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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/109709

MARK: TOESOX



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: ToeSox, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

TOES-001 TM

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	ToeSox, Inc.	:	
Trademark:	TOESOX	:	BEFORE THE
			TRADEMARK TRIAL
Serial No:	77109709	:	AND
Attorney:	Manuel F de la Cerra	:	APPEAL BOARD
Address:	The Law Office of Manuel de la Cerra 6885 Catamaran Drive Carlsbad CA 92011	:	ON APPEAL

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the Trademark Examining Attorney's final refusal to register the trademark TOESOX for goods in International Class 25 on the grounds that the mark, under Trademark Act Section 23(c), 15 U.S.C. Section 1091(c), is generic for the goods.

I. FACTS

Applicant, ToeSox, Inc., applied for registration on the Principal Register of the trademark TOESOX for “socks” in International Class 25. The Trademark Examining Attorney refused registration under Section 2(e)(1) of the Trademark Act based on descriptiveness. Subsequently, the applicant amended its application to the Supplemental Register.¹ This appeal now follows the Trademark Examining Attorney’s final refusal for registration on the Supplemental Register on the grounds that the applied-for mark is generic for the identified goods under Section 23(c) of the Trademark Act.

II. THE APPLIED-FOR MARK IS BOTH THE CLASS NAME OF AND HOW CONSUMERS CALL FOR THE GOODS SUCH THAT THE APPLIED-FOR MARK IS GENERIC UNDER SECTION 23(C) OF THE TRADEMARK ACT

Sections 1, 2 and 45 of the Trademark Act permit registration of a trademark when the mark is used in commerce. A “trademark” is defined as:

The term “trademark” includes any word, name, symbol, or device, or any combination thereof—

- (1) used by a person, or
- (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act,

to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and *to indicate the source of the goods, even if that source is unknown.*

¹ On page 4 of its brief, the applicant argues that its mark is suggestive and should be allowed on the Principal Register. In its response dated September 19, 2007, the applicant amended its application to the Supplemental Register without reservation. Accordingly, whether the mark is permissible on the Principal Register is not at issue here.

15 U.S.C. §1127 (emphasis added).

Where a mark is not registrable on the Principal Register, registration will be granted on the Supplemental Register for “any matter that as a whole is not functional... [and] such mark must be *capable of distinguishing* the applicant’s goods...” Trademark Act Section 23(c), 15 U.S.C. §1091(c) (emphasis added).

Incapable matter, however, is not registrable on the Supplemental Register. Only matter that primarily serves as a source indicator can be registered as a mark, and any matter that does not identify and distinguish the source of a person’s goods cannot function as a trademark as required by the Trademark Act. “[A]n unprotectable ‘generic name’ in trademark law... must be the name of the same product or service which it is alleged to identify the source of.” J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §12:1 (4th ed. 2009). Accordingly, a generic term cannot be registered as a trademark, because, by definition, generic terms are incapable of indicating source. *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 1569 (Fed. Cir. 1987). There is no such thing as a “generic trademark.” “Either a designation is protectable as a ‘mark’ or it is a ‘generic name’ of a thing or service, in which case it can never be a protectable mark. A given designation cannot be both at once.” *McCarthy*, §12:1.

The test for determining whether an applied-for mark is generic is a two-part inquiry. First, what is the class or genus of the goods? Second, is the applied-for mark understood by the relevant public primarily to refer to that genus of goods? *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 990

(Fed. Cir. 1986). The Office has the burden of proving genericness by “clear evidence” of the public’s understanding thereof. *Merrill Lynch* at 1571.

A. The genus of the applicant’s goods is toe socks.

The genus of the applicant’s goods is also known as the class name for or category of the goods. Here, the genus of the applicant’s goods is “toe socks.” The applicant broadly defines the genus as “socks.” Applicant’s Brief (“App. Br.”) p. 2. In determining the genus of the goods, it is appropriate to review the applicant’s web site for context. *See In re Steelbuilding.com*, 415 F.3d 1293, 1298 (Fed. Cir. 2005). Printouts from the applicant’s web site reveal no goods are offered by the applicant other than toe socks. Office Action (“OA”) 1/21/09 p. 49 and OA 3/20/07 pp. 50-53.² The context of the applicant’s socks is limited to “toe socks” and not to socks in general. Indeed, the applicant identifies its own goods by the term “toe socks.” (“Yoga **Toe Socks**” and “wearing **toe socks** on a regular basis can liberate those jammed feet”). Applicant’s Response (“App. Resp.”) 12/29/08 p. 3. Accordingly, the appropriate genus of the goods is “toe socks.”

