

This Opinion Is Not A
Precedent Of The TTAB

Mailed: February 12, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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San Antonio Shoe, Inc.

v.

Nike, Inc.
—

Opposition No. 91263731
—

Erin S. Hennessy, Joseph Lawlor and Annie Allison of Haynes and Boone LLP
for San Antonio Shoe, Inc.

Helen Hill Minsker, Michael J. Harris, Michael Kientzle and Kathleen P. Duffy of
Arnold & Porter Kaye Scholer, LLP for Nike, Inc.
—

Before Kuhlke, Goodman and Coggins,
Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Nike, Inc., seeks registration on the Principal Register of the proposed
mark FOOTWARE in standard characters for:

Computer hardware modules for receiving, processing, and transmitting data in Internet of things electronic devices; electronic devices and downloadable computer software that allow users to remotely interact with other smart devices for monitoring and controlling automated systems; downloadable computer software and firmware used to allow electronic devices to share data and communicate with each other; downloadable software drivers for

electronic devices that allow computer hardware and electronic devices to communicate with each other; downloadable computer software for network and device security, namely, software that ensures secure receipt, processing, transmission and storage of data in the internet of things; downloadable computer software for use and interoperability of application program interfaces that are used by electronic devices, systems, and interchanges that exchange data via communications networks and the internet and that connect with private and public computer networks for data storage and exchange services in International Class 9;

Telecommunications services, namely, transmission of data by means of telecommunications networks, wireless communications networks and the Internet, in International Class 38;

Application service provider featuring application programming interface (API) software for integration of third-party applications to allow an interactive user experience; Cloud computing featuring software for connecting, operating and managing networked devices via wireless or wired networks; cloud computing featuring software for connecting, operating and managing networked devices in the internet of things; cloud computing featuring software for use in the collection, management, monitoring, storage and analysis of data; cloud computing featuring software for managing machine-to-machine applications and machine-to-machine networks; providing temporary use of non-downloadable cloud-based software for connecting, operating, and managing networked payment terminals, entertainment devices, smartphones, lighting systems, HVAC systems, in the internet of things (IoT) in International Class 42.¹

¹ Serial No. 88350648, filed March 21, 2019, based on an allegation of a bona fide intent to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

Opposer, San Antonio Shoe, Inc., has opposed registration of Applicant's proposed mark on the ground that it is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1) and not capable of acquiring distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f).²

By its answer, Applicant generally denies the salient allegations and does not plead the affirmative defense of acquired distinctiveness.³ See *Colonial Arms Corp. v. Trulock Firearms Inc.*, 5 USPQ2d 1678, 1680 n.5 (TTAB 1987). See also *Perma Ceram Enters. Inc. v. Preco Indus. Ltd.*, 23 USPQ2d 1134, 1139 n.13 (TTAB 1992) ("Although the application did not include a Section 2(f) claim, the defense of acquired distinctiveness clearly could have been raised.") (citing *Colonial Arms, supra*).

Opposer, as plaintiff in this proceeding, must prove its entitlement to a statutory cause of action and its claim by a preponderance of the evidence. *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998); *Cerveceria Centroamericana, S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989).

I. RECORD

The record includes the pleadings and, by operation of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), the file of the application subject to the notice of opposition. In addition the record includes:

² Not. of Opp., 1 TTABVUE. Citations in this opinion to the briefs and other materials in the case docket refer to TTABVUE, the Board's online docketing system. See *New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *2 n.1 (TTAB 2020). The record contains confidential information that we refer to generally and otherwise there is no need to refer to the confidential information in connection with the determination.

³ Ans., 4 TTABVUE.

- Opposer’s Trial Declaration of Christopher Schmitzer, Head of Product Development of Opposer, and exhibits;⁴
- Opposer’s Notices of Reliance on: discovery materials including excerpts from the discovery depositions of Jordan Rice, Applicant’s Senior Director of Smart Systems, taken pursuant to Fed. R. Civ. P. 30(b)(6), and Michael Maoz, Applicant’s Assistant General Counsel, Trademarks and Copyright;⁵ documents produced and admitted as genuine and authentic by Applicant;⁶ printouts from various third-party websites;⁷ printouts from the USPTO’s Trademark Status & Document Retrieval (TSDR) database of third parties’ registrations;⁸ Applicant’s responses to specific interrogatories propounded by Opposer;⁹
- Applicant’s Oral Cross-Examination of Christopher Schmitzer, and exhibits;¹⁰

⁴ 39 TTABVUE (public); 40 TTABVUE (confidential).

