by evidence of actual third party use. *AMF Inc. v. American League Products, Inc.* 474 F.2d 1403, 1406, 177 USPQ 268, 269-7- (CCPA 1973); *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005) (The existence of widespread third-party use under the du Pont factors

may serve to indicate the weakness of a term in the context of its source identifying significance).

With regards to the application at hand there are at least twenty-three (23) concurrent registrations for educational services in International Class 41 that include the word BAREFOOT. (Attached as Exhibit A). In addition, there are at least seven (7) concurrent registrations for printed material in International Class 16 that include the word BAREFOOT. (Attached as Exhibit B). Finally, there are at least twenty-six (26) concurrent registrations for business services in International Class 35. (Attached as Exhibit C).

Examples of concurrent registrations include BAREFOOT MINISTRIES for “lectures,” THE BAREFOOT CEO for “on-line journals,” THE BAREFOOT EXECUTIVE for “business advice,” BAREFOOT DREAMS for “promoting the goods and services of others,” BAREFOOT CONTESSA for “stationary,” BAREFOOT BOOKS for “children’s books,” and BAREFOOT BALLERINA for “children’s books.”

The cited mark is therefore subject to a narrow scope of protection. It is particularly unlikely that consumers will confuse Applicant’s BAREFOOT CONSULTANTS mark with Registrant’s BAREFOOT SERVICE mark given the concurrent existence without confusion of such marks as BAREFOOT MINISTRIES, THE BAREFOOT CEO, BAREFOOT CONTESSA, and BAREFOOT BOOKS. For this reason, the Applicant requests that the Examining attorney withdraw the rejection based on Section 2(d).

**B. The Examining Attorney Should Withdraw the Rejection Under Section 2(d) Because the Cited Mark Creates a Different Commercial Impression**

Applicant's mark BAREFOOT CONSULTANTS contains an incongruity in the mark itself. The incongruity occurs between the word BAREFOOT, which describes a person without shoes, and the word CONSULTANTS, a word describing a professional person who has expertise in a particular area. A consultant would normally be expected to be a person who dresses professionally and would never be providing services without dress shoes. Thus the combination of BAREFOOT with CONSULTANTS brings forth the mental impression of an expert in a particular area who is dressed in professional attire but lacks shoes. Because of the incongruity, customers encountering Applicant's mark would see a coy, playful, self-referential brand of consulting services. By contrast, Registrant's mark BAREFOOT SERVICE creates the commercial impression of service that is provided with regards to feet, such as pedicures. Because of the incongruity of the placement of the word BAREFOOT with the word CONSULTANTS, Applicant's mark leaves a unique commercial impression in the consumers mind. That commercial impression is distinct and different from the impression left by the mark BAREFOOT SERVICE.

**CONCLUSION**

Because the material common between the marks is highly diluted, the differences in the marks, when they are viewed as a whole, become dominant in indicating source. On the basis of those differences, Applicant's mark creates a different commercial impression from Registrant's mark. When viewing the marks as a whole, in light of the crowded marketplace of similar marks and the differences in commercial impression,

consumers are not likely to confuse the source of Applicant's and Registrant's respective goods and services. For that reason, Applicant respectfully requests that the Examining Attorney reconsider the statutory refusal and allow Applicant's mark to proceed to publication.

The Applicant has responded to all issues in the Office Action. If any further information or response is required, please contact the Applicant's attorney. The attorney may be reached by phone at 312-523-2096.

# **EXHIBIT A**

**Trademarks > Trademark Electronic Search System (TESS)**

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record:**42 Records(s) found (This page: 1 ~ 42)**

Refine Search

Current Search: S5: [\(barefoot\)\[MN\] and \("ic 041"\)\[IC\]](#) docs: 42 occ: 84

	Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
1	85279165		BAREFOOT STRATEGIES	TARR	LIVE
2	85449926		BAREFOOT BARRE	TARR	LIVE
3	85329531		BAREFOOT RESORT & GOLF	TARR	LIVE
4	85114512		BAREFOOT FTS	TARR	LIVE
5	85238878		BAREFEET LACROSSE EST. 2011	TARR	LIVE
6	85143400		BAREFOOT CONSULTANTS	TARR	LIVE
7	85067834		BAREFOOT BILLY'S, INC.	TARR	DEAD
8	79023619	3557631	MASAI BAREFOOT TECHNOLOGY	TARR	LIVE
9	78955552	3443000	THE BAREFOOT DRUMMER	TARR	LIVE
10	78867557	3309681	BAREFOOT HEALTH & FITNESS	TARR	LIVE
11	78729408	3353672	THE BAREFOOT NATIVES	TARR	LIVE
12	78633237		BAREFEET	TARR	DEAD
13	78602092	3129046	THE BAREFOOT HAWAIIAN	TARR	LIVE
14	78586254		BAREFOOT RADIO	TARR	DEAD
15	78373499	3044574	BAREFOOT WEDDINGS	TARR	LIVE
16	78485994		BAREFOOT BAY	TARR	DEAD
17	78451462	3529024	BAREFOOT AND BEYOND	TARR	LIVE
18	78444427	3056659	BAREFOOT MASTERS	TARR	LIVE
19	78229765	2844076	BAREFOOT AND PREGNANT	TARR	LIVE
20	78108432	2887464	BAREFOOT MINISTRIES	TARR	LIVE
21	77920604	3840882	BAREFOOT WAHINES	TARR	LIVE
22	77787518	3757283	BLOGGING BAREFOOT	TARR	LIVE
23	77774856	3749280	BAREFOOT FUSION	TARR	LIVE
24	77668498	3672716	THE BAREFOOT CEO	TARR	LIVE
25	77569154	3608695	BAREFOOT CONFIDENTIAL	TARR	LIVE
26	77252325	3439666	THE BAREFOOT PHOTOGRAPHER	TARR	LIVE

## Record List Display

27	77194919	3644125	BAREFOOT SERVICE	TARR	LIVE
28	77184169		THE BAREFOOT COACHING COMPANY	TARR	DEAD
29	77171226	3554773	BAREFOOT LEGEND	TARR	LIVE
30	76586507	3064747	BAREFOOT RECORDING	TARR	LIVE
31	76626056	3216738	BAREFOOT CONTESSA	TARR	LIVE
32	76616284		BAREFOOT	TARR	DEAD
33	76295329	2863184	BAREFOOT MARKETING	TARR	DEAD
34	76013943		BAREFOOT BAY	TARR	DEAD
35	75924975	2465409	BAREFOOT STUDIO	TARR	LIVE
36	75799236	2357766	THE BAREFOOT BOYS	TARR	DEAD
37	75702006	2400960	BAREFOOT KIDS	TARR	LIVE
38	75667377		BAREFOOT DOCTORS' ACADEMY	TARR	DEAD
39	75592480	2481228	BAREFOOT PRESS	TARR	LIVE
40	74008335	1770127	THE BAREFOOT COMPANY	TARR	DEAD
41	73566780	1425206	BAREFOOT PARK	TARR	DEAD
42	73456264	1334757	MASTERS BAREFOOT TOURNAMENT	TARR	DEAD

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## **EXHIBIT B**



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**18 Records(s) found (This page: 1 ~ 18)**

Refine Search

Current Search: S4: [\(barefoot\)\[MN\] and \("ic 016"\)\[IC\]](#) docs: 18 occ: 36

	Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
1	85143400		BAREFOOT CONSULTANTS	TARR	LIVE
2	78925261		BAREFOOT PERSPECTIVES	TARR	DEAD
3	78704988		BAREFOOT HOME	TARR	DEAD
4	78395623		THE BAREFOOT CEO	TARR	DEAD
5	78108432	2887464	BAREFOOT MINISTRIES	TARR	LIVE
6	77814385		SEEK PEACE, FIND ADVENTURE, GIVE LOVE, END POVERTY, SAVE LIVES, BE KIND, REACH OUT, RESPECT NATURE, CONSERVE AND RECYCLE, STAY OPEN, GO BAREFOOT, SHARE IDEAS, SMILE AT THE SUN, DARE TO DREAM, CREATE CHANGE, EMBRACE DIVERSITY, CHERISH YOUR HEALTH, LEAD THE WAY, SEEK WISDOM, THINK BIG, LAUGH OFTEN, KEEP LEARNING, GET EXCITED, HELP OTHERS, PAVE THE PATH, LIVE IN UNITY, GIVE BACK, INSPIRE OTHERS, TAKE FLIGHT	TARR	LIVE
7	77668518	3788365	THE BAREFOOT CEO	TARR	LIVE
8	77252325	3439666	THE BAREFOOT PHOTOGRAPHER	TARR	LIVE
9	76667815		BOB BAREFOOT	TARR	DEAD
10	76626056	3216738	BAREFOOT CONTESSA	TARR	LIVE
11	76513291		BAREFOOT	TARR	DEAD
12	76072135		BAREFOOT WALKING	TARR	DEAD
13	75810449		BAREFOOT BILLIONAIRE	TARR	DEAD
14	75437583	2401217	BAREFOOT BOOKS	TARR	LIVE
15	75249288		BAREFOOT PUBLICATIONS	TARR	DEAD
16	74238789	1838407	BAREFOOT BALLERINA	TARR	LIVE
17	73580897	1410453	BAREFOOT BEAR	TARR	DEAD
18	73256881	1186684	BAREFOOT GRASS	TARR	DEAD