B. The meaning of TOESOX to the relevant public is toe socks.

a. Relevant Public

Identification of the relevant public is necessary to understand how consumers of the goods perceive the term in question. In this case, the relevant public is the general

² The specified page numbers pertain to the March 20, 2007, January 21, 2009, and August 11, 2009, Office actions and to the page in the electronic record (TICRS or TDR) on which the reference can be found. The Office action, in its entirety, is page 1 and the supporting evidence begins with page 2.

public customarily understood to purchase toe socks, including athletes and females at large. This is shown through the extensive evidence of record, including print newspaper advertisements of major retailers, Lexis article excerpts from across the nation, major national and specialty on-line retail store sites and blogs.

The applicant proposes to limit the relevant public to “people who practice yoga and/or pilates.” App. Br. p. 2. The applicant’s web site, however, states its toe socks are for all types of activities including “yoga, pilates, dance and martial arts, as well as any other barefoot activity...” and are “[g]reat to wear in your athletic shoes or sandals.” OA 1/21/09 p. 49. The applicant’s touting of the wide-ranging uses of its toe socks shows that the relevant public is much broader than the applicant’s narrow “people who practice yoga and/or pilates.” App. Br. p. 2.

Taken in conjunction with the examining attorney’s extensive evidence of record, it is clear that the relevant public is not limited to only one narrow portion of the applicant’s own consumers; it is the general public customarily understood to purchase toe socks. Evidence of the relevant public’s understanding of a term may be obtained from any competent source including consumer surveys, dictionary definitions, newspapers and other publications. *See In re Reed Elsevier Properties Inc.*, 482 F.3d 1376, 82 USPQ2d 1378, 1380 (Fed. Cir. 2007); *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 1559 (Fed. Cir. 1985). The evidence of record includes print advertisements and web site printouts from national retailers, such as, Walgreens, Wal-Mart and Amazon, and clearly shows that “toe socks” is the term by which the relevant public consistently calls for the goods and understands the goods to be called.

b. Meaning of TOESOX

Toe socks are a type of sock that individually encase each toe in the same way a glove encases each finger. The term “toe” is defined as “digit of human foot” and “the part of a sock, shoe, or boot that covers the digits of the foot.” OA 3/20/07 pp. 5 and 7. The term “sox” is defined as “plural of sock,” (OA 8/11/09 pp. 2 and 4), and “sock” is defined as a “short stocking reaching a point between the ankle the and the knee” and “a soft, usually knitted covering for the foot and ankle that may reach as high as the knee. It is usually worn inside a shoe.” OA 3/20/07 pp. 2 and 4. “Sox” is not a phonetic equivalent or novel spelling of “socks;” it is a standard spelling of the plural of the word “sock.” Indeed, the applicant itself uses socks and sox interchangeably on its web site (“Yoga **Toe Socks**,” “wearing **toe socks** on a regular basis can liberate those jammed feet” and “walk around in your comfortable, toe-spreading **sox**”). App. Resp. 12/29/08 p. 3. Thus, the applied-for mark TOESOX is the same as or equivalent to “toe socks.”

Even if it is determined that “sox” is not a legal equivalent of “socks,” the terms are certainly phonetic equivalents. The phonetic equivalent of a generic term is also generic. *See In re Hubbard Milling Co.*, 6 USPQ2d 1239 (TTAB 1987).

The definition that toe socks are socks that individually encase each toe is buttressed by the Wikipedia article 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.” OA 3/20/07 pp. 10-11. The toe sock in the photograph of the Wikipedia article closely resembles the toe socks shown on the applicant’s web site. The photographs from Wikipedia and the applicant mirror each one of the thousands of toe socks shown in photographs in the record.

