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Mailed:
March 26, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re ToeSox, Inc.

Serial No. 77109709

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115 (Thomas V. Vlcek, Managing Attorney).

Before Seeherman, Zervas and Bergsman,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

ToeSox, Inc. (applicant), on February 16, 2007, filed an application to register **ToeSox** in standard characters for "socks" in International Class 25. The application was filed under Section 1(a) of the Trademark Act of 1946, 15 U.S.C. §1051(a). In response to a refusal under Section 2(e)(1) of the Trademark Act, applicant filed an amendment to seek registration on Supplemental Register. Upon applicant's amendment to the Supplemental Register, the examining attorney refused registration under Section 23 of

the Trademark Act, 15 U.S.C. § 1091, on the ground that applicant's proposed mark is generic and, as such, unregistrable. Trademark Manual of Examining Procedure ("TMEP") §§815.04 and 1209.02(a)(i) (6th ed. 2009) (when an applicant amends its application to the Supplemental Register in response to a Section 2(e)(1) descriptiveness refusal, if the examining attorney determines that the designation is a generic name for the applicant's goods, the statutory basis for such a refusal is Section 23 of the Trademark Act). See also *In re Controls Corp. of America*, 46 USPQ2d 1308, 1309 n. 2 (TTAB 1998).

Applicant appealed the refusal to register its proposed mark **ToeSox** on the Supplemental Register. Thus, the issue on appeal is whether applicant's proposed mark **ToeSox** is generic for "socks" and, therefore, incapable of registration on the Supplemental Register.¹

When a proposed mark is refused registration as generic, the examining attorney has the burden of proving genericness by "clear evidence" thereof. See *In re*

¹ Applicant's amendment to the Supplemental Register is a concession that the mark is merely descriptive. *Plus Products v. Star-Kist Foods, Inc.*, 220 USPQ 541, 543 (TTAB 1983); *Evans Products Co. v. Boise Cascade Corp.*, 218 USPQ 160, 162 (TTAB 1983); *In re Amerace Corp.*, 196 USPQ 193, 195 (TTAB 1977). Because the only issue on appeal is whether applicant's mark is generic and, therefore, incapable of registration on the Supplemental Register, we will not consider applicant's argument that its mark is suggestive.

Hotels.com, 573 F.3d 1300, 91 USPQ2d 1532, 1533 (Fed. Cir. 2009); *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987); and *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1111 (Fed. Cir. 1987).

The critical issue is to determine whether the record shows that members of the relevant public primarily use or understand the term sought to be registered to refer to the category or class of goods in question. *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986); *In re Women's Publishing Co. Inc.*, 23 USPQ2d 1876, 1877 (TTAB 1992). Making this determination "involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?" *Ginn*, 228 USPQ at 530. Evidence of the public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers and other publications. *See Merrill Lynch*, 4 USPQ2d at 1143; *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985).

We begin by finding that the genus of goods at issue in this case is adequately defined by applicant's identification of goods, namely, "socks." *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) ("[A] proper genericness inquiry focuses on the description of [goods or] services set forth in the [application or] certificate of registration"). As shown below, the excerpt from applicant's website submitted by the examining attorney further clarifies that the goods in this genus include toe-fitting socks (*i.e.*, socks that delineate the individual toes):



ToeSox brand toe socks are an innovative alternative to traditional athletic socks. ToeSox are a form-fitting second skin for your feet, forming to the contours of your foot while allowing the toes to separate.

www.toesox.com.² See *In re Web Communications*, 49 USPQ2d 1478, 1479 (TTAB 1998) (consulting services

² March 20, 2007 Office Action.

include assisting customers in communications through the Internet). See also *In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005), quoting, *Application of Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46, 48 (CCPA 1975) ("Our predecessor court...has stated that registration should be refused if the mark is descriptive of any of the goods for which registration is sought"); *In re Analog Devices, Inc.*, 6 USPQ2d 1808, 1810 (TTAB 1988), *aff'd*, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989) (unpublished) (registration is properly refused if the subject matter for registration is generic of any one of the goods for which registration is sought).

Turning to the second inquiry, the public's understanding of the term, the relevant public consists of the ordinary consumer interested in purchasing socks, including toe-fitting socks.