⁵ 30, 44 TTABVUE (public); 31, 45 TTABVUE (confidential). The parties stipulated to the refiling of the first notice of reliance to include exhibits inadvertently absent from the original filing. 44 TTABVUE.

⁶ 32 TTABVUE (public); 33-34 TTABVUE (confidential).

⁷ 35 TTABVUE.

⁸ 37 TTABVUE.

⁹ 38 TTABVUE.

¹⁰ 56 TTABVUE (public); 57 TTABVUE (confidential).

- Applicant’s Notices of Reliance on: excerpts from the discovery deposition of Christopher Schmitzer;¹¹ Opposer’s responses to specific interrogatories and requests for admission;¹² printouts from the TSDR database of third-party registrations for marks ending in “WARE”;¹³ excerpts from the discovery deposition of Michael Moaz;¹⁴ excerpts from the discovery deposition of Jordan Rice.¹⁵

We note the parties objections to certain testimony and exhibits. None of the testimony or evidence subject to objection is outcome determinative. We have taken the objections into account and have given the evidence of record the weight it warrants. *Cf. Harris v. Rivera*, 454 U.S. 339, 346 (1981) (“In **bench** trials, judges routinely hear inadmissible evidence that they are presumed to ignore when making decisions.”) (emphasis added); *see See Krause v. Krause Publ’n Inc.*, 76 USPQ2d 1904, 1907 (TTAB 2005) (“[w]here we have relied on testimony to which respondent objected, it should be apparent to the parties that we have deemed the material both admissible and probative to the extent indicated in the opinion.”).

¹¹ 48 TTABVUE (public); 49 TTABVUE (confidential).

¹² 50 TTABVUE.

¹³ 52 TTABVUE.

¹⁴ 51 TTABVUE (public); 53 TTABVUE (confidential).

¹⁵ 54 TTABVUE (public); 55 TTABVUE (confidential).

II. ENTITLEMENT TO A STATUTORY CAUSE OF ACTION

Opposer's entitlement to a statutory cause of action is a requirement that must be proven in this inter partes case. *See Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, *3 (Fed. Cir. 2020) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2067 n.4 (2014)). A party in the position of plaintiff may oppose registration of a mark where such opposition is within the zone of interests protected by the statute, 15 U.S.C. § 1063, and the party has a reasonable belief in damage that is proximately caused by the prospective registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, *6-7 (Fed. Cir. 2020).

Where, as here, descriptiveness of the proposed mark is in issue, a plaintiff may prove its entitlement to a statutory cause of action by alleging that it is engaged in the sale of the same or related products or services (or that the product or service in question is within the normal expansion of plaintiff's business) and that the plaintiff has an interest in using the term at issue descriptively in its business. *Univ. of Ky. v. 40-0, LLC*, 2021 USPQ2d 253, at *13, *15 (TTAB 2021) (opposer demonstrated entitlement to a statutory cause of action by establishing that it has a present or prospective interest in using the term 40-0); *Poly-America, L.P. v. Illinois Tool Works Inc.*, 124 USPQ2d 1508, 1512 (TTAB 2017) (standing established by plaintiff showing that it is engaged in the manufacture or sale of the same or related goods and that the product in question is one which could be produced in the normal expansion of plaintiff's business); *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1487 (TTAB 2017) (opposer's status as competitor establishes standing to oppose

registration of product configuration); *Kistner Concrete Prods, Inc. v. Contech Arch Techs., Inc.*, 97 USPQ2d 1912, 1918 (TTAB 2011) (competitor in industry has a real interest in cancelling registration for product configuration); *Kellogg Co. v. Gen. Mills Inc.*, 82 USPQ2d 1766, 1767 (TTAB 2007) (commercial interest in allegedly descriptive term).