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## **EXHIBIT C**



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Current Search: S3: (barefoot)[MN] and ("ic 035")[IC] docs: 38 occ: 76

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1	85215364	4009378	THE BAREFOOT BEE	TARR	LIVE
2	85113982	3946345	BAREFOOT WINE BEACH RESCUE PROJECT	TARR	LIVE
3	78955509	3447045	BAREFOOT DRUMS OF HOUSTON	TARR	LIVE
4	78801079	3428421	BAREFOOT WHEN YOU CAN ... THORLOS WHEN YOU CAN'T.	TARR	LIVE
5	78801064	3428420	BAREFOOT WHEN YOU CAN	TARR	LIVE
6	78800930	3428419	LET'S GO BAREFOOT'N	TARR	LIVE
7	78800928	3428418	BAREFOOT'N	TARR	LIVE
8	78683047	3285616	BAREFOOT TESS	TARR	LIVE
9	78602092	3129046	THE BAREFOOT HAWAIIAN	TARR	LIVE
10	78375671	2997299	BAREFOOT WEALTH MANAGEMENT	TARR	LIVE
11	78108432	2887464	BAREFOOT MINISTRIES	TARR	LIVE
12	78080383	2741787	BAREFOOT ADVERTISING	TARR	DEAD
13	77821439	3905294	BAREFOOT DREAMS	TARR	LIVE
14	77811829	3891048	BAREFOOT DREAMS	TARR	LIVE
15	77890639	3840501	BAREFOOT REPUBLIC	TARR	LIVE
16	77885094		BAREFOOT PLAN	TARR	DEAD
17	77865796	3902704	BAREFOOT SEARCH	TARR	LIVE
18	77787524	3760596	BAREFOOT TESS	TARR	LIVE
19	77284221	3435198	THE BAREFOOT EXECUTIVE	TARR	LIVE
20	77190612		BAREFOOT LIVING	TARR	DEAD
21	77184169		THE BAREFOOT COACHING COMPANY	TARR	DEAD
22	77171226	3554773	BAREFOOT LEGEND	TARR	LIVE
23	76172249	2892226	BAREFOOT CONTESSA	TARR	LIVE
24	76665424	3315273	BAREFOOT CONTESSA PANTRY	TARR	LIVE
25	76665079		BAREFOOT PARTIES	TARR	DEAD
26	76664997	3489175	BAREFOOT AMBASSADOR	TARR	LIVE

Record List Display

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28	76614048	3107383	GO BAREFOOT	TARR	LIVE
29	76577500	3392251	BAREFOOT TECHNOLOGIES	TARR	LIVE
30	76519633	2850522	BAREFOOT FLOORING	TARR	LIVE
31	76281103	2792126	"THE BAREFOOT COAST"	TARR	DEAD
32	75671496	2560889	BAREFOOT DREAMS	TARR	LIVE
33	75668186	2376170	BAREFOOT BABY	TARR	DEAD
34	75275070	2243425	BAREFOOT COMFORT COMPANY	TARR	DEAD
35	75213407	2284367	BAREFOOT SHOE OUTLET	TARR	DEAD
36	75194722	2187148	" BAREFOOT ELEGANCE "	TARR	DEAD
37	74165950	1746011	BAREFOOT IGUANA	TARR	DEAD
38	73455831		THE BAREFOOT EAGLE	TARR	DEAD

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