Additionally, the extensive evidence of record also shows that “toe socks” is the name by which both consumers and retailers call this type of sock. The seventy-three *pages* of Lexis article excerpts attached to the August 11, 2009, denial of request for reconsideration show the general public purchasing toe socks from the New Orleanian excited to purchase anything from the newly rebuilt corner store post-Hurricane Katrina (document 27), to those reliving the 1970s (documents 20, 24, 53, 98, 110, documents 1 and 29 of the second set), to athletes (documents 8, 9, 61, 67, 73, 102, 134) and those with medical conditions (documents 8 and 10), and to people who simply enjoy wearing unusual socks (documents 2, 45, 57, 81, 108, second set document 36). For example:

“...I walked in the kitchen door, laden with spontaneous purchases (electric toothbrush, blue **toe socks**) from the newly rebuilt store at the corner of West End and Robert E. Lee boulevards.” Renée Peck, *Keeping it All in The Neighborhood*, TIMES-PICAYUNE, November 29, 2008, at 99;

“I demanded tie-dyed bellbottoms, **toe socks**, buffalo sandals and rhinestone blouses. Every morning it was a fight.” Gina Phillips, *The Hands of One Live on in the Heart of Another*, THE ASHEVILLE CITIZEN-TIMES, September 30, 2006, at 5A;

“‘I do wear the same **toe socks** every game. I got them from a teammate earlier in the season,’ Hoffpauir said. **Toe socks** are like gloves... ..Springfield manager Chris Maloney might want to put in a request for the front office to buy **toe socks** in bulk for next year’s team.” Amanda Stone, *Hoffpauir Finding Comfort*, SPRINGFIELD NEWS-LEADER, July 19, 2006, at 1D;

“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.” Jennifer Fernandez, *Keep Your Socks On*, NEWS & RECORD, Greensboro Edition, April 10, 2009, at B1;

“blockages in the lymphatic system prevent lymph fluid from draining properly. As a result she must wear compression stockings and **toe socks** at all times - except when in the shower - to prevent swelling. But the condition hasn't hampered her playing ability. The centerfielder

is...” Kimberley A. Martin, *She Refuses To Let It Stop Her*, NEWSDAY, April 21, 2009, at A52;

“in quilted corduroys, stickers smacked on his bike helmet, hippied-out down to his Birkenstocks and rainbow **toe socks**.” Kathryn Lange, *W-I-N-N-E-R*, METROLAND, June 26, 2008, at 34;

“the wheels were set in motion for students in grades K-5 to start collecting silly socks. From **toe socks**, and Batman to Sponge Bob and zoo animals - the kids decided the sillier the better.” Sherry Mitchell, *Silly Socks Turn into Christmas Project for Students*, THE TENNESSEAN, December 26, 2007, available in Micro; and

“‘a ridiculous outfit,’ Leaman said. Haneman was decked out in a bath towel with straps, mismatched **toe socks** and fuzzy pink antennas.” Roxanne Todd, *Seniors Go To Highest Bidders*, LANCASTER NEW ERA, May 3, 2006, at B9.

The evidence of record shows that toe socks are available from a variety of major national retailers, such as:

Walgreens: printed newspaper circular showing a “Super Soft **Toe Socks** and Glove Set” (OA 8/11/09 p. 5);

Wal-Mart: web page printout showing “Women’s Tree and Presents **Toe Socks**” along with a Merry Poodle **Toe Socks**, Striped **Toe Socks**, Snowman **Toe Socks** and Penguin Wide Stripe **Toe Socks** (OA 1/21/09 pp. 11-12);

Amazon: web page printout featuring “ToeSox Yoga/Pilates **Toe Socks**,” “ToeSox Sport/Sandal **Toe Socks**,” “Urban Boundaries Fuzzy Crew Striped Fashion **Toe Socks**,” “Feelmax Sport **Toe Socks**” and “SOX8 Black and White Striped High **Toe Socks**” (OA 1/21/09 pp. 33-35); and

eBay: web page printouts featuring a plethora of **toe socks** offered in 345 different auctions on January 21, 2009, and 410 auctions on March 30, 2007 (OA 1/21/09 pp. 19-32 and OA 3/20/07 pp. 37-40).