As noted above, the evidentiary burden of establishing that a term is generic rests with the USPTO and the showing must be based on clear evidence. *Merrill Lynch*, 4 USPQ2d at 1143. Based on the record described below, we find that there is clear evidence to support a finding that the relevant public, when it considers **ToeSox** in conjunction with socks, would readily understand the term

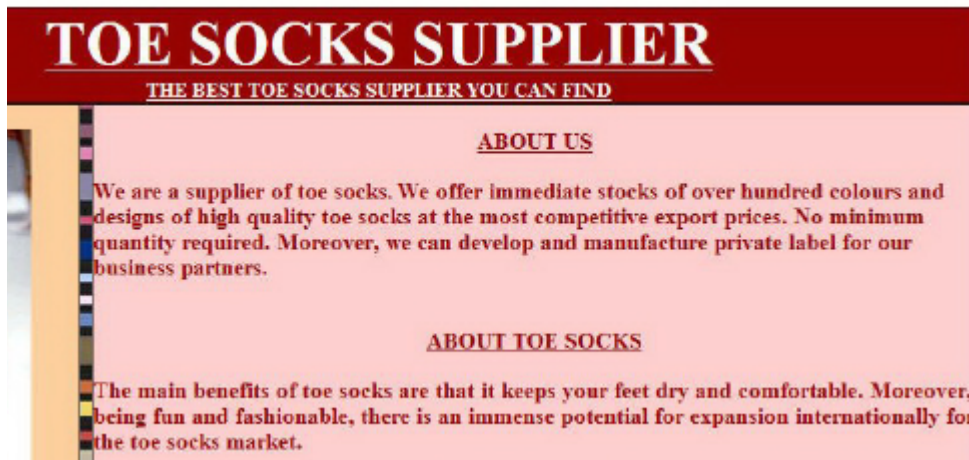
to identify a type of socks, namely, toe-fitting socks.

The examining attorney submitted the following evidence:

1. An entry from *Wikipedia* defining "toe socks" as "socks that have been knitted so that each toe is individually encased the same way that fingers are individually encased in a glove."³

2. An entry from the *About Shoes* website (<http://shoes.about.com>) entitled "Toes Socks: Why and Where to Buy Toe Socks." The author describes "toe socks" as "socks with toes."⁴

3. Website excerpts from 11 retailers advertising the sale of "toe socks."⁵ The websites use the term "toe socks" to identify socks with toes. Attached below is an excerpt from the *Toesocksupplier.com* website.



³ March 20, 2007 Office Action.

⁴ *Id.*

⁵ *Id.*

4. Copies of three registrations and five applications that use the term "toe socks" in the description of goods.⁶

5. An excerpt from the *Inthe80s.com* website entitled "Clothes of the Eighties, toe socks."⁷

Type of clothing: brightly stiped
(sic) socks w/a pocket for ea. toe.

6. An excerpt from *The Gremlin Wrangler* blog (<http://gremlinwrangler.blogspot.com>) posted Thursday, October 30, 2008, entitled "Toe Socks: A Deep and Meaningful Discussion."

I have a VERY important question to pose to you. You know, to encourage blogging interaction and whatnot.

Are you back? That's peachy.

Now.

Toe socks.

I'm not a big fan of socks usually. I'm hot natured and socks put me over the edge. But when the land of eternal flatness turns on me about this time of the year and I start freezing my tush off, I must wear the socks. And what a contradiction I am to myself to have anything on my feet, yet to so in lurve (sic) with socks that embrace each little piggy.

So. Toe socks. Discuss please.

⁶ *Id.*

⁷ January 29, 2009 Office Action.

Eighteen people posted comments on the blog. The postings show that the writers understand that toe socks are form fitting socks with separate pockets for each toe.

7. An excerpt from the *All Things Cupcake* website (allthingscupcake.com) featuring a blog regarding "Cupcake Toe Socks."⁸

CUPCAKE TOE SOCKS

December 24, 2007 | Filed in: **Clothing** by SuperWife

I was greeted this morning as I strolled in to work at the crack of noon, by a Christmas gift from my lovely boss. She found cupcake toe socks! Being a lover of cupcakes AND toe socks, she really hit the nail on the head with these! Judging by the "No Boundaries" tag, I'm guessing they're from Wal-Mart which means they probably didn't cost more than a few dollars. Awesome!



⁸ January 21, 2009 Office Action.

8. A second set of excerpts from websites from 14 retailers advertising the sale of "toe socks."⁹ The websites use the term "toe socks" to identify socks with toes.

9. A sampling of 440 news articles from the LexisNexis database referencing "toe socks."¹⁰ The following excerpts are representative:

Daily Camera (Boulder, Colorado)
June 8, 2009

Laura wears striped socks, toe socks, thigh-high socks, argyle and tie-dyed and homemade and theme socks for every occasions. ... In the summer, wear lightweight socks, thin tights or toe socks - preferably with ballet flats or May Janes and not flip-flops.

News & Record (Greensboro, North Carolina) April 10, 2009

. . . shop offers items such as beaded vintage handbags and modern, gently used clothes.

And on one side of the store: socks.

There are "toe socks" that resemble gloves for feet. There are socks for athletes and special ones for people with diabetes.

⁹ *Id.* We note that the excerpts from the EBay website and applicant's website were submitted in both this Office Action and the March 20, 2007 Office Action.

¹⁰ August 11, 2009 Office Action.

St. Petersburg Times (Florida) April 5, 2009)

. . . you're planning a trip with a long flight and have concerns about circulation in your legs, look to travel in toe socks offered by Injinji. The socks fit like gloves for your feet, with toes separated, and are made with Lycra fiber.

10. An advertisement from Walgreens for numerous products, including "Super Soft Toe Socks and Glove Set."¹¹

The examples of competitors' use of the term "toe socks" as the name of their goods is persuasive evidence that the relevant consumers perceive the term as generic. *Continental Airlines Inc. v. United Airlines Inc.*, 53 USPQ2d 1385, 1395 (TTAB 1999). Indeed, even applicant represents its products as "toe socks" in its website, as shown *supra* ("ToeSox brand toe socks").

The compression of the words "toe socks" into a single term, **ToeSox**, still conveys the commercial impression of two words. In other words, consumers would recognize the mark as consisting of the separate elements "Toe" and "Sox." See *In re Cox Enterprises Inc.*, 82 USPQ2d 1040, 1043 (TTAB 2007) ("THEATL is simply a compressed version of the descriptive term THE ATL without a space between the two words. Without the space, THEATL is equivalent in sound,

¹¹ *Id.*

meaning and impression to THE ATL and is equally descriptive of applicant's goods"); *In re Planalytics Inc.*, 70 USPQ2d 1453 (TTAB 2004) (GASBUYER merely descriptive of providing on-line risk management services in the field of pricing and purchasing decisions for natural gas; the absence of the space does not create a different meaning or perception of the term). The *Planalytics* decision, 70 USPQ2d at 1455-56, also cited the following cases in which, although a space was deleted between the words, the combined term remained descriptive:

In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) (SCREENWIPE generic for a wipe for cleaning television and computer screens); *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978) (GASBADGE at least descriptive for gas monitoring badges; three judges concurred in finding that term was the name of the goods); *In re Orleans Wines, Ltd.*, 196 USPQ 516 (TTAB 1977) (BREADSPRED descriptive for jams and jellies that would be a spread for bread); *In re Perkin-Elmer Corp.*, 174 USPQ 57 (TTAB 1972) (LASERGAGE merely descriptive for interferometers utilizing lasers).

Also, consumers readily perceive "sox" to be a misspelling of "socks." In this regard, the examining attorney introduced evidence that "sox" is informally defined as the plural of "socks." *MSN.Encarta Dictionary* (<http://msn.com>) and *Yahoo!Education dictionary*

(<http://education.yahoo.com>).¹² It is settled that a mere misspelling of a generic term does not negate its genericness. See, e.g., *In re Stanbel Inc.*, 16 USPQ2d 1469 (TTAB 1990), *aff'd*, 20 USPQ2d 1319 (Fed. Cir. 1991) (ICE PAK held generic for ice packs); *In re Hubbard Milling Co.*, 6 USPQ2d 1239 (TTAB 1987) (MINERAL-LYX held generic for mineral licks for feeding livestock).

Applicant argues that the relevant consumers are limited to people who practice yoga and pilates.

Applicant is one of the nation's top brands of yoga socks, which are worn when practicing yoga and/or pilates. As such, the consuming public here consists of people who practice yoga and/or pilates, and the Examining Attorney must show these people understand "TOESOX" to refer to socks in general.¹³

However, applicant's description of goods is not limited to socks for use in connection with yoga and pilates, and we may not insert such a limitation in the description of goods. See *in re BetaBatt Inc.*, 89 USPQ2d 1152, 1156 (TTAB 2008), *citing In re Theatre Clubs Co.*, 9 USPQ2d 1660, 1662 (TTAB 1998) (since applicant's identification of services does not restrict their location to sites away from the actual place of performance, it is presumed that such

¹² August 11, 2009 Office Action.

¹³ Applicant's Brief, p. 2.

services may be offered at the site of performance or away from it). It is well settled that the Board may not read unstated restrictions into the goods. In the absence of a restriction in the description of goods as to the type of goods, channels of trade, or classes of purchasers, the presumptions afforded to a registration under Section 7(b) of the Trademark Act of 1946 include a presumption of use on all the goods encompassed by the description of goods in all of the normal markets or channels of trade for such goods and services to all potential purchasers therefor. *Cf. Autac Inc. v. Viking Industries, Inc.*, 199 USPQ 367, 374 (TTAB 1978), and cases cited therein. Because the description of goods is unrestricted, the products identified in the application include all consumers of socks, not just consumers of socks for use in connection with yoga and pilates. Moreover, practitioners of yoga and pilates are members of the general public, and would buy socks for regular use as well.

Applicant argues that **ToeSox** is not generic because that word or term does not appear in any dictionaries. In this regard, it is well settled that the fact that a term is not found in a dictionary is not controlling on the question of registrability if the examining attorney can show, as she did in this case, that the term has a well

understood and recognized meaning. See *In re Central Counties Bank*, 209 USPQ 884, 888 (TTAB 1981); *In re Orleans Wines, Ltd.*, 196 USPQ 516 (TTAB 1977).

Finally, applicant asserts that its extensive advertising and promotional efforts rebut any finding that **ToeSox** is generic.¹⁴ Applicant cited *In re America Online Inc.*, 77 USPQ2d 1618 (TTAB 2006), for the proposition that “[s]ignificant amounts of marketing and advertising, and adequate policing of a mark negate a finding of genericness.”¹⁵ Although such evidence must be considered in determining whether a term is generic, in this case, applicant did not submit evidence demonstrating significant amounts of marketing and advertising and policing.

The evidence that applicant submitted includes excerpts from its website. However, those web pages use the term “toe socks” generically. For example, applicant touted the fact that it is “using 100% Organic Cotton in our toe socks,”¹⁶ and it entitled another entry in its website as “Yoga Toe Socks.”¹⁷

¹⁴ Applicant’s Brief, p. 2.

¹⁵ Applicant’s Brief, p. 2.

¹⁶ Applicant’s July 20, 2009 request for reconsideration.

¹⁷ Applicant’s December 29, 2008 response.

Applicant also submitted a review of its product in the *1greenproduct.com* website, but it is not clear how many, if any, people have seen this website as there were no comments in the space provided in the website to respond to the review.¹⁸

Finally, applicant submitted excerpts from websites identifying socks with toes as "Yoga Socks," presumably to show that this is the generic name for socks with toes. However, a product may have more than one generic name. *In re Sun Oil Co.*, 426 F.2d 401, 165 USPQ 718, 719 (CCPA 1970) (Rich, J., concurring) ("All of the generic names for a product belong in the public domain") (emphasis in the original); *Roselux Chemical Co., Inc. v. Parsons Ammonia Company, Inc.*, 299 F.2d 855, 132 USPQ 627, 632 (CCPA 1962) (a product may have more than one common descriptive name).

In view of the foregoing, we find that the examining attorney has met her burden of establishing that **ToeSox** is generic and incapable of registration for "socks."

Decision: The refusal to register is affirmed.

¹⁸ Applicant's July 20, 2009 request for reconsideration.