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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77109709
Applicant	ToeSox, Inc.
Applied for Mark	TOESOX
Correspondence Address	Dana B. Robinson TechLaw LLP P.O. Box 1416Carlsbad CA 92011 La Jolla, CA 92038 UNITED STATES dana@danarobinson.com
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Filer's Name	Dana B. Robinson
Filer's e-mail	Dana@TechLawLLP.com, deborah@techlawllp.com
Signature	/Dana B. Robinson/
Date	10/09/2009

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application of: ToeSox, Inc.)
Serial No.: 77109709)
Filed: February 16, 2007)
Trademark: TOESOX)
)
)

APPEAL BRIEF

Dana B. Robinson
TechLaw LLP
P.O. Box 1416
La Jolla, CA 92038
(858) 488-2545

Introduction

The Examining Attorney issued a final refusal for the registration of Applicant's proposed mark, "TOESOX" and denied request for reconsideration. Applicant believes this refusal was in error. Legal precedent of this Board holds that generic uses by some third parties do not automatically render a mark generic, since such uses are not always indicative or probative of how relevant consumers view the mark at issue. Applicant's extensive advertising and marketing activities demonstrate consumer recognition and refute a finding of genericness. As such, Applicant maintains the proposed mark, "TOESOX" is not generic.

The Examining Attorney's Burden

The genericness inquiry must focus on the description of goods set forth in the application. *Magic Wand, Inc. v. RDB, Inc.*, 940 F.2d 638, 640 (Fed. Cir. 1991). Applicant's goods as set forth in the application are socks. To show genericness, the Examining Attorney must first establish the class or genus of goods at issue. Next, the Examining Attorney must show that the term sought to be registered is understood by the consuming public to refer to that genus of goods. *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 989-90, 228 USPQ 528, 530 (Fed. Cir. 1986). As applied here, the Examining Attorney must show that the relevant consuming public understands TOESOX to refer to socks. The Examining Attorney bears the burden of showing a proposed mark is generic by clear evidence. *See TMEP 1209.01(c)(i)*(4th ed. 2005). Specifically, the Examining Attorney must make a "substantial showing based on clear evidence of generic use." The Examining Attorney here has not made such a showing.

The Proposed Mark, TOESOX, Is Not Generic

The relevant consuming public consists of individuals who purchase or may purchase the goods for which registration is sought. *Id.* Widespread generic use of a mark or term by irrelevant non-consumers does not render a mark generic. *In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 1571 (Fed. Cir. 1987); *See generally, In re America Online Inc.*, 77 USPQ2d 1618, 1623 (TTAB 2006). In *Merrill Lynch*, a LEXIS NEXIS search generated many examples of generic usage of the term "CASH MANAGEMENT ACCOUNT." Even so, this was held to be insufficient to show the mark was generic to people in the brokerage industry. *Id.* Similarly, in *America Online*, despite numerous generic uses of the term "INSTANT MESSENGER,"

by irrelevant sources, the Board found that AOL's licensing, enforcement and advertisement efforts demonstrated that relevant consumers understood "INSTANT MESSENGER" to be a service offered by America Online. *America Online Inc.*, 77 USPQ2d 1618 at 1621.

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.

Although the Examining Attorney has submitted evidence of third party retailers' generic uses of the term "toe socks," this is not dispositive. Such evidence is not probative on the matter of whether the relevant consumers understand "TOESOX" to refer to socks as a class of goods. Similarly, a Wikipedia article written by an irrelevant third party using the term "toe socks" generically does not establish that the consumers at issue here believe "TOESOX" to refer to socks. The Examining Attorney states in the denial of reconsideration that the evidence shows how "the public perceives the term." However, it is incorrect to focus on general public perception; this is not the proper inquiry. The correct legal standard requires an examination of the relevant consuming public. *H. Marvin Ginn Corp.*, 782 F.2d 987 at 989-990.

The Examining Attorney also cites to some dictionary definitions of the term "sox" in contending Applicant's mark is generic. For the same reasons discussed above, the perception of non-consumers is not probative on the matter. Further, even if dictionary definitions were to be considered, the term "TOESOX" does not appear in any dictionary. A search for "TOESOX" generates no results when entered into dictionary.com, Merriam-webster.com, or dictionary.cambridge.org. On the other hand, when the term "TOESOX" is entered into a Google search, most results refer to Applicant's website or products.

Like the examples of "CASH MANAGEMENT ACCOUNT" and "INSTANT MESSENGER," some third-party generic use does not automatically render the mark generic. The present case is analogous to *America Online* and *Merrill Lynch*; while the Examining Attorney has submitted some evidence of generic use, these sources are not probative on whether the relevant public understands the mark to refer to socks in a generic sense. Legal precedent of this Board requires the evidence show generic use by relevant consumers; generic use by other third parties is not probative on the matter.