This retailer and newspaper evidence tends to show that a large segment of the general population is exposed to the term toe socks.

The record also includes numerous printouts from specialty retailers, some of whom sell only toe socks.

Toe Socks Supplier (www.**toesocks**supplier.com) is a supplier of toe socks for men, women and children with over a hundred colors and designs (OA 1/21/09 p. 2);

Likewise, **Toe Socks** & More (www.toehugger.com) specializes in all types of toe socks (OA 1/21/09 p. 15); and

Sock retailer AbsoluteSocks.com features an entire section of novelty toe socks (OA 1/21/09 p. 50).

Additionally, as shown by the evidence of record, the U.S. Patent & Trademark Office has issued three trademark registrations and has five pending applications for the goods “toe socks,” including:

U.S. Registration No. 3013601 SKI TECH for, *inter alia*, gloves, mittens, scarves, **toe socks**, socks, booties, leg warmers, slipper socks, tights (OA 3/20/07 p. 54);

U.S. Registration No. 3056541 SIDECCA WHERE YOU FIT IN for, *inter alia*, retail store and online store retail services featuring, Hosiery namely leg warmers, panty hose, socks, tights, **toe socks** (OA 3/20/07 p. 59); and

U.S. Registration No. 3115364 MERRY TOES for, *inter alia*, socks, stockings, tights, **toe socks**, zoris (OA 3/20/07 p. 66).

These registrations and applications show that the applicant’s competitors consider “toe socks” to be the generic name for an item of clothing.

All of this evidence is in addition to many blogs written about toe socks. In The Gremlin Wrangler blog, the author has a “deep and meaningful discussion” about toe socks. Eighteen comments are logged, almost all of which specifically recall their own toe socks or indicate a desire to purchase toe socks. OA 1/21/09 p. 38. Similarly, the

blog All Things Cupcake dedicates an entire entry to a recent gift of “Cupcake Toe Socks.” OA 1/12/09 p. 36.

The overwhelming evidence of record clearly shows that “toe socks” is a type or category of socks. As the evidence of record shows, the term “toe socks” is the common name by which both consumers and retailers, the relevant public, call this type of sock. The evidence also shows that toe socks is the only name that identifies this type of sock. The applied-for mark is a legal equivalent of “toe socks,” and the identified goods are socks. Thus, the applied-for mark TOESOX is generic.

Because the evidence of record clearly shows that toe socks is the only name by which consumers and retailers call socks that individually encase each toe, this evidence shows clear competitive need for the term toe socks. Because this mark is generic, businesses and competitors to have the freedom to use common generic language when merely describing their own goods to the public in advertising and marketing materials without fear of infringement. *In re Abcor Development Corp.*, 588 F.2d 811, 813 (CCPA 1978).

Citing *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567 (Fed. Cir. 1987), the applicant argues that this evidence of “some third-party generic use” does not render its mark generic. The facts here differ. Most significantly, in *Merrill Lynch*, all of the evidence was issued after Merrill Lynch began using its mark in commerce and Merrill Lynch provided substantial evidence of acquired distinctiveness. Neither are facts here. Furthermore, the evidence of record showing genericness is not of an insignificant amount. Contrary to the applicant’s assertion that there is only “one example of a third-party retailer’s generic use of the term ‘toe socks,’” the evidence of

record is voluminous and consistent, clearly showing that the applied-for term TOESOX is generic for the goods.

The applicant also argues that its “extensive advertising and promotional efforts rebut a finding of genericness.” App. Br. pp. 2-4. No amount of advertising or promotion can make a generic term a trademark. A generic term can never become a trademark. *See H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 989 (Fed. Cir. 1986).

III. CONCLUSION

Because the applied-for mark is the class of goods at issue and the name by which consumers call for the identified goods, the mark is generic. For the foregoing reasons, the refusal to register under Section 23(c) of the Trademark Act should, therefore, be affirmed.

Respectfully submitted,

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