Opposer has shown that it sells footwear and further that it has an interest in using the term FOOTWARE to describe its own “foot worn wearable technology” involving the goods and services identified in the application in a natural expansion of its business. Opp. brief, 58 TTABVUE 33; Schmitzer Trial Decl. ¶¶ 31, 39, 40, TTABVUE 7 .

This is sufficient to show that registration of Applicant’s mark is within Opposer’s zone of interests and Opposer has a reasonable belief in damage that is proximately caused by the prospective registration of FOOTWARE. *DeWalt, Inc. v. Magna Power Tool Corp.*, 48 CCPA 909, 289 F.2d 656, 129 USPQ 275, 280 (1961) (“[D]amage to an opposer or injury to a petitioner for cancellation ... will be presumed or inferred when the mark sought to be registered is descriptive of the goods and the opposer or petitioner is one who has a sufficient interest in using the descriptive term in its business.”); *Nature’s Way Prods. Inc. v. Nature’s Herbs Inc.*, 9 USPQ2d 2077, 2080 (TTAB 1989) (“In the present case, petitioner has demonstrated its standing by showing that it manufactures and sells products similar to those recited in respondent’s registration and that, being a competitor of respondent, it is in a position to use the designation sought to be cancelled in a descriptive manner.”) *See also*

DeWalt, 129 USPQ at 280 (Standing, now entitlement, “will be presumed or inferred when ... the opposer or petitioner is one who has a sufficient interest in using the descriptive term in its business.”) Applicant does not dispute Opposer’s entitlement.

Opposer has established its entitlement to a statutory cause of action to oppose registration of Applicant’s proposed mark.

III. MERE DESCRIPTIVENESS

In the absence of acquired distinctiveness, Section 2(e)(1) of the Trademark Act prohibits registration of a term on the Principal Register that, when used in connection with the goods or services identified in the registration, is merely descriptive of them. “A mark is merely descriptive if it immediately conveys information concerning a feature, quality, or characteristic of the goods or services for which registration is sought.” *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1373 (Fed. Cir. 2018) (quoting *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017)). A mark is suggestive, and not merely descriptive, if it requires imagination, thought, and perception on the part of someone who knows what the goods or services are to reach a conclusion about their nature from the mark. *See, e.g., In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1513 (TTAB 2016). Suggestive marks, unlike merely descriptive terms, are registrable on the Principal Register without proof of acquired distinctiveness. *See Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 71 USPQ2d 1173, 1180 (Fed. Cir. 2004).

We “must consider the mark as a whole and do so **in the context of the goods or services at issue.**” *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695

F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (emphasis added); *In re Calphalon Corp.*, 122 USPQ2d 1153, 1162 (TTAB 2017). “Whether consumers could guess what the product is from consideration of the mark alone is not the test.” *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985). Rather, “the question is whether someone who knows what the goods and services are will understand the mark to convey information about them.” *DuoProSS*, 103 USPQ2d at 1757 (quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002)). It is not necessary, in order to find a term merely descriptive, that the term describe each feature of the goods or services, only that it describe a single, ingredient, quality, characteristic, function, feature, purpose or use of the goods or services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

“Evidence of the public’s understanding of [a] term ... may be obtained from any competent source, such as purchaser testimony, consumer surveys, listing in dictionaries, trade journals, newspapers and other publications,” *Real Foods*, 128 USPQ2d at 1374 (quoting *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1046 (Fed. Cir. 2018)), as well as websites, “labels, packages, or in advertising material directed to the goods [or services].” *N.C. Lottery*, 123 USPQ2d at 1710 (quoting *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978)); *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1565 (Fed. Cir. 2001).

A. The Parties’ Arguments and Evidence

Relying on Applicant’s confidential internal documents, Opposer argues “[Applicant’s] own testimony and documents demonstrate that ‘footware’ is merely descriptive of footwear with integrated technology.” Opp. brief, 58 TTABVUE 7.

Further, Opposer posits that “[a]n ordinary consumer will understand that: (i) ‘FOOT’ refers to a product worn on the foot; (ii) ‘WARE’ refers to the advanced hardware and software technologies embedded in the product,” and concludes that “‘footware’ is merely descriptive for foot[-]worn wearable technology.” Opp. brief, 58 TTABVUE 9, 38.

Opposer submitted evidence showing that third-party manufacturers and Applicant are developing or selling footwear products incorporating software and hardware technology. With regard to Applicant, Opposer points to the “Nike Adapt” shoe that is a “self-lacing shoe that provides consumers with technology-driven functionality through software embedded in the shoe which is controlled directly through a connected mobile application.” Opp. brief, 58 TTABVUE.

Applicant “does not deny that the FOOTWARE platform may be incorporated into a shoe, or that the sensing and communication technologies incorporated into a product like ADAPT represents an early version of the FOOTWARE Platform.” App. brief, 60 TTABVUE 16. In fact, Applicant has worked on and offered products that integrate hardware and software into footwear and other products. As explained by Applicant, “[A]pplicant has a long history of developing and selling such products, including the Nike+Fuelband, the Nike GPS Sport Watch, Nike+Training, and Nike+Basketball connected footwear, the Nike Sport Band.” App. brief, 60 TTABVUE 10. The crux of Applicant’s defense is that there is no proof of how Applicant intends to use the word FOOTWARE and, in particular, the evidence does not show that

Applicant “intends to use FOOTWARE to refer to shoe products themselves, rather than the Platform.” *Id.*

Specifically Applicant argues:

[Opposer] devotes almost the entirety of its brief to a different question: whether FOOTWARE is merely descriptive of an article of clothing, namely, footwear. More specifically, [Opposer] focuses on whether FOOTWARE is merely descriptive of “a line of ‘footware’ shoes that integrate advanced sensors, computer chips, and technologies.” But that question, and the answer to that question, are irrelevant to the question actually before the Board. As a result, [Opposer] fails to demonstrate by a preponderance of the evidence that FOOTWARE is merely descriptive of the Identified Goods and Services.

First, the Identified Goods and Services in [Applicant’s] intent-to-use application do not include any type of footwear (shoes). [Applicant] intends to use the mark FOOTWARE for the Identified Goods and Services, which relate to a platform of technology capabilities combining hardware, firmware, software and connectivity (the “Platform”). Shoes and a technology platform are not the same thing, notwithstanding [Opposer’s] attempts to improperly conflate the two. The fact that [Opposer’s] Platform may be used in connection with products, including shoes, apparel and equipment, does not make the term FOOTWARE a merely descriptive term for the Identified Goods and Services.¹⁶

App. brief, 60 TTABVUE 6 (citation omitted).

Opposer counters that “[e]ach of the goods and services identified in Nike’s Footware Application is a ‘WARE’ and is a ‘footware’ when integrated into foot worn

¹⁶ Much of Applicant’s arguments appear to address an analysis that pertains to whether a term is understood as the class of goods, i.e., whether it is generic. As set out above, the question for mere descriptiveness is whether the term merely describes a feature, function or purpose of the goods or services. As discussed below, use of the goods or services in connection with footwear would be a feature, function or purpose of the identified goods or services.

wearable technology.” 58 TTABVUE 36. Opposer adds another theory that the words “‘footware’ and ‘footwear’ are often used interchangeably, which renders the term merely descriptive,” because phonetically identical words or simple misspellings do not remove the merely descriptive aspect of the word. Opp. brief, 58 TTABVUE 39-40. Opposer points to examples in the record showing that “footwear” and “footware” are used interchangeably to refer to shoes. *See, e.g.*, Notice of reliance Exhs. 31-32, 34, 36-37, 39-40, 42-43, 45-49, 35 TTABVUE 44-72, 77-79, 82-87, 91-96, 99-103, 111-121.

Both parties submitted third-party registrations that include the term “WARE” in the mark. Applicant submitted 100 examples on the Principal Register without disclaimer or a showing of acquired distinctiveness under Section 2(f). A few representative examples are summarized below:¹⁷

Registration Number	Mark	Goods
2170016	ADVISORWARE	Computer software to help investment advisors conduct marketing and sales and develop and maintain databases related thereto (Class 9)
5486739	AIRWARE	Mission computer software for the command, control and operation of Unmanned Aerial Vehicles or Drones and for the autonomous waypoint navigation, take-off, landing, loiter, ... for controlling

¹⁷ App. notice of reliance Exhs. 4, 5, 6, 9, 10, 11, 13, 14, 15, 22, 26, 28, 62, 67, 68, 52 TTABVUE 52, 59, 66, 79, 83, 88, 97, 101, 106, 143, 159, 165, 359, 381, 385.

Registration Number	Mark	Goods
		Unmanned Aerial Vehicles or Drones (Class 9)
6672316	AIWARE	Downloadable software for analyzing, compiling, organizing, and monitoring audio, video and text data (Class 9) Software as a service; cloud computing featuring software for analyzing, compiling, organizing and monitoring audio, video and text data (Class 42)
3841093	AUTHENWARE	Computer software for biometric identification and verification (Class 9)
1961762	AUTHORWARE	Computer software for designing, developing and presenting business, educational, and multimedia programs, and instructional manuals for use therewith (Class 9)
3109355	BOARDWARE	Software that creates a scoreboard image used in aquatic sports that can be projected (Class 9)
5724692	BRAINWARE	Computer software for children and adults in the field of education, cognitive development, comprehension and retention enhancement (Class 9)
2320381	CALLWARE	Computer software for use in facilitating communication, namely, electronic mail, voicemail and facsimiles through


Registration Number	Mark	Goods
		use of local area networks and the global communication network (Class 9)
3736984	CAREWARE	Computer software for management of patients with chronic conditions, namely, HIV Aids, and instruction manuals distributed as a unit therewith (Class 9)
3482989	CONNECTWARE	Computer software for use in customer relationship management (CRM) (Class 9)
6551262	DEALERWARE	Downloadable computer software in the nature of a mobile application for use in managing and administrating vehicle fleets (Class 9)
5713242	DENTWARE	Computer software for management of a dental practice (Class 9)
2065192	PAYWARE	Payment card acceptance software (Class 9)
2521009	RATEWARE	Computer software for use in providing transportation pricing information to applications such as freight audit and payment, transportation analysis, and bill of lading systems (Class 9)
1779562	REMOTWARE	Computer programs for communications and creating and managing applications software (Class 9)
6162107	WARE	Downloadable software for locating, identifying,

Registration Number	Mark	Goods
		monitoring, analyzing, and reporting about assets and inventory inside of warehouses and distribution centers; downloadable software for the development and operation of robotic devices, drones, unmanned aerial vehicles ... downloadable computer software, computer hardware and robotic systems comprised primarily of robots, operating software, cameras, and sensors all for locating, identifying, monitoring, processing, and analysis of assets and inventory at warehouses and distribution centers ... (Class 9)

Opposer submitted several third-party registrations where the term “WARE” or the full word mark is disclaimed. A few representative examples are shown below:¹⁸

Registration No.	Mark	Goods or Services
5506059	πware (WARE disclaimed)	Computer operating programs, recorded; software utilizing bidirectional communication; computer peripheral devices (Class 9)

¹⁸ Opp. notice of reliance Exhs. 72, 73, 74, 80, 82, 84, 37 TTABVUE 7-35, 115, 144, 239.

5399241	BUSWARE	Computer software for monitoring and operating onboard data systems in the field of mass transit (Class 9)
6670393	 (ACCOUNTING WARE disclaimed)	Computer software development; Design, development and implementation of software (Class 42)
6147822	ZR WARE (WARE disclaimed)	Computer software for use in task management; Computer software services, namely, providing temporary use of on-line non-downloadable software for task management (Class 9)
2604258	FREEDOM WARE (WARE disclaimed)	Computer software for use in elevator systems maintenance and repair (Class 9)
3854657	MxL WARE (WARE disclaimed)	Computer application software for mobile phones; Computer firmware for providing a common application programming interface among multiple software services and abstracting multiple hardware devices functionality to a common framework (Class 9)

We first note there are no examples in Class 38, but as to those in the record we do not find the competing third-party registrations particularly helpful other than to underscore that each case must be decided based on its own facts and evidence. Third-party registrations are not conclusive on the question of descriptiveness; a mark that

is merely descriptive does not become registrable simply because other seemingly similar marks appear on the register. *See Nett Designs*, 57 USPQ2d at 1566 (holding ULTIMATE BIKE RACK merely descriptive of “bicycle racks” despite the presence of “ultimate” without a disclaimer in other marks on the Principal Register); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084, 1088 (TTAB 2001) (holding AGENTBEANS merely descriptive of computer software for use in software development and deployment where the Board found that changes in the vocabulary of the field reduced the relevance of third-party registrations). The question of whether a mark is merely descriptive or generic must be determined based on the evidence of record at the time registration is sought. *In re Consumer Prot. Firm PLLC*, 2021 USPQ2d 238, at *22 (TTAB 2021) (citing *In re theDot Commc’ns Network LLC*, 101 USPQ2d 1062, 1064 (TTAB 2011)).

The excerpts from third-party websites submitted by Opposer include examples of consumer exposure to wearable technology in shoes and use of FOOTWARE in connection with such products. A few representative examples are summarized below:¹⁹

The gigantic global tech conference CES 2020 opened January 8th in Las Vegas, Nevada. It is the world’s largest showcases of artificial intelligence, innovative footwear, and incredible wearable tech innovations. ASICS made an impressive showing at CES 2020 with some of the most incredible sneaker innovations. ... Sneaker Innovations: Smart Sneakers The 21st century brings incredible technology and smart devices to everyday wearable apparel and footwear. Evoride and ASICS paired up to

¹⁹ These printouts were submitted under notices of reliance and we do not include examples that do not have URL’s and dates. *Safer, Inc. v. OMS Invs., Inc.*, 94 USPQ2d 1031 (TTAB 2010).

present the very first smart-sneakers ... prototype. ... FootWARE Technology by TacSense ... FootWARE, designed by TacSense, promises to be the very first health-tracking sneaker. The shoe's unique design allows it to collect a number of important fitness-data points ... The shoe collects the information as the runner exercises. This health information can be shared with the athlete's health professionals. ... CES 2020 Sneaker innovations took center stage this year. Several companies were honored for their unique designs and inventions at the recent CES 2020 event.;²⁰

CES Consumer Technology ... CES 2020 INNOVATION AWARD PRODUCT FootWARE by TacSense Inc. ... FootWARE smart shoe is the world's first ever health-tracking smart shoe ... The shoe comes complete with a rechargeable Bluetooth circuit that connects to the latest FootWARE software where users can gain access to track and store their well-being anywhere at any time.;²¹

Ambit Technologies ... Footware ... With an Ambit footwear pos system, you will instantly improve your customer services by knowing what the customer wants, manage your inventory better and maximize your profits. ... Footware Features: easily manage your inventory ...²²;

Classify This Robot-Woven Sneaker With 3D-Printed Soles as "Footware" ... Adidas's Futurecraft.Strung running shoes explore complex geometries of support for the world's fastest feet;²³ and

When Footwear Becomes Footware > Adidas explores complex geometries of support for the world's fastest feet.²⁴

²⁰ Opp. notice of reliance Exh. 26, 35 TTABVUE 12-23 (www.sigridsays.com).

²¹ *Id.* Exh. 28, 35 TTABVUE 31-32 (www.ces.tech).

²² *Id.* Exh. 29, 35 TTABVUE 33-35 (<https://ambittechinc.com>).

²³ *Id.* Exh. 44, 35 TTABVUE 104-05 (spectrum.ieee.org).

²⁴ Opp. notice of reliance Exh. 63, 36 TTABVUE 38 (spectrum.ieee.org).

Applicant argues these examples do not show use of the term:

... to describe a set of technological capabilities comparable to [Applicant's] Platform. Nor does the evidence show that any of [Applicant's] competitors, any third-party shoe retailer, or [Opposer] for that matter, ever used "footware" in connection with a shoe product that integrates advanced sensors, computer chips, and technologies, and that is actually available to purchase in the United States.

App. brief, 60 TTABVUE 7.

These examples do not show use solely in connection with a "Platform" but they do show the word "footware" used in connection with footwear to message the idea of technology in a shoe, and in one case shows industry use of and consumer exposure to the term at a trade show in connection with footwear that is embedded with and connected to hardware and software that can communicate with mobile devices. Although, the use of the term in that case is arguably used in the manner of a trademark rather than simply descriptively.

Finally, the record includes the following dictionary definitions for WARE:

Manufactured articles of a specified type; Articles offered for sale;²⁵

An item that is offered for sale; An attribute or ability, especially when regarded as an article of commerce; *suff.* 2. Software²⁶

²⁵ OXFORD LIVING DICTIONARIES en.oxforddictionaries.com (2018). Opp. notice of reliance, Exh. 72, 37 TTABVUE 14 (part of file history of third-party registration). The dictionary definition with the date and URL is self-authenticating. To the extent necessary the Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or regular fixed editions. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff'd*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

²⁶ THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE www.ahdictionary.com (2018) (www.ahdictionary.com)); 37 TTABVUE 15.

And we take judicial notice of the following definitions of WARE and -WARE:

WARE 2. a specified kind or class of merchandise or of manufactured article (usually used in combination): silverware; glassware; see also -ware²⁷

-WARE 1. A combining form extracted from software, occurring as the final element in words that refer to a specified kind or class of software: spyware; shareware.²⁸

B. Analysis

The proposed mark is FOOTWARE a clear combination of the word FOOT (the specification) and the suffix WARE which, in the context of the computer goods and services, is defined as software and when used as a combining element specifies a “kind or class of software.” WARE is, at minimum, merely descriptive of computer software and hardware goods and services. The addition of FOOT in front of WARE informs the consumer of a feature (or specification) of the computer software, hardware and services, that they are used in connection with footwear, the phonetic equivalent of footwear. This case presents the unusual situation where the double entendre engendered by the suffix “WARE” unambiguously informs the consumer the computer software and hardware, and computer services, the “Platform,” are for use in connection with footwear. In both meanings FOOTWARE or FOOTWEAR the term merely describes a feature of the computer goods and services.

Taken as a whole this combination of FOOT + WARE does not result in a separate distinctive meaning. Even if Applicant is the first to use this particular combination

²⁷ Dictionary.com based on THE RANDOM HOUSE UNABRIDGED DICTIONARY (2024).

²⁸ *Id.*

of merely descriptive terms, that does not justify registration if the only significance conveyed by the term is merely descriptive. *See Fat Boys*, 118 USPQ2d at 1514.

As noted above and strenuously argued by Applicant, mere descriptiveness must be determined in relation to the goods or services for which registration is sought. *In re Omniome, Inc.*, 2020 USPQ2d 3222, at *10 (TTAB 2019) (citing *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979)). Therefore, the fact that the “Platform” could be used with other networked devices and FOOTWARE may have a different meaning in a different context is not controlling. *Id.* Applicant’s identification of goods is broadly worded and encompasses “computer hardware modules for receiving, processing, and transmitting data in Internet of things electronic devices,” “electronic devices and downloadable computer software that allow users to remotely interact with other smart devices,” “telecommunications services, namely, transmission of data by means of telecommunications networks, wireless communications networks and the Internet,” and “cloud computing featuring software for connecting operating and managing networked devices via wireless or wired networks,” used in connection with footwear. This is clearly admitted by Applicant (“[Applicant] does not deny that the FOOTWARE platform may be incorporated into a shoe,” App. brief, 60 TTABVUE 16). If the refusal of registration applies to any of the goods or services within the class, registration is refused as to the entire class. *See In re Chamber of Com. of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) quoting *In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005) (“A descriptiveness refusal is proper “if the mark is descriptive of any of the [goods or

services in the class] for which registration is sought.”). It therefore merely describes a feature, function and purpose of the computer goods and services, namely, that they may be used with footwear or shoes. Terms that identify the function or purpose of a product or service may be merely descriptive. *See, e.g., In re Zuma Array Ltd.*, 2022 USPQ2d 736, at *1-2, *15-17 (TTAB 2022) (SMART BEZEL merely descriptive of electronic sensor modules for controlling and integrating home automation systems in which the sensor modules were to be used on bezels); *see also In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) (SCREENWIPE generic for an anti-static cloth used for cleaning computer and television screens).

DECISION: We sustain the opposition to register FOOTWARE on the ground that it is merely descriptive.