Extensive Advertising and Promotional Efforts Rebut a Finding of Genericness

Significant amounts of marketing and advertising, and adequate policing of a mark negate a finding of genericness. *See generally, In re America Online Inc.*, 77 USPQ2d 1618, 1623 (TTAB 2006). Even when there are *numerous* generic uses of a

mark, genericness may be refuted if there is substantial advertising that demonstrates users understand the mark to be indicative of source. *Id.* An applicant may offset evidence of generic use by showing proper trademark use and trademark recognition by consumers, publishers and third parties. *Id.* In regard to such evidence, declarations by Applicant may suffice to show the extent of use, consumer recognition, advertising expenditures and licensing activities. *See e.g., In re America Online Inc.*, 77 USPQ2d 1618 at 1621. In *America Online*, the Examining Attorney made a prima facie showing that “INSTANT MESSENGER” was used generically to refer to several kinds of communication, including online chat and text messaging. The evidence contained articles that referred to “using Microsoft’s instant messenger” and other general, generic uses that were unrelated to AOL’s (the applicant) mark. The Applicant there performed a NEXIS News Group search, which indicated about 39 percent of articles mentioning “INSTANT MESSENGER” did not use it in conjunction with AOL. However, Applicant stated in a declaration it had licensed its mark to various third parties, had engaged in trademark enforcement, and had spent a substantial amount of money promoting its “INSTANT MESSENGER” mark. *Id.* at 1621.

The Board acknowledged the Examining Attorney had shown clearly generic uses of the term “INSTANT MESSENGER” but nevertheless held that AOL’s showing of significant advertising and trademark policing adequately refuted a finding of genericness. The Board relied on the long-standing rule that “the critical issue is whether members of the relevant public primarily or understand the terms sought to be protected to refer to the genus of goods or services in question.” *Id.* at 1622. The Board also noted AOL’s licensing of its trademark to other parties was probative in rebutting genericness. *Id.* at 1621.

Applicant has expended significant resources establishing the TOESOX trademark. Like America Online, Applicant has advertised through various media, including the internet, magazines and newspapers. As a result of extensive advertising, relevant consumers recognize TOESOX as an indicator of source, and do not consider TOESOX to be a generic term for all socks. As in the *America Online* and *Merrill Lynch* cases, the fact some third parties may use the term generically is not dispositive, since relevant consumers understand TOESOX to be a trademark. Although the Examining Attorney has given one example of a third-party retailer’s generic use of the term “toe socks,” the Board in *America Online* held that even though 39 percent of articles mentioning “INSTANT MESSENGER” used it generically, genericness was refuted by advertising efforts and consumer recognition. Here, one example of generic use is far from sufficient to make a substantial showing by clear evidence that the proposed mark is generic to relevant consumers.

In addition, Applicant is also like AOL in that Applicant was the first to attempt to register the term at issue, and has continuously used the proposed mark over the last five years. Continuous use in combination with advertising efforts may have attributed to the popularity of the term and caused other people to use it generically. Even so, like

AOL, sufficient advertising and publicity by Applicant indicate even if the term can be used generically, relevant consumers view it as a trademark for Applicant's products.

The Examining Attorney states in her refusal for reconsideration that "regardless" of Applicant's assertions of considerable efforts in advertising and promotions, "the applied-for mark is generic, and generic marks may never be trademarks." However, this approach completely ignores the Board's precedent in *America Online*, which very clearly indicates that extensive advertising, promotion and licensing of a mark can refute a finding of genericness. The Examining Attorney essentially contends that irrelevant third party usage of "TOESOX" is probative on whether the *consuming public* considers the mark generic, while Applicant's advertising efforts directed at promoting the product to the *consuming public*, is not probative. This simply cannot be the case.

The Proposed Mark Functions as a Source Indicator

Generic trademarks are incapable of functioning as trademarks. *Dan Robbins & Associates, Inc. v. International Association of Fire Chiefs, Inc.*, 599 F.2d 1009, 1014, 202 USPQ 100, 105 (CCPA 1979). A mark that may not meet all requirements for registration on the Principal Register may still be registered on the Supplemental Register if it is "capable of distinguishing the applicant's goods." *In re Bush brothers & Co.*, 884 F.2d 569, 570 (Fed. Cir. 1989). The proposed mark is capable of distinguishing Applicant's goods in the marketplace and thus, at the very least, should be allowed registration on the Supplemental Register.

The Proposed Mark is Suggestive

A mark is suggestive if it is indicative of qualities of a product and requires a degree of effort by the consumer to come to conclusions about the nature of the good. *See Playtex Prods v. Georgia-Pacific Corp.*, 390 F.3d 158. A mark that directly conveys some information about a product is still suggestive if it is likely to conjure up other arbitrary connotations. *McCarthy on Trademarks* §11:71.

Applicant's mark, TOESOX is at the very least both suggestive and descriptive. TOESOX does not immediately evoke any connotations or certain ideas about the goods being offered. TOESOX is a suggestive term that requires imaginative effort by the consumer to come to a conclusion regarding the nature of the goods. TOESOX may suggest a product that protects the toes or feet, but the actual purpose or function of Applicant's goods is not directly expressed in the mark. TOESOX is thus suggestive and registration even on the Principal Register should be allowed.

Conclusion

For the foregoing reasons, Applicant maintains TOESOX is not generic; rather it is suggestive of Applicant's goods, and is capable of functioning as a source indicator. The Examining Attorney has not met the burden of showing that relevant consumers consider TOESOX to be generic of Applicant's goods by clear and convincing evidence. As such, Applicant respectfully requests the generic refusal be withdrawn and the application proceed to registration on the Principal Register.

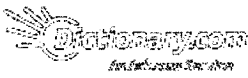
Respectfully Submitted,

TOESOX, INC.

By: 

Dana B. Robinson
Attorney for Applicant

Dated: October 5, 2